

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN M. BEAKES,
GARY E. CLEMENZ,
PATRICK A. DOLGAS,
MARK E. HEATON,
and LAWRENCE E. NEWMAN

Appeal No. 1998-1192
Application 08/456,093

ON BRIEF

Before ABRAMS, FRANKFORT, and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Pursuant to 37 CFR § 1.197(b), John M. Beakes et al.
request rehearing (i.e., reconsideration) of our decision

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rendered July 18, 2000 (Paper No. 26) to the extent that we sustained the examiner's 35 U.S.C. § 102(e) rejections of claims 13 through 19, 41 through 45, 60 and 61.

The request focuses on independent claim 13 (from which claims 14 through 19 depend), independent 41 (from which claims 42 through 45 depend) and independent 60 (from which claim 61 depends).

Claim 13 recites a stator winding machine comprising, inter alia, "a roller for providing relative motion between said winding station and a first stator support rotated into position adjacent said winding station." In our decision, we found that this roller limitation "reads on the Santandrea '228 roller 47 which provides relative motion between the winding station and a first stator support rotated into position adjacent said winding station" (page 11). In their request for rehearing (see page 2), the appellants contend that we failed to properly interpret the roller limitation in light of their disclosure which describes roller 182 as supporting a winding head for movement along a base relative

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to a stator support. Presumably, the appellants would have us read these limitations into claim 13 to distinguish over the stator winding machine disclosed by Santandrea '228. It is well settled, however, that during patent examination claims are to be given their broadest reasonable interpretation consistent with the underlying specification without reading limitations from the specification into the claims. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). When given its broadest reasonable interpretation consistent with the specification, the roller limitation in claim 13 does indeed read on the roller 47 disclosed by Santandrea '228. The narrower interpretation urged by the appellants rests on an improper reading of limitations from the specification into the claim.

Claims 41 and 60 recite stator winding methods comprising, inter alia, the step of "winding" a stator with at least one coil of wire. In our decision (see pages 16, 17 and 21), we determined that these winding step limitations are not step plus function recitations under 35 U.S.C. § 112, sixth paragraph, because they embody acts without function, and that

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they read on the winding steps disclosed by Santandrea '228 (claim 41) and Santandrea '618 (claim 60). In their request for rehearing (see pages 2 and 3), the appellants submit that these winding step limitations are step plus function recitations under 35 U.S.C. § 112, sixth paragraph, because they actually embody function without acts, and that as so construed they should be treated commensurately with the means for winding limitation in claim 1 which was found to define over the winding means disclosed by Santandrea '228 (see pages 8 through 10 in the decision). As we explained on page 7 of the decision, however, citing O.I. Corp. v. Tekmar Co., 115 F.3d 1576, 1583, 42 USPQ2d 1777, 1782 (Fed. Cir. 1997),

[t]he term 'steps' refers to the generic descriptions of elements of a process, and the term 'acts' refers to the implementation of such steps. Merely claiming a step without recital of a function is not analogous to a means plus a function; if every process claim containing steps described by an 'ing' verb, such as passing, heating, reacting, transferring, etc., were construed as a step plus function limitation, process claims would be limited in a manner never intended by Congress.

The "ing" verb "winding" as employed in the step limitations

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at issue denotes an act, not a function. Thus, we remain of the view that these winding step limitations do not fall under 35 U.S.C. § 112, sixth paragraph, and that they read on the winding steps respectively disclosed by the Santandrea references.

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Hence, the arguments advanced in the appellants' request for rehearing are not persuasive of any error in our decision. We therefore decline to make any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

	NEAL E. ABRAMS)	
	Administrative Patent Judge)	
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)	BOARD OF
PATENT)	
	CHARLES E. FRANKFORT)	
APPEALS)	
	Administrative Patent Judge)	AND
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INTERFERENCES)	
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	JOHN P. McQUADE)	
	Administrative Patent Judge)	

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