

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN W. BIDDER

Appeal 2007-3542
Application 10/325,554
Technology Center 1700

Decided: January 29, 2008

Before EDWARD C. KIMLIN, PETER F. KRATZ, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 13-18, the only claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

The invention relates to magnesium metal and/or magnesium alloy articles that are coated with a permanganate composition to provide paint adhesion. (Spec. 1, ¶ 1). Claims 14 and 18 are illustrative of the invention and are reproduced below:

14. The magnesium or magnesium alloy article of claim 13, wherein the article has a layer of a non-chromate containing paint over the permanganate

composite to provide a paint protected magnesium or magnesium alloy article that passes the neutral salt-fog spray at 95°F according to ASTM 117B specification for at least 200 hours exposure.

18. A magnesium or magnesium alloy article comprising said article having coated thereon a permanganate composite having a pH of 3.0 to 4.0; a permanganate ion concentration greater than 1.3 gms per liter; and said permanganate composite consisting essentially of an alkali metal permanganate and a mixture of the alkali metal permanganate and a buffer.

The Examiner relies on the following prior art reference to show unpatentability:

Nakada US 6,485,580 Nov. 26, 2002

The Examiner made the following rejections:

1. claim 18 under 35 U.S.C. § 112, second paragraph, as indefinite; and
2. claims 13-18 under 35 U.S.C. § 102(a) as anticipated by Nakada.

With respect to the second ground of rejection, Appellant contends that the following groups of claims are separately patentable: (1) claims 13 and 15-18, and (2) claim 14. Accordingly, we decide this ground of rejection on the basis of claims 14 and 18. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Rejection of claim 18 under 35 U.S.C. § 112, second paragraph

The Examiner maintains that the claim 18 recitation of a composition “consisting essentially of an alkali metal permanganate and a mixture of the alkali metal permanganate and a buffer” is indefinite. (Ans. 3). The Examiner suggests that the rejection could be overcome by changing the first occurrence of the term “and” in the above-quoted language to “or”, thereby making the claim language consistent with the language of original claim 18 (i.e., prior to amendment), which provided that the composition had

"ingredients selected from the group consisting of an alkali metal permanganate and a mixture of the alkali metal permanganate and a buffer." (Ans. 3). Appellant contends that use of the term "and" is appropriate in a Markush grouping. (Br. 4).

We are in agreement with the Examiner that appealed claim 18 is not drafted using proper Markush group language and, therefore, appears to be indefinite for the reasons noted by the Examiner. (Ans. 5).

The rejection is affirmed.

Rejection of claims 13-18 under 35 U.S.C. § 102(a) as anticipated by Nakada

The Examiner finds that claims 14 and 18¹ read on Nakada's Comparative Example 8. (Ans. 4). The Examiner concedes that Nakada does not specifically state that the disclosed magnesium alloy article, when coated with a layer of a non-chromate containing paint, would pass the test recited in claim 14. However, the Examiner contends that "[b]ecause Nakada et al disclose the layer structure and composition of the permanganate layer, in addition to the coating increasing the adherence of non-chromate containing paint films to the metal surface, (columns 13-14, lines 65-3), it would be expected that the coated alloy of Nakada et al would pass the same tests as set forth in claims 14 and 17, absent an objective showing to the contrary." (Ans. 4).

¹ To further prosecution, the Examiner has interpreted the language of claim 18 as directed to a permanganate composition consisting essentially of an alkali metal permanganate *or* a mixture of the alkali metal permanganate and a buffer. (Ans. 3). In the Reply Brief, which was not entered, Appellant agreed that this interpretation was correct.

Appellant attempts to refute the Examiner's finding of anticipation as to both claims 14 and 18 by arguing that "Nakada teaches away from Appellant's invention by stating the use of sodium permanganate alone as a first layer on a magnesium surface does not provide the desirable anti-corrosion that is necessary - Nakada's comparative example 8. Therefore, any skilled artisan reading Nakada would be led away from using sodium permanganate alone on a magnesium surface." (Br. 6-7 and 8).

Based on the contentions of the Examiner and the Appellant, the issue presented is: Are the Examiner's findings sufficient to establish that Nakada expressly or inherently anticipates the invention of claims 14 and 18? We answer this question in the affirmative for essentially those reasons stated in the Examiner's Answer.

Nakada discloses an aqueous bath for treating the surfaces of light metals and light metal alloys that does not contain hexavalent chromium and forms a highly corrosion-resistant and paint-adherent conversion coating. (Abstract). In Nakada comparative Example 8, the surface of a die cast sheet of magnesium alloy (Table 1, substrate B) was treated using a permanganate salt by itself as the treatment bath component to produce a manganese-containing coating (col. 12, ll. 31-33). The treatment bath contained 10 g/l Mn compound and pH was adjusted to 4.0. (Nakada, Table 3). Paint adherence to the treated surface was evaluated by applying an epoxy resin paint on the surface to a dried paint film thickness of 10 µm followed by baking for 10 minutes at 200 °C. (Nakada, col. 13, ll. 40-43).

Contrary to Appellant's contention, the Examiner's reliance on a comparative rather than a working example in Nakada was entirely proper in establishing anticipation. As explained by our reviewing court, "[a]

reference is no less anticipatory if, after disclosing the invention, the reference then disparages it. Thus, the question whether a reference 'teaches away' from the invention is inapplicable to an anticipation analysis."

Bristol-Myers Squibb Co. v. Ben Venue Lab., Inc., 246 F.3d 1368, 1378 (Fed. Cir. 2001)(quoting *Celeritas Techs., Ltd. v. Rockwell Int'l Corp.*, 150 F.3d 1354, 1361 (Fed.Cir. 1998)). Moreover, we are in agreement with the Examiner that the article of appealed claim 14 appears to be substantially identical to Nakada's treated alloy. Thus, the burden was properly shifted to Appellant to prove that Nakada's treated alloy would not necessarily or inherently possess the characteristics or properties necessary to meet the test recited in claim 14. See *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990); *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977). Appellant has not presented arguments or evidence to refute the Examiner's finding of inherency. We note that Appellant relies on the Declaration of John W. Bibber, the inventor, in support of patentability. We do not find the declaration persuasive, however, as it fails to discuss Nakada Comparative Example 8 or provide any type of evidentiary showing which establishes that Nakada's treated alloy would not necessarily or inherently possess the characteristics or properties necessary to meet the test recited in claim 14.

Appeal 2007-3542
Application 10/325,554

ORDER

The decision of the Examiner rejecting claim 18 under 35 U.S.C. § 112, second paragraph, as indefinite and claims 13-18 under 35 U.S.C. § 102(a) as anticipated by Nakada 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)(i)(iv).

AFFIRMED

PL Initials
sld

ROBERT F. I. CONTE
LEE, MANN, SITH, MCWILLIAMS,
SWEENEY & OHLSON
P.O. BOX 2786
CHICAGO, IL 60690-2786