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HENRY M FEIEREISEN, LLC			LIANG, ANTHONY M	
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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 REQUEST FOR REHEARING

This is in response to a Request, filed November 22, 2019, for rehearing of our Decision dated September 25, 2019.

Appellant argues that the Board overlooked the fact that the argument regarding criticality in the correlation of the Mn amounts and the strip thicknesses was presented in the Appeal Brief (Request 2). Appellant contends that Appellant referred to paragraphs 113 to 115 of the Specification in the opening Brief, which discloses the advantages and disadvantages of adding too much or too little Mn (Request 3). Appellant concedes that the argument regarding criticality of the Mn amount citing

paragraph 117 appeared for the first time in the Reply Brief (Request 3). Appellant contends that the criticality argument in the Reply Brief was in response to the Examiner's Answer raising the issue of criticality between the Mn amount and the thickness correlation (Request 3). Appellant argues that because the opening Brief discusses the advantages and disadvantages of Mn in the alloy for achieving minimal strength, the argument regarding the criticality in the correlation between strip thickness and Mn amount is made in the opening Brief and the Board overlooked that fact (Request 3).

As admitted by Appellant on page 2 of the Request, the argument about paragraph 117, which describes the correlation between Mn amount and strip thickness is only found in the Reply Brief. The Board considered the arguments regarding the effect of the Mn content on the alloy minimal strength made in the opening Brief and disclosed in paragraphs 113 to 115 of the Specification. The opening Brief, however, does not argue the criticality of the combination of Mn amount and strip thickness. That untimely argument is not made until the Reply Brief.

Appellant's Request seems to suggest that the Examiner's statement in the Answer opened the door to the criticality argument. We disagree. The Examiner stated in the Answer that Appellant had not overcome the prima facie case of obviousness based on overlapping ranges because criticality of the presently claimed Mn range with its corresponding thickness range relative to prior art broader ranges has not been shown to achieve unexpected results (Ans. 6). The Examiner's statement merely reflects the Examiner's finding that Appellant did not make a criticality argument in the evidence in the record. This finding did not invite Appellant to make new arguments in the Reply Brief.

Appellant further argues that the Board failed to consider that the Steel Nos. 6, 19, and 35 upon which the Examiner relies lack the claimed element ranges (Request 2). Appellant provides a table on page 5 of the Request that compares Uenishi's Steels 6, 19, and 35 with the elemental amounts recited in claim 17 (Request 5). Appellant argues that Steels 6, 19, and 35 do not include all the claimed elements in amounts that fall within the ranges recited in claim 17 (Request 5).

The Examiner's findings regarding Uenishi's Steels 6, 19, and 35 were presented on page 6 of the Answer. The Examiner presented further findings regarding Uenishi's steel 19 on pages 4 to 5 of the Final Action. Despite the Examiner's findings in the Final Action and Answer, Appellant did not raise any argument regarding any difference in composition between steels 6, 19 or 35 and the claims (Reply Brief *generally*). While acknowledging that the Mn content of steels 6, 19 and 35 fall within the Mn range recited in the claim, Appellant only argued that Uenishi does not teach the correlation of Mn amount and strip thickness (Reply Br. 3). Appellant's arguments in this Request are untimely because arguments in rehearing requests are limited to arguments made in the record unless a new ground of rejection is made or the argument concerns a recent relevant decision of the Board or a federal court. *See*, 37 CFR 41.52(a).

In any event, the Examiner's rejection on pages 4 to 5 of the Final Action deals specifically with Uenishi's steel 19. The Examiner recognizes that, for example, steel 19 does not teach Cr as part of the alloy (Final Act. 4). The Examiner finds that Uenishi includes a broader disclosure that concerns the total amount of Mn and Cr in the composition is between 0.15 and 3.5 wt.% (Final Act. 4). The Examiner finds that Uenishi's broader

disclosure regarding the total amount of Mn and Cr would have led one of ordinary skill in the art to modify steel 19 of Uenishi to add between 0.28 and 0.48% Cr (Final Act. 5). Appellant has never challenged this finding or otherwise shown reversible error with this finding (Appeal Br. *generally*; Reply Br. *generally*).

We adhere to our decision for the reasons discussed above.

Appellant's rehearing request is denied.

Outcome of Decision on Rehearing:

Claims	Basis	Granted	Denied
17-24	§ 103 Uenishi		17-24
Overall Outcome			17-24

Final Outcome of Appeal after Rehearing:

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

DENIED