

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEWART G. HOLDERNESS
and ROBERT G. LEWIN

Appeal No. 1998-0553
Application 08/405,372

ON BRIEF

Before JOHN D. SMITH, GARRIS and DELMENDO, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 27-40 which are all of the claims pending in the application.

The subject matter on appeal relates to a method of treating scrap graphite having a metal contaminant adhered thereto which comprises placing the graphite into a bath comprising an aqueous oxidizing electrolyte, the graphite being contained in one or more baskets having at least a base which has a grill or perforations to allow graphite particles to fall therethrough, and applying to the scrap graphite an electric current contact whereby the graphite forms one electrode of an electrolytic cell. The method further comprises

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passing an electric current around the electrical circuit which includes the scrap graphite, thereby causing the scrap graphite to disintegrate and graphite particles to fall through the grill or perforations. Further details of this appealed subject matter are set forth in representative independent claim 27 which reads as follows:

27. A method of treating scrap graphite having a metal contaminant adhered thereto to separate the metal from the graphite, which method comprises the steps of:

(a) placing scrap graphite having a metal contaminant adhered thereto into a bath comprising an aqueous oxidizing electrolyte, the graphite being contained in one or more baskets having at least a base which has a grill or perforations to allow graphite particles to fall therethrough;

(b) applying to the scrap graphite an electric current contact whereby the graphite forms one electrode of an electrolytic cell;

(c) providing a second electrode in contact with the electrolyte; and

(d) passing an electric current around the electrical circuit comprising the electric current contact, the scrap graphite, the electrolyte and the second electrode thereby causing the scrap graphite to disintegrate and graphite particles to fall through the grill or perforations.

The references relied upon by the examiner as evidence of obviousness are:

Parrish	429,386	Jun. 3, 1890
Fromm	2,903,402	Sep. 8, 1959

A comparison of section (11) (Grounds of Rejection) and section (13) (Response to Argument) in the Examiner's Answer reveals a lack of clarity as to whether the § 112, second paragraph, rejection set forth in the final office action has been advanced on this

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appeal. For purposes of completeness and to avoid the wastage of resources occasioned by piecemeal prosecution and review, we will assume that the § 112, second paragraph, rejection is before us on this appeal. This rejection is set forth below.

Claims 27-40 stand rejected under the second paragraph of 35 USC § 112 for failing to particularly point out and distinctly claim the subject matter which the appellants regard as their invention. The file record reflects that the examiner considers this rejection to be appropriate due to the “whereby” clause set forth in step (b) of appealed independent claim 27.

Claims 27-40 also stand rejected under 35 USC § 103 as being unpatentable of Fromm in view of Parrish.

We refer to the Brief and Reply Brief and to the Answer and final office action for an exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning the above noted rejections.

OPINION

Neither of these rejections can be sustained.

Concerning the § 112, second paragraph, rejection, the statements made and authorities cited by the examiner in the final office action and in the Answer provide no basis for regarding the specific “whereby” language of appealed claim 27 as indefinite. Moreover, we independently perceive no rational basis for considering this claim language to offend the second paragraph of § 112. It follows that the examiner’s rejection of claims

27-40 under the second paragraph of 35 USC § 112 cannot be sustained.

The examiner's § 103 rejection of these claims as being unpatentable over Fromm in view of Parrish also cannot be sustained. As correctly argued by the appellants and not contested by the examiner, the applied references contain no teaching or suggestion of the independent claim 27 recitation of "the graphite being contained in one or more baskets having at least a base which has a grill or perforations to allow graphite particles to fall therethrough" and of "causing the scrap graphite to disintegrate and graphite particles to fall through the grill or perforations". Nevertheless, the examiner considers his § 103 rejection to be proper. In this regard, the examiner urges that "to be entitled to weight in method claims, the recited structural limitations therein must affect the method in a manipulative sense (citing Ex parte Pfeiffer, 135 USPQ 31 (Bd.App. 1961)) and that "the placement of the graphite into baskets having perforated bottoms [pursuant to the appealed claims], does not affect the method in any manipulative sense" (Answer, page 5).

Clearly, the above quoted recitation of claim 27 cannot be ignored. Furthermore, even assuming without deciding that the examiner has properly interpreted and relied upon the cited legal authority, the aforementioned claim recitation must be accorded "weight" in the method claims under review. This is because, from our perspective, the recitation plainly affects the here claimed method in a manipulative sense. For example, the presence of a basket having a base with a grill or perforations unquestionably would affect

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how the scrap graphite and particles falling therefrom would be manipulated during practice of the appellants' claimed method.

Under the circumstances recounted above, we are constrained to agree with the appellants that the references applied by the examiner are deficient in the manner described above and correspondingly that the examiner's § 103 rejection of claims 27-40 as being unpatentable over these references cannot be sustained.

The decision of the examiner is reversed.

REVERSED

JOHN D. SMITH)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
BRADLEY R. GARRIS)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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