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OBLON, MCCLELLAND, MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			LIN, JAMES	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KOJI WADA, TAKAYUKI TSUBOTA,
MAMORU HOSOKAWA, and JUN HISAMOTO¹

Appeal 2015-000858
Application 12/647,760
Technology Center 1700

Before BRADLEY R. GARRIS, JULIA HEANEY, and
MONTÉ T. SQUIRE, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134, Appellants appeal from the Examiner's rejection under 35 U.S.C. § 103(a) of claim 2 as unpatentable over Yahalom (US 5,382,347; Jan. 17, 1995) in view of Fujii (JP 06-029088 A; Feb. 4, 1994 (as translated)) (Non-final Act. (dated October 3, 2013) 2–3; Ans. (dated August 13, 2014) 2–4). We have jurisdiction under 35 U.S.C. § 6.

We AFFIRM.

¹ Kobe Steel, LTD is identified as the real party in interest. App. Br. 1.

Appellants claim a method of manufacturing a surface treated member having aluminum alloy or pure aluminum as a basic material comprising forming an anodized film on the member surface, applying a hydrating treatment to the anodized film, and then performing a heat treatment to increase the hardness of the member without inducing substantial cracking (claim 2).

A copy of claim 2, taken from the Claims Appendix of the Appeal Brief, appears below.

2. A method of manufacturing a surface treated member used for semiconductor liquid crystal manufacturing apparatus comprising the steps of:

forming an anodized film to the surface of a member having an aluminum alloy or pure aluminum as a basic material;

then dipping the member having an aluminum alloy or pure aluminum as a basic material, and having an anodizing film formed to the surface, in pure water, thereby applying a hydrating treatment to the anodized film, wherein the hydrating treatment is conducted at a treatment temperature from 80°C to 100°C and a treatment time of (min) $\geq -1.5 \times$ treatment temperature (°C) + 270; and

performing a heat treatment to increase the hardness of the member without inducing substantial cracking, after the hydrating treatment and the step of forming an anodized film, under the conditions satisfying that

a treatment temperature is from 120 to 450°C, and

a treatment time (min) $\geq -0.1 \times$ treatment temperature (°C) + 71.

We sustain the rejection for the reasons expressed in the Non-final Action, the Answer, and below.

In rejecting claim 2, the Examiner finds that Example 3 of Yahalom includes the claimed anodizing step as well as a testing step at a temperature and time period falling within the temperatures and times of the claimed heat treating step (Non-final Act. 2–3). The Examiner also finds that Yahalom fails to disclose the claimed hydrating step but that Fujii teaches hydrating an anodized aluminum member for a time and temperature falling within the claim 2 range in order to achieve certain benefits (*id.* at 3). Based on these findings, the Examiner concludes that it would have been obvious to subject the anodized aluminum member of Yahalom to a hydrating step in order to achieve the benefits taught by Fujii (*id.*).

Appellants argue that “the testing step in Yahalom is a step of testing the product in its complete state; it does not inherently ‘treat’ or further alter the product[, and t]herefore, is not a heat ‘treatment’ step and has no relevance to the claimed method” (App. Br. 6).

Appellants’ argument lacks persuasive merit. The Examiner emphasizes the undisputed fact that the temperature and time of the testing step in Yahalom’s Example 3 falls within the claim 2 range (Ans. 7). As stated by the Examiner, “Appellant[s] ha[ve] not explained why these parameters would alter the product when performed by [A]ppellant[s] but not in the process of Yahalom” (*id.*). That is, practicing this testing step on the anodized and hydrated member of Yahalom as modified by Fujii necessarily and inherently would increase hardness without inducing substantial cracking as recited in claim 2 because this result occurs when practicing the corresponding steps of the claim (*id.*).

For these reasons, the record supports a determination that the limitation at issue (i.e., “performing a heat treatment to increase the hardness of the member without inducing substantial cracking, after the hydrating treatment and the step of forming an anodized film” (claim 2)) would be the natural result of the Yahalom and Fujii combination proposed by the Examiner. *See Par Pharm., Inc. v. TWi Pharms., Inc.*, 773 F.3d 1186, 1195–96 (Fed. Cir. 2014) (“[I]n order to rely on inherency to establish the existence of a claim limitation in the prior art in an obviousness analysis – the limitation at issue necessarily must be present, or the natural result of the combination of elements explicitly disclosed by the prior art.”).

Appellants further argue that “any prima facie case of obviousness that may be raised by Yahalom in view of Fujii . . . is rebutted by the evidence of unexpected improved results set forth in the present specification [concerning increased hardness without inducing substantial cracking]” (App. Br. 7; *see also, e.g., id.* at 2–3, Fig. 1, Spec. Tables 1–4).

According to the Examiner, the Specification evidence of unexpected results is not reasonably commensurate in scope with the claim 2 invention (Ans. 8–10). *See In re Huai-Hung Kao*, 639 F.3d 1057, 1068 (Fed. Cir. 2011) (“Evidence of secondary considerations must be reasonably commensurate with the scope of the claims.”). As the Examiner explains, the Specification data in Tables 1–4 are specific to a particular aluminum alloy, a particular anodized film thickness, a particular anodizing solution, and a particular anodizing electrolysis current density whereas claim 2 is not limited in any of these respects (Ans. 9). Under these circumstances, no adequate basis exists for believing that the results exhibited by the narrow

embodiment of Tables 1–4 also would be exhibited by other embodiments falling within the scope of claim 2.²

In summary, the arguments and evidence of record, on balance, weigh most heavily in favor of the Examiner’s ultimate conclusion that the subject matter defined by claim 2 would have been obvious over Yahalom and Fujii.

DECISION

The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

² In addition, we observe that Appellants do not identify any Specification disclosure which characterizes the results under consideration as unexpected. Apparently, only the attorney who wrote the Appeal Brief states that these results are unexpected. Such an attorney-statement is not evidence and is not adequate to establish unexpected results. *See In re Geisler*, 116 F.3d 1465, 1470–71 (Fed. Cir. 1997) (statement by attorney that improved results were “surprising” insufficient to establish unexpected results).