THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL B. SUMNER
WILLIAM P. KETTINGER

Appeal No. 95-2733
Application 07/944,146

HEARD: NOVEMBER 6, 1995

Before GARRIS, TURNER and PAK, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-12, 26-37 and 39. Claims 2[illegible], 26 and 34 were amended subsequent to the final rejection. These are all of the claims remaining in the application.

Application for patent filed September 11, 1992. According to applicants, this application is a Division of Application 07/369,442, filed June 20, 1989, now U.S. Patent No. 5,238,672.

The subject matter on appeal relates to a process for producing a mesophase pitch as well as to the mesophase pitch itself. This appealed subject matter is adequately illustrated by claims 1, 6 and 39 which read as follows:

1. A process for producing a mesophase pitch from a catalytic petroleum pitch, which process comprises:

A. forming a film of said catalytic petroleum pitch;

B. maintaining said film at a temperature in the range of about 325°C to about 425°C under a pressure in the range of about 20 microns of mercury to about 1 atm for a time that is sufficient to produce a heavy isotropic pitch having a softening point in the range of about 125°C to about 290°C, a coking value in the range of about 55 wt% to about 95 wt%, and a maximum mesophase content of about 5 vol%; and

C. agitating said heavy isotropic pitch at a temperature in the range of about 327°C to about 454°C for a time sufficient to produce a mesophase pitch having a minimum mesophase content of about 60 vol%.

Claim 6. The mesophase pitch produced by the process of

39. A pitch containing greater than 80 wt% mesophase and having a 0.1% by volume of volatiles given off at a temperature above about 356°C.

The references set forth below are relied upon by the examiner in the rejections before us:

Lewis et al. (Lewis)	3,976,729	Aug. 24, 1976
Pickakian	4,427,530	Jan. 24, 1984
Kitamura et al. (Kitamura)	4,851,122	Aug. 08, 1989 (filed Jan. 03, 1989)
Jemura et al. (Jemura) (European Patent)	0,084,275	Jul. 27, 1983

Claims 6, 9 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by or alternatively under 35 U.S.C. 103 as being unpatentable over Lewis.

Claims 1-12 and 39 are rejected under 35 U.S.C. 103 as being unpatentable over Lewis in view of Dickakian and Kitamura.

Claims 1-12, 26-37 and 39 are rejected under 35 U.S.C. 103 as being unpatentable over Lewis, Dickakian, Kitamura and further in view of Uemura.

Finally, claims 31, 33, 35 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by or alternatively under 35 U.S.C. 103 as being unpatentable over Uemura.

We refer to the main and reply briefs and to the answer for an exposition of the respective positions advocated by the appellants and the examiner concerning the above noted rejections.

Having carefully studied the record before us, we conclude that we should sustain the above noted rejections of product claims 6, 9, 12, 28, 31, 33, 35, 37 and 39 but not the rejections of process claims 1-5, 7, 8, 10, 11, 26, 27, 29, 30, 32, 34 and 36. Our reasons for these conclusions are set forth below.

We completely agree with the appellants that the applied prior art contains no teaching or suggestion of the "pre-treatment" step required by all of the process claims on appeal which step appears to be most broadly defined in appealed claim 1

at clause B. The examiner seems to believe that Dickakian would have suggested such a step. However, for the reasons fully detailed in the briefs, the teachings of this reference differ widely, and in fact seemingly lead away, from the here claimed "pre-treatment" step and from the process disclosed by Lewis.

In light of the foregoing, it is clear to us that, in the absence of guidance provided by the appellants' own disclosure, one with ordinary skill in the art would not have combined Lewis with Dickakian or any of the other applied references in such a manner as to result in a process having the "pre-treatment" step claimed by the appellants. As a consequence, we cannot sustain any of the examiner's rejections of process claims 1-5, 7, 8, 10, 11, 26, 27, 29, 30, 32, 34 and 36.

We reach a different conclusion concerning the product claims on appeal. Although most of these claims define the product thereof by referring to the process by which the product is made, it is well settled that the determination of patentability of such claims is based upon the product itself. *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). With this in mind, we view the record before us as reflecting that the products claimed by the appellants are patentably indistinguishable from the products of Lewis.

Like the appellants, Lewis seeks to obtain a mesophase pitch having a mesophase content of up to 65% by weight which appears to be well within the appellants' mesophase content

range. In addition, again like the appellants, Lewis forms this mesophase pitch into carbonized or graphite fibers. Nevertheless, it is the appellants' basic position that comparative experiments described in the subject specification reflect a difference between mesophase pitch produced by their process and mesophase pitch produced by the process disclosed in Chwastiak Patent No. 4,209,500 and that this difference would also exist with respect to mesophase pitch made from the process of Lewis because of its fundamental similarities to the process of Chwastiak. Even assuming that the appellants' specification comparisons are applicable to Lewis, we cannot agree with the appellants that such comparisons evince a difference between the here claimed mesophase pitch and the mesophase pitch of Chwastiak or concomitantly of Lewis.

For example, on page 55 of their specification, the appellants state that "the process of the present invention provides a suitable mesophase pitch in a time that is substantially shorter than the time required to provide a similar mesophase pitch by means of the stripping technique employed by Chwastiak" (see the first sentence on this page). Notwithstanding the fact that the appellants' process involved a substantially shorter time period, the fact that the mesophase pitch made by this process is "similar" to the mesophase pitch of Chwastiak militates against, rather than for, the appellants' position that

their claimed mesophase pitch patentably distinguishes over the prior art mesophase pitch of Chwastiak or Lewis.

As another example, and concerning appealed claim 39 specifically, we point out that the mesophase pitch defined by this claim appears to be indistinguishable from the prior art (Chwastiak) mesophase pitch disclosed at Mesophase Run No. 27 in Table XIV on specification page 64. By way of explanation, we consider the claim 39 phrase "at a temperature above about 356°C" as encompassing a temperature of 356°C by virtue of the imprecise term "about". *In re Pappas*, 214 F.2d 172, 102 USPQ 298 (CCPA 1954); *In re De Vaney*, 185 F.2d 679, 88 USPQ 97 (CCPA 1950); *In re Ayers*, 154 F.2d 182, 69 USPQ 109 (CCPA 1946).

Under the circumstances recounted above, we conclude that the evidence of record including the comparative examples of the subject specification support the view that the products claimed by the appellants are indistinguishable from the products of Lewis. Certainly, on this record, the appellants have failed to carry their burden of showing otherwise. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-434 (CCPA 1977). We shall, therefore, sustain each of the above noted rejections which are based upon Lewis whether alone or in combination with other references of product claims 6, 9, 12, 28, 31, 33, 35, 37 and 39.

Finally, we will not sustain the §§ 102/103 rejection of claims 31, 33, 35 and 37 over the Uemura reference. These claims are directed to fiber products made from mesophase pitch

formed in accordance with the appellants' claimed process. Although Uemura discloses fibers made from pitch, the pitch is nowhere described by Uemura as a mesophase pitch, much less one having a mesophase content within the range claimed by the appellants. For this reason, no reasonable basis exists for the examiner's conclusion that the fiber product of Uemura corresponds to the fiber product defined by claims 31, 33, 35 and 37.

The decision of the examiner 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).

AFFIRMED-IN-PART

BRADLEY R. GARRIS Administrative Patent Judge	)
VINCENT D. TURNER Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
CHUNG K. PAK Administrative Patent Judge	)

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Application 07/944,146

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