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HENRY M FEIEREISEN, LLC HENRY M FEIEREISEN 35 West 35th Street SUITE 900 NEW YORK, NY 10001			JOHNSON, JONATHAN J	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte THOMAS SCHULZ, MARION BECHTOLD,
NORBERT KWIATON, and ALEXANDER GEORGIEW

Appeal 2018-005522
Application 14/409,918
Technology Center 1700

Before KAREN M. HASTINGS, MICHAEL P. COLAIANNI, and
GEORGE C. BEST, *Administrative Patent Judges*.

COLAIANNI, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to finally reject claims 17–24. We have jurisdiction under 35 U.S.C. § 6(b). Appellant presented oral arguments in the appeal on September 12, 2019.

We AFFIRM.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Salzgitter Flachstahl GmbH. App. Br. 2.

Appellant's invention is directed to a cold or hot rolled steel strip having improved forming properties (Spec. ¶¶ 1 to 3; Claim 17). The steel composition permits the manufacture of more lightweight vehicle components (Spec. ¶ 5).

Claim 17 is representative of the subject matter on appeal:

17. A cold or hot rolled steel strip having improved forming properties, for a vehicle lightweight construction, said steel strip being made of a $[[A]]^{[2]}$ high strength multiphase steel with tensile strengths lying in a range of 580 MPa to 700 MPa and a yield strength ratio of less than 66% with dual phase microstructure, and composed of the following elements weight %:

C	0.075 to \leq 0.105
Si	0.600 to \leq 0.800
Mn	1.000 to \leq 2.250
Cr	0.280 to \leq 0.480
Al	0.010 to \leq 0.060
P	\leq 0.020
N	\leq 0.0100
S	\leq 0.0150

remainder iron including usual steel accompanying elements not mentioned above which constitute smelting related impurities, with the proviso that at strip thicknesses up to 1[]mm the Mn content is \leq 1.500%, that at strip thicknesses from 1 mm to 2 mm the Mn content is \leq 1.750%, and that at strip thicknesses 2[]mm the Mn content is \geq 1.500%.

Claims 17 to 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Uenishi (EP 0 969 112 A1; publ. Jan. 5, 2000).

² In future appeals, Appellant is reminded that the Claims Appendix should include a *clean* copy of the claims.

Appellant argues the claims as a group (App. Br. 3 to 7). We select claim 17 as representative of the group. 37 C.F.R. § 41.37(c)(iv). The Examiner states that all the rejections in the November 22, 2017 Advisory Action remain (Ans. 1³). An amendment of the claims after final rejection was entered by the Examiner (Advisory Act. 1). The amendment addressed a 35 U.S.C. § 112, second paragraph, rejection (After Final Amendment dated November 1, 2017). It appears from the disappearance of the § 112 rejection from the record that the entered amendment overcame that rejection.

FINDINGS OF FACT & ANALYSIS

The Examiner's findings and conclusions regarding Uenishi are located on pages 3 to 5 of the Answer and pages 4 to 6 of the Final Action.

Appellant argues that Uenishi's teachings of manganese contents that overlap with the claimed range of manganese and steel strip thicknesses in claim 17 have no bearing on the question of obviousness (App. Br. 6). Appellant contends that Uenishi provides no guidance on how to arrive at the claimed invention of steel strips with a manganese content that is dependent on the thickness of the steel strip (App. Br. 6). Appellant argues that the Examiner has not provided a reason why one of ordinary skill in the art would have modified Uenishi to arrive at the composition of claim 17 (App. Br. 6). Appellant contends that Uenishi does not provide any correlation between strip thickness and manganese content in the

³ The page numbering in the Answer skips from page 1 to page 3. The Patent Office's application database reveals a copy of the same Answer. It appears that the page number is merely a typographical error. Our citation to the Answer adheres to the formal numbering in Answer.

composition (App. Br. 6). Appellant contends that the Examiner engaged in impermissible hindsight in concluding that Uenishi would have rendered obvious the subject matter of claim 17 (App. Br. 7).

Generally, a prima facie case of obviousness exists when the ranges of a claimed composition overlap the ranges in the prior art. *In re Peterson*, 315 F.3d 1325, 1329 (Fed. Cir. 2003). In the present case, Appellant does not dispute that ranges for Mn, Cr, C, Al, P, S, and N in claim 17 overlap the ranges for these elements disclosed by Uenishi (App. Br. 6; Reply Br. *generally*). Because the claimed and prior art ranges overlap, a prima facie case of obviousness exists. *Peterson*, 315 F.2d at 1329. Appellant contends that the prior art fails to teach the correlation between the strip thickness and the Mn content (App. Br. 6). The Examiner finds, however, that Uenishi discloses Examples 6, 19, and 35 where the Mn amount in the composition falls within the claimed range and the steel strip thickness falls within the range recited in claim 17 (Ans. 4). In other words, the Examiner has shown that Uenishi teaches that it would have been with the skill of the ordinarily skilled artisan to use Mn amounts with the strip thickness recited in the claim 17.

Although Appellant alleges that the Specification paragraphs 112 to 117 establish criticality in the correlation of the Mn amounts and the strip thicknesses, this argument is presented for the first time in the Reply Brief (Reply Br. 3). There is no reason why this argument could not have been raised earlier in prosecution of the appeal. We will not consider this untimely argument. 37 C.F.R. § 41.41(b)(2).

The Examiner has established that claim 17 is prima facie obvious over Uenishi. Appellant has not established criticality of the claimed ranges

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or otherwise sufficiently rebutted the Examiner's prima facie case. On this record, we affirm the Examiner's § 103(a) rejection of claims 17 to 24.

CONCLUSION

In summary:

Claims Rejected	Basis	Affirmed	Reversed
17-24	§ 103 Uenishi	17-24	
Overall Outcome		17-24	

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