

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 STEVEN JOEL BULLIED, JOHN JOSEPH MARCIN, JR.,
ROBERT CHARLES RENAUD, ROY ALAN GARRISON, and STEPHEN
DOUGLAS MURRAY¹

Appeal 2007-1488
Application 10/809,072
Technology Center 1700

Decided: July 10, 2007

Before ADRIENE LEPIANE HANLON, ROMULO H. DELMENDO, and
SALLY G. LANE, *Administrative Patent Judges*.

DELMENDO, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The real party in interest is UNITED TECHNOLOGIES CORP. (Appeal Br. 1).

1 Representative claim 1 reads as follows:

2 1. A system comprising:
3 an investment molding cavity;
4 a seed crystal starter cavity;
5 a seed crystal for initiating epitaxial crystal growth in
6 molten metallic material that comes into contact therewith;
7 a grain selector operatively connecting the seed crystal
8 starter cavity and the investment molding cavity for at least one
9 of: (1) selecting a single crystal from the seed crystal to grow
10 into the molten metallic material during solidification, or (2)
11 ensuring that a single crystal from the seed crystal continues to
12 grow into the molten metallic material during solidification;
13 and
14 a grain selector support for at least partially supporting
15 the weight of the investment molding cavity and any molten
16 metallic material contained therein to take at least a portion of
17 this weight off the grain selector,
18 wherein the system is capable of producing a single
19 crystal investment cast component, and wherein the grain
20 selector comprises a non-linear tubular structure comprising at
21 least one of: a helix, a three-dimensional bend, a staircase, and a
22 zigzag.

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24 The Examiner rejected claims 1-12, 15, 17-30, and 33-35 under 35
25 U.S.C. § 103(a) on three separate grounds over various combinations of
26 prior art references.² (Answer 3-4.)

27 The prior art relied upon by the Examiner in rejecting the claims on
28 appeal is:

29 Burd US 4,180,119 Dec. 25, 1979

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31 Giamei US 4,475,582 Oct. 9, 1984

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² The Examiner expressly stated that the rejections no longer rely on United States Patent 4,940,073 issued to Jeyarajan et al., which had been applied in the Final Office Action of May 26, 2006. (Answer 3.)

1 Monte US 5,062,468 Nov. 5, 1991

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3 Monte US 5,062,469 Nov. 5, 1991

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5 With respect to the first rejection, the Examiner's position is that
6 although Monte '468 or Monte '469 does not describe a grain selector
7 having the configuration (a helix, a three-dimensional bend, a staircase, or
8 zigzag) recited in the claims, a person having ordinary skill in the art would
9 have found it obvious to use a helical grain selector as shown in Burd in
10 either Monte '468 or Monte '469 because such helical grain selectors have
11 conventionally been used in the art. (Answer 3.) Conversely, in the second
12 rejection, the Examiner determined that although Burd differs from the
13 claimed system in that it does not describe a seed crystal for initiating
14 epitaxial growth, the teachings of Monte '468 and Monte '469 would have
15 led one of ordinary skill in the art to provide Burd's system with a seed
16 crystal "to ensure only single crystal is grown in the mold cavity and thereby
17 reduce the scrap rate." (Answer 3-4.) In the third rejection, the Examiner
18 found that although Giamei does not describe a grain selector support, the
19 teachings of Monte '468, Monte '469, and, in particular, Burd would have
20 led one of ordinary skill in the art to modify Giamei's system to include a
21 grain selector support that would "assume the load imposed on the crystal
22 selector..." (Answer 4.)

23 Applicants, on the other hand, contend that Monte '468 and Monte
24 '469 limit the configuration of the crystal (grain) selector to "simple single
25 two-dimensional bends" and therefore teach away from "more complex
26 grain selector configurations" such as "a helix, a three-dimensional bend, a
27 staircase, and a zigzag." (Appeal Br. 7-8 and 9-10.) Applicants further

1 contend that “[t]here is no suggestion or motivation” in the prior art
2 references “to modify any of the inventions [described in the references] as
3 suggested by the Examiner.” (Appeal Br. 11.)

4 We affirm all three rejections.

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6 ISSUE

7 Have Applicants shown that the Examiner erred in concluding that
8 one of ordinary skill in the art would have found it obvious to modify the
9 system of Monte ‘468 or Monte ‘469 to include a helical crystal (grain)
10 selector such as that shown in Burd, thus arriving at a system encompassed
11 by appealed claim 1?

12 Have Applicants shown that the Examiner erred in concluding that
13 one of ordinary skill in the art would have found it obvious to modify the
14 system of Burd to include a seed crystal as taught in Monte ‘468 or Monte
15 ‘469, thus arriving at a system encompassed by appealed claim 1?

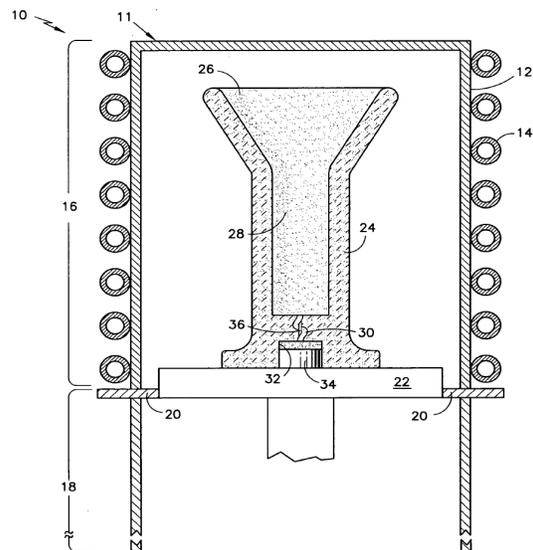
16 Have Applicants shown that the Examiner erred in concluding that
17 one of ordinary skill in the art would have found it obvious to modify the
18 system of Giamei to include a grain selector support as shown in Monte
19 ‘468, Monte ‘469, or Burd, thus arriving at a system encompassed by
20 appealed claim 1?

21

22 FINDINGS OF FACT

- 23 1. Applicants’ Specification states that Figure 1 shows “an
24 exemplary investment casting system 10.” (Specification,
25 [0022].)
- 26 2. Applicants’ Figure 1 is reproduced below:

FIG.1



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3. Applicants' Figure 1 is said to depict an investment casting system 10, wherein relevant reference numerals 28, 30, 32, 34, and 36 denote a mold cavity, a grain selector, a seed crystal starter cavity, a seed crystal, and a grain selector support, respectively. (Specification, [0023].)

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Rejection I: Monte '468 or Monte '469, Each in View of Burd

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4. The Examiner found that each of Monte '468 and Monte '469 describes the claimed invention "except that the configuration of their grain selector is different from that...claimed." (Answer 3.)

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5. Applicants do not contest the Examiner's finding in this regard.

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6. Specifically, the crystal (grain) selector described in Monte '468 or Monte '469 does not include "a non-linear tubular

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1 structure comprising at least one of: a helix, a three-dimensional
2 bend, a staircase, and a zigzag,” as recited in appealed claim 1.

3 7. The Examiner also found that both Monte ‘468 and Monte ‘469
4 teach that helical crystal (grain) selectors of the so-called
5 “pigtail” type have been used in the prior art but that they are
6 “relatively expensive,” which “may be contributed to by a
7 substantial scrap rate.” (Monte ‘468, 1:21-25; Monte ‘469,
8 1:17-22.)

9 8. The crystal (grain) selectors of Monte ‘468 and Monte ‘469 are
10 said to be an improvement over prior art grain selectors.
11 (Monte ‘468, 3:48-60; Monte ‘469, 2:25-36.)

12 9. The Examiner also relied on Burd to show that grain selectors
13 with a helical configuration were commonly used in the prior
14 art. (Answer 3; Burd, 2:10-35.)

15 10. Applicants do not rely on any evidence (e.g., declaration
16 evidence) to show that their invention does not suffer from the
17 known disadvantages of helical grain selectors.

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19 *Rejection II: Burd in View of Either Monte ‘468 or Monte ‘469*

20 11. Burd’s Figure 2 is reproduced as follows:

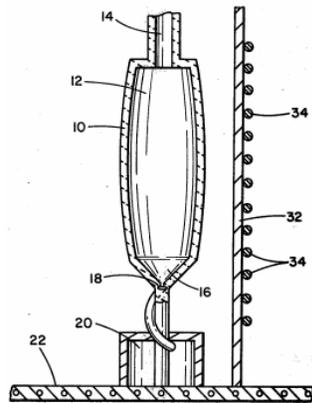


FIG. 2

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12. Burd's Figure 2 is said to depict a mold assembly, wherein relevant reference numerals 12, 18, and 20 represent a cavity, a helix crystal selector, and a starter chamber, respectively.

(Burd, 2:3-48.)

13. The Examiner found that Burd describes every element of the claimed invention except it does not explicitly disclose "a seed crystal for initiating epitaxial crystal growth in molten metallic material..." as recited in appealed claim 1. (Answer 4.)

14. Applicants do not dispute the Examiner's finding in this regard.

15. Monte '468 teaches that a single crystal seed may be used in association with the crystal (grain) selector to provide an "even closer correspondence between the secondary orientation of the cast articles and the selected secondary orientation." (Monte '468, 22:18-23.)

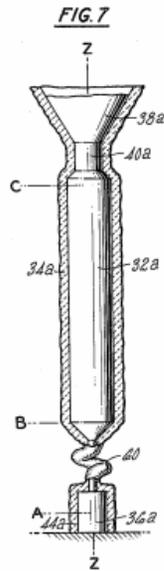
16. Likewise, Monte '469 teaches that seed crystal may be used in combination with the crystal (grain) selector "[t]o enable only the main crystal having the desired crystallographic orientation

1 to grow from the starter cavity to the article mold cavity.”
2 (Monte ‘469, 2:57-60.)

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4 *Rejection III: Giamei in View of Monte ‘468, Monte ‘469, or Burd*

5 17. Giamei’s Figure 7 is reproduced below:



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7 18. Giamei’s Figure 7 is said to depict a ceramic shell mold,
8 wherein relevant reference numerals 34a, 36a, 44a, and 60
9 represent a mold, a first seed, a starter section, and a helical
10 selector, respectively. (Giamei, 5:27-44, 6:9-14.)

11 19. The Examiner found that Giamei describes every limitation of
12 appealed claim 1 “except [Giamei does not disclose] the [use of
13 a] grain selector support.”

14 20. Applicants do not contest the Examiner’s finding in this regard.

15 21. Monte ‘468 and Monte ‘469 both teach the use of a support
16 element for the single crystal selector to support a bend section

1 of the crystal selector against vertical and/or sideward loading.
2 (Monte '468, 6:43-48; Monte '469, 6:3-8.)

3 22. Similarly, Burd teaches the use of central column 26 "in the
4 form of a post high strength so as to be able to assume the load
5 otherwise imposed on the crystal selector." (Burd, 2:41-44;
6 Figures 1-2.)

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PRINCIPLES OF LAW

9 The factual inquiry into whether claimed subject matter would have
10 been obvious includes a determination of: (1) the scope and content of the
11 prior art; (2) the differences between the claimed subject matter and the prior
12 art; (3) the level of ordinary skill in the art; and (4) secondary consideration
13 (e.g., the problem solved) that may be indicia of (non)obviousness. *Graham*
14 *v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966). The Supreme
15 Court of the United States has stated that "[t]he obviousness analysis cannot
16 be confined by a formalistic conception of the words teaching, suggestion,
17 and motivation, or by overemphasis on the importance of published articles
18 and the explicit content of issued patents." *KSR Int'l Co. v. Teleflex, Inc.*,
19 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396, (2007). Rather, "[w]hen
20 there is a design need or market pressure to solve a problem and there are a
21 finite number of identified, predictable solutions, a person of ordinary skill
22 has good reason to pursue the known options within his or her technical
23 grasp." *KSR*, 127 S. Ct. at 1732, 82 USPQ2d at 1397.

24 "When the PTO shows prima facie obviousness, the burden then shifts
25 to the applicant[s] to rebut." *In re Mayne*, 104 F.3d 1339, 1342, 41 USPQ2d
26 1451, 1454 (Fed. Cir. 1997). "Such rebuttal or argument can consist of a

1 comparison of test data showing that the claimed compositions possess
2 unexpectedly improved properties or properties that the prior art does not
3 have...” *In re Dillon*, 919 F.2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed.
4 Cir. 1990)(en banc).

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6 ANALYSIS

7 Applicants have argued claims 1-12, 15, 17-30, and 33-35 together.
8 We therefore select claim 1 as representative of all the appealed claims and
9 confine our discussion to this representative claim. Furthermore, any
10 argument not made has been waived. 37 CFR § 41.37(c)(vii).

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12 *Rejection I: Monte ‘468 or Monte ‘469, Each in View of Burd*

13 The Examiner found that the only difference between the invention
14 recited in appealed claim 1 and the system of Monte ‘468 or Monte ‘469 is
15 in the configuration of the tubular structure of the grain selector. This
16 finding is not disputed. The Examiner then demonstrated that helical grain
17 selectors were old in the art and thus concluded that it would have been
18 obvious to one of ordinary skill in the art to modify Monte ‘468 or Monte
19 ‘469 by providing the systems described therein with a conventional helical
20 grain selector.

21 Applicants argue, however, that each of the Monte references
22 describes the use of an improved crystal selector having a single bend
23 section and “actually teaches away from the more complex grain selector
24 configurations (i.e., helix, three-dimensional bends, staircases, zigzags) of
25 the present invention...” (Br. 7.) We disagree.

1 Here, rather than teach away, Monte ‘468, Monte ‘469, and Burd all
2 indicate to one of ordinary skill in the art that helical grain selectors were
3 well known in the art and have been successfully used. *In re Fulton*, 391
4 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004)(“[M]ere
5 disclosure of alternative designs does not teach away.”). That the Monte
6 references state that helical grain selectors result in certain disadvantages,
7 such as higher cost does not automatically render a claim reciting such
8 helical grain selectors patentable. Specifically, Applicants have not shown
9 that their claimed invention does not suffer from the same disadvantages. A
10 reference “teaches away” if a person of ordinary skill in the art would have
11 been discouraged or led to a divergent path from the one taken by the
12 inventors. *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1132 (Fed.
13 Cir. 1994) (“Although a reference that teaches away is a significant factor to
14 be considered in determining unobviousness, the nature of the teaching is
15 highly relevant, and must be weighed in substance. A known or obvious
16 composition does not become patentable simply because it has been
17 described as somewhat inferior to some other product for the same use.”).

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19 *Rejection II: Burd in View of Either Monte ‘468 or Monte ‘469*

20 The Examiner found that the only difference between the invention
21 recited in appealed claim 1 and the system of Burd lies in the use of a seed
22 crystal. This finding is not disputed. The Examiner then found that the
23 Monte references teach the use of a single crystal seed in combination with a
24 non-linear tubular grain selector to ensure that a predetermined crystal
25 structure is obtained in the final cast component. Based on these findings,
26 the Examiner concluded that it would have been obvious to one of ordinary

1 skill in the art to modify Burd's system with a seed crystal as shown in
2 Monte '468 or Monte '469 in order to ensure the growth of only a single
3 crystal, thereby reducing the scrap rate.

4 Applicants argue that "Burd never even mentions the possibility of
5 using a seed crystal." (Br. 8.) This argument is unpersuasive. The
6 Examiner acknowledged this difference but relied on the Monte references
7 to account for the difference. Applicants' argument ignores the collective
8 teachings of the prior art as the evidentiary basis for the Examiner's
9 rejection. *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA
10 1981) ("The test for obviousness is not whether the features of a secondary
11 reference may be bodily incorporated into the structure of the primary
12 reference; nor is it that the claimed invention must be expressly suggested in
13 any one or all of the references. Rather, the test is what the combined
14 teachings of the references would have suggested to those of ordinary skill
15 in the art.").

16 Applicants appear to be urging an incorrect standard of obviousness
17 ("lack of suggestion in the prior art of the desirability of combining
18 references"). (Br. 11; *see also* R. Br. 2-3.) The Supreme Court has recently
19 disapproved such a rigid approach to obviousness. *KSR*, 127 S. Ct. at 1741.
20 Here, seed crystals have been used in the prior art in similar systems, as
21 shown in the Monte references. Thus, a person having ordinary skill in the
22 art would have reasonably predicted that the use of a seed crystal in Burd
23 would provide similar advantages and results as reported in the Monte
24 references. Applicants have not shown anything beyond what would have
25 been expected by a person skilled in the art.

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1 *Rejection III: Giamei in View of Monte '468, Monte '469, or Burd*
2 The Examiner found that the only difference between the invention
3 recited in appealed claim 1 and the system of Giamei lies in the use of grain
4 selector support. This finding is not disputed. The Examiner then found that
5 the Monte references and Burd all teach the use of a selector support to
6 assume the load. Based on these findings, the Examiner concluded that it
7 would have been obvious to one of ordinary skill in the art to modify
8 Giamei's system with a selector support as shown in Monte '468, Monte
9 '469, or Burd in order to lessen the load on the crystal selector.

10 Applicants' only contention appears to be that there is no motivation
11 or suggestion to combine. (Br. 11; R. Br. 3-4.) Even if this were the only
12 test that is appropriate for determining obviousness, we disagree. Monte
13 '468, Monte '469, and Burd provide a reason for combining their teachings
14 with those of Giamei, namely to ease the load on the crystal selector.

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CONCLUSIONS OF LAW

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On the record before us, Applicants have failed to rebut the prima facie case established by the Examiner that a person of ordinary skill in the art would have found the subject matter of appealed claims 1-12, 15, 17-30, and 33-35 obvious over the prior art.

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We therefore affirm the rejections under 35 U.S.C. § 103(a) of all appealed claims.

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Appeal 2007-1488
Application 10/809,072

- 1 No time period for taking any subsequent action in connection with
- 2 this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

LP

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