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

Paper No. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte COLIN ROY, T. MICHAEL SHORE
and MELICHER PUCHOVSKY

Appeal No. 2000-1274
Application No. 08/977,286

ON BRIEF

Before CALVERT, STAAB, and McQUADE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 4 and 6. Claim 5, the only other claim in the application, has been indicated as being allowable if rewritten in independent form.

The claims on appeal are drawn to a rolling mill (claims 1 to 4) and a method of rolling billets (claim 6), and are reproduced in the appendix of appellants' brief.

The references applied in the final rejection are:

Neumann	3,675,909	Jul. 11, 1972
Kovacs	4,393,680	Jul. 19, 1983
Kusaba	5,287,715	Feb. 22, 1994

Claims 1 to 4 and 6 stand finally rejected as unpatentable over Neumann in view of Kovacs and Kusaba, under 35 U.S.C. § 103(a).

The examiner’s basis for the rejection is set forth on the third and fourth pages of the answer, and need not be repeated here.

After fully considering the record in light of the arguments presented in the appellants’ brief and the examiner’s answer, we conclude that the rejection is not well taken.

The examiner characterizes Neumann’s element 10 as a "rolling line" and asserts that "Nowhere in the claims does the Applicant [sic] specifically state that the 'rolling line’ include[s] roll stands." This statement is not understood, since independent claims 1 and 6 do not even recite a "rolling

line," but do specifically recite that there are breakdown roll stands positioned or located at or on the second side of the furnace. Also, we agree with the appellants that (brief, page 5):

> Neumann does not disclose or suggest rolling on the opposite furnace side. Contrary to what the examiner states, the equipment identified by the reference numeral (10) in Neumann is merely a "rollway" [,] i.e., a roller table, and not a series of roll stands for rolling larger billets into smaller process sections.

The examiner further takes the position that (answer, third and fourth pages):

> it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the breakdown roll stands of Kovacs for the descaling device of Neumann in order to provide a workpiece suitable for rolling in subsequent roll stands.

We do not agree. Under § 103, teachings of references can be combined only if there is some suggestion or incentive to do so.

ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Here, we fail to see what suggestion or incentive there would have been for one of ordinary skill to substitute Kovacs' breakdown roll stands 22 for Neumann's descaling device 4, since they perform

entirely different functions. In fact, a descaler would normally be used in conjunction with (prior to) breakdown roll stands, as disclosed by Kovacs at col. 4, lines 56 to 60, rather than instead of them. Absent any teaching or suggestion that billets from breakdown roll stands should be returned to the furnace for reheating prior to further rolling, the examiner's apparent conclusion that it would have been obvious to provide breakdown roll stands at the same side of Neumann's furnace as rollway 10 seems to be based entirely on impermissible hindsight gleaned from appellants' own disclosure.

Accordingly, the rejection of claims 1 to 4 and 6 will not be sustained.

Conclusion

The examiner's decision to reject claims 1 to 4 and 6 is reversed.

REVERSED

IAN A. CALVERT Administrative Patent Judge	)	
LAWRENCE J. STAAB Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOHN P. McQUADE Administrative Patent Judge	)	

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REVERSED

Prepared: July 2, 2001