

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VALERIU BULARCA

Appeal No. 1997-2836
Application 08/106,009

ON BRIEF

Before CAROFF, WILLIAM F. SMITH and KRATZ, Administrative
Patent Judges.

CAROFF, Administrative Patent Judge.

DECISION ON APPEAL

This decision on appeal relates to the final rejection of
claims 1-6, 10 and 12-25, all the pending claims in
appellant's application.

The appealed claims are directed to a laminated assembly
(claims 17-21 and 24-25), and a method for manufacturing the

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same (claims 1-6, 10, 12-16 and 22-23).

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Claim 1 (method of manufacture) and claim 17 (laminated product) are reproduced below as illustrative of the diversity of subject matter encompassed by the appealed claims:

- assembly
1. A method for manufacture of a laminated assembly comprising the steps of:
- least
- forming at least one notch along an edge of at least one lamination;
- positioning the laminations between at least two chocks of a die wherein said at least one notch frictionally engages one of said at least two chocks to support the at least one lamination against a press fit bonding force during a subsequent bonding step;
- a
- press fit bonding the laminations together to form a laminated assembly; and
- removing the laminated assembly from between the chocks.
- of
17. A laminated assembly, comprising a plurality of laminations connected to each other by successively pressing laminations against a stack of previously pressed together laminations frictionally held temporarily between at least two chocks of a die during manufacture, wherein each lamination includes an edge having at least one notch means for frictionally engaging solely during manufacture one of said at least two chocks as the laminations are being pressed together.

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The following references of record are relied upon by the examiner as evidence of obviousness (in conjunction with the disclosure of prior art in the Background of the Invention section of appellant's specification):

Frank	1,315,827	Sep. 9, 1919
Radtke	3,176,253	Mar. 30, 1965
Mittermaier	662,627	May 7, 1963

(published Canadian Pat. Application)

All of the appealed claims stand rejected under 35 U.S.C. § 103 for obviousness in view of either Radtke, Frank or Mittermaier, with each of the references taken in combination with background prior art disclosed in appellant's specification relating to the so-called press fit bonding technique for manufacturing a laminated assembly within a die.¹ According to this disclosed prior art manufacturing technique, the individual laminations are positioned against chocks of the die, and then pressed together within the die. Each lamination includes stakes which are pressed into an adjacent lamination so that they are connected together.

After having carefully considered the entire record in

¹Although the examiner has chosen to apply six separate rejections to the claims, these rejections can be viewed collectively for purposes of this appeal.

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light of the opposing positions advanced on appeal, we agree with appellant that the examiner has not established a prima facie case of obviousness with regard to the appealed claims. Accordingly, we cannot sustain the rejections applied by the examiner.

Initially, we note that claims 17-21 and 24-25 are in a product-by-process format, but have not been separately addressed by the examiner. Rather, the examiner has grouped these claims with the method claims in his outstanding rejections. The examiner's fundamental position is that it would have been obvious within the ambit of 35 U.S.C. § 103 to apply the current chock and die press fit bonding procedure in manufacturing the laminated assemblies of Radtke, Frank and Mittermaier and, in so doing, one of ordinary skill in the art would of necessity recognize that the chocks should engage the laminations at the notched regions.

We disagree with the examiner essentially for the reasons stated in appellant's Brief and Reply Brief. In appellant's claimed method, the position of the lamination notches is specifically associated with the chocks of a die so that the notches engage a chock. As we see it, the notches in the

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reference laminations serve entirely different purposes, i.e. to permanently receive a clamp or claiming bolt for holding the laminations together in their final assembled configuration (Radtke, Frank), or to engage a mechanism for releasing lamination punchings from a magazine (Mittermaier). Thus, we find no teaching or suggestion in the prior art to do what appellant has done, namely, to form at least one notch along an edge of a lamination so that the notch is positioned to engage the chock of a die in a press fit bonding operation. According to appellant, this particular arrangement eliminates the need for precision cutting the entire edge of the lamination, and thereby minimizes the amount of scrap generated in cutting the lamination to fit between the chocks of a die.

In view of the foregoing, we reverse all of the rejections at issue. However, it is clear that the examiner has not paid due regard to the scope of claims 17-21 and 24-25 which define a laminated assembly in product-by-process terms. Accordingly, we remand the application to the examiner for an appropriate independent consideration of each of those claims bearing in mind that, as regards product-by-process claims,

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the examiner should determine whether there are any characteristics which distinguish the claimed products from the laminated assemblies depicted in the cited prior art references. If the examiner determines that there are no substantial differences, the examiner should consider whether the prior art products anticipate, or render obvious, the laminated assembly defined by any particular product-by-process claim or claims. When claims are presented in a product-by-process format, it is the patentability of the product, and not the process, which must be determined. See In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985);

In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

For the foregoing reasons, the decision of the examiner is reversed, and the application is remanded to the examiner, via the Office of a Director of the involved Technology Center, for appropriate action consistent with our opinion.

This application, by virtue of its special status requires an immediate action. Manual of Patent Examining Procedure § 708.01 (7th ed., July 1998). It is important that the Board be informed promptly of any action affecting the

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appeal in this case.

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REVERSED AND REMANDED

MARC L. CAROFF))
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
WILLIAM F. SMITH)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
PETER F. KRATZ))
Administrative Patent Judge)	

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