

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

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte JOHN P. BARBER

---

Appeal No. 1999-2852  
Application 08/681,898

---

ON BRIEF

---

Before STAAB, McQUADE, and CRAWFORD, Administrative Patent Judges.

CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 32 through 43. Claims 1 through 31 have been withdrawn from consideration.

The appellant's invention relates to a magnetic

Appeal No. 1999-2852  
Application 08/681,898

compaction system for densifying a material to achieve a predetermined

density. An understanding of the invention can be derived from a reading of exemplary claim 32, which appears in the appendix to the appellant's brief.

#### THE REJECTIONS

Claims 32 through 43 stand rejected under 35 U.S.C. § 101 because in the examiner's opinion the claimed invention is not supported by either a creditable asserted utility or a well established utility.

Claims 32 through 43 stand rejected under 35 U.S.C. § 112, first paragraph (enablement) for similar reasons.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above noted rejections, we make reference to the examiner's final rejection and answer (Paper Nos. 11 and 14) for the examiner's complete reasoning in support of the rejections and to the appellant's brief (Paper No. 13) for the appellant's arguments

Appeal No. 1999-2852  
Application 08/681,898

thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the declaration filed by the appellant, and to the respected positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

We will address the rejections of the claims under 35 U.S.C. § 112, first paragraph, and under 35 U.S.C. § 101 together. The lack of utility because of inoperativeness and the absence of enablement are closely relative grounds of unpatentability. Newman v. Quigg, 877 F.2d 1575, 1581, 11 USPQ2d 1340, 1345, (Fed. Cir. 1989), cert. denied, 495 U.S. 932 (1990). A rejection under 35 U.S.C. § 101 for lack of utility is tantamount to a rejection under the how-to-use provision of the enablement clause of the first paragraph of 35 U.S.C. § 112. In re Fouche, 439 F.2d 1237, 1243, 169 USPQ 429, 434 (CCPA 1971).

Appeal No. 1999-2852  
Application 08/681,898

A disclosure of an utility satisfies, the utility requirement of § 101 unless there are reasons for the artisan to question the truth of such disclosure. In re Gaubert, 524 F.2d 1222, 1224, 187 USPQ 664, 666 (CCPA 1975); In re Langer, 503 F.2d 1380, 1391-92, 183 USPQ 288, 297 (CCPA 1974).

To comply with the clause of the first paragraph of 35 U.S.C. § 112, the disclosure must adequately present the claimed invention so that the artisan can practice it without undue experimentation, In re Scarbrough, 500 F.2d 560, 566, 182 USPQ 298, 302 (CCPA 1974); In re Brandstadter, 484 F.2d 1395, 1407, 179 USPQ 286, 294-95 (CCPA 1973).

In support of the rejections the examiner states:

. . . specification teaches a device that accelerates away from the material to be acted upon. As a result it appears as if the container does not impact on the material, making the magnetic energy the only force used in compaction. Thus, the claims are inconsistent with the specification, and it is not perfectly clear what caused the compaction. . . . one skilled in the art clearly would not know how to use the claimed invention. The specification, it discloses only the wall 108' (the container wall) "expands radially to compress material 102" (page 15, line 25 ). (Final Rejection at page 2)

We have reviewed the appellant's specification and note that in the summary of the invention the specification states

that the container is reduced in transverse dimensions thereby indicating that the walls of the container move inward upon the application of the magnetic force. (see specification at pages 5 and 6). The specification also discloses in connection with the first embodiment depicted in figure 1 that the magnetic pressure acts inwardly upon the electrically conductive container 38 so that the transverse dimensions of the container are reduced (see specification at page 8). In connection with the tubular container depicted in figure 2, the specification also indicates that the magnetic pressure acts upon the tubular member and causes reduction of the transverse dimensions of the tubular member thereby also indicating that the walls of that container move inward. (See specification at pages 9 and 10). The specification and it's explanation of the embodiment depicted in Figures 3 through 7, in which there is a predetermined stand-off distance states:

. . . magnetic pressure is applied upon the electrically conductive container 100'. This pressure acts similarly upon the electrically conductive container 100', and the transverse dimensions of the electrically conductive container 100' are reduced (specification at page 12).

The specification also states that the process and operation

Appeal No. 1999-2852  
Application 08/681,898

of the embodiment depicted in Figures 3 through 7c, is substantially the same as the embodiment described earlier herein. Therefore, in our view, a person of ordinary skill in the art reading the specification as a whole would understand that the wall of the container depicted in Figures 3 through 7c moves inwardly to compact the material notwithstanding the use of the phrase "expands radially."

Appeal No. 1999-2852  
Application 08/681,898

In view of the above we will not sustain the examiner's rejections under 35 U.S.C. § 101 and 35 U.S.C. § 112, paragraph one.

The decision of the examiner is reversed.

REVERSED

LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
JOHN P. McQUADE	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
MURRIEL E. CRAWFORD	)	
Administrative Patent Judge	)	

Appeal No. 1999-2852  
Application 08/681,898

Jacox Meckstroth and Jenkins  
2310 Far Hills Building  
Dayton, OH 45419-1575

Appeal No. 1999-2852  
Application 08/681,898

MEC:pgg