

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

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

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT M. RUMPH

Appeal No. 1998-1215
Application No. 08/091,039

ON BRIEF

Before CALVERT, FRANKFORT, and JENNIFER D. BAHR,
Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

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DECISION ON APPEAL

This is an appeal from the final rejection of claims 25 to 31 and 33 to 43, all the claims remaining in the application.

The appealed claims are drawn to a method of disposing of hazardous waste (claims 25 to 31, 33 to 37 and 40) and a method of transporting hazardous waste (claims 38, 39 and 41 to 43). They are reproduced in Appendix A of appellant's brief.¹

¹ In reviewing the claims, it appears that "into a conduit . . . to an incinerator" (claim 25, lines 16 and 17) and "generally planar flat surface" (claim 38, line 19) have no antecedent basis in the specification. 37 CFR § 1.75(d)(1).

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The prior art applied in the final rejection is:

McLennan 1893	510,545	Dec. 12,
Morrell 1927	1,618,669	Feb. 22,
Gillican 1933	1,896,616	Feb. 7,
Nakayama et al. 1976 (Nakayama)	3,951,581	Apr. 20,

Affidavits of Sid Morrison and Otto Ewers, dated July 6 and 7, 1994, respectively.²

Additional prior art applied herein in rejections pursuant to 37 CFR § 1.196(b) is:

Wallace	4,552,460	Nov. 12,
1985 ³		

The admitted prior art described on page 1, line 15, to page 4, line 3 of appellant's specification (APA).

The claims on appeal stand finally rejected on the following grounds:

(1) Claims 34 to 37 and 40, unpatentable for failure to comply with 35 U.S.C. § 112, second paragraph.

² These affidavits were filed with an Information Disclosure Statement on Aug. 9, 1994 (Paper No. 9).

³ This reference was cited in an Information Disclosure Statement filed on July 27, 1993 (Paper No. 4).

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(2) Claims 25, 28, 29, 33, 34 and 40, unpatentable over Nakayama in view of Gillican and Morrell, under 35 U.S.C. § 103(a).

(3) Claims 26, 27, 30, 31, 35 to 39 and 41 to 43, unpatentable over Nakayama in view of Gillican, Morrell, McLennan, and either of the Morrison or Ewers affidavits, under 35 U.S.C. § 103(a).

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Rejection (1)

In this rejection, the examiner asserts that the term "appreciable" in claim 34 (line 9) is indefinite. Appellant does not contest this rejection, but states on page 28 of the brief that the rejection is mooted because he is willing to delete the term from the claims. However, the rejection is not moot because, as the examiner notes on page 3 of the answer, no amendment deleting "appreciable" has been filed.

Accordingly, rejection (1) will be summarily sustained.

Rejection (2)

Nakayama discloses a method of disposing of paint waste in which the waste is mixed with waste oil and water in tank 1, forming a slurry which prevents sedimentation of the paint waste particles (col. 1, lines 22 to 24; col. 2, lines 37 to 40). The slurry is fed to storage tank 2, and therefrom continuously to incinerator 3, where it can be completely burned without pollution (col. 1, lines 37 to 39). The examiner recognizes that Nakayama does not disclose moving the waste in a tank with an elongated bottom to the incinerator, but takes the position that such a modification of the Nakayama process would have been obvious in view of Gillican.

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He further cites Morrell as teaching that the Nakayama waste material should be agitated so that it becomes substantially homogeneous.

After fully considering the record in light of the arguments presented in appellant's brief and the examiner's answer, we conclude that the involved claims are patentable over the combination of references applied by the examiner. In particular, we do not consider that it would have been obvious, in view of Gillican, to move the waste material of Nakayama to the incinerator in a tank and to agitate it in the tank. The purpose of the tank car disclosed by Gillican is to transport materials which "are very viscous, and may or do solidify after they have been stored or placed in the cold for some time" (page 1, lines 4 to 6), such as crude pine gum, oils, fats, etc. In order to render the material being transported more fluid when the car is to be unloaded, Gillican provides heating pipes 21, etc., and an agitator 13 to stir and mix the material simultaneously with the heating (page 1, lines 68 to 73; page 3, lines 36 to 55). While it might have been obvious, as a general proposition, to transport the paint waste of Nakayama from the waste source to

the incinerator, it would seem that one of ordinary skill would transport the paint waste after it had been formed into a slurry from which there would be no sedimentation (i.e., would transport tank 2), rather than to agitate the mixture of paint waste, oil and water to form the slurry in the tank used for transportation. In any event, we do not consider that it would have been obvious from Gillican to agitate the Nakayama mixture and/or slurry in the transportation tank, because the Gillican agitator is not used to form a suspension of solids in a liquid or to prevent the separation of solids from the material being transported, but rather is used simply to agitate the material in the tank so that it will be more evenly and completely heated to reduce its viscosity.⁴ Since there is no indication that the paint waste mixture or slurry of Nakayama is subject to solidification when cold, Gillican's disclosure would not have taught or suggested to one of ordinary skill agitation of the waste material of Nakayama in

⁴ Although the examiner states that the Gillican apparatus is capable of agitating "a viscous material which contains solids" (answer, page 5), the only solids disclosed by Gillican are debris and solid material which will be melted (page 1, lines 28 to 31).

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a tank being used to move that material. The Morrell reference not affect our conclusion because, as noted above, it concerns the desirability of homogenization, but does not concern the question of transportation in a tank.

Rejection (2) therefore will not be sustained.

Rejection (3)

The basis of this rejection is somewhat unclear. The examiner states at page 9 of the answer that:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have hauled the hazardous waste of Nakayama to its point of incineration, in a tank car as described by either the Ewers or Morrison affidavit[s], because Nakayama require[s] the agitation of the waste in a tank so as to disperse solids therein into a slurry and because Gillican teaches a mobile tank car capable of providing agitation of viscous materials which contain solids, in order to allow said material to be discharged as a flowable fluid, and because Ewers and Morrison both show tank cars specifically adapted for hauling liquids having a high concentration of solids.

The examiner seems to be taking the position that, in view of Gillican, it would have been obvious to transport the waste of Nakayama to the incinerator in a tank and to agitate it in that tank. However, as discussed above in connection with

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rejection (2), we do not agree with this position of the examiner, since Gillican's tank car is not disclosed as being for transporting a slurry from which solids may settle, nor is the agitator of Gillican provided for placing or maintaining the solids in suspension.

The Morrison and Ewers affidavits each state that at least as early as 1988 (Morrison) or in 1982 (Ewers) tank trailers were sold which had an auger mounted within and extending the length of the tank; the trailers were for transporting high-solids content liquid materials. According to Morrison, the auger was "to agitate the liquids and solids carried in the tank and facilitate removal of materials during draining of the tank"

(page 2). Ewers states that the auger was "to move the liquids and solids carried in the tank to the outlet valve for draining the tank," but "[a]fter operating the system, we discovered that the auger also agitated or mixed the tank contents" (page 2).

Since the apparatus disclosed by these references is basically the same, insofar as relevant to this case, as that of Gillican, it is not clear what the Morrison and Ewers

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affidavits are intended to add to the combination of Nakayama and Gillican. Insofar as the examiner is asserting that it would have been obvious, in view of the affidavits, to transport Nakayama's paint waste to an incinerator in a tank and agitate it in that tank, we do not agree. As previously discussed, Nakayama agitates paint waste with waste oil and water to form a slurry from which there is no sedimentation of paint particles. We find nothing in the Morrison or Ewers affidavits which would teach one of ordinary skill to agitate the paint waste/waste oil/water mixture of Nakayama to form a slurry during transportation in the tank trailer of the affidavits, since the augers are provided to facilitate unloading of the tank. Nor do we consider that it would have been obvious to wait until unloading to agitate the paint waste/waste oil/water mixture of Nakayama to form the slurry, since most of the benefit of having a slurry would be lost; in our view, one of ordinary skill would form the slurry of Nakayama before transporting it to the incinerator, in which case agitation would not be necessary. McLennan, which discloses a paint mixer, does not affect this conclusion.

We will, therefore, not sustain rejection (3).

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Rejections Pursuant to 37 CFR § 1.196(b)

(A) Claims 40 and 43 are rejected for failing to comply with the second paragraph of 35 U.S.C. § 112. Each of these claims recites "wherein the tank includes a floor, a lower-most portion of the floor being the tank bottom." This language implies that there is a floor structure which, other than at its lower-most portion, is separate from the tank bottom, but the scope of the claims is indefinite when one attempts to read them on the disclosure (cf. In re Cohn, 438 F.2d 989, 993, 169 USPQ 95, 98 (CCPA 1971)) because there is no disclosure of a floor separate from the bottom of the tank 10, but rather, the bottom of the tank and the floor seem to be used in the specification as interchangeable terms. See, e.g., page 8, lines 28, 31, 32 and 34.

(B) Claims 25, 28, 29, 33, 34 and 40 are rejected under 35 U.S.C. § 103(a) as unpatentable over the APA in view of Wallace.

The relevant portion of appellant's disclosure of what was known at the time of his invention may be summarized as follows:

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(i) Hazardous waste, such as paint waste, which contains solids and liquids, is burned as fuel in industrial burners, such as cement kilns (page 1, lines 15 to 26).

(ii) The waste is transported to the kiln in tank trucks (page 1, line 33, to page 2, line 1).

(iii) Discharge of the waste from the tank truck to the kiln burner is a problem because the solids remain at the bottom of the tank. This has several undesirable consequences (page 2, line 10, to page 3, line 16).

(iv) "It is known that a previous attempt to agitate the contents of a hazardous waste transport tank included the use of vertically extending augers or the like, but it resulted in a considerable residue of solids in the tank after it was supposedly drained." (page 3, lines 25 to 29)

Wallace discloses apparatus for maintaining solid particles in suspension in a liquid, particularly when contained in a right circular cylindrical tank. The patent discloses that an agitator which rotates about a vertical axis is not satisfactory (col. 1, lines 23 to 49). Instead, Wallace utilizes an agitator which rotates about a horizontal shaft 24 extending along the tank 12, eliminating growth of a

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bed of solid particles on the bottom of the tank and obtaining uniform particle concentration and size (i.e., a substantially homogeneous mixture) throughout the slurry (col. 1, lines 60 to 65). It is noted that such mixing, applied to paint waste, would inherently increase the effective BTU rating of the waste material, in accordance with appellant's disclosure at page 2, lines 28 to 32.

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In view of appellant's disclosure ((iv),supra) that vertically extending augers have been used to agitate the hazardous waste in a transport tank, but still left a considerable residue of solids, and Wallace's disclosure of the superiority of his disclosed (horizontal axis) apparatus in relation to agitators having vertical axes, it would have been obvious to one of ordinary skill in the art to use an agitator such as that disclosed by Wallace instead of the vertically extending augers disclosed by appellant, the motivation for such modification being the superior results disclosed by Wallace.

As for claim 29, it would have been obvious to have agitated the waste material in the tank while the tank was being moved in view of Wallace's teaching at col. 1, lines 13 to 15, that the particles should not be allowed to settle out.

The limitation in claim 34, lines 16 and 17, of "burning the hazardous waste while the waste is in a [sic: the] form of the substantially homogeneous mixture" would inherently result from discharging the (agitated) hazardous waste "from the tank to the kiln burner," as appellant discloses at page 2, line 11.

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Claim 40, rejected above under 35 U.S.C. § 112, second paragraph, would be met by the APA-Wallace combination insofar as the claim language is understood, since every tank has a bottom, which may be designated the "floor."

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Remand to the Examiner

This application is remanded to the examiner to determine whether any of claims 26, 27, 30, 31, 35 to 39 and 41 to 43 should be rejected under 35 U.S.C. § 103(a) as unpatentable over the APA in view of Wallace and/or other prior art.

Conclusion

The examiner's decision to reject claims 34 to 37 and 40 under 35 U.S.C. § 112, second paragraph, is affirmed, and to reject claims 25 to 31 and 33 to 43 under 35 U.S.C. § 103(a) is reversed. Claims 25, 28, 29, 33, 34, 40 and 43 are rejected pursuant to 37 CFR § 1.196(b), and the case is remanded to the examiner.

In addition to affirming the examiner's rejection of one or more claims, this decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

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Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 CFR § 1.197(c) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere

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incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of

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Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for reconsideration thereof.

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; 37 CFR § 1.196(b); REMANDED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JENNIFER D. BAHR)	
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REVERSED

Prepared: February 4, 2002