

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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TADAYOSHI NAKAMURA
and KAZUMI TANAKA

Appeal No. 1999-0778
Application No. 08/710,685

ON BRIEF

Before PAK, OWENS, and TIMM, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 18-24, which are all of the claims remaining in the application.

THE INVENTION

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The appellants claim a refined magnesium or magnesium alloy ingot or billet which has a recited composition and has no substantial porosity.¹ Claim 18 is illustrative:

¹ The appellants' specification (page 9, lines 14-16; page 9, line 24 - page 10, line 2) indicates that "no substantial porosity" means that the ingot or billet has less than 5 pores per 40 cm² which are larger than 0.5 mm in diameter, and has at most 100 pores per 40 cm² which are smaller than 0.5 mm in diameter.

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18. A refined magnesium or magnesium alloy ingot or billet provided with no substantial porosity, which contains 0.1 to 10 weight % of at least one alkaline earth metal selected from the group consisting of calcium, barium and strontium and less than 10 weight % of at least one corrosion resistant metal selected from the group consisting of zinc, cadmium, lead, tin, silicon, manganese and zirconium.

THE REFERENCE

Akiyama et al. (WO '238)² WO 93/15238 Aug. 5,
1993
(PCT application)

THE REJECTION

Claims 18-24 stand rejected under 35 U.S.C. § 103 as being unpatentable over WO '238.

OPINION

We affirm the aforementioned rejection. Because our rationale differs substantially from that of the examiner, we denominate the affirmance as involving a new ground of rejection under 37 CFR § 1.196(b).

The appellants state that they do not concede that a *prima facie* case of obviousness has been established, but that

² Our consideration of this reference is based upon an English translation thereof, a copy of which is provided to the appellants with this decision.

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for purposes of this appeal only, the appellants do not contest that WO '238 establishes a *prima facie* case of obviousness (brief, page 4). The appellants argue that their Japanese priority application, 04-269365, filed September 11, 1992, a certified translation of which has been filed by the appellants, antedates WO '238 and, therefore, renders it unavailable as prior art. *See id.*

The examiner argues that there is no written descriptive support in the appellants' '365 priority application for the term "no substantial porosity" which appears in both of the appellants' independent claims and that, therefore, WO '238 is available as prior art (answer, pages 3-4). It is undisputed that this priority document does not state that the ingot or billet has no substantial porosity.

The appellants respond that the declaration of Nakamura (filed March 9, 1998, paper no. 9) shows that the product in embodiment 1 of the '365 priority application has no substantial porosity (brief, pages 4-5). The appellants rely upon *Kennecott v. Kyocera*, 835 F.2d 1419, 1420, 5 USPQ2d 1194, 1195 (Fed. Cir. 1987), *cert. denied*, 486 U.S. 1008 (1988). In

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Kennecott the court found that although the priority application did not mention equiaxed microstructure, it was undisputed conceded that the method in the priority application invariably produced this microstructure and that the product in all thirty of the relevant examples had this microstructure. See *Kennecott*, 835 F.2d at 1420, 5 USPQ2d at 1196. Accordingly, the court found that the priority application provided adequate written descriptive support for "a predominantly equiaxed microstructure" recited in the claims of the patent in suit. See *Kennecott*, 835 F.2d at 1421-22, 5 USPQ2d at 1197.

In the present case, however, it has not been established that the claimed ingots or billets invariably have no substantial porosity. The appellants rely upon only one example within the scope of their claims and have not established that this example is representative of the ingots or billets encompassed by these claims. In this example the ingot is made of AZ 91 alloy having dissolved therein 0.5 wt% calcium and 0.5 wt% zinc (declaration, page 2). The appellants' broadest claim, however, encompasses the use of 1)

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magnesium alloys in general, 2) calcium, barium and strontium, alone or in any combination, in amounts of 0.1 to 10 wt%, and 3) less than 10 wt% (which includes zero) of zinc and six other corrosion resistant metals, alone or in any combination. Even the appellants' narrowest claim (21) encompasses the use of either AZ 91 or AM 60 alloy, 0.4 to 3 wt% calcium, and up to 2 wt% of barium and/or strontium, and does not require the zinc used in the relied-upon example in the declaration.

Because the appellants have not established that the '365 priority application indicates that the ingots or billets encompassed by their claims invariably have no substantial porosity, the appellants have not shown that the priority application provides adequate written descriptive support for their claimed invention. Consequently, the appellants are not entitled to the filing date of this priority application. Hence, WO '238 has not been antedated and, therefore, is available as prior art. For this reason and because the appellants have not challenged the examiner's conclusion that WO '238 establishes a *prima facie* case of obviousness, we affirm the examiner's rejection. Because our rationale differs substantially from that advanced by the examiner, we

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denominate this affirmance as involving a new ground of rejection under 37 CFR § 1.196(b).

DECISION

The rejection of claims 18-24 under 35 U.S.C. § 103 over WO '238 is affirmed. This affirmance is denominated as involving a new ground of rejection under 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

§ 1.196(b) provides, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197© as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner

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(2) Request that the application be reheard
under § 1.197(b) by the Board of Patent Appeals and
Interferences upon the same record

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

AFFIRMED; 37 CFR § 1.196(b)

CHUNG. K. PAK)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
TERRY J. OWENS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
CATHERINE TIMM)	
Administrative Patent Judge)	

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APJ OWENS

APJ

APJ KEYBOARD()

DECISION: AFFIRMED; 37 CFR

1.196(b)

Prepared: November 6, 2002