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Siemens Corporation Intellectual Property Department 170 Wood Avenue South Iselin, NJ 08830			RIPA, BRYAN D	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* URSUS KRUGER, DANIEL KORTVELYESSY,  
TALPH REICHE, JAN STEINBACH,  
and GABRIELE WINKLER

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Appeal 2011-012829  
Application 10/555,137  
Technology Center 1700

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Before ROMULO H. DELMENDO, JEFFREY T. SMITH and  
DONNA M. PRAISS, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134 from a final rejection of claims 10 through 16 and 18 through 24. We have jurisdiction under 35 U.S.C. § 6.

Appellants' invention is directed to a process for removing a coating from a turbine component. App. Br. 4. Claim 10 is illustrative of the subject matter on appeal and is reproduced below<sup>1</sup>:

10. A process for removing a coating from a component of a turbine, comprising:

arranging the turbine component in an agent that at least partially chemically attacks the surface of the turbine component;

periodically applying a voltage to the turbine component and pole so a current having a time profile flows through the agent, the voltage applied in order to determine a state of the coating removal process via the time profile and applied such that an electrolytic process does not occur; and

using the time profile to decide whether to terminate or interrupt the residence of the component in the agent,

wherein the time profile represents a state of the coating removal process, and

wherein electrolysis in [sic] not involved in the coating process.

The Examiner relied on the following references in rejecting the appealed subject matter:

Kanda	US 4,338,157	Jul. 6, 1982
Lada	US 4,339,282	Jul. 13, 1982
Chen	US 4,678,552	Jul. 7, 1987
Jaworowsky 552	US 4,886,552	Dec 12, 1989
Jaworowsky 999	US 6,176,999 B1	Jan. 23, 2001

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<sup>1</sup> The Claims Appendix listing the claims on appeal is erroneous because it does not include an accurate reproduction of claims 10-24. App. Br. 10-11. Accordingly, we rely on the claims entered on October 6, 2010 as the correct version of the claims on appeal.

Czech	US 6,217,668 B1	Apr. 17, 2001
Jaworowsky 240	US 2002/0074240 A1	Jun. 20, 2002
Riewe	US 2004/00060827 A1	Apr. 1, 2004

Appellants, App. Br. 10, request review of the following rejections from the Examiner's final office action:

I. Claims 10-14, and 19-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jaworowski 999 or Riewe each in view of Jaworowski 240, Jaworowski 552, Kanda, and Chen

II. Claims 15, 16, and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Jaworowski 999 or Riewe each in view of Jaworowski 240, Jaworowski 552, Kanda and further in view of Czech and Lada.

#### OPINION

The dispositive issue for this appeal is: Did the Examiner err in determining that it would have been obvious to one of ordinary skill in the art to use voltage to monitor a process to chemically remove a coating from a surface as required by the subject matter of independent claim 10?<sup>2</sup>

After thorough review of the respective positions provided by Appellants and the Examiner, we answer the question in the negative and AFFIRM for the reasons presented by the Examiner and add the following.

The Examiner found that chemical stripping and electrolytic stripping processes to remove materials from various components, such as the surface of a turbine component, was known in the art. Ans. 8; Jaworowsky 999 col. 1, ll. 21-26; Jaworowsky 240 ¶ [0003], [0005]; Chen col. 1, ll. 26-28. The Examiner found that Kanda teaches chemical removal (etching) process

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<sup>2</sup> We will limit our discussion to independent claim 10. Appellants have not argued the dependent claims separately. Accordingly, claims not argued separately will stand or fall together with independent claim 10.

wherein a current-time profile of the surface to be etched is monitored in order to determine the end-point of the chemical removal process. Ans.9; Kanda, col. 10, ll. 47-57, col. 2, ll. 2-8.<sup>3</sup> The Examiner found that it would have been obvious to one skilled in the art performing the known chemical stripping processes to incorporate the known voltage monitoring steps of the prior art to determine the endpoint of the removal process and avoid damaging the underlying surface. Ans. 8, 10.

Appellants argue that the primary references Jaworowsky 999 and Riewe, as well as some of the secondary references, are directed to removing a coating material using an electrolysis process while the subject matter of independent claim 10 is directed to chemically removing the coating and excludes an electrolytic process. App. Br. 6-7. Thus, Appellants argue that there is no motivation to modify the teachings of the primary references because to do so would replace the principle operation of the electrolysis process with a chemical process. App. Br. 7.

We are unpersuaded by these arguments because they do not address the portion of the references relied on by the Examiner in the stated rejection. Our reviewing court has held that

[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

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<sup>3</sup> The Examiner found that it is also known to use current to monitor the removal of coatings from surfaces of components to determine the endpoint of coating removal processes. Ans. 6-7, 9; Jaworowsky 999 col. 3, ll. 5-12, 57-65; Riewe ¶ [0015].

*In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

The Examiner found that chemical stripping processes are known and methods of monitoring the removal of a coating from a surface are also known. *See generally* Ans. 6-10; Jaworowsky 999 (Background of the Invention). The Examiner found it would have been obvious to modify the known chemical stripping process by incorporating the coating removal monitoring steps (voltage monitoring steps) of the prior art to determine the end point of the stripping process. Ans. 10, 17. Appellants have not adequately explained why one skilled in the art would not or could not modify the known chemical stripping processes to incorporate the monitoring steps of the prior art.

Appellants further argue that one skilled in the art would not consider the claimed process of removing a coating on a turbine component analogous to Kanda's process of manufacturing a semiconductor using an etching. App. Br. 7. We are also unpersuaded by this argument and agree with the Examiner that Appellants' claimed invention and Kanda's method are both directed to monitoring the end point of a chemical process for removing material from a surface. Ans. 18-19. We also agree with the Examiner that one skilled in the art would have recognized the need to monitor the removal of a coating from a substrate without damaging the underlying substrate regardless of the use of the substrate. Ans. 8. Appellants have not adequately explained why one skilled in the art would not have looked into the teachings of Kanda to improve the effectiveness of a chemical stripping process.

Accordingly, we sustain the rejection of claims 10-14 and 19-24 under 35 U.S.C. § 103(a) as unpatentable over Jaworowski 999 or Riewe each in view of Jaworowski 240, Jaworowski 552, Kanda, and Chen for the reasons given above and by the Examiner.

Appellants rely on the same arguments in addressing the separate rejection of claims 15, 16, and 18 under 35 U.S.C. § 103(a) as unpatentable over Jaworowski 999 or Riewe each in view of Jaworowski 240, Jaworowski 552, Kanda, and further in view of Czech and Lada. App. Br. 7-8. Therefore, we also sustain this rejection for the reasons given above and presented by the Examiner.

#### ORDER

The rejection of claims 10-14 and 19-24 under 35 U.S.C. § 103(a) as unpatentable over Jaworowski 999 or Riewe each in view of Jaworowski 240, Jaworowski 552, Kanda, and Chen is affirmed.

The rejection of claims 15, 16, and 18 under 35 U.S.C. § 103(a) as unpatentable over Jaworowski 999 or Riewe each in view of Jaworowski 240, Jaworowski 552, Kanda, and further in view of Czech and Lada is affirmed.

#### TIME PERIOD

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

AFFIRMED

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