

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 49

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RICHARD J. BLAYNER and CHARLES L. MATHEWS

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Appeal No. 95-4407  
Application No. 08/124,834<sup>1</sup>

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ON BRIEF

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Before PATE, NASE, and CRAWFORD, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to the appellants' request for rehearing<sup>2,3</sup> of our decision mailed June 18, 1998, wherein we

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<sup>1</sup> Application for patent filed September 21, 1993.

<sup>2</sup> Filed July 16, 1998.

<sup>3</sup> Effective Dec. 1, 1997, 37 CFR § 1.197(b) was amended to change the term "reconsideration" to "rehearing." See the

affirmed the examiner's rejection of claims 52 to 55, 62 to 65, 70 to 73, 76 and 77 under 35 U.S.C. § 112, first paragraph, affirmed the examiner's rejection of claims 68, 69, 74 and 75 under 35 U.S.C. § 102(b), reversed the examiner's rejection of claim 69 under 35 U.S.C.

§ 112, first paragraph, and reversed the examiner's rejection of claims 52 to 54, 62 to 64, 70 to 72 and 76 under 35 U.S.C. § 103. The appellants seek rehearing only with respect to the affirmance of the examiner's rejection of claims 52 to 55, 62 to 65, 70 to 73, 76 and 77 under 35 U.S.C. § 112, first paragraph.

We have carefully considered the arguments raised by the appellants in their request for rehearing, however, those arguments are only persuasive with respect to claims 70 and 76.

The first argument (p. 2) raised by the appellants is that terms "uniform grain size" (claim 70) and "uniform . . . grains" (claim 76) find literal support in the appellants' specification

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final rule notice published at 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)).

as originally filed. The original disclosure does teach that the surface of the metal has a uniform, small grain size to resist corrosion (see pages 19, 20 and 43). Since the "uniform grain size" (claim 70) and "uniform . . . grains" (claim 76) find literal support in the appellants' specification as originally filed, the decision of the examiner to reject claims 70 and 76 under 35 U.S.C. § 112, first paragraph, is reversed. Accordingly, our interpretation of "uniform grain size" (claim 70) and "uniform . . . grains" (claim 76) to mean that all the grains in the metal are uniform (i.e., always the same, unvarying, without variation) found in footnote 4 (p. 5) of our decision is withdrawn.

The second argument (pp. 3-5) raised by the appellants is that term "uniform grain size throughout the metal" (claims 52 and 62) would have been understood by one skilled in the art of metallurgy. In that regard, the appellants do not agree with our definition of "uniform" to mean always the same, unvarying, without variation. The appellants argue (p. 4) that

[o]ne skilled in the art of metallurgy, particularly lead-based products, would appreciate the uniform grain size produced by the extrusion method of the present invention, especially when compared to the non-uniform grain size resulting from cast lead grids such as those shown in Figs. 7-12 of the Prengaman Declaration.

It is our determination that the limitation that the grain size is uniform throughout the metal is not an inherent property of the originally disclosed structure for extruding the composite wire. The declaration of R. David Prengaman (¶ 15-17) states that disclosed structure for extruding the composite wire produces "a uniform crystalline grain structure." The declaration of R. David Prengaman (¶ 18) refers to micrographs (Figures 1-6 of Exhibit 4) that show the grain structure of an extruded lead coating made according to the method disclosed in this application. However, those micrographs do not show a grain size that is uniform (i.e., always the same, unvarying, without variation) throughout the metal. The micrographs (Figures 1-6 of Exhibit 4 of the Prengaman declaration) show a **more uniform** grain structure than the micrographs (Figures 7-12 of Exhibit 4 of the Prengaman declaration). However, claims 52 and 62 recite that the grain size is uniform throughout the

metal, not that the grain size is **more uniform** when compared to another product. Furthermore, the appellants have not presented any evidence<sup>4</sup> that would establish that one skilled in the wire art would not have understood "uniform" to mean always the same, unvarying, without variation. Accordingly, the specification, as originally filed, does not provide support for "uniform grain size throughout the metal" (claims 52 and 62).

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<sup>4</sup> Attorney's arguments in a brief cannot take the place of evidence. In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

In light of the foregoing, the appellants' request for rehearing is granted only to the extent that the decision of the examiner to reject claims 70 and 76 under 35 U.S.C. § 112, first paragraph, is reversed.

No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REQUEST FOR REHEARING - GRANTED-IN-PART

WILLIAM F. PATE, III	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
MURRIEL E. CRAWFORD	)	
Administrative Patent Judge	)	

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**ON REQUEST FOR REHEARING**

APPEAL NO. 95-4407 - JUDGE NASE  
APPLICATION NO. 08/124,834

APJ NASE

APJ CRAWFORD

APJ PATE

DECISION: **GRANTED-IN-PART**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 11 Aug 98

**FINAL TYPED:**