

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD F. POST

Appeal No. 1999-2388
Application 08/758,513

ON BRIEF

Before KRASS, JERRY SMITH and FLEMING, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-9, which constitute all the claims in the application.

The disclosed invention pertains to the field of electro-mechanical (E-M) batteries that employ a fiber-composite rotor. More particularly, the invention relates to

the manner in which the stator windings couple energy into and out of the rotor.

Representative claim 1 is reproduced as follows:

1. An electric machine, comprising:

a cylindrical rotor comprising an array of permanent magnets that provide a uniform dipole field; and

a stator inserted down the axis of said dipole field, wherein said rotor is on the outside of said stator, said stator comprising a first set of windings and a second set of windings, wherein said first set of windings are orthogonal to said second set of windings, wherein said first set of windings and said second set of windings together comprise orthogonal windings, wherein said first set of windings are electrically decoupled from said second set of windings;

means for providing power to said first set of windings, wherein power is delivered to said first set of windings to bring said rotor up to its normal operating speed, wherein said rotor will store kinetic energy.

The examiner relies on the following references:

Post	3,683,216	Aug. 08, 1972
Paulsen	4,990,808	Feb. 05, 1991
Leupold	5,349,258	Sep. 20, 1994

Claims 1-9 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Paulsen taken alone with respect to claims 1-4 and 7-9, Paulsen in view of Post with respect to claim 5, and Paulsen in view of Leupold with respect to claim 6.

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Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-9. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In

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so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis

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of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

We consider first the rejection of claims 1-4 and 7-9 based on Paulsen taken alone. Appellant has indicated that the claims on appeal do not stand or fall together [brief, page 6]. However, appellant has made no separate arguments with respect to the claims subject to this rejection. The extent of appellant's argument is to simply indicate what is recited in each of the claims [brief, pages 9-10]. Simply pointing out what a claim requires with no attempt to point out how the claims patentably distinguish over the prior art does not amount to a separate argument for patentability. In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). Since appellant has failed to appropriately argue

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the separate patentability of the claims, all contested claims stand or fall together. See In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Accordingly, we will consider the rejection against claim 1 as representative of all of claims 1-4 and 7-9.

With respect to representative, independent claim 1, the examiner finds that Paulsen discloses the claimed invention except for the rotor being external to the stator. The examiner finds that it would have been obvious to the artisan to form the device of Paulsen with the rotor external to the stator because such arrangements were well known in this art [final rejection, page 3, incorporated into answer].

Appellant argues that the combination of features necessary to achieve the principles of the disclosed invention are not present in the applied prior art. Appellant argues that the stator windings in Paulsen are not required to be orthogonal as claimed. Appellant also argues that Paulsen does not contain a rotor. In summary, appellant argues that Paulsen does not provide (i) an array of permanent magnets that provide a uniform dipole field; (ii) a stator inserted

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down the axis of the dipole field; (iii) a rotor outside the stator; and (iv) two orthogonal windings electrically decoupled from each other [brief, pages 7-9].

The examiner responds that the drive magnet 42 of Paulsen is considered to be a rotor for purposes of the claimed invention. The examiner also notes that Paulsen teaches that the stator windings can be orthogonal to each other in order to provide low electromagnetic coupling between the coils. Finally,

the examiner asserts that locating the stator inside of the rotor is an obvious modification and well known in the art [answer, pages 5-6].

We will not sustain the examiner's rejection of claims 1-4 and 7-9 because the examiner has failed to establish a prima facie case of obviousness. There are several features recited in representative claim 1 which are either not addressed by the examiner or are simply dismissed by the examiner as being obvious. Specifically, the examiner has not addressed the fact that Paulsen does not disclose a rotor

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comprising an array of permanent magnets that provide a uniform dipole field. Element 42 is described as a single magnet. The examiner has also followed a per se rule of obviousness that the rearrangement of parts is not patentable. It is the specific rearrangement and orientation of the parts of the invention which are disclosed to give the E-M battery its unique characteristics. This discovered arrangement of parts cannot simply be dismissed by the examiner. The device of Paulsen also does not appear to provide a rotor which stores kinetic energy. Claim 1 recites a means for providing power to the stator windings such that the rotor will store kinetic energy. The examiner has not interpreted this means in light of appellant's disclosure, and the examiner has not considered whether the corresponding means in Paulsen is an obvious equivalent to the means disclosed by appellant. For all of these reasons, the examiner has failed to establish a prima facie case of obviousness. Therefore, we do not sustain the examiner's rejection of claims 1-4 and 7-9.

We now consider the rejection of claim 5 based on Paulsen and Post and the rejection of claim 6 based on Paulsen and Leupold. Paulsen suffers the deficiencies noted above.

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Since neither Post nor Leupold overcomes the deficiencies of Paulsen, we also do not sustain the examiner's rejection of claims 5 and 6.

In summary, we have not sustained any of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-9 is reversed.

REVERSED

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Administrative Patent Judge)	
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JERRY SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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