

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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* PIUS SCHWELLINGER

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Appeal No. 2002-2189  
Application No. 09/194,294

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ON BRIEF

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Before LIEBERMAN, TIMM, and POTEATE, *Administrative Patent Judges*.  
TIMM, *Administrative Patent Judge*.

***DECISION ON APPEAL***

Appellant appeals the final rejection of claims 16-33 which are all the claims pending in the application. Subsequent to the final rejection, the Examiner withdrew a non-statutory double patenting rejection (Answer at p. 2) and, additionally, withdrew a number of prior art references from a rejection over prior art (Answer at p. 4). Therefore, our review is limited to the two remaining grounds of rejection:

- (1) the rejection of claims 16-21 and 24-33 under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Warren<sup>1</sup>; and
- (2) the rejection of claims 16-33 under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Schwellinger<sup>2</sup> or Bergsma<sup>3</sup>.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

Claim 16 illustrates the subject matter on appeal:

16. A component made of an AlMgSi alloy having high capacity to absorb kinetic energy by plastic deformation, the alloy containing in wt. %:

silicon		0.40	to	0.80;
magnesium		0.40	to	0.70;
iron	max.	0.30;		
copper	max.	0.20;		
manganese	max.	0.15;		
vanadium		0.05	to	0.20;
chromium	max.	0.10;		
titanium	max.	0.10;		
zinc	max.	0.10;		

further elements each individually at most 0.05, in total at most 0.15; and

a remainder aluminum, wherein the alloy is one of in a partially age hardened condition T64 and in an over-aged condition T72.

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<sup>1</sup>U.S. Patent 5,527,404 issued to Warren on June 18, 1996.

<sup>2</sup>U.S. Patent 4,525,326 issued to Schwellinger et al. on June 25, 1985.

<sup>3</sup>U.S. Patent 5,571,347 issued to Bergsma on November 5, 1996.

***OPINION***

We reverse with regard to all of the rejections.

All of the claims call for an alloy which is in either a partially-age-hardened condition T64 or in an over-aged condition T72. Appellant argues that the aged condition is a structural characteristic of the alloy (Brief at p. 13 and p. 17). In the rejection, the Examiner makes no specific findings of fact with regard to the age hardened condition of the prior art alloys (Answer at p. 4). In answering Appellant's argument, the Examiner merely states that "appellant fails to show how the claimed aging conditions would affect the alloy's properties which are different from the aged alloys as taught by the cited references." (Answer at p. 5).

In order to establish a *prima facie* case with respect to a rejection made under § 102 or, alternatively, under § 103, the Examiner must present a reasonable basis to believe that what is claimed is identical or substantially identical to what is taught in the prior art. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433-34 (CCPA 1977). Only then does the burden shift to Appellant. *Id.* The Examiner, here, attempts to shift the burden without presenting the required reasonable basis to believe a component made by the prior art is identical or substantially identical to the component claimed (Answer at p. 5).

Moreover, the record supports Appellant's position that the limitation on age hardened condition is a structural difference. The independent claims refer to a "condition" not a method. The letter "T" followed by a number is a designation, in accordance with the Aluminum Association system, for a condition which arises in the alloy upon tempering. In the T6 condition, the alloy has

maximum or peak strength (Warren at col. 6, ll. 1-2). A partially- or under-aged alloy does not have maximum strength (specification at p. 3, l. 36). It follows that alloys with different “T” designations have different properties and, thus, are different from each other.

None of the references describe an alloy of the composition claimed that is in the T64 or T72 condition. Warren either naturally ages or artificially ages to T6 strength (col. 6, ll. 1-2). Schwelling does not specify the condition achieved upon artificial age hardening (Examples 2E, 4E, and 5E, col. 2, ll. 31-46). Bergsma describes alloys which can be aged by any of the typical under-aging or over-aging treatments, but Bergsma does not specifically describe aging to T64 or T72 condition.

There is no adequate basis to believe that the prior art alloys are identical or substantially identical to those claimed. Under such circumstances, there is insufficient evidence to support a rejection based on “inherency” under 35 U.S.C. § 102, or on “*prima facie* obviousness” under 35 U.S.C. § 103. *Best*, 562 F.2d at 1254, 195 USPQ at 433-34.

The Examiner also provides an additional obviousness rationale. According to the Examiner, “treating known alloys for the known aging conditions is contemplated within [the] ordinary skill [of the] artisan.” (Answer at p. 6). This may be true, but it is alone not enough to establish that one of ordinary skill in the art would have had a reason or motivation to age harden the alloys of the references to, specifically, either the T64 or the T72 condition. None of the references, when taken by themselves, provide a suggestion to so under- or over-age an alloy of the claimed composition. Nor has the Examiner provided an objective basis supporting a finding that knowledge generally

available in the prior art would have led one of ordinary skill in the art to artificially age the alloys to the specifically claimed T64 and T72 conditions. An objective basis is required to establish a *prima facie* case of obviousness. *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002)(The factual inquiry whether to combine references must be thorough and searching and be based on objective evidence of record). No such objective basis is presented.

### ***CONCLUSION***

To summarize, the decision of the Examiner to reject claims 16-33 under 35 U.S.C. § 102(b), or in the alternative, under 35 U.S.C. § 103(a) is reversed.

REVERSED

PAUL LIEBERMAN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
CATHERINE TIMM	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
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	)	
LINDA R. POTEATE	)	
Administrative Patent Judge	)	

CT/jrg

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KLAUS P. STOFFEL, ESQ.  
OSTROLENK, FABER, GERB & SOFFEN, LLP  
1180 AVENUE OF THE AMERICAS  
SUITE 1210  
NEW YORK, NY 10036-8403