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EXAMINER

SWIATOCHA, GREGORY D.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte EMILE DI SERIO and FABIEN SOUBRAS

Appeal 2018-002437¹
Application 14/369,371
Technology Center 3700

Before WILLIAM V. SAINDON, ARTHUR M. PESLAK, and
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

FINAMORE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant² appeals from the
Examiner’s decision to reject claims 1–8. We have jurisdiction under § 6(b).

We reverse.

¹ We reference herein the Specification filed June 27, 2014 (“Spec.”), Appeal Brief filed August 23, 2017 (“Appeal Br.”), Reply Brief filed January 2, 2018 (“Reply Br.”), as well as the Examiner’s Answer mailed November 2, 2017 (“Ans.”), Advisory Action mailed April 25, 2017 (“Adv. Act.”), and Final Office Action mailed February 23, 2017 (“Final Act.”).

² Appellant is the Applicant, Saint Jean Industries, which, according to the Appeal Brief, is the real party in interest. Appeal Br. 1.

CLAIMED SUBJECT MATTER

Claim 1, reproduced below, is the sole independent claim on appeal and representative of the claimed subject matter.

1. A method of casting and forging, the method comprising:
creating, in a foundry, a preform of a first shape and size;
transferring the preform from the foundry to a tunnel oven;
preheating the preform to a temperature of 500°C;
transferring the preheated foundry preform into a die forge with a second shape and size that is substantially smaller than the first size and shape;
performing a die punching operation at a pressure of between 600 and 700 MPA; and
prior to transferring the preheated foundry preform to the forge die, powder-spraying a surface of the forge die and one or more pins for positioning the preform.

Appeal Br. 8, Claims App.

REFERENCES

The Examiner relies on the following references in rejecting the claims on appeal:

Burgess et al.	US 3,931,020	Jan. 6, 1976	(“Burgess”)
Lum et al.	US 5,468,401	Nov. 21, 1995	(“Lum”)
Jain	US 6,330,818 B1	Dec. 18, 2001	
DiSerio	US 2002/0170635 A1	Nov. 21, 2002	
Hasegawa et al.	US 2010/0014940 A1	Jan. 21, 2010	(“Hasegawa”)
Pandey	US 2010/0254850 A1	Oct. 7, 2010	
McLean	US 7,895,873 B1	Mar. 1, 2011	

REJECTIONS³

The Examiner rejects the claims on appeal as follows:

claims 1–4 under 35 U.S.C. § 103(a) as unpatentable over Jain, DiSerio, Pandey, and McLean;

claims 5, 7, and 8 under 35 U.S.C. § 103(a) as unpatentable over Jain, DiSerio, Pandey, McLean, and Lum; and

claim 6 under 35 U.S.C. § 103(a) as unpatentable over Jain, DiSerio, Pandey, McLean, and Burgess.

ANALYSIS

Independent claim 1 recites a “die punching operation,” and the Examiner finds Jain discloses this limitation. Final Act. 4. Notably, Jain is silent regarding a die punching operation. Rather, Jain discloses a forging operation whereby workpiece 10 is deformed between two forging dies 20 and 22 urged together by components 30 and 32 of a hydraulic press, which can exert tens of thousands of tons of force on the workpiece. Jain 5:7–16.

In finding Jain discloses a “die punching operation,” the Examiner “has interpreted the phrase, ‘a die punching operation’ in a forge die to be forging with a die that applies pressure to a workpiece.” Ans. 7. The Examiner similarly interprets “die punching” as “die stamping.” *Id.* at 8. The Examiner also interprets “punch” to be “any form of impact.” *Id.*

³ The Examiner has withdrawn the rejection of claim 8 under 35 U.S.C. § 112, first paragraph. Adv. Act. 1. We note that this rejection in the Final Office Action references claim 7, instead of claim 8. Final Act. 3. However, Appellant amended claim 8 in response to the rejection (Appeal Br. 2), and, in withdrawing the rejection, the Examiner indicated that the rejection is of claim 8 (Adv. Act. 1). Accordingly, we understand the withdrawn rejection regards claim 8.

In support of the Examiner's interpretations, the Examiner finds "the Specification does not provide any further structure for the term 'die punching' and refers only to 'die punching' as die stamping in a forge die cavity (Page 1, line 18; Page 2, line 1) and die punching in a forge die cavity (Page 4, line 7-8)." *Id.* at 7. The Examiner further finds "no references to scrap, apertures, or holes are found in the Specification from which to ascertain that die punching has meaning beyond die stamping in a forge die." *Id.* at 8. The Examiner also cites to Hasegawa as evidence that the term "punching" has been used to indicate forging a material in a forge die. *Id.*

In contrast, Appellant argues the Examiner's interpretation of "die punching operation" is improper because it ignores the claim language by reading out the word "punching." Appeal Br. 4. Appellant ostensibly maintains that the meaning of "die punching operation" is distinct from forging in a die. *See id.* Thus, the issue here is one of claim construction, namely whether the Examiner properly construed "die punching operation" to encompass forging a material in a die.

When construing claims,

the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification.

In re Morris, 127 F.3d 1048, 1054 (Fed. Cir. 1997). Furthermore, the Federal Circuit has explained that "the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective

filing date of the patent application.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc) (citations omitted).

Beginning with Appellant’s Specification, the Specification provides little guidance as to the meaning of the term “die punching operation.” In particular, the Specification refers to “die punching operation” only twice, and neither of these instances provides an express definition or describes the die punching operation in detail, other than explaining an operating pressure of between 600 and 700 MPA. Spec. 1:19–20, 4:7–8. In addition to referring to a “die punching operation,” the Specification refers to a “forging operation” (*see, e.g., id.* at 2:10) and a “die stamping operation” (*id.* at 2:1). The Specification, however, provides minimal detail regarding these operations, and it is unclear whether the terms “die punching operation,” “die stamping operation,” and “forging operation” are used interchangeably or have different meanings. We do not agree with the Examiner that the paucity of description in the Specification would lead one of ordinary skill in the art to equate two different terms, i.e., die stamping and die punching. Ans. 7–8.

Further, the Examiner has not persuasively explained why Hasegawa supports the proposed construction. Ans. 8. In our view, Hasegawa is more insightful and does not support the Examiner’s proposed construction. The paragraph the Examiner relies upon discloses a preliminary forging process that uses a punch to form a material held in a die cavity. Hasegawa ¶ 21. More specifically, paragraph 21 describes “a preliminary forging process comprising setting a columnar bolt material into the cylindrical cavity of the die of a cold forging machine . . . and punching said bolt head forming part of said bolt material with a punch used for the preliminary forging.”

Hasegawa, therefore, describes punching as using a punch to form material held in a die.

Despite the scant description in Appellant's Specification, Hasegawa provides evidence that a person of ordinary skill in the art would have understood punching to be a forging process that uses a punch to form material held in a die. Consequently, the Examiner's interpretation of "die punching operation" to encompass forging a material in a die is unreasonably broad.

In view of the foregoing, the Examiner's finding that Jain's forging operation in a die discloses a "die punching operation" is based on an improper claim construction, and, therefore, the Examiner has not shown that Jain discloses a "die punching operation," as recited in independent claim 1. Accordingly, we do not sustain the Examiner's rejection of independent claim 1 and claims 2–4 depending therefrom. The Examiner's rejections of claims 5–8, are based on the same unduly broad interpretation of "die punching operation," and consequently suffer from the same deficiency as the rejection of independent claim 1. Final Act. 6–8. We similarly do not sustain the Examiner's rejections of claims 5–8.

DECISION

The Examiner's decision to reject claims 1–8 is reversed.

REVERSED