

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SIGENOBU SEKIYA,
KAZUYA SAKAGUCHI
AND KENJI WATANABE

Appeal 2007-3425
Application 10/375,152
Technology Center 1700

Decided: November 16, 2007

Before EDWARD C. KIMLIN, BRADLEY R. GARRIS, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 and 4-6.

Claim 1 is illustrative:

1. A damping alloy which comprises from 16.9 to 27.7 wt% copper, from 2.1 to 8.2 wt% nickel, from 1.0 to 2.9 wt% iron, carbon having a maximum of 0.05 wt% and a minimum of 0.02 wt%, oxygen having a

maximum of 0.06 wt% and a minimum of 0.01 wt%, nitrogen having a maximum of 0.06 wt% and a minimum of 0.01 wt%, and manganese and unavoidable impurities as the remainder.

The Examiner relies upon the following references as evidence of obviousness:

Takeshi (as translated)	JP 2002-146498 A	May 22, 2002
Shindo	6,458,182 B2	Oct. 1, 2002

Yin, "Temperature Dependent Damping Behavior In A Mn-18Cu-6Ni-2Fe Alloy Continuously Cooled In Different Rates From The Solid Solution Temperature," 38, No. 9, 1341-1346 (1998).

Appellants' claimed invention is directed to a damping alloy comprising copper, nickel, iron and manganese, as well as carbon, oxygen, and nitrogen in the recited amounts. According to Appellants, "the specific ranges of carbon and nitrogen required by claim 1 are critical to the prevention of manganese vaporization and the reduction of carbides and nitrides in the claimed damping alloy" (Br. 20, penultimate para.).

Appealed claims 1 and 4-6 stand rejected under 35 U.S.C. § 103 as being unpatentable over either Takeshi or Yin in view of Shindo.

Appellants do not set forth an argument that is reasonably specific to any particular claim on appeal. Accordingly, all the appealed claims stand or fall together.

We have thoroughly reviewed each of Appellants' arguments for patentability. However, we are in complete agreement with the Examiner that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning of § 103 in view of the applied prior art.

Accordingly, we will sustain the Examiner's rejections for essentially those reasons expressed in the Answer.

There is no dispute that both Takeshi and Yin, like Appellants, disclose a manganese-based damping alloy that comprises manganese, copper, nickel, and iron in the claimed amounts. As acknowledged by the Examiner, however, both Takeshi and Yin are silent with respect to the presence of carbon, oxygen, and nitrogen in the alloys as impurities. It is the Examiner's position that manganese-based alloys of the type disclosed by Takeshi and Yin, and presently claimed, inherently possess carbon, oxygen, and nitrogen as impurities in the small amounts claimed. As evidence in support of the Examiner's position, Shindo is cited as demonstrating that in order to obtain purified manganese-based alloys the impurities of carbon, oxygen, and nitrogen must be removed from the alloy. The Examiner cites the Examples of Shindo which show that the manganese alloys, before purification, comprise carbon, oxygen, and nitrogen as impurities in the amounts claimed by Appellants. We note that Appellants do not dispute the findings of fact with respect to the Shino disclosure.

Appellants devote a major portion of the Brief to arguments that miss the thrust of the Examiner's rejection, i.e., that Shindo is non-analogous to Takeshi and Yin and, therefore, not properly combinable under § 103. However, the Examiner's rejection is not based upon a proposed modification of the manganese alloys of Takeshi and Yin in accordance with the purity demands of Shindo. Rather, the Examiner offers Shindo as evidence that manganese alloys of the type claimed inherently possess carbon, oxygen, and nitrogen as impurities in the amounts claimed. Appellants, on the other hand, offer no evidence that such manganese alloys

do not inherently contain the three elements as impurities. Appellants offer only the argument that there is nothing in Shindo "that would show that the starting manganese material inherently has carbon and nitrogen impurities or that all manganese materials must have carbon and nitrogen impurities" (Br. 14, 4th para.). Hence, rather than advance a positive argument that, in fact, not all manganese alloys contain carbon, oxygen, and nitrogen as impurities, and support such a positive statement with evidence, Appellants simply require more evidence from the Examiner.

Consequently, based on the state of the present record, we find that the evidence in support of inherency has not been rebutted by Appellants. While it is well settled that argument of counsel cannot take the place of objective evidence, we find it noteworthy that Appellants have not even advanced an argument that not all manganese alloys of the type claimed and disclosed by Takeshi and Yin necessarily contain carbon, oxygen, and nitrogen as impurities. Also, it cannot be gainsaid that such elements are well-known impurities in a wide variety of alloys.

Appellants also submit that "[a]s shown in the pending specification in Tables 1 and 2 on pages 16 and 18, a relatively small variation in carbon or nitrogen content in a manganese alloy can have substantial effect on the properties of strength and damping of the manganese alloy" (Br. 16, 3rd para.). However, we will decline Appellants' invitation to study the specification data. Manifestly, it is not within the province of this Board to review and analyze specification data and interpret it in a light most favorable to Appellants' position. It is Appellants' burden to analyze any such data and present an argument, based on the analysis, that the claimed parameters are critical to achieving a particular end, and that compositions

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within the scope of the claims produce results that would be considered truly unexpected by one of ordinary skill in the art. *In re Geisler*, 116 F.3d 1465, 1469-70 (Fed. Cir. 1997); *Ex parte Gelles*, 22 USPQ2d 1318, 1319, (BPAI 1992). In the present case, Appellants have not presented the requisite analysis of the specification data. Also, in the event of further prosecution of the subject matter at bar, such as by way of a continuing application, it should be borne in mind that one cannot remove from the public domain known compositions by discovering unknown properties of the compositions. See *In re Woodruff*, 919 F.2d 1575, 1578 (Fed. Cir. 1990); *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 782 (Fed. Cir. 1985); *In re Malagari*, 499 F.2d 1297, 1303 (CCPA 1974).

In conclusion, based on the foregoing, the Examiner's decision rejecting the appealed claimed 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)(vi).

AFFIRMED

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