

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM WILSON and DON L. BARAGAR

Appeal No. 2003-1156
Application No. 09/745,062

ON BRIEF

Before KIMLIN, KRATZ and POTEATE, Administrative Patent Judges.
KIMLIN, Administrative Patent Judge.

REQUEST FOR REHEARING

Appellants request rehearing of our Decision of July 15, 2003, wherein we affirmed the examiner's rejection of the appealed claims under 35 U.S.C. § 103.

We have thoroughly reviewed each of appellants' arguments set forth in the Request but we are not persuaded that our decision was in error.

Appellants contend that neither the Examiner nor the Board followed the current law on combining prior art references inasmuch as the examiner failed to "show that the combined

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references provided a motivation, incentive or suggestion for making the required modifications as required by current law in *ACS Hospital Systems, Inc. v. Montefiore Hospital and Ex parte Levengood*" (page 2 of Request, first paragraph). In particular, appellants maintain that "neither the Examiner nor the Board has shown any motivation, incentive or suggestion for providing alloy compositions having the particular combination of elements in the narrow ranges of concentration of claim 1" (page 2 of Request, last paragraph). However, inasmuch as it was pointed out in our decision that prior art ranges which encompass or overlap claimed ranges establish a prima facie case of obviousness, it is implicit that the motivation arises from one of ordinary skill in the art having a reasonable expectation that the claimed combination of elements would have similar properties to the compositions disclosed in the prior art. Moreover, appellants acknowledge that "the examiner relied on the passage in Nomoto (col. 6[,] lines 60 to col. 7, line 3) that nitrogen is effective for improving the hardness and tensile strength of steel as the motivation, incentive and suggestion for adding nitrogen to the steels of Motomura" (page 3 of Request, second paragraph). As for the motivation for one of ordinary skill in the art to remove selenium from Motomura's composition, we explained in the

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decision that "it would have been obvious for one of ordinary skill in the art to eliminate selenium from a steel alloy of the type disclosed by Motomura along with its advantage, namely, enhanced decarburization of properties" (page 5 of Decision, lines 3-6). The motivation arises from one of ordinary skill in the art understanding that selenium need not be present when enhanced decarburization of properties are not necessary.

Accordingly, based on the foregoing, appellants' request is granted to the extent we have reconsidered our decision, but is denied with respect to making any change therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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PETER F. KRATZ)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
LINDA R. POTEATE)	
Administrative Patent Judge)	

ECK:clm

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Cook, Alex, McFarron, Manzo, Cummings
& Mehler Ltd.
Suite 2850
200 West Adams St.
Chicago, IL 60606