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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MINEO ASANO and YUSUKE YAMAMOTO

Appeal 2018–003214
Application 13/930,685
Technology Center 1700

Before LINDA M. GAUDETTE, JAMES C. HOUSEL, and
N. WHITNEY WILSON, *Administrative Patent Judges*.

WILSON, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner’s March 20, 2017 decision finally rejecting claims 4 and 5 (“Final Act.”). We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We reverse.

¹ Appellant is the Applicant UACJ Corporation, which is also identified as the real party in interest (Br. 1).

CLAIMED SUBJECT MATTER

Appellant's disclosure relates to an aluminum alloy sheet comprising a 5,000 series aluminum alloy sheet containing 1.0 to 6.0 mass% of magnesium and an oxide coating (Abstract, Br. 2). The magnesium is present in a solid solution state in a very uniform concentration, as set forth in claim 4, which is reproduced below from the Claims Appendix to the Appeal Brief:

4. An aluminum alloy sheet comprising a 5000 series aluminum alloy sheet containing 1.0-6.0 mass% of Mg, the Mg concentration in a solid-solution state that is present in an outermost surface area of the aluminum alloy sheet varying in a widthwise direction of the aluminum alloy sheet in the form of a band having a width of a least 0.05 mm and a difference in the concentration of Mg between adjacent bands is no more than 0.20 mass%, and an oxide coating provided thereon.

REJECTIONS

I. Claims 4 and 5 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Uesugi.²

II. Claims 4 and 5 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Moriyama.³

² Uesugi et al., US 2008/0289731 A1, published November 27, 2008.

³ Moriyama et al., JP 09-143602, published June 3, 1997 (both the Examiner and Appellant refers to the machine translation of record).

III. Claims 4 and 5 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Kobayashi.⁴

The obviousness-type double patenting rejections set forth in the Final Action were withdrawn by the Examiner in light of a Terminal Disclaimer filed by Appellant (Ans. 7) and are not, therefore, before us.

DISCUSSION

Rejection I. “A prior art reference anticipates a patent claim under 35 U.S.C. § 102(b) if it discloses every claim limitation.” *In re Montgomery*, 677 F.3d 1375, 1379 (Fed. Cir. 2012) (citing *Verizon Servs. Corp. v. Cox Fibernet Va., Inc.*, 602 F.3d 1325, 1336–37 (Fed. Cir. 2010)). Appellant argues that Uesugi does not disclose an aluminum sheet with the claimed uniformity of magnesium concentration, which, according to Appellant, manifests itself in an aluminum alloy sheet “that exhibits an excellent surface quality without a band-like streaking pattern” (Br. 2–7).

In this regard, the Examiner finds that

[r]egarding the limitation “the Mg concentration in a solid-solution state that is present in an outermost surface area of the aluminum alloy sheet varying in a widthwise direction of the aluminum alloy sheet in a form of a band having a width of 0.05 mm or more, and a difference in the concentration of Mg between adjacent bands being 0.20 mass% or less,” the alloy of Uesugi exhibits a uniform pattern and good pit uniformity, with no visible streaks, and is homogenized under the same conditions as that of the instant specification (Uesugi, para [0031-0040], Tables 2 and 3). When the structure recited in the

⁴ Kobayashi et al., EP 2 263 811 A1, published Dec 22, 2010.

reference is substantially identical to that of the claims, claimed properties or functions are presumed to be inherent. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established (see MPEP 2112.01 [R-3].) In the instant case, the aluminum alloy sheet of Uesugi would be expected to have the same or similar properties as the instantly claimed aluminum alloy sheet because Uesugi discloses the same or substantially the same composition, structure, and method of manufacturing.

(Final Act. 5).

In response, Appellant provides a detailed explanation of why Uesugi's method of production of its aluminum alloy sheet differs from the methods used to produce the claimed alloy sheet (Br. 2–3). In particular, Appellant argues that Uesugi requires a 60–300 second “hold” for the product between a rough hot-rolling step and a finish hot-rolling step to recrystallize the surface of the product (Br. 3, citing Uesugi ¶ 27). Appellant explains that the process to make the claimed aluminum alloy sheet does not include this step (Br. 4). Appellant also explains that the process to make the claimed aluminum alloy sheet requires homogenization at a temperature less than the solidus temperature and at a temperature equal to or higher than the solidus temperature -50°C for more than three hours to obtain the ingot, whereas Uesugi's process uses a shorter time for temperatures in this range or lower temperatures within this time range (*id.*).

Appellant provides evidence in the form of two Rule 132 Declarations which report attempts to replicate Uesugi's Alloy D (which was the example relied on by the Examiner). This evidence showed that Alloy D had band-like streaking patterns, and also greater differences in magnesium concentrations than allowed in the claims (Br. 5–7). According to

Appellant, this showed that the structure of Uesugi did not meet the requirements of claim 4, in particular the claimed uniformity of magnesium concentration (Br. 6–7).

Appellant’s arguments are persuasive of reversible error. The Examiner does not dispute the evidence set forth in the Declarations, but finds it unpersuasive because the Declarants did not measure the distribution of magnesium concentrations in exactly the same way as set forth in the claim (Ans. 7–8). The Examiner also argues that because the Declarations reported streaking in the Uesugi alloy it must have differed from Uesugi’s preparation because Uesugi reported no streaking (Ans. 8). Neither of these arguments are sufficient to sustain the rejection.

With regards to the Uesugi’s statement that its alloy does not display streaking, while the Declarations report streaking in the alloy prepared according to Uesugi’s method, Appellant explains that the streaking reported in the Declarations was observed using microscopic examination, while the observations reported in Uesugi were with the naked eye (Br. 6–7). The Examiner does not dispute this explanation (*see* Uesugi ¶ 38).

As for the Examiner’s statements that the method by which the distribution of magnesium concentrations differs between the evidence in the Declarations and the claims, we note that the rejection relies on a presumption that Uesugi’s structure is the same as the claimed aluminum alloy sheet because the claimed and prior art products are allegedly produced by identical or substantially identical processes (Final Act. 5). However, Appellant has provided an undisputed explanation of how the production method for the claimed product differs from Uesugi’s method of production, and has also provided factual evidence that the different methods of

production produce different structures. This is sufficient to overcome the prima facie case of anticipation.

The Examiner makes no separate findings in support of the obviousness rejection. Accordingly, we reverse both the anticipation and obviousness rejections over Uesugi.

Rejections II and III.

The reasoning provided for the §102/§103 rejections over Moriyama and Kobayashi is similar to the rejections over Uesugi (i.e. overlapping range of components and a determination that a similar method of manufacture creates a prima face case of anticipation/obviousness). Appellant presents arguments and evidence in the form of the Rule 132 Declarations which again are sufficient to overcome those rejections, essentially for the same reasons as discussed above in connection with Uesugi. That is, Appellant has explained how the manufacturing methods shown in the prior art differ from those set forth in the Specification, and has also shown that they produce a product with different properties than those of the claimed materials.

Accordingly, we reverse the anticipation/obviousness rejections over both Moriyama and Kobayashi.

CONCLUSION

We REVERSE the rejection of claims 4 and 5 under 35 U.S.C. § 102(b) as anticipated by Uesugi and the rejection of claims 4 and 5 under 35 U.S.C. § 103(a) as unpatentable over Uesugi.

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We REVERSE the rejection of claims 4 and 5 under 35 U.S.C. § 102(b) as anticipated by Moriyama and the rejection of claims 4 and 5 under 35 U.S.C. § 103(a) as unpatentable over, Moriyama.

We REVERSE the rejection of claims 4 and 5 under 35 U.S.C. § 102(b) as anticipated by Kobayashi and the rejection of claims 4 and 5 under 35 U.S.C. § 103(a) as unpatentable over, Kobayashi.

REVERSED