

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WILLIAM M. DAVIS, JR.

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Appeal No. 1998-0838  
Application No. 08/265,858

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ON BRIEF

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

FRANKFORT, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to appellant's request for rehearing of our decision mailed July 31, 2000, wherein we affirmed the examiner's rejection of claims 1 through 6 under 35 U.S.C. § 103.

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We have carefully considered each of the points of argument raised by appellant in the request for rehearing, however, those arguments do not persuade us that our prior decision was in error in any respect.

In contrast with appellant's position that we have misapprehended the primary distinction between the prior art applied by the examiner and appellant's invention, we recognize that the slag handling system disclosed by appellant and that disclosed in Hibbel are not the same, however, it is the claimed subject matter which we have evaluated in this appeal relative to the applied prior art and not the system as specifically disclosed by appellant. During the prosecution of a patent application, claims are given their broadest reasonable interpretation consistent with the specification. See In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); In re Tanaka, 551 F.2d 855, 860, 193 USPQ 138, 141 (CCPA 1977). However, limitations in the specification will not be read into the claims. See In re Winkhaus, 527 F.2d 637, 639, 188 USPQ 129, 131 (CCPA 1975). In this particular case, we have given the claimed slag handling system and, more particularly, the claim language "closed loop sluice water system" in appellant's

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independent claim 1 on appeal its broadest reasonable interpretation and found that it is readable on the closed loop sluice water system in Hibbel which transports slag from the separating chamber (43) and lock vessel (6) in a water/slag mixture into the collecting vessel or sump pit (22). Appellant has pointed to nothing in the claims on appeal (particularly, independent claim 1) which in any way changes our views as set forth on pages 5 through 10 of our earlier decision.

The fact that appellant's invention as disclosed may be a substitute for the mechanical device (49) of Hibbel and that the system or process in Hibbel may be an appropriate process precursor to appellant's process, is of no avail, since the claims before us on appeal (specifically independent claim 1) do not include any limitations which make or require any such distinctions in the claimed subject matter. For that reason, we remain of the view expressed in our earlier decision concerning the obviousness of the subject matter set forth in appellant's claims on appeal.

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In light of the foregoing, appellant's request is granted to the extent of reconsidering (rehearing) our earlier decision, but is denied with respect to making any changes therein.

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

DENIED

|                             |   |                 |
|-----------------------------|---|-----------------|
| Charles E. Frankfort        | ) |                 |
| Administrative Patent Judge | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
| Jeffrey V. Nase             | ) | BOARD OF PATENT |
| Administrative Patent Judge | ) | APPEALS AND     |
|                             | ) | INTERFERENCES   |
|                             | ) |                 |
|                             | ) |                 |
| Jennifer D. Bahr            | ) |                 |
| Administrative Patent Judge | ) |                 |

CEF:tdl

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