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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MATTHEW V. FONTE

Appeal 2019-001321
Application 14/747,705
Technology Center 1700

Before KAREN M. HASTINGS, MONTÉ T. SQUIRE, and
MERRELL C. CASHION, JR., *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ requests our review under 35 U.S.C. § 134(a) of the Examiner's decision rejecting claims 1–5, 7, 8, and 11–30 under 35 U.S.C. § 103 as unpatentable over at least the combined prior art of Fonte '688 (US 2006/0070688 A1; published Apr. 6, 2006), Ashida (US 2010/0183112 A1;

¹ We use the word “Appellant” to refer to the “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies ATI Properties LLC as the real party in interest (Appeal Br. 1).

published July 22, 2010), and Fonte ‘122 (US 2010/0236122 A1; published Sept. 23, 2010).²

We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

CLAIMED SUBJECT MATTER

Claim 1 is illustrative of the subject matter on appeal (emphasis added to highlight key disputed limitations):

1. A process for the production of a tube comprising:
 - deforming a corrosion resistant alloy plate to form a hollow cylindrical preform having a longitudinal seam region located between two abutting ends of the deformed plate;
 - welding the longitudinal seam region to join together the abutting ends, *wherein the welding is performed using a filler-less welding technique*; and
 - flowforming the hollow cylindrical preform to produce a corrosion resistant alloy tube.

Appellant’s arguments focus on the sole independent claim 1 (*see generally* Briefs). Accordingly, all other claims, including those separately rejected, stand or fall with claim 1.

OPINION

Upon consideration of the evidence of record and each of Appellant’s contentions as set forth in the Appeal Brief, as well as the Reply Brief, we determine that Appellant has not demonstrated reversible error in the Examiner’s rejections (e.g., *see generally* Ans.). *In re Jung*, 637 F.3d 1356,

² The additional references applied to various dependent claims are listed in the Summary Table located at the end of this Decision. A discussion of these references is not necessary for disposition of this appeal.

1365–66 (Fed. Cir. 2011) (explaining the Board’s long-held practice of requiring Appellant(s) to identify the alleged error in the Examiner’s rejection). We sustain the rejections for the reasons expressed by the Examiner in the Final Office Action and the Answer.

We add the following primarily for emphasis.

It has been established that “the [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007); *see also In re Fritch*, 972 F.2d 1260, 1264–65 (Fed. Cir. 1992) (a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in the art would have reasonably been expected to draw therefrom).

Appellant’s main contentions are that Ashida does not teach “using only filler-less welding” and teaches away from this technique (Appeal Br. 9 (emphasis omitted); Reply Br. 5–7). Appellant also argues that there is no motivation to combine Ashida with Fonte ‘688 (Appeal Br. 13, 14; Reply Br. 8). Appellant’s arguments are not persuasive of reversible error for reasons presented by the Examiner (Ans. 6–11).

Contrary to Appellant’s argument, a plain reading of claim 1 clearly does not require “only” a filler-less welding; furthermore, in contrast to the case law discussed by Appellant in the Reply Brief, the word “only” is not used in the claim (Ans. 6). *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) (limitations not appearing in the claim may not be relied upon for patentability). In addition, Appellant does not direct us to any limiting definition in the Specification. In any event, the Examiner aptly points out

that Ashida explicitly teaches that “it is possible to weld only by the laser beam irradiation without feeding the weld wire” (Ashida ¶ 58; Ans. 6–8).

The argument that Ashida teaches away from filler-less welding is not persuasive for reasons stated by the Examiner (e.g., Ans. 7–10). It is well established that a prior art reference must be considered in its entirety, i.e., as a whole, when determining if it would lead one of ordinary skill in the art away from the claimed invention. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550 (Fed. Cir. 1983); *In re Harris*, 409 F.3d 1339, 1341 (Fed. Cir. 2005) (whether a reference teaches away from a claimed invention is a question of fact). As pointed out by the Examiner, one of ordinary skill in the art would have inferred and readily appreciated that a known filler-less welding technique (laser beam irradiation), as discussed in Ashida, may be used to weld Fonte ‘688’s tube (Fonte ‘688 ¶ 41 (“the edges can be welded to produce the desired integral tube shape”)). An artisan of ordinary skill would have weighed the advantages and disadvantages of known welding techniques. “The fact that the motivating benefit comes at the expense of another benefit, however, should not nullify its use as a basis to modify the disclosure of one reference with the teachings of another. Instead, the benefits, both lost and gained, should be weighed against one another.” *Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 n. 8 (Fed. Cir. 2000).

Likewise, Appellant’s arguments regarding the lack of motivation to combine the cited art (Appeal Br. 13–14) are also unpersuasive for the reasons given above. That is, the arguments fail to account for “the inferences and creative steps that a person of ordinary skill in the art would employ.” *See KSR*, 550 U.S. at 418.

Thus, Appellant has not shown reversible error in the Examiner’s position that it would have been obvious for one of ordinary skill to have used a known filler-less welding technique as exemplified in Ashida on the tube of Fonte ‘688/Fonte ‘122. *See KSR*, 550 U.S. at 417 (the predictable use of known prior art elements or steps performing the same functions they have been known to perform is normally obvious; the combination of familiar elements/steps is likely to be obvious when it does no more than yield predictable results); *Ball Aerosol & Specialty Container, Inc. v. Limited Brands, Inc.*, 555 F.3d 984, 993 (Fed. Cir. 2009) (under the flexible inquiry set forth by the Supreme Court, the PTO must take account of the “inferences and creative steps,” as well as routine steps, that an ordinary artisan would employ) (emphasis omitted).

Accordingly, we sustain the Examiner’s rejection of independent claim 1, as well as all claims dependent thereon, noting that no dependent claims are separately argued (Appeal Br. *generally*).

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–5, 7, 8, 15, 16, 22–27, 30	103	Fonte ‘688, Ashida, Fonte ‘122	1–5, 7, 8, 15, 16, 22–27, 30	
11, 12	103	Fonte ‘688, Ashida, Fonte ‘122, Lamb	11, 12	
13, 14	103	Fonte ‘688, Ashida,	13, 14	

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
		Fonte '122, Nakamura		
17, 28	103	Fonte '688, Ashida, Fonte '122, Mok	17, 28	
18	103	Fonte '688, Ashida, Fonte '122, Rawson	18	
19–21	103	Fonte '688, Ashida, Fonte '122, Rawson, Mok	19–21	
29	103	Fonte '688, Ashida, Fonte '122, Mok, Manning	29	
Overall Outcome			1–5, 7, 8, 11– 30	

TIME PERIOD FOR RESPONSE

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)(iv).

AFFIRMED