THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WOLFGANG SCHNEIDER and WERNER DROSTE

Appeal No. 1996-1598
Application No. 08/206,743[1]

ON BRIEF

Before STAAB, NASE, and GONZALES, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 13, 15 to 22 and 25 to 30, which are all of the claims pending in this application.[2]

We REVERSE.

[1] Application for patent filed March 4, 1994.

[2] Claim 1 was amended twice after the final rejection.

BACKGROUND

The appellants' invention relates to a continuous casting apparatus for billets to be rolled. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the amendment filed October 26, 1996 (Paper No. 21).

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Goodrich	4,509,580	April 9, 1985
Lazzaro	5,217,060	June 8, 1993
Scholtze et al. (Scholtze)	2,029,295 (United Kingdom)	Mar. 19, 1980
Miyate et al.[3] (Miyate)	5-50186[4] (Japan)	March 2, 1993

[3] The examiner and the appellants have referred to this reference as Showa (referring to the applicant Showa Aluminum Corp.). We will refer to this reference by utilizing the name of the first named inventor as is the custom in the Patent and Trademark Office.

[4] In determining the teachings of Miyate, we will rely on the translation of record provided by the PTO.

Claims 1 to 13, 15 to 20 and 25 to 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lazzaro in view of Goodrich and Miyate.

Claims 21 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lazzaro in view of Goodrich and Miyate as applied to claim 1 above, and further in view of Scholtze.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 12, mailed December 7, 1995) and the supplemental examiner's answer (Paper No. 18, mailed July 26, 1996) for the examiner's complete reasoning in support of the rejections, and to the appellants' reply brief (Paper No. 15, filed May 17, 1996) and substitute brief (Paper No. 25, filed October 20, 1997) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a case of obviousness with respect to independent claim 1. Accordingly, we will not sustain the examiner's rejection of claim 1, and claims 2 to 13, 15 to 22 and 25 to 30 dependent thereon, under 35 U.S.C. § 103. Our reasoning for this determination follows.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Furthermore, the conclusion that the claimed subject matter is obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual

to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Claim 1 recites a continuous casting apparatus for billets to be rolled, comprising, inter alia, a mould, a hot top shaping attachment and a starter block. Claim 1 further recites that the starter block comprises a vertically-movable block having a continuous peripheral wall having a downwardly and inwardly inclined inner surface and a raised portion arranged symmetrically relative to the central axes of the starter block with the outer surface thereof being inclined downwardly towards the inclined surface of the continuous wall. Claim 1 also recites that the raised portion has a height which is equal to approximately 1/2 to 2/3 of the height of the peripheral wall.[5]

---

[5] This limitation was first presented in an amendment to dependent claim 14 in the amendment after final filed May 17, 1996 (Paper No. 16). Thereafter, this limitation was incorporated into independent claim 1 in the amendment after final filed on October 28, 1996 (Paper No. 21).

The appellants argue (reply brief, pp. 1-3 and substitute brief, pp. 8-13) that the above-noted height limitation is not taught or suggested by the applied prior art (i.e., Lazzaro, Goodrich, Miyate and Scholtze). We agree. In fact, the examiner never concluded that the above-noted height limitation would have been obvious to one of ordinary skill in the art at the time the invention was made. Moreover, in applying the above-noted test for obviousness, we conclude that the above-noted height limitation would not have been obvious to one of ordinary skill in the art at the time the invention was made. In that regard, while we agree with the examiner's determinations (answer, p. 3) that Goodrich would have suggested a rectangular starter bar and that Miyate would have suggested a tapered raised portion to prevent the development of cracks, it is our opinion that in applying the teachings of Miyate to prevent the development of cracks, one of ordinary skill in the art would have also incorporated his teachings as to the relative height of the raised portion relative to the peripheral wall. Miyate teaches that to prevent cracks a tapered projection is provided which extends from 0-15 mm above the top surface of the peripheral wall.

Thus, the combined teachings of the applied prior art would not have been suggestive of the now claimed invention.

For the reasons stated above, the decision of the examiner to reject claims 1 to 13, 15 to 22 and 25 to 30 under 35 U.S.C.
§ 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 13, 15 to 22 and 25 to 30 under 35 U.S.C. § 103 is reversed.

REVERSED

LAWRENCE J. STAAB Administrative Patent Judge	)	
JEFFREY V. NASE Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOHN F. GONZALES Administrative Patent Judge	)	

JVN/gjh

THOMAS L. TULLY
PERMAN & GREEN
425 POST ROAD
FAIRFIELD, CT 06430

APPEAL NO. 1996-1598 - JUDGE NASE
APPLICATION NO. 08/206,743

APJ NASE

APJ GONZALES

APJ STAAB

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 04 Mar 99

FINAL TYPED: