

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOACHIM UNSIN

Appeal No. 1996-0941
Application 08/091,421¹

HEARD: September 14, 1999

Before KIMLIN, OWENS and SPIEGEL, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 8-26, which are all of the claims remaining in the application.

THE INVENTION

¹ Application for patent filed July 15, 1993.

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Appellant's claimed invention is a quick-setting hydraulic binding agent which includes, *inter alia*, aluminous cement in an amount less than 5 wt%. Appellant states that including less than 5 wt% of aluminous cement in the binder, rather than using a greater amount, produces improved cement compressive strength and only slightly reduces the early consistency (specification, page 3). Claim 15 is illustrative and reads as follows:

15. A quick-setting hydraulic binding agent, comprising:

Portland cement;

aluminous cement in an amount less than 5 wt.%;

an alkali carbonate; and

an organic liquefaction-facilitating and calcium silicate hydration-inhibiting material.

THE REFERENCES

References relied upon by the examiner

Braunauer 1972	3,689,294	Sep. 5,
Braniski et al. (Braniski) 1973	3,748,158	Jul. 24,
Crinkelmeyer et al. (Crinkelmeyer) 1978	4,131,578	Dec. 26,
Kolar et al. (Kolar) 1979	4,168,985	Sep. 25,
Crocker	5,328,507	Jul. 12,

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1994

(filed Sep. 23,

1992)

P. Barnes, *Structure and Performance of Cements* 376-77, 429
(Applied Science Publishers 1983).

References relied upon by appellants

McGraw-Hill Dictionary of Scientific and Technical Terms 73,
934 (McGraw-Hill, undated).

European Standard EN 197-10 (undated).²

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 102(b) as follows: claims 15-18 over Braunauer, claims 15, 16 and 18 over Kolar, and claims 15-17 over Crinkelmeyer. The claims stand rejected under 35 U.S.C. § 103 as follows: claim 14 over Braunauer, claims 14 and 17 over Kolar, and claims 14 and 18 over Crinkelmeyer. Claims 8-26 stand rejected under 35 U.S.C. § 112, first paragraph, on the ground that the specification, as originally filed, does not provide support for the

²The examiner does not argue that the undated dictionary definitions and European standard relied upon by appellant are not indicative of the meanings of the terms therein at the time appellant's application was filed. Accordingly, we consider the meanings of the terms in those references to be the meanings of those terms as of appellant's filing date.

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invention as now claimed.

OPINION

We have carefully considered all of the arguments advanced by appellant and the examiner and agree with appellant that the rejection under 35 U.S.C. § 112, first paragraph, is not well founded. Accordingly, we reverse this rejection. However, we affirm the rejections under 35 U.S.C. §§ 102(b) and 103.

Rejection under 35 U.S.C. § 112, first paragraph

The examiner argues that appellant's claims 8-26 do not have support in appellant's original specification because the original specification does not include the term "aluminous cement" recited in appellant's independent claims 8 and 15 which were added by amendment.

Regarding independent claim 14, the amendment (filed October 25, 1994, Paper No. 12) in which this claim was amended to include the term "aluminous cement" was not entered by the examiner (advisory action mailed October 27, 1994,

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Paper No. 13).³ Because "aluminous cement", which is the only term objected to by the examiner, does not appear in claim 14, we reverse the rejection of this claim under 35 U.S.C. § 112, first paragraph.

As for claims 8-13 and 15-26, the examiner argues that the disclosures in Barnes that typical high alumina cements include 37-41% alumina (Table 2, page 377), and that aluminous cements containing from below 40% to over 80% alumina (page 429) are used, indicate that high alumina cement is a specific type of aluminous cement (answer, pages 7-8). Appellant argues that these two passages are not contradictory (reply brief, page 3), and the examiner provides no explanation as to why Barnes' teaching that high alumina cements typically

³ "Do Not Enter" is written in the margin of the amendment and is initialed, apparently by the examiner or his supervisor. Also, the examiner stated in an advisory action (mailed October 27, 1994, paper no. 13) that the amendment will not be entered, and stated in the examiner's answer (page 6) that it has not been entered. This amendment, however, has been clerically entered. Upon return of the application to the examiner, the discrepancy between the instruction not to enter the amendment and the entry of the amendment should be resolved. Contrary to appellant's argument (reply brief, pages 1-2), denial of entry of an amendment is only a petitionable matter, not an appealable matter. See *Manual of Patent Examining Procedure* § 1002.02(c) (7th ed., July 1998); *Ex parte Des Granges*, 162 USPQ 379, 380 (Bd. App. 1968).

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contain 37-41% alumina indicates that the alumina content range of high alumina cements is not that of aluminous cements as disclosed by Barnes, i.e., from below 40% to over 80%.

The examiner points out that Branski uses the term "iron-containing aluminous cements" (col. 1, line 46) and Crocker uses the term "expansive ettringite forming sulfoalumina cement" (col. 1, lines 51-52), and argues that these disclosures indicate that "aluminous cement" is broader than "high alumina cement" (answer, page 8). The examiner has not explained, however, and it is not apparent, why these disclosures indicate that one of ordinary skill in the art would not have considered a sulfoalumina cement to be an aluminous cement.

Appellant has provided a dictionary definition (McGraw-Hill, page 73) which states: "aluminate cement . . . Also known as aluminous cement; high alumina cement; high speed cement." Appellant also relies upon European Standard EN 197-10 which states:

NOTE 2: Calcium aluminate cement has previously been known by several alternatives in other countries:
- high alumina cement;

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- aluminous cement;
- high alumina melted cement;
- etc.

These disclosures provide a sound indication that "high alumina cement" and "aluminous cement" have the same meaning, and the examiner sets forth no evidence or reasoning which shows that these disclosures are in error.

For the above reasons, the evidence of record, on balance, weighs in favor of a finding that "high alumina cement" and "aluminous cement" are synonymous as argued by appellant. Accordingly, we reverse the rejection of claims 8-13 and 15-26 under 35 U.S.C. § 112, first paragraph.

Rejections under 35 U.S.C. §§ 102(b) and 103

Appellant acknowledges that the components in the claimed binding agent were known in the art at the time of appellant's invention (brief, pages 6-7).⁴ Appellant's argument is that the prior art does not disclose or suggest a binding agent which contains aluminous cement in an amount which is greater than zero but less than 5 wt.% (brief, pages 7-8).

⁴Citations herein to appellant's brief are to the substitute appellant's brief filed on April 26, 1995, (Paper No. 21).

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Appellant's argument is not well taken because "less than 5 wt.%" , as recited in appellant's claims, encompasses amounts of aluminous cement including zero. See *In re Mochel*, 470 F.2d 638, 640, 176 USPQ 194, 195 (CCPA 1972); *In re Egbert*, 298 F.2d 947, 948, 132 USPQ 456, 458 (CCPA 1962).

Appellant relies upon *In re Kirsch*, 498 F.2d 1389, 182 USPQ 286 (CCPA 1974). In that case, the court stated that "the amount of unreacted olefin in the reaction mixture being maintained at less than 7 mole percent based on the unreacted isobutane" was not vague and indefinite. See *Kirsch*, 489 F.2d at 1393-94, 182 USPQ at 290. The court stated that "[t]he imposition of a maximum limit on the quantity of one of the reactants without specifying a minimum does not warrant distorting the overall meaning of the claim, to preclude performing the claimed process." See *Kirsch*, 498 F.2d at 1394, 182 USPQ at 290.

In the present case, the relevant issue is written description rather than claim clarity. Nevertheless, to the extent that the language in *Kirsch* regarding distorting the overall meaning of a claim to preclude the claimed process is

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pertinent to the present case, appellant has not established, or even asserted, that omitting the aluminous cement from their claimed binder would prevent the binder from being quick setting. Indeed, the "comprising" transition term opens the claim to other components. See *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 802 (CCPA 1981). Appellant provides no evidence that such components cannot be materials other than aluminous cement which render the binder quick setting.

Appellant argues that his specification shows that the claimed binding agent provides compressive strengths which are superior to those of Braunauer (brief, page 7). The evidence, however, is not commensurate in scope with appellant's claims which, as stated above, include an amount of aluminous cement of zero. See *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983); *In re Clemens*, 622 F.2d 1029, 1035, 206 USPQ 289, 296 (CCPA 1980).

For the above reasons, we affirm the rejections under 35 U.S.C. § § 102(b) and 103.

DECISION

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The rejections under 35 U.S.C. § 102(b) of claims 15-18 over Braunauer, claims 15, 16 and 18 over Kolar, and claims 15-17 over Crinkelmeyer, and the rejections under 35 U.S.C. § 103 of claim 14 over Braunauer, claims 14 and 17 over Kolar, and claims 14 and 18 over Crinkelmeyer, are affirmed. The rejection of claims 8-26 under 35 U.S.C. § 112, first paragraph, on the ground that the specification, as originally filed, does not provide support for the invention as now claimed, is reversed.

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

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EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
TERRY J. OWENS))
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
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CAROL A. SPIEGEL)
Administrative Patent Judge)

STAAS & HALSEY
700 ELEVENTH ST., N.W.
SUITE 500
WASHINGTON, D.C. 20061