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REINHART BOERNER VAN DEUREN P.C. 2215 PERRYGREEN WAY ROCKFORD, IL 61107			MCCRACKEN, DANIEL	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte FRANZ-JOSEF LENZE, SASCHA SIKORA, and
JANKO BANIK

Appeal 2019-001871
Application 15/461,783
Technology Center 1700

Before ADRIENE LEPIANE HANLON, BRIAN D. RANGE, and
LILAN REN, *Administrative Patent Judges*.

RANGE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–19. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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 ThyssenKrupp Steel Europe AG. Appeal Br. 2.

CLAIMED SUBJECT MATTER²

Appellant describes the invention as relating to a method of producing a component by a hot forming and/or press curing process and then tempering it. Spec. ¶ 2. Claim 1 is the only independent claim on appeal and is illustrative:

1. Method **for manufacturing a component for a body part or a chassis of a motor vehicle** with improved elongation at break properties, **in which a component is first produced** by one of a hot forming and press curing process, and in which the component is tempered after the one of hot forming and press curing processes characterised [sic, British spelling] in that

a tempering temperature T and a tempering time t substantially satisfy the numerical relationship $T \geq 900 \cdot t^{-0,087}$ [sic, $t^{-0.087}$], wherein the tempering temperature T is expressed in °C and the tempering time t in seconds and wherein the tempering temperature is at least 500°C and lower than AC_1 temperature.

Appeal Br. Claims App. 1 (emphases added to key recitations).

We note the Board's decisions related to Application No. 13/156,260 (a parent application to the present patent application): Appeal 2016-000312 (Jan. 18, 2017) and the related Decision on Request for Rehearing (Apr. 7, 2017).

REFERENCES

The Examiner relies upon the prior art below in rejecting the claims on appeal:

² In this Decision, we refer to the Final Office Action dated December 1, 2017 ("Final Act."), the Appeal Brief filed July 2, 2018 ("Appeal Br."), the Examiner's Answer dated October 29, 2018 ("Ans."), and the Reply Brief filed December 31, 2018 ("Reply Br.").

Name	Reference	Date
Berndsen et al. (hereinafter “Berndsen”)	DE 102006053819 A1	May 15, 2008
Peters et al. (hereinafter “Peters”)	DE 102007023306 A1	Nov. 20, 2008 ³

REJECTION(S)

The Examiner maintains (Ans. 3) the following rejections on appeal:

- A. Claims 1–5 and 9–18 under 35 U.S.C. § 103(a) as obvious over Peters. Final Act. 2.
- B. Claims 6–8 and 19 under 35 U.S.C. § 103(a) as obvious over Peters in view of Berndsen. *Id.*

OPINION

The Examiner has the initial burden of establishing a prima facie case of obviousness under 35 U.S.C. § 103. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (“[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.”). To establish a prima facie case of obviousness, the Examiner must show that each and every limitation of the claim is described or suggested by the prior art or would have been obvious based on the knowledge of those of ordinary skill in the art or the inferences and creative steps a person of ordinary skill in the art would have employed. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988); *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007).

³ For the Peters reference, the Examiner refers to the English equivalent publication, US 2011/0259482 A1, Oct. 27, 2011. Final Act. 2. We likewise refer to the English equivalent publication.

To resolve the issues before us on appeal, we focus on the Examiner's findings and conclusions that relate to the error Appellant identifies. The Examiner finds that Peters teaches a manufacturing method that overlaps with the recitations of claim 1. Appeal Br. 2. The Examiner, however, does not dispute the Appellant's position that Peters does not explicitly teach producing a component for a motor vehicle. Appeal Br. 6; Final Act. 2–5. Rather, Peters teaches production of a steel alloy for use as a well pipe for a perforation unit. *Id.*; Peters ¶¶ 1–5, 11. The well pipe may be used for opening boreholes for exploration of gas or crude oil. Peters ¶ 1.

Claim 1 recites in its preamble a “[m]ethod for manufacturing a component for a body part or chassis of a motor vehicle” and recites in its body “a component is first produced.” Appeal Br. Claims App. 1. To address these recitations, the Examiner, as a primary position, determines that the preamble recitation of “a component . . . for a motor vehicle” is merely intended use and does not accord this recitation patentable weight. Ans. 5. As an alternative, the Examiner finds that even if the preamble were accorded weight, Peters teaches a steel alloy in a tubular form that could be used in a motor vehicle.

Appellant persuasively argues that the Examiner's primary position is in reversible error because the “component” recited in the preamble is the same “component” recited in the method steps. Appeal Br. 8. In particular, we agree with Appellant's claim construction. The Specification emphasizes that the invention relates to components advantageous for use in a motor vehicle because of, for example, low weight, high dimensional stability, and high resistance to deformation in a crash. Spec. ¶ 3. In view of the Specification and the claim language, the broadest reasonable

construction for “a component [that] is first produced” is that the recited “component” must be the same as the preamble’s recitation “a component for a body part or a chassis of a motor vehicle.” The Examiner does not identify anything in the Specification that would support that the second recitation of “a component” could reasonably refer to a component other than a component for a body part or a chassis of a motor vehicle.

We are aware that, after the Final Office Action, Appellant sought to amend “a component is first produced” to instead recite “the component is first produced,” and the Examiner denied this amendment as narrowing the claim at too late a stage of prosecution. Ans. 4, 7. While we agree that claim 1’s reference to “a component” twice is not ideal claim drafting, the difference between “a” and “the” does not, in this instance, broaden claim 1 so much that “a component is first produced” may refer to any type of component. Rather, in view of both the claim and the Specification, “a component is first produced” can only be reasonably construed as meaning that a component for a body part or a chassis of a motor vehicle is first produced.

The Examiner emphasizes that there is no “manipulative difference” between Appellant’s claim 1 and Peters. Ans. 5. Claim 1, however, requires as one of its method steps producing “a component” and, as explained above, that “a component” must be a body part or chassis of a motor vehicle. The Examiner does not assert that Peters teaches the method step of producing a component of a body part or chassis of a motor vehicle.

Appellant also persuasively identifies error in the Examiner’s alternative position that Peters’s manufactured component could be used as a motor vehicle component. Reply Br. 5–6. In particular, the Examiner does

not provide adequate evidentiary support for the finding that Peters explicitly teaches manufacture of a component (for example, a well pipe of a perforation unit (Peters ¶ 11)) that would also be “a component for a body part or a chassis of a motor vehicle.” *Id.* The Examiner also does not provide evidentiary support or reasoning as to why a person of skill in the art would have used Peters’s process to make a component for a motor vehicle. *Id.* (“Whether or not the shape of a pipe can be incorporated into a roll cage is far different from whether or not the specific material from which the pipe is constructed renders the pipe suitable for use in a roll cage.”). We emphasize that the key properties emphasized by Peters for its perforation unit material are not the same as the properties emphasized by Appellant’s Specification for use in a motor vehicle. *Compare* Peters ¶¶ 2–5 (explaining, for a well pipe, the need for withstanding high stress and pressure as the pipe is lowered into the ground and further emphasizing high strength for when explosive charges within the well pipe ignite), *with* Spec. ¶ 3 (explaining, for a vehicle component, the need for low weight, high dimensional stability, resistance to deformation in a crash, and certain ductility to avoid cracking); *see also* Appeal Br. 6–7 (explaining different considerations).

Finally, we also agree with Appellant that the Board’s decision in Appeal 2016-000312 (Jan. 18, 2017) is distinguishable. Reply Br. 7. The claim analyzed by that decision does not require producing a motor vehicle component.

For the reasons above, we do not sustain the Examiner’s rejection of claim 1. Because the Examiner’s treatment of dependent claims 2–19 does

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not cure the error we address above, we also do not sustain the Examiner's rejection of those claims.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1-5, 9-18	103	Peters		1-5, 9-18
6-8, 19	103	Peters, Berndsen		6-8, 19
Overall Outcome				1-19

REVERSED