

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BERNHARD ENGL, DIETER SENK,
JOHANN WILHELM SCHMITZ and ANDREAS OFFERGELD

Appeal 2006-2882
Application 10/433,729
Technology Center 3700

Decided: February 28, 2007

Before BRADLEY R. GARRIS, CHUNG K. PAK, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 12-25, the only claims pending in this application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

We AFFIRM.

INTRODUCTION

Appellants invented a method for producing a steel hot strip having a manganese content of more than 12 and up to 30 weight percent comprising the following steps: (1) forming a roughed strip by casting a melt in a double-roller casting machine, and (2) immediately after casting and without reheating the roughed strip, hot-rolling the roughed strip in a single hot roll pass through the a roll stand to the final thickness of the strip (Specification 1-2). By hot rolling immediately after casting, Appellants avoid reheating the roughed strip that is required by conventional methods (Specification 3).

Claim 12 is illustrative:

12. A method for producing a steel hot strip with TWIP and TRIP characteristics from a steel which comprises more than 12 weight % and up to 30 weight % of manganese, comprising

casting a melt in a double-roller casting machine so as to form a roughed strip at close to the final dimensions of said hot strip, said roughed strip having a thickness of up to 6 mm,

immediately after said casting step and without reheating said roughed strip, continuously processing said roughed strip by being hot rolled in a roll stand in a single hot roll pass to the final thickness of the hot strip.

The Examiner relies on the following prior art references as evidence of unpatentability:

Suzuki (as translated)	JP 57-025950	Aug. 27, 1983
Guelton	US 6,358,338 B1	Mar. 19, 2002

The rejections as presented by the Examiner are as follows:

1. Claims 12-14 and 18-25 are rejected under 35 U.S.C. § 102(e) as unpatentable over Guelton.
2. Claims 15-17 are rejected under 35 U.S.C. § 103(a) as unpatentable over Guelton in view of Suzuki.

Rather than reiterate the respective positions advocated by the Appellants and by the Examiner concerning these rejections, we refer to the Brief and to the Answer respectively for a complete exposition thereof.

OPINION

The Examiner rejected claims 12-14 and 18-25 under § 102(e) as being anticipated by Guelton. The Examiner found that Guelton discloses Appellants' claim features, including "immediately after said casting step and without reheating said roughed strip, continuously processing said roughed strip by being hot rolled in a roll stand in a single hot roll pass to the final thickness of the hot strip." (Answer 3-4). Appellants dispute whether Guelton discloses the aforequoted claim feature (Br. 6).

Appellants argue that Guelton fails to disclose the "influences of such a step [of hot rolling in a single pass immediately after casting the roughed strip] on the structure and the properties such hot rolling has [on the steel hot strip], and thus the desirability of performing the hot rolling step" (Br. 5). Appellants argue that Guelton's hot rolling is merely an option and Guelton actually discloses an advantage in eliminating the hot rolling (Br. 5). Specifically, Appellants contend that Guelton discloses removing hot rolling from the process so as to eliminate the risk of hot cracking the steel strip by the necessary reheating prior to hot rolling (Br. 5). Appellants further contend Guelton's steel is austenitic in structure regardless of the temperature used to hot roll it, such that there is no reason to implement Guelton's optional hot rolling step (Br. 5).

The Examiner responds that Guelton discloses all of the features of claim 12 (Answer 6). Specifically, the Examiner indicates that Guelton

discloses that the hot rolling step is “preferable” not merely optional (Answer 6). Moreover, the Examiner finds Guelton discloses that hot rolling may be performed in “one or more steps” (Answer 7). The Examiner also finds that the properties of Guelton’s high manganese steel strip would “inherently” be the same as Appellants’ properties because Guelton’s process is identical to that claimed by Appellants (Answer 7).

We agree with the Examiner’s ultimate finding that claims 12-14 and 18-25 are anticipated by Guelton.

Appellants’ only argued distinction is whether Guelton discloses performing a hot rolling step in a single pass immediately after casting. However, as clearly stated by the Examiner, Guelton discloses Appellants’ features recited in claim 12, including “immediately after said casting step and without reheating said roughed strip, continuously processing said roughed strip by being hot rolled in a roll stand in a single hot roll pass to the final thickness of the hot strip” (Answer 3). As the Examiner correctly found, Guelton discloses that the hot rolling step is “preferable” and may be performed in “one or more” passes (Guelton, col. 4, ll. 11, 19-20) (Answer 6-7). Hence, Guelton discloses Appellants’ only argued distinction.

Moreover, Appellants are mistaken that Guelton teaches away from hot rolling. Appellants cite to Guelton, column 2, lines 4-11 as showing that Guelton teaches away from using a hot rolling step (Br. 5). However, a closer examination of Appellants’ cited passage indicates such passage refers to a conventional method of manufacturing a steel strip, not Guelton’s disclosed method.

For two reasons, we are unpersuaded by Appellants’ arguments regarding the various properties of the steel strip achieved by hot rolling in a

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single pass without reheating the steel strip. First, as the Examiner correctly found, and the Appellants have not met their burden of proving otherwise, such properties would be inherent in Guelton's steel strip because Appellants' and Guelton's method of manufacturing the steel strip are identical (Answer 7). *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977). Second, since the properties Appellants argue are present in their steel strip are not recited in their claims, such properties will not be read into the claims when assessing the patentability thereof. *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

For the foregoing reasons, we affirm the Examiner's rejection of claims 12-14 and 18-25 under § 102(e) over Guelton.

CLAIMS 15-17

Appellants have not separately argued the § 103(a) rejection of dependent claims 15-17 over Guelton in view of Suzuki. Rather, Appellants rely on their arguments made with regard to the § 102(e) rejection.

As previously noted, we are unpersuaded by Appellants' arguments regarding the § 102(e) rejection. Accordingly, the § 103(a) rejection is sustained for the same reasons the § 102(e) rejection is sustained.

We affirm the § 103(a) rejection of claims 15-17 over Guelton in view of Suzuki.

CONCLUSION

We have affirmed the § 102(e) rejection of claims 12-14 and 18-25 over Guelton.

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We have affirmed the § 103(a) rejection of claims 15-17 over Guelton in view of Suzuki.

The Examiner's decision is affirmed.

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)(2006).

AFFIRMED

clj

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