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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BERNHARD KERNIG, CHRISTOPH SETTELE, and
OLAF GÜßGEN

Appeal 2019-003463
Application 15/466,671
Technology Center 2800

Before MICHAEL J. STRAUSS, JOHN A. EVANS, and
JON M. JURGOVAN, *Administrative Patent Judges*.

STRAUSS, *Administrative Patent Judge*.

DECISION ON APPEAL¹

Pursuant to 35 U.S.C. § 134(a), Appellant² appeals from the Examiner’s decision to reject claims 1–14 and 16–19. *See* Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

¹ We refer to the Specification, filed March 22, 2017 (“Spec.”); Final Office Action, mailed February 9, 2018 (“Final Act.”); Appeal Brief, filed October 8, 2018 (“Appeal Br.”); Examiner’s Answer, mailed January 22, 2019 (“Ans.”); and the Reply Brief, filed March 22, 2019 (“Reply Br.”).

² 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 Hydro Aluminium Rolled Products GmbH. Appeal Br. 2.

PRIOR APPEAL

This Application is a continuation of parent application 13/866,639 which was subject to a prior appeal 2017-002309, decided on January 25, 2017 (our “prior Decision”), in which the Board affirmed the Examiner’s rejections of all claims then pending. *See* Appeal Br. 6.

CLAIMED SUBJECT MATTER

The claims are directed to a litho strip for electrochemical roughening. Spec., Title. Claim 1, reproduced below with formatting altered, is representative³ of the claimed subject matter:

1. Ctp-printing plate manufactured from a litho strip for electrochemical roughening, comprising
a rolled aluminium alloy,
wherein a strip surface of the litho strip has a topography with a maximum peak height R_p and/or S_p of a maximum of 1.4 μm ,
wherein the topography of the litho strip surface is essentially an imprint of a rolling topography of a final cold rolling step conducted after a controlled degreasing treatment with simultaneous pickling until a surface erosion of at least 0.25 g/m^2 is achieved,
wherein the Ctp-printing plate has a photosensitive coating with a thickness of less than 2 μm .

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Sawada	US 2002/0029709 A1	Mar. 14, 2002
Kernig	US 2009/0209444 A1	Aug. 20, 2009

³ Appellant argues independent claims 1, 8, and 14 together as a group. App. Br. 10. Accordingly, we select claim 1 as representative of the group and address only this claim in our analysis. *See* 37 C.F.R. §41.37(c)(1)(iv).

REJECTION⁴

Claims 1–14, and 16–19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant’s Admitted Prior Art (AAPA) in view of Sawada and Kernig. Ans. 3.

STANDARD OF REVIEW

We review the appealed rejections for error based upon the issues identified by Appellant, and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential).

OPINION

Examiner’s Findings

The Examiner finds the disclosure by Applicant’s Admitted Prior Art (AAPA) of printing plates “used . . . in the field of [computer to plate (Ctp)] technology” wherein “the thickness of the [photosensitive] coating is decreasing [in the past few years]” (Spec. ¶ 5) teaches the recited CtP-printing plate manufactured from a litho strip for electrochemical roughening comprising a rolled aluminum alloy. Final Act. 5. The Examiner finds Sawada’s support for a lithographic printing plate with a photosensitive layer thickness of, preferably, 0.1 to 30 μm and, more preferably, 0.5 to 10 μm teaches the recited thickness of less than 2 μm. *Id.* According to the Examiner “it would have been obvious to one having

⁴ Rejections of claim 14 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement and under 35 U.S.C. § 103(a) over Applicant’s Admitted Prior Art (AAPA) in view of Kernig have been withdrawn. Ans. 3.

ordinary skill in the art to use a photosensitive layer with a thickness of less than 2 μm . . . because it has been shown in the art to be a suitable thickness for a photosensitive layer on a printing plate.” *Id.* (citing MPEP §2144.07⁵). The Examiner finds Kernig’s method for conditioning an aluminum alloy work piece would result in, and thereby teaches or suggests, the claimed surface erosion and topography. *Id.* at 6–7.

Ctp Printing Plate

Appellant’s first contention is that the Examiner erred by finding the prior art teaches or suggests a computer to plate (Ctp) printing plate as recited in the preamble of claim 1. Appeal Br. 8. Addressing the rejection over the combination of AAPA, Sawada and Kernig Appellant incorporates argument made earlier in the Appeal Brief in connection with the now withdrawn rejection over AAPA and Kernig alone. *Id.* Thus, Appellant argues “the Examiner has failed to demonstrate that the alleged AAPA in view of Kernig disclose[s] specifically a Ctp-printing plate, i.e., a printing plate specifically configured for Ctp printing, as opposed to a conventional printing plate used with Ctp technology.” *Id.* at 5. Appellant argues the Examiner’s reliance on AAPA disclosed at paragraph 5 of the Specification is misplaced, the cited paragraph only disclosing the latter, i.e., currently available printing plate carriers used in the field of Ctp technology, not a Ctp-printing plate as recited in the preamble of claim 1. *Id.* at 6. According to Appellant, conventional printing plates do not include or disclose features

⁵ MPEP § 2144.07 Art Recognized Suitability for an Intended Purpose (The selection of a known material based on its suitability for its intended use supports a prima facie obviousness determination.).

required of printing plates specifically configured for use with Ctp technology as claimed. *Id.* at 6–7. Appellant further argues “the Examiner does not cite Kernig as disclosing Ctp-printing plates as recited in claims 1 and 8. Therefore, the combination of Kernig and AAPA fails to disclose, teach, or suggest all the limitations of claims 1 and 8.” *Id.* at 7. Appellant argues the addition of Sawada fails to cure the argued deficiencies of AAPA and Kernig.

The Examiner responds

Sawada et al. show the general knowledge in the art that photosensitive layers on printing plates typically have a thickness of from 0.1 to 30 μm (paragraph 86). Thus, one having ordinary skill in the art would have reasonably expected that choosing a thickness of the photosensitive layer in this range (including the recited, overlapping range(s) of less than 2 μm . . .) would have resulted in a successful Ctp-printing plate.

Ans. 4. According to the Examiner “Appellant’s arguments here amount to arguments against the references individually; one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.” *Id.* (citing *In re Keller*, 642 F. 2d 413 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091 (Fed. Cir. 1986)).

Appellant replies, arguing the preamble recitation of a Ctp-printing plate is limiting. Therefore, according to Appellant, because the prior art does not disclose the recited method steps specifically for making a Ctp-printing plate, the combination fails to teach or suggest the claimed subject matter. Reply Br. 5–8.

Appellant’s contention is unpersuasive of reversible Examiner error. “In general, a preamble limits the invention if it recites essential structure or steps, or if it is ‘necessary to give life, meaning, and vitality’ to the claim.”

Catalina Marketing International, Inc. v. Coolsavings.com, Inc., 289 F.3d 801, 808–809 (Fed. Cir. 2002) (quoting *Pitney Bowes Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999)). In *Catalina*, the Federal Circuit identified several “guideposts” to help determine whether a preamble limits claim scope. *Id.* at 808. For example, a preamble may operate as a claim limitation “when reciting additional structure or steps underscored as important by the specification.” *Id.* Additionally, a preamble phrase that provides antecedent basis for a claim limitation generally limits the scope of the claim. *Id.*

“Conversely, a preamble is not limiting ‘where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention.’” *Id.* (quoting *Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997)). Put another way, “a preamble generally is not limiting when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention.” *Id.* at 809. Furthermore, a preamble is not limiting where it merely gives a name to the invention, or extols its features or benefits. *Id.*

On this record, we do not consider the preamble of claim 1 to be limiting. The argued phrase “Ctp-printing plate” does not provide antecedent basis for a claim limitation. Furthermore, Appellant does not argue and we do not identify any effect that specifying the structure as a Ctp-printing plate has on the structure or steps of the claimed invention. In particular, Appellant fails to identify any features required of Ctp-printing plates other than those specified by the limitations recited in the body of claim 1. To the contrary, Appellant argues “convention[al] printing plates

do not disclose, teach, or suggest many of the limitations of claims 1 and 8 that specifically make the printing plate configured for use with Ctp technology” and “the Examiner has failed to appreciate the limitations of claims 1 and 8 directing the claimed subject matter to Ctp-printing plates.” Reply Br. 7. Thus, the structurally complete invention is recited in the claim body and the preamble is used only to state a purpose or intended use for the invention (i.e., for use in Ctp-printing) and/or merely gives a name to the invention (i.e., a Ctp-printing plate).

The facts here are distinguishable from those in the cases Appellant relies on to support its position. For example, in *Corning Glass Works v. Sumitomo Elec. USA, Inc.*, 868 F.2d 1251 (Fed. Cir. 1989), the Federal Circuit found that “optical waveguide” in the preamble was limiting because the specification included a specific definition for the phrase “optical waveguide” that described the physical attributes of the waveguide and “sets forth in detail the complex equation for the structural dimensions and refractive index differential necessary” for the claimed optical waveguide to transmit light. *Id.* at 1256. In view of this, the Federal Circuit determined the claim did not cover all types of optical fibers, but instead was “restricted to those fibers that work as waveguides as defined in the specification.” *Id.* at 1257. As a result, the Federal Circuit concluded the preamble did not merely state a purpose or intended use but, rather, provided further positive limitations to the claimed invention, namely the particular structural relationship defined in the specification. *Id.*

Unlike the situation in *Corning*, there is no explicit definition of “Ctp-printing plate” in Appellant’s Specification. Instead, the Specification discloses “[t]he printing plate carrier according to the invention can

preferably be used in CtP technology, in other words for a CtP printing plate.” Spec. ¶48. Thus, a Ctp-printing plate is defined by the claimed structure and processing steps.

For the reasons discussed above, the argued preamble of claim 1 is not limiting. Accordingly, Appellant’s argument that the prior art fails to teach a Ctp printing plate is unpersuasive of reversible Examiner error.

Combination of AAPA, Sawada and Kernig

Appellant contends, because neither Sawada nor Kernig are specifically directed to Ctp-printing plates, there is no recognition of “the particular issues faced by Ctp-printing plates, which are discussed in Appellant[’s S]pecification.” Appeal Br. 7. Thus, according to Appellant, absent recognition of these issues, one skilled in the art would not have combined the teachings of the prior art. *Id.* at 9. Appellant further argues, because Sawada is not directed to Ctp-printing plates, a person of ordinary skill in the art would not look to that reference to mitigate printing errors involving that technology. *Id.* According to Appellant, although Sawada discloses photosensitive layers with a thickness of 0.1 to 30 μm , rather than reducing layer thickness, a person of ordinary skill in the art would increase layer thickness toward the upper end of the disclosed range. *Id.* “Accordingly, Sawada, when read in view of the problems found in the Ctp printing art discussed in the relied upon alleged AAPA, actually would lead one of ordinary skill in the art away from Appellant[’s] claimed range of less than 2 μm .” *Id.*

The Examiner responds, directing attention to page 5 of the Final Action for the Examiner’s reasoning for combining AAPA and Sawada.

Ans. 5. In response to Appellant's argument that Sawada is not concerned with Ctp-printing plates, the Examiner finds "[t]he teachings of Sawada . . . are generic to printing plates, which includes Ctp printing plates." *Id.* Responding to Appellant's assertion that one having ordinary skill in the art would be led to choose a thickness closer to the maximum thickness disclosed by Sawada (i.e., a thickness greater than that recited by claim 1), the Examiner finds insufficient evidence to support the assertion. *Id.*

According to the Examiner

The fact remains that Sawada . . . teach[es] that photosensitive layers typically have thicknesses from 0.1 μm to 30 μm , overlapping the instantly recited range of less than 2 μm ; [the] Examiner maintains that this express teaching by Sawada . . . would motivate one having ordinary skill in the art to choose the thickness of the photosensitive layer of the Ctp plate of AAPA to fall within this range because of the art-recognized suitability of the range.

Id.

Appellant replies, arguing "no rationale was provided regarding application of Sawada to Ctp-printing plates." Reply Br. 8. According to Appellant

Sawada does not establish the suitability of the thickness of the photosensitive layer for any and all printing plates but just for the printing plates disclosed in Sawada. Thus, the Examiner must provide some factual basis to apply Sawada's teachings to Ctp-printing plates. As pointed out by Appellants, the Examiner did not.

Id. at 8–9.

Appellant's contentions are unpersuasive of reversible Examiner error. As discussed above, the preamble of claim 1 is not limiting and,

therefore, the claim is not restricted to Ctp-printing plates as argued. Furthermore, we disagree the combination of AAPA and Sawada is improper because there is no recognition by the references of the problem solved by Appellant's invention. Appeal Br. 17. This is because the Examiner's reason why one of ordinary skill in the art would have incorporated Sawada's thickness of the photosensitive layer in the photosensitive layers of AAPA need not address the same problem as that to which the invention is directed. *In re Kahn*, 441 F.3d 977, 987 (Fed. Cir. 2006) (The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant.); *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1323 (Fed. Cir. 2005) ("One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings."); *In re Linter*, 458 F.2d 1013 (CCPA 1972); *In re Dillon*, 919 F.2d 688 (Fed. Cir. 1990), *cert. denied*, 500 U.S. 904 (1991).

Moreover, the Supreme Court has held, "[i]n determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls." *KSR.*, 550 U.S. at 419. For a prima facie case of obviousness to be established, the reference need not recognize the same problem solved by Appellants. *See Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Int. 1985) ("The fact that [Appellants have] recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.>").

We are also not persuaded by Appellant's contention that one skilled in the art would not look to Sawada to solve printing problems in making Ctp-printing plates. Appeal Br. 9. Appellant provides insufficient evidence that Sawada is not applicable to Ctp-printing plates or otherwise teaches away from using the disclosed photosensitive layer thicknesses in connection with AAPA. Attorney argument and conclusory statements, which are unsupported by factual evidence, are entitled to little probative value. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984). Attorney argument is not evidence. *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974). Nor can such argument take the place of evidence lacking in the record. Likewise, we are not persuaded one skilled in the art would only use the upper range of Sawada's layer thicknesses rather than the lower end of the range that includes the claimed thickness of less than 2 μm . Appellant's arguments being unpersuasive for the reasons discussed above, on this record, we determine the Examiner has articulated reasoning with rational underpinnings sufficient to justify the legal conclusion of obviousness. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007); see Final Act. 5, Ans. 5.

For the reasons discussed above, we sustain the rejection of claims 1–14 and 16–19 under 35 U.S.C. § 103(a) over AAPA, Sawada, and Kernig.

CONCLUSION

The Examiner's rejection of claims 1–14 and 16–19 under 35 U.S.C. § 103(a) over AAPA, Sawada, and Kernig is affirmed.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1-14, 16-19	103a	AAPA, Sawada, Kernig	1-14, 16-19	

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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED