

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INGERSOLL CUTTING TOOL COMPANY
Requester and Appellant and Cross-Respondent

v.

TDY INDUSTRIES
Patent Owner and Respondent and Cross-Appellant

Appeal 2013-001102
Reexamination Control 95/001,417
Patent 7,244,519
Technology Center 3900

Before HUBERT C. LORIN, LORA M. GREEN, and RICHARD M. LEOVITZ,
Administrative Patent Judges.

LEOVITZ, *Administrative Patent Judge.*

This is a decision on appeal by the Patent Owner from the Patent Examiner's decision to reject pending claims 1-31, 33-52, 56-59, 83-90, and 93 in an inter partes reexamination of U.S. Patent No. 7,244,519. This is also a decision on an appeal by the Third-Party Requester from the Patent Examiner's decision not to adopt proposed rejections of claims 1-4, 9-18, 23, 24, 27-31, 33-38, 45, 46, 49, 50,

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58, 83-85 and 89. The Board's jurisdiction for this appeal is under 35 U.S.C. §§ 6(b), 134, and 315. We affirm-in-part.

BACKGROUND

The patent in dispute in this appeal is U.S. Patent No. 7,244,519 B2 (hereinafter, "the '519 patent"), which issued July 17, 2007. The claims are drawn to PVD (physical vapor deposition) coated ruthenium cutting tools comprising a cemented carbide substrate. "Cemented carbide cutting tools and inserts (generally 'cutting tools') are commonly employed in machining operations such as, for example, cutting, drilling, reaming, countersinking, counterboring, end milling, turning, grooving, threading, and tapping." ('519 patent, col. 1, ll. 15-19.)

A corrected request for *inter partes* reexamination under 35 U.S.C. §§ 311-318 and 37 C.F.R. §§ 1.902-1.997 for the '519 patent was filed August 16, 2010 by a Third-Party Requester (Request for *Inter Partes* Reexamination). The Third-Party Requester is Ingersoll Cutting Tool Company (Requester Appeal Br. 1, dated June 25, 2012). The Patent Owner is TDY Industries, Inc. (Patent Owner Appeal Br. 1, dated June 20, 2012). An oral hearing was held on _____, the transcript for which will be entered into the record in due course.

There are four independent claims which are pending in this *inter partes* reexamination. Claims 1 and 15 are representative and reproduced below (underlining and brackets relative to original patent claim):

1. (Amended) A cutting tool, comprising:
a cemented carbide substrate, wherein the substrate comprises hard particles and a binder, and the binder comprises ruthenium; and
at least one physical vapor deposition coating on at least a portion of the substrate[, wherein the coating has the characteristics of a coating applied by physical vapor deposition].

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15. A method of coating a substrate, comprising:
applying a coating on a cemented carbide substrate by physical vapor deposition, wherein the substrate comprises hard particles and a binder and the binder comprises ruthenium.

I. APPEAL BY REQUESTER OF NON-ADOPTED REJECTIONS

Requester appeals the Examiner's decision not to adopt Requester's proposed rejections under 35 U.S.C. § 102(b) (Requester Appeal Br. 5). The following are the appeal non-adopted rejections:

A. Claims 1-4, 9-18, 23, 24, 27-31, 35, 36, 45, 46, 49, 50, 58, 83, 85 and 89, as anticipated by Grab.¹

B. Claims 1-4, 9-18, 23, 27-31, 33-38, 45, 46, 58, 83-85 as anticipated by Leverenz.²

PRINCIPLES OF LAW

Keeping in mind that the Karrer patent is a publication addressed to those of ordinary skill in this art, it is our opinion that the pattern of Karrer's specific preferences in connection with his generic formula constitutes a description of a definite and limited class of compounds .

..

We think the Karrer patent, as a printed publication, describes to one skilled in this art not only the broad class but also this much more limited class within that broad class, and we think it is immaterial that Karrer did not expressly spell out the limited class as we have done here. It is our opinion that one skilled in this art would, on reading the Karrer patent, at once envisage each member of this limited class, even though this skilled person might not at once define in his mind the formal boundaries of the class as we have done here.

¹ George P. Grab et al., U.S. 6,554,548 B1 (Apr. 29, 2003).

² Roy V. Leverenz, U.S. 6,214,247 B1 (Apr. 10, 2001).

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In re Petering and Fall, 301 F.2d 676, 681 (CCPA 1962).

Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983). The requirement that the prior art elements themselves be “arranged as in the claim” means that claims cannot be “treated ... as mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning.” *Lindemann Maschinenfabrik GMBH v. Am. Hoist & Derrick Co.*, 730 F.2d 1452, 1459 (Fed. Cir. 1984). “[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. §102.” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008) (emphasis added).

Therasense, Inc. v. Becton, Dickinson & Co., 593 F.3d 1325, 1332 (Fed. Cir. 2010).

I.A. ANTICIPATION BY GRAB

Findings of Fact

Grab patent

FF1. Grab describes a “coated cutting insert” for use in metal cutting applications (Grab, col. 1, ll. 7-16; 32-36).

FF2. The coated cutting insert includes a substrate that has a surface zone of binder alloy (Grab, col. 2, ll. 32-35).

FF3. “The substrate 18 comprises a cemented carbide material. One exemplary substrate is a cemented (cobalt-chromium binder alloy) tungsten carbide that contains one or more carbide forming elements such as, for example, titanium, tantalum, niobium, zirconium, and hafnium.” (Grab, col. 2, 44-48.)

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FF4. "Other elements may optionally be a component of the binder alloy wherein these elements include tungsten, iron, nickel, ruthenium, and **rhenium**." (Grab, col. 2, 55-57; emphasis added)

FF5. "Generally speaking, one or more of the coating layers of the coating schemes are applied by chemical vapor deposition (CVD) and moderate temperature chemical vapor deposition (MTCVD). However, applicants also contemplate that one or more layers of a coating scheme may be applied by physical vapor deposition (PVD)." (Grab, col. 4, ll. 56-61.)

FF6. Claims 1 and 5 of Grab read as follows:

1. A coated cutting insert comprising:

a rake face and a flank face, a cutting edge at the juncture of the rake face and the flank face;
the cutting insert having a hard refractory coating and a substrate wherein the coating is adherently bonded to the substrate;
the substrate comprising a tungsten carbide-based material comprising a bulk composition of at least about 70 weight percent tungsten and carbon, between about 3 weight percent and about 12 weight percent cobalt, and at least 0.09 weight percent chromium;
the cobalt and the chromium forming a binder alloy . . .

5. The coated cutting insert of claim 1 wherein the binder alloy further includes one or more of tungsten, iron, nickel, ruthenium, and rhenium.

'519 patent

FF7

The hard particles may be, for example, carbides, nitrides, borides, silicides, or oxides of elements within groups IVB through VIB of the periodic table. A common example is tungsten carbide.

(Col. 1, ll. 29-33.)

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Analysis

The issue is whether Grab describes all the elements of the claimed subject matter as arranged in the claim. *Therasense*, 593 F.3d at 1332. First, we shall identify the elements in instant claim 1. Second, we will determine whether Grab's describes these elements as arranged in the claim.

Claim 1 of the '519 patent comprises the following elements:

- [1] "A cutting tool, comprising:"
- [2] "a cemented carbide substrate, wherein the substrate comprises"
- [3] "hard particles" and
- [4] "a binder,"
- [5] "the binder comprises ruthenium" and
- [6] "at least one physical vapor deposition coating on at least a portion of the substrate."

Claim 5 of Grab depends on claim 1 of Grab and therefore incorporates all its limitations. Grab's Claim 5 describes elements [1] through [5] of claim 1 of the '519 patent. The correspondence between Grab's claim 5 (FF6) and the '519 patent claim is as follows:

- [1] "A cutting tool, comprising:" corresponding to the "coated cutting insert" of Grab claim 5.
- [2] "a cemented **carbide substrate**, wherein the substrate comprises" corresponding to "the **substrate** comprising a **tungsten carbide-based** material comprising a bulk composition of at least about 70 weight percent tungsten and carbon, between about 3 weight percent and about 12 weight percent cobalt, and at least 0.09 weight percent chromium" of Grab claim 5.

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- [3] “hard particles” corresponding to the “**tungsten carbide**” (FF7) of the substrate of Grab claim 5.

- [4],[5] “a **binder**” comprising “**ruthenium**” corresponding to “the **binder alloy** further includes one or more of tungsten, iron, nickel, **ruthenium**, and rhenium” of Grab’s claim 5. Ruthenium is one of five metals named in claim 5, and claim 5 specifically requires “one of more” of the five.

Element [6] of the ‘519 patent claim 1 is “at least one physical vapor deposition **coating** on at least a portion of the substrate.” Grab’s claim 5 comprises a “cutting insert having a hard refractory **coating**,” but does not specifically recite that the coating is “physical vapor deposition coating.” However, Grab discloses only three different ways of applying the coating to the cutting insert, one of which is physical vapor deposition (PVD), i.e., CVD, MTCVD, and PVD (FF5). While CVD and MTCVD are characterized by Grab as preferred ways of applying the coating, there are only three different coating methods described by Grab and the choice of one of those three is a necessary choice to have made the coating of Grab’s claim 5.

If one binder metal (element [5] of claim 1) of the five were selected one at a time, and coated (element [6] of claim 1) by either of the three coating methods specifically identified by Grab (FF5), there are about 15 different embodiments – a “definite and limited” class, each of which would be immediately “envisage[d]” by one of ordinary skill in the art upon reading claim 5 of Grab. *Petering*, 301 F.2d at 681.

Patent Owner contends that Grab does not describe articles or methods including the claimed elements “arranged or combined in the same way as in the claim.” (PO Respondent Br. 5, quoting from *Net MoneyIN v. VeriSign*, 545 F.3d

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1359, 1370 (Fed. Cir. 2008)). Patent Owner contends: “Grab does not show the combination of ruthenium-containing substrates and PVD coatings. Instead, Grab merely discloses ruthenium and PVD coatings as separate optional features that are not linked in any way.” (PO Respondent Br. 6.)

As explained above, this position is not factually supported. Grab’s claim 5 is drawn to an embodiment which comprises all the elements of claim 1, except for specifying that the recited “hard refractory coating” is formed by PVD. However, there are only three coating schemes specifically disclosed by Grab, and one of these PVD (FF5). The fact that a “coating” is recited in Grab’s claim 5 is a specific hook back into the Grab disclosure for the further description of how that coating is applied. This is not a “speculative” or a “theoretical possibility” as argued by Patent Owner (PO Respondent Br. 7), but a definite path to a description of the claimed invention.

For the foregoing reasons, we reverse the Examiner’s determination not to adopt the rejection based on Grab as an anticipatory reference.

Claim 15, 83, 89

Claims 15, 83, and 89 are independent claims. Claims 15 and 83 are method claims. Claim 89 is directed to a cutting tool. Each of the claims, as does claim 1, requires a binder with ruthenium and a PVD coating. The Requester relied on the same evidence of anticipation for claims 15, 83, and 89 as for claim 1. Neither the Examiner nor the Patent Owner distinguished claims 15, 83, and 89 from claim 1. We find the evidence is sufficient to establish that the subject matter of claims 15, 83, and 89 is anticipated by Grab, and reverse the Examiner’s determination not to adopt the rejection.

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Claims 2-4, 9-14, 16-18, 23, 24, 27-31, 35, 36, 45, 46, 49, 50, 58, and 85

Claims 2-4, 9-14, 16-18, 23, 24, 27-31, 35, 36, 45, 46, 49, 50, 58, and 85 are dependent claims. Requester provided support for where each limitation of the dependent claims could be found in Grab (Requester Appeal Br. 16-18). Neither Examiner nor Patent Owner challenged Requester's evidence. We find the evidence persuasive and sufficient to establish that dependent claims 2-4, 9-14, 16-18, 23, 24, 27-31, 35, 36, 45, 46, 49, 50, 58, and 85 are anticipated by Grab, and reverse the Examiner's determination not to adopt the rejection.

I.B. ANTICIPATION BY LEVERENZ

The Third Party Requester contends that the Examiner erred in not adopting the proposed rejection of claims 1-4, 9-18, 23, 27-31, 33-38, 45, 46, 58, 83-85 as anticipated by Leverenz. The Requester contends that Example 1 of Leverenz discloses a tungsten carbide substrate having **a cobalt binder** and the **hard particles** titanium carbide (TiC), tantalum carbide (TaC) and Niobium Carbide (NbC) (Requester Appeal Br. 20). Furthermore, Requester contends that Leverenz in Example 1 provides a coating to the substrate using CVD. The Requester acknowledges that Leverenz in Example 1 does not describe ruthenium in the binder or a PVD coating as claimed, but argues with respect to Example 1, "Leverenz suggests one skilled in the art to employ PVD and two other coating processes in lieu of CVD for coating a substrate, the binder of which, in addition to cobalt, can include one or more of 15 different elements, including ruthenium." (*Id.*)

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The Examiner did not adopt the anticipation rejection because “[n]one of Leverenz’s examples prepared at cols. 9-13 contains ruthenium or uses PVD. In view of the selections for Ru and PVD that need to be made and in view of said examples, Leverenz does not anticipate the claims.” (RAN 17.) The Examiner noted Requester had cited testimony that PVD coatings and ruthenium had been used in the art, but responded that it does “not take away from the fact that ruthenium is optional and selected from a list of materials, and PVD is selected from other processes.” (RAN 18)

Specific examples, while helpful, are not required to establish anticipation. For example, a very small genus can be a disclosure of each species within the genus. *Petering*, 301 F.2d at 682; *see also Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1380 (Fed. Cir. 2001) (“[T]he disclosure of a small genus may anticipate the species of that genus even if the species are not themselves recited.”); *WM. Wrigley Jr. Co. v. Cadbury Adams USA LLC*, 683 F.3d 1356, 1361-62 (Fed. Cir. 2012). As held in *Petering*, in order to anticipate, one skilled in the art must be able to “at once envisage” the claimed structure in the disclosure. *Petering*, 301 F.2d at 681.

In this case, however, we agree with the Examiner, that Leverenz does not anticipate the claims. In particular, Leverenz does not contain explicit disclosure that ruthenium should be included in the binder of the substrate of Example 1 nor that PVD would be suitable to prepare the coatings in Example 1. Leverenz describes ruthenium (atomic number 44) as an optional element that may be included in the binder:

The binder material of the present composite material may include one or a combination of more than one of cobalt, nickel, copper, and iron. In addition to cobalt, nickel, copper, and/or iron, the binder

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material may include other elements and compounds as are known in the art. **Such other elements** include, for example, those within Group VIII of the periodic table (elements having atomic numbers 26-28, **44-46**, and 76-78), tungsten, zinc, and rhemium.

Leverenz, col. 5, ll. 40-48 (emphasis added.)

Example 1 does not specifically identify the binder in Leverenz's Example 1, but the Examiner did not dispute the Requester's assertion it is the cobalt disclosed at column 9, line 27. Instant claim 1 also requires ruthenium in the binder. The Requester did not provide a sufficient explanation as to why a skilled worker would have envisioned Example 1 specifically with ruthenium, other than saying that ruthenium is a material that "may" be present in the binder as taught at column 5, lines 40-48 (Requester Respondent Br. 19 & 20). However, Example 1 is described as complete, and the Requester did not give an adequate reason as to why one of ordinary skill in the art would have understood it to include any of the additional, *optional*, binders disclosed Leverenz. While it is true that ruthenium is disclosed as an optional binder material, it has not been established that one of ordinary skill in the art would have immediately envisaged it as part of Example 1.

For a reference to be anticipatory, it must disclose all the limitations of the claimed invention arranged as in the claim, not merely as a catalog of separate parts. *Therasense*, 593 F.3d at 1332. In this case, Requester has not provided sufficient evidence that the separate disclosure about ruthenium and other optional binder materials would have been combined with Example 1 of Leverenz to provide a description of the claimed subject matter. Similarly, Example 1 is narrowly focused on CVD for applying the coatings to the substrate, and insufficient reason has been provided by Requester as to why the skilled worker would have looked elsewhere in the Leverenz disclosure of using other coating application techniques, such as PVD, to replace the CVD method of Example 1.

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Testimony was provided by Kenneth J.A. Brookes and Dennis Quinto, Ph.D. that PVD coatings and ruthenium binders were known in the art prior to the claimed invention (Requester Respondent Br. 13-16). However, this testimony does not establish that the skilled worker, reading Leverenz, would have envisioned all the elements of claim 1 arranged as in the claim.

II. APPEAL BY PATENT OWNER

Patent Owner appeals the Examiner's determination to reject all the pending claims as obvious over different combinations of prior art (Patent Owner App. Br. 4-6).

II.A. GRAB

Claims 1-4, 9-18, 23, 24, 27-31, 35, 36, 45, 46, 49, 50, 58, 83, 85 and 89 stand rejected under 35 U.S.C. 103(a) as obvious in view Grab (RAN 9) (PO Appeal Br. 4, Rejection 1)

We determined that claims 1-4, 9-18, 23, 24, 27-31, 35, 36, 45, 46, 49, 50, 58, 83, 85 and 89 are anticipated by Grab. Since these claims have already been found to be unpatentable over Grab for lack of novelty, it is unnecessary for us to reach the obviousness rejection.

II.B. GRAB IN VIEW OF ADDITIONAL PRIOR ART

Dependent claims 5-8, 19-22, 23, 24, 25, 26, 56, 57, 59, 86, and 90 stand rejected as obvious in view of Grab and additionally cited prior art (Rejections 2-5 summarized on page 4-5 of PO Appeal Br. 4-5). The Examiner provided evidence as to why the limitations are obvious in view of the combination of Grab with additional prior art (RAN 11-16), which we find to be factually supported.

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Patent Owner provided evidence of unexpected results obtained with PVD-coated ruthenium cutting tools (Patent Owner Appeal Br. 9). However, we found that a preponderance of the evidence established that claims to this combination were anticipated by Grab, and thus secondary considerations are inapplicable.

Claims 5-8, 19-22, 23, 24, 25, 26, 56, 57, 59, 86, and 90 comprise further limitations in addition to the recited PVD and ruthenium features. Patent Owner did not demonstrate that these further limitations were responsible for the asserted unexpected results. "For objective evidence to be accorded substantial weight, its proponent must establish a nexus between the evidence and the merits of the claimed invention." *In re GPAC, Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995). No nexus was established between the limitations recited in the dependent claims and the asserted unexpected results. As Patent Owner did not provide additional arguments as to why the dependent claims are patentable over Grab, we shall affirm the rejections for the sufficient reasons given by the Examiner.

II. C. LEVERENZ

Claims 1-4, 9-18, 23, 27-31, 33-48, 58, and 83-85 are rejected under 35 U.S.C. 103(a) as obvious in view Leverenz (Rejection 6, PO Appeal Br. 5).

We determined that claims 1-4, 9-18, 23, 27-31, 58, 83, and 85 are anticipated by Grab. Since these claims have already been found to be unpatentable over Grab for lack of novelty, it is unnecessary for us to reach the obviousness rejection over the Leverenz publication.

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Claims 33, 34, 37-44, 47, 48, 84

Claims 33, 34, 37-44, 47, 48, 84 were found by the Examiner to be obvious in view of Leverenz. The Examiner provided an explanation of how the limitations of these claims were suggested Leverenz's teachings (RAN 18-20), which we find to be factually supported.

Patent Owner provided evidence of unexpected results obtained with PVD-coated ruthenium cutting tools (Patent Owner Appeal Br. 9). However, we found that a preponderance of the evidence established that claims to this combination were anticipated by Grab. Claims 33, 34, 37-44, 47, 48, 84 comprise limitations in addition to the PVD and ruthenium limitations. Patent Owner did not demonstrate that these additional limitations were responsible for the asserted unexpected results. "For objective evidence to be accorded substantial weight, its proponent must establish a nexus between the evidence and the merits of the claimed invention." *In re GPAC, Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995). No nexus was established between the limitations recited in the dependent claims and the asserted unexpected results. As Patent Owner did not provide additional arguments as to why the dependent claims are patentable over Leverenz, we shall affirm the rejection for the sufficient reasons given by the Examiner.

II.D. LEVERENZ IN VIEW OF ADDITIONAL PRIOR ART

Claim 24, 25, 26, 49-52, 56, 57, 59, 86-90, and 93 stand rejected as obvious in view of Leverenz and additionally cited prior art (Rejections 7-9 and 11-15 summarized on page 5 of Patent Owner Appeal Br.). The Examiner provided an explanation of how the limitations of these claims were suggested Leverenz's teachings (RAN 20-30), which we find to be factually supported. As already

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discussed, Patent Owner did not establish a nexus between the unexpected results and the further limitations recited in the claims. We affirm the rejection for the sufficient reasons given by the Examiner.

Claims 1-23, 27, 31, 33-48, 58 and 83-85 are rejected under 35 U.S.C. 103(a) as obvious over Leverenz in view of Shing (RAN 23; Rejection 10 on page 5 of PO Appeal Br.). The independent claims 1, 15, and 83 have already been found to be anticipated by Grab and thus we shall not further address them. With respect to the dependent claims not already addressed, the Examiner provided evidence of their obviousness, which we find to be factually supported (RAN 24), and unchallenged by Patent Owner. As already discussed, Patent Owner did not establish a nexus between the unexpected results and the further limitations recited in the claims. We affirm the rejection for the sufficient reasons given by the Examiner.

II.E. ADMITTED PRIOR ART, TRACY, SCHACHNER, AND STOLL REJECTIONS

For each of the rejections based on Admitted Prior Art, Tracey,³ Schachner,⁴ and Stoll,⁵ Patent Owner argued that the cited publications “do not contain any technological information linking ruthenium additions and PVD coatings, or addressing the technical problems that would prevent the successful application of PVD coatings to cemented carbide substrates comprising ruthenium-containing

³ V.A. Tracey et al., Development of Tungsten Carbide-Cobalt-Ruthenium Cutting Tools For Machine Steels. 14 Modern Developments in Powder Metallurgy 281 (June 1980).

⁴ Herbert Schachner et al., U.S. 4,734,339 (Mar. 29, 1988).

⁵ William M. Stoll et al., U.S. 5,603,075 (Feb. 11, 1997).

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binders by the mere application of ordinary skill before the present invention” (PO Appeal Br. 20, 21, and 22) (Rejections 16-33 on pages 5-6 of PO Appeal Br.).

However, the combination of a ruthenium binder and PVD coating on a carbide substrate was found to have been described by Grab (see *supra* at p. 7-8).

Consequently, it is unnecessary for us to further consider independent claims 1, 15, 83, and 89 drawn to this combination since we have determined that these claims are anticipated by Grab.

With respect to the dependent claims, the Examiner provided evidence of their obviousness, which we find to be factually supported (RAN 30-54), and unchallenged by Patent Owner. As already discussed, Patent Owner did not establish a nexus between the unexpected results and the further limitations recited in the claims.

SUMMARY

I. APPEAL BY REQUESTER

The determination by the Examiner not to adopt the anticipation rejections of claims 1-4, 9-18, 23, 24, 27-31, 35, 36, 45, 46, 49, 50, 58, 83, 85 and 89, as anticipated by Grab is reversed. A decision to reverse the Examiner’s determination not to adopt a rejection is a new ground of rejection. 37 C.F.R. § 41.77(b).

The determination by the Examiner not to adopt the anticipation rejections of claims 1-4, 9-18, 23, 27-31, 33-38, 45, 46, 58, 83-85 as anticipated by Leverenz is affirmed.

II. APPEAL BY PATENT OWNER

Obviousness rejections 2-33 as they pertain to dependent claims 2-14, 16-31, 33-52, 56-59, 84-88, 90, and 93 are affirmed. Obviousness rejections of claims

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1, 15, 83, 89, and 93 were not reached because these claims were found to be anticipated by Grab.

NEW GROUNDS OF REJECTION

37 C.F.R. § 41.77(a) states that “[t]he reversal of the examiner’s determination not to make a rejection proposed by the third party requester constitutes a decision adverse to the patentability of the claims which are subject to that proposed rejection which will be set forth in the decision of the Board of Patent Appeals and Interferences as a new ground of rejection.”

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.77(b) which provides that “[a]ny decision which includes a new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Accordingly, no portion of the decision is final for purposes of judicial review. A requester may also request rehearing under 37 C.F.R. § 41.79, if appropriate, however, the Board may elect to defer issuing any decision on such request for rehearing until such time that a final decision on appeal has been issued by the Board.

For further guidance on new grounds of rejection, see 37 C.F.R. § 41.77(b)-(g). The decision may become final after it has returned to the Board. 37 C.F.R. § 41.77(f).

37 C.F.R. § 41.77(b) also provides that the Patent Owner, WITHIN ONE MONTH FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* The owner may file a response requesting reopening of prosecution before the examiner. Such a response must be either an amendment of the claims so rejected or new evidence relating to the claims so rejected, or both.

(2) *Request rehearing.* The owner may request that the proceeding be reheard under § 41.79 by the Board upon the same record. ...

Any request to reopen prosecution before the examiner under 37 C.F.R. § 41.77(b)(1) shall be limited in scope to the “claims so rejected.” Accordingly, a request to reopen prosecution is **limited** to issues raised by the new ground(s) of rejection entered by the Board. A request to reopen prosecution that includes issues other than those raised by the new ground(s) is unlikely to be granted. Furthermore, should the patent owner seek to substitute claims, there is a

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presumption that only one substitute claim would be needed to replace a cancelled claim.

A requester may file comments in reply to a patent owner response. 37 C.F.R. § 41.77(c). Requester comments under 37 C.F.R. § 41.77(c) shall be **limited** in scope to the issues raised by the Board's opinion reflecting its decision to reject the claims and the patent owner's response under paragraph 37 C.F.R. § 41.77(b)(1). A newly proposed rejection is not permitted as a matter of right. A newly proposed rejection may be appropriate if it is presented to address an amendment and/or new evidence properly submitted by the patent owner, and is presented with a brief explanation as to why the newly proposed rejection is now necessary and why it could not have been presented earlier.

Compliance with the page limits pursuant to 37 C.F.R. § 1.943(b), for all patent owner responses and requester comments, is required.

The examiner, after the Board's entry of a patent owner response and requester comments, will issue a determination under 37 C.F.R. § 41.77(d) as to whether the Board's rejection is maintained or has been overcome. The proceeding will then be returned to the Board together with any comments and reply submitted by the owner and/or requester under 37 C.F.R. § 41.77(e) for reconsideration and issuance of a new decision by the Board as provided by 37 C.F.R. § 41.77(f).

Requests for extensions of time in this *inter partes* reexamination proceeding are governed by 37 C.F.R. § 1.956. See also 37 C.F.R. § 41.79.

AFFIRMED-IN-PART

NEW GROUNDS UNDER § 41.77(b)

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