

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MATTHEW P. PASULKA

Appeal No. 2005-2687
Application 10/322,194

HEARD: DECEMBER 13, 2005

Before KIMLIN, Pak, and KRATZ, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 9-15, 21 and 22. Claims 9, 12, and 21 are illustrative:

9. A piece of cut metal formed by a metal cutting apparatus, comprising:

cooled slag semi-adhering to the metal base wherein the cooled slag forms a plurality of general arcuate paths,

wherein the pieces of cut metal has a cut formed therein by the metal cutting apparatus, so that an edge of the cut is straight.

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12. A piece of cut metal formed by a metal cutting apparatus, comprising:

first and second surfaces, said first and second surfaces being disposed on opposite sides of said cut metal; and

an edge connecting said first and second surfaces, wherein said edge has a grain pattern that is not perpendicular to said first and second surfaces of said cut metal.

21. A piece of cut metal formed by a metal cutting apparatus, comprising:

a metal base; and

a cooled slag semi-adhering to the metal base.

The examiner relies upon the following references in the rejection of the appealed claims:

Jones	2,289,786	July 14, 1942
Babcock	2,301,923	Nov. 17, 1942
Meincke	2,470,999	July 28, 1944
Bissonnette	5,944,915	Aug. 31, 1999

Appellant's claimed invention is directed to a piece of cut metal having slag semi-adhered to the metal base.

Claims 9-15, 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over any one of Bissonnette, Babcock, Meincke or Jones. Claims 21 and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated each of Bissonnette, Babcock and Jones.

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We have thoroughly reviewed the respective positions advanced by appellant and the examiner. In so doing, we will sustain the examiner's rejection of claims 9-11, 21 and 22, but reverse the examiner's rejection of claims 12-15. Our reasoning follows.

We consider first the examiner's section 102 rejection of claims 21 and 22. Claim 21 on appeal simply calls for a piece of cut metal having cooled slag semi-adhered to the metal base. There is no dispute that each of Bissonnette, Babcock and Jones describes cut metal work pieces having slag adhered thereto. It is appellant's contention that the slag described in the references is not semi-adhered to the metal base. However, as pointed out by the examiner, the present specification fails to define the claim term "semi-adhering" in any way that serves to distinguish the piece of cut metal from the pieces described in the applied references. While appellant maintains that "the apparatus is described in the cited and applied references are incapable of forming a cooled slag semi-adhering to a metal base" (page 10 of principal brief, fourth paragraph), and relies on the Sykes declaration in support of the argument, appellant has not established on the present record actual differences between how the slag is adhered to the cut metal

pieces of the references and how the slag of the claimed invention semi-adheres to the cut metal piece. Significantly, the Sykes declaration states that the slag of the references is not sufficiently oxidized "to make it semi-adhering, thus requiring the user to grind substantial amounts" (page 3 of declaration, first full sentence.) However, appellant's own specification at page 37, discloses that the semi-adhering "slag may be removed with a grinder and other methods known in the art" (second paragraph). Hence, although there maybe a distinction in appellant's method and apparatus for forming a cut metal piece, appellant has not demonstrated that cut metal pieces within the scope of the appealed claims are patentably distinct from the cut metal pieces of the prior art.

We will also sustain the examiner's Section 103 rejection of claims 9-11, 21 and 22. Manifestly, inasmuch as we find that the subject matter of claims 21 and 22 is described by the applied prior art within the meaning of Section 102, it logically follows that we will sustain the rejection of these claims under Section 103. As for claims 9-11, the claims recite that the slag "forms a plurality of general arcuate paths" (claim 9), forms paths "traverse to the longitudinal length of the gouge" (claim 10), and "has generally linear

shapes" (claim 11). In essence, we find that the relative nature of the claim language that defines the paths of the cooled slag does not serve to distinguish the claimed slag from the slag of the prior art. We essentially agree with the examiner that if the cut pieces of the prior art are in the form of "a bar or other round shape, the slag shapes will be arcuate" (page 5 of answer, first paragraph), at least generally so. On the other hand, appellant has not established on the record, let alone explained, how the actual paths of the cooled slag in the prior art are substantively different than the paths of the cooled slag within the scope of the appealed claims.

The rejection of claims 12-15 is another matter. These claims specify particular grain patterns on the edge which connect the first and second surfaces of the piece of cut metal. Claim 12, for example, recites that "said edge has a grain pattern that is not perpendicular to said first and second surfaces of said cut metal." As acknowledged by the examiner, the cited references are silent with respect to the grain pattern of the edge of the cut metal. Faced with such silence, it is the examiner's burden to set forth a rationale which explains either why the prior art inherently has a grain

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pattern like that claimed, or why it would have been obvious for one of ordinary skill in the art to form such a grain pattern. The examiner has done neither. The examiner erroneously reasons that because no method or apparatus is recited in the appealed claims, "[t]he claims are so direct solely to an article with no mention of any processing step required to produce the article, thereby allowing for any desired processing step able to produce the article to be employed" (sentence bridging pages 4 and 5 of answer).

However, while the claims may embrace any process for making the recited grain pattern, the examiner has pointed to no process or apparatus in the prior art that would form the claimed grain pattern. In essence, the examiner has ignored the specific features of the articles defined in claims 12-15.

In conclusion, based on the foregoing, the examiner's Section 102 rejection of claims 21 and 22 is sustained, as is the examiner's Section 103 rejection of claims 9-11 and 21-22. However, the examiner's Section 103 rejection of claims 12-15 is reversed.

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Accordingly, the examiner's decision rejecting the
appealed claims is affirmed-in-part.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a) (iv) (effective Sept. 13, 2004).

AFFIRMED-IN-PART

Edward C. Kimlin)	
Administrative Patent Judge)	
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Chung K. Pak)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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