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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT AND TRIAL  
APPEAL BOARD

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*Ex parte* HIDEO TAKAMI and HIROHISA AJIMA

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Appeal 2011-012808  
Application 11/841,165  
Technology Center 1700

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Before KAREN M. HASTINGS, DEBORAH KATZ, and  
GEORGE C. BEST, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1-11 under 35 U.S.C. § 103(a) as unpatentable over JP '483 (JP 2002-352483 A published June 12, 2002; as translated). We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

Claim 1 is illustrative of the claimed subject matter:

1. A method of manufacturing a Ge-Cr alloy sputtering target, comprising the steps of:

evenly dispersing and mixing Cr powder of 75 $\mu$ m minus sieve and Ge powder of 250 $\mu$ m minus sieve, said Ge powder having a BET specific surface area of 0.1 to 0.4m<sup>2</sup>/g; and thereafter performing sintering thereto.

#### ANALYSIS

“On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.” *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (emphasis omitted).

Where the Examiner establishes a reasonable assertion that a claimed process appears to be identical or substantially identical to a process disclosed by the prior art and/or that the products claimed by the applicant and disclosed in the prior art appear to be the same, the burden is properly shifted to the applicant to show that they are not. *See In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990); *In re Best*, 562 F.2d 1252, 1254-56 (CCPA 1977); *cf. In re Crush*, 393 F.3d 1253, 1259 (Fed. Cir. 2004).

After thorough review of the respective positions provided by Appellants and the Examiner, we AFFIRM the § 103(a) rejection on appeal for essentially the reasons presented by the Examiner, including the Response to Argument section (Ans., mailed April 29, 2011). We add the following primarily for emphasis.

Appellants’ main argument—that the claimed method is nonobvious because JP ’483 does not disclose or suggest the minus sieve sizes of the Cr and Ge powders as recited in claim 1 (App. Br. 6-8; Reply Br. 2-7)—is unavailing as it fails to consider the reference as a whole. Appellants have not provided any credible evidence or persuasive technical reasoning to refute the Examiner’s reasonable determination that the powder sizes of JP

'483, even though they are stated in terms of a mean particle size versus the recited "minus sieve", overlap the claimed ranges (*e.g.*, Ans. 3, 6; *generally* App. Br., Reply Br.). A *prima facie* case of obviousness exists where the prior art and claimed ranges overlap, as well as in those cases where the claimed range and the prior art range, though not overlapping, are sufficiently close that one skilled in the art would have expected them to have the same properties. *See In re Peterson*, 315 F.3d 1325, 1329 (Fed. Cir. 2003); *In re Geisler*, 116 F.3d 1465, 1469 (Fed. Cir. 1997); *In re Woodruff*, 919 F.2d 1575, 1578 (Fed. Cir. 1990); *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 783 (Fed. Cir. 1985).

Appellants have also not provided any evidence or persuasive technical reasoning to refute the Examiner's reasonable determination that Ge powders having the mean particle size of 100 microns in JP '483, that is well below the recited 250 micron minus sieve size, would also have a similar BET specific surface area as recited in claim 1 (Ans. 7; *generally* App. Br., Reply Br.).

Appellants argument that the product made by JP '483's sintering method is different than the product made by their sintering method because it has "fish-eye" compound phases and Cr-rich phases (App. Br. 7, 9) is unpersuasive, since, as pointed out by the Examiner, the claims do not exclude the presence of these phases (Ans. 5). *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) ("Many of appellant's arguments fail from the outset because . . . they are not based on limitations appearing in the claims . . .").

Furthermore, the artisan of ordinary skill would have appreciated that powder size was a known result effective variable. The law is replete with cases in which the difference between the claimed invention and the prior art

is some range or other variable within the claims. It is well settled that, generally speaking, it would have been obvious for an artisan with ordinary skill to develop workable or even optimum ranges for result-effective parameters. *In re Woodruff*, 919 F.2d at 1577; *In re Boesch*, 617 F.2d 272, 276 (CCPA 1980). These cases have consistently held that the Appellants must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range. *In re Woodruff*, 919 F.2d at 1578.

Appellants' statements in the Appeal Brief and Reply Brief that their product is different than that of JP '483 when using the claimed powder sizes in the claimed sintering method falls far short of meeting this burden. Attorney's arguments in a brief cannot take the place of evidence. *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974). Likewise, mere attorney argument does not take the place of evidence lacking in the record. *Meitzner v. Mindick*, 549 F.2d 775, 782 (CCPA 1977).

Accordingly, we affirm the § 103 rejection on appeal.

We affirm the Examiner's decision to reject all of the pending claims.

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

AFFIRMED

kmm