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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte HORST-DIETER BORGWARDT,
KARL-HEINZ KUMMER, CHRISTIAN KEMPE,
and SIEGFRIED BENDER

Appeal 2012-009099
Application 11/990,325
Technology Center 3700

Before: CHARLES N. GREENHUT, MICHAEL L. HOELTER, and SCOTT A. DANIELS, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 14–22. App. Br. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

The claims are directed to an individual segment cooling device for the electrodes of a metallurgical furnace. Claim 14, reproduced below, is illustrative of the claimed subject matter:

> 14. A cooling device for electrodes of a metallurgical furnace, comprising a suspension frame (6); and a plurality of individual segments (2, 3, 4, 5) arranged adjacent to each other for surrounding the electrodes and suspended from the suspension frame (6), wherein at least one of the plurality of individual segments (2, 3, 4, 5) is formed with at least one hinge (7) provided at an upper edge thereof for pivotally suspending the at least one of the plurality of individual segments from the suspension frame

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Beck	US 1,549,431	Aug. 11, 1925
Foyn	US 2,671,816	Mar. 9, 1954
Kongsgaarden	US 2,778,865	Jan. 22, 1957
Hardin	US 3,898,364	Aug. 5, 1975
Mori	US 4,424,611	Jan. 10, 1984
Salice	US 5,765,262	Jun. 16, 1998
Giordano	US 2007/0180857 A1	Aug. 9, 2007

REJECTIONS

Claims 14 and 17–22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Foyn and Hardin or Kongsgaarden. Ans. 4.

Claim 15 stands rejected under 35 U.S.C. § 103(a)[1] as being unpatentable over Foyn and Hardin or Kongsgaarden and further in view of Salice or Beck. Ans. 6.

Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Foyn and Hardin or Kongsgaarden and further in view of Giordano or Mori. Ans. 7.

[1] We treat this claim as rejected under § 103 as opposed to § 102 because that is consistent with the Examiner's discussion.

OPINION

Although the Examiner is correct regarding the issues of claim constructions raised in this appeal (*see* App. Br. 8–9, 11–13; Ans. 7–8, 9–10), it is not enough to simply show that the references disclose each element of a claim; in addition, it is important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements in the manner set forth in the claim. *See, e.g., Transocean Offshore Deepwater Drilling, Inc. v. Maersk Contractors USA, Inc.*, 617 F. 3d 1296, 1303 (Fed. Cir. 2010) (citing *KSR Int'l Co. v. Teleflex, Inc.,* 550 U.S. 398, 418 (2007) ("a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art")); *see also In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

Regarding a reason for combining the references, the Examiner states:

> It would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize in Foyn, a suspension frame and the segments suspended from the suspension frame, as taught by Hardin or Kongsgaarden, for the purpose of suspending the holder.

Ans. 5.

This statement is conclusory. At best, it describes the results of the proposed combination, as opposed to articulating a reason for making it. Reply Br. 5. As Appellants correctly point out, the fact that references relate to the same technical field (Ans. 9) does not, without more, demonstrate the obviousness of their combination. The relevant technical field relates to the scope and content prong of the *Graham* analysis. *Graham v. John Deere Co*. 383 U.S. 1, 17–18 (1966). Concluding references are within the same technical field does not conclude that analysis. Rather, it forms part of the background,

upon which the obviousness or nonobviousness of the subject matter must be determined. *Id.* As the Examiner's rejections fail to articulate reasoning with rational underpinnings supporting the Examiner's determination of obviousness, the Examiner's rejections cannot be sustained. *See In re Kahn, supra.*

DECISION

The Examiner's rejections are reversed.

REVERSED

Klh