

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ULRICH HIELSCHER, HORST STERNAU
and HUBERT KOCH

Appeal No. 1997-4283
Application No. 08/342,695

HEARD: July 12, 2001

Before PAK, WARREN and JEFREY T. SMITH, Administrative Patent Judges.

PAK, Administrative Patent Judge.

REQUEST FOR REHEARING

This is a decision on appellants' request for rehearing of our earlier decision entered May 29, 2001, wherein we affirmed the examiner's rejections of the appealed claims under 35 U.S.C.

§ 103. This decision is rendered subsequent to the oral hearing dated July 12, 2001 consistent with appellants' request in the Request for Rehearing dated June 15, 2001.

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We have carefully considered the arguments raised by appellants in the Request for Rehearing. However, we are not persuaded by those arguments to alter our earlier decision entered May 29, 2001.

Initially, we note that appellants argue that we overlooked dependent claims 2 and 3 which were separately argued at page 8, lines 3-10, of the Brief. See the Request for Rehearing, page 2. However, we are not persuaded that those claims are separately patentable over the applied prior art. As indicated in our earlier decision, appellants have not timely challenged the examiner's determination that "[a]ppellants do not provide reasons why each appealed claim is considered separately patentable [over the applied prior art]." See, e.g., Reply Brief. Thus, we determine that the patentability of those claims stands or falls together with the patentability of claim 13.

Even were we to consider those claims separately, our conclusion will not be changed. As acknowledged by appellants (Brief, page 5), the applied prior art references, namely Kurofuchi and Yonezawa, teach employing less than or equal to 5000 ppm strontium or less than or equal to 150 ppm strontium,

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which are all inclusive of the amount of strontium recited in claim 2. Moreover, the applied prior art references, namely Latkowski, Kurofuchi and Yonezawa, teach employing the amount of zirconium recited in claim 3. Thus, it would have been *prima facie* obvious to employ workable or optimum proportions of strontium and/or zirconium in the aluminum alloy described or suggested in the applied prior art. See *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

Appellants also argue that we overlooked the sufficiency of the Koch declaration in rebutting the *prima facie* cases established by the examiner. However, we are not persuaded of any error on our part for the reasons set forth at pages 5 and 6 of our earlier decision. We find that appellants have not evinced either directly or indirectly that the claimed entire concentration ranges of Magnesium and Manganese are shown to be critical. See *In re Clemens*, 622 F.2d 1029, 1035, 206 USPQ 289, 296 (CCPA 1980). Nor have appellants evinced that the showing limited to a single aluminum alloy having specific proportions of silicon, magnesium, manganese, strontium, aluminum, iron, copper, zinc and titanium is sufficient to

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support the myriad of alloys covered by the appealed claims. *Clemens*, 622 F.2d at 1035, 206 USPQ at 296. Appellants have not demonstrated that the unexpected improvements attributable to the alloy tested in the Koch declaration are attributable to those claimed alloys containing either no or only some of strontium, iron, copper, zinc, titanium and zirconium. The need for a broader and more representative showing is even more compelling in view of appellants' own argument regarding the effect of the presence of certain proportions of certain alloy components, such as zirconium and strontium, in the claimed alloy. See Brief, page 8.

In view of the foregoing, appellants' request for rehearing is granted to the extent of reconsidering our earlier decision entered May 29, 2001, but is denied with respect to making any changes thereto.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REQUEST FOR REHEARING-DENIED

CHUNG K. PAK)	
Administrative Patent Judge)	
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)	
)	
)	BOARD OF PATENT
CHARLES F. WARREN)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
JEFREY T. SMITH)	
Administrative Patent Judge)	

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APJ PAK

APJ WARREN

APJ SMITH, JEFREY T.

DECISION: DENIED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s):

Prepared: May 23, 2002

Draft Final

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OB/HD GAU

PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT