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HENRY M FEIEREISEN, LLC HENRY M FEIEREISEN 708 THIRD AVENUE SUITE 1501 NEW YORK, NY 10017			LEE, REBECCA Y	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KARL-HEINZ SPITZER, BIANCA SPRINGUB,
JOACHIM KONRAD, HELLFRIED EICHHOLZ,
MARKUS SCHÄPERKÖTTER, and ZACHARIAS GEORGEOU

Appeal 2015-002862
Application 13/255,548
Technology Center 1700

Before MICHAEL P. COLAIANNI, JAMES C. HOUSEL, and
MONTÉ T. SQUIRE, *Administrative Patent Judges*.

SQUIRE, *Administrative Patent Judge*.

DECISION ON REHEARING

Appellants request rehearing under 37 C.F.R. § 41.52 of a DECISION ON APPEAL mailed August 31, 2016 (“Decision”), wherein we affirmed the Examiner’s § 103 rejections of all appealed claims. Request for Rehearing dated October 31, 2016 (“Request”).

We have thoroughly reviewed the arguments set forth by Appellants in the Request, and we have reconsidered our Decision in light of those comments. We, however, are not persuaded of reversible error in the disposition of the rejections and decline to modify the Decision.

Appellants argue that “the Board has misapprehended an argument presented by Appellant[s] regarding the interpretation of the disclosure of the Kroos reference.” Request 2. In particular, Appellants argue that: “When read in context the preconception mentioned in paragraph [0021] of Kroos refers to the preconception that carbon has to be eliminated to eliminate κ -carbides and that with the particular steel composition disclosed in Kroos κ -carbides can be prevented even when adding carbon” and that as a result “a person with skill in the art would not have had any reason to use the steel disclosed in Kiese in the method of Kroos, because Kiese teaches a steel containing κ -carbides and Kroos teaches against a steel containing κ -carbides.” *Id.* at 2.

We do not find this argument persuasive because it is essentially the same argument Appellants made previously in the Appeal Brief (App. Br. 4, 5), which was considered in the course of rendering the Decision (Decision 6, 7).

Accordingly, for the reasons previously discussed in our Decision, we continue to agree with the Examiner that the combination of Kroos and Kiese would have suggested all of the limitations of claim 16 and maintain our finding that the Examiner provides a reasonable basis and identifies sufficient evidence in the record to evince why one of ordinary skill would have been motivated to combine the teachings of the references to arrive at Appellants’ claimed invention. Kroos, Abstract, ¶ 28; Kiese, Abstract; Decision 4, 5 (explaining that one of ordinary skill in the art would have been motivated to use Kiese’s steel in Kroos’s hot strip process with a reasonable expectation of success because “the use of conventional materials to perform

their known functions in a conventional process is obvious”) (citing *In re Rainer*, 305 F.2d 505, 511 (CCPA1962)).

Appellants’ Request does not reveal any factual findings regarding the prior art’s teachings and the claimed invention which we have misapprehended or overlooked or that otherwise establishes reversible error in this regard. Contrary to what Appellants argue, Kroos’s paragraph 21 does not teach against a steel containing any κ -carbides. *Cf. DyStar Textilfarben GmbH v. C.H. Patrick Co.*, 464 F.3d 1356, 1364 (Fed. Cir. 2006); *In re Fulton*, 391 F.3d 1195, 1201 (finding that there is no teaching away where the prior art’s disclosure “does not criticize, discredit, or otherwise discourage the solution claimed”). Claim 16 also does not preclude use of a steel containing κ -carbides. *In re Van Geuns*, 988 F.2d 1181, 1184-85 (Fed. Cir. 1993).

Moreover, aside from attorney argument, Appellants do not direct us to sufficient evidence or provide an adequate technical explanation regarding any advantage or disadvantage in preventing or eliminating κ -carbides in certain steel compositions. *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984).

In any event, even if Appellants had shown that paragraph 21 of Kroos suggests some advantage in preventing or eliminating κ -carbides when adding carbon in certain steel compositions, we are not persuaded that such suggestion alone would prevent one of ordinary skill from using Kiese’s steel in Kroos’s hot steel strip process as found by the Examiner. *See Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006) (“a given course of action often has simultaneous advantages and disadvantages, and this does not necessarily obviate motivation to

combine”). Indeed, Kroos discloses in paragraph 21 that the disclosed invention overcomes the preconception of needing to eliminate all κ-carbides from the composition. Rather, Kroos teaches that a targeted amount of carbon may be added (*id.* at ¶ 21).

Accordingly, we have considered the request, but decline to modify our Decision affirming the Examiner’s § 103 rejections of the appealed claims. Hence, we deny Appellants’ Request for Rehearing.

DENIED