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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SARJIT JOHAL

Appeal 2011-000209
Application 11/383,593
Technology Center 3700

Before LINDA E. HORNER, STEVEN D.A. McCARTHY, and WILLIAM A. CAPP, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Sarjit Johal (Appellant) seeks our review under 35 U.S.C. § 134 of the Examiner's decision rejecting claims 1-16 and 18-39. App. Br. 1.[1] We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART and enter a NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).

THE INVENTION

Appellant's claimed invention relates to methods for treating spent filter media containing diatomaceous earth, compositions that contain such spent filter media, and associated methods. Spec., para. [03]. Claims 1 and 10, reproduced below, are representative of the subject matter on appeal.

> 1. A process of drying spent filter media comprising mixing the filter media with a dry material to produce a composition having a moisture content that is sufficiently low to inhibit microbial growth in the composition; wherein the spent filter media comprises spent diatomaceous earth.
>
> 10. A composition comprising spent filter media and a second material and at least one additional material selected from the group consisting of a binder, a surfactant, a mineral, a nutrient, and a fibrous plant material, wherein the spent filter media comprises spent diatomaceous earth and the composition comprises at most 18 wt % water.

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[1] Claim 17 is pending and rejected. Ans. 5-6. Appellant has withdrawn the appeal as to claim 17. App. Br. 2, 8. We suggest that the Examiner cancel this claim upon return of jurisdiction of this application to the Examiner. *See Ex Parte Ghuman*, 88 USPQ2d 1478, 1480 (BPAI 2008) (precedential).

THE EVIDENCE

The Examiner relies upon the following evidence:

Ross '163	US 4,263,163	Apr. 21, 1981
Beauman	US 4,396,512	Aug. 2, 1983
Altmansberger	US 4,434,060	Feb. 28, 1984
Ross '525	US 4,579,525	Apr. 1, 1986
Koslow	US 2003/0205531 A1	Nov. 6, 2003

THE REJECTIONS

Appellant seeks review of the following rejections:

1. Claims 1-7, 9, 19-26, and 39 under 35 U.S.C. § 103(a) as unpatentable over Koslow and Ross '525;
2. Claims 10-14 and 16 under 35 U.S.C. § 103(a) as unpatentable over Ross '163 and Ross '525;
3. Claims 18-20 and 34-37 under 35 U.S.C. § 103(a) as unpatentable over Beauman and Ross '525;
4. Claim 8 under 35 U.S.C. § 103(a) as unpatentable over Koslow, Ross '525, and Altmansberger; and
5. Claims 15, 27-33, and 38 under 35 U.S.C. § 103(a) as unpatentable over Ross' 163, Ross '525, and Altmansberger.

STATUS OF CLAIMS

Appellant sought to cancel claim 17 and amend claims 19 and 20 to depend from claim 18 in an amendment after final. The Examiner refused entry of this amendment. Appellant now requests that the Board review the propriety of the Examiner's refusal to enter the amendment after final. App. Br. 6. The Examiner's refusal to enter the amendment after final is a matter

petitionable to the Director under 37 C.F.R. § 1.181, and thus is not within the jurisdiction of the Board. 37 C.F.R. § 1.127; *In re Berger*, 279 F.3d 975, 984 (Fed. Cir. 2002) (citing *In re Hengehold*, 440 F.2d 1395, 1403-04 (CCPA 1971)); and *In re Mindick*, 371 F.2d 892, 894 (CCPA 1967).[2]

ANALYSIS

Claim Construction

One of the matters in dispute is the broadest reasonable construction of "spent filter media" as recited in the claims. An ordinary meaning of "spent" is "Of material things: Expended, consumed, used up completely."[3] The description in Appellant's Specification of a "spent" filtration aid is consistent with this ordinary meaning of "spent." *See, e.g.*, Spec., para. [05] (describing the problem of "disposal of the used (spent) filtration aid"). As such, "spent filter media" refers to filter media that has been used as a filtration aid to the point at which it is no longer useful as such unless regenerated.

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[2] We decline to adopt Appellant's suggestion to include an explicit statement pursuant to 37 C.F.R. § 41.50(c) to permit cancellation of claim 17 and correction of the dependency of claims 19, 20, and 33. App. Br. 6. Such is not the proper use of this rule, which provides that the Board can include such an explicit statement to explain "how a claim on appeal may be amended to overcome a specific rejection." In this instance, no ground of rejection is involved in the requested amendments.

[3] Oxford English Dictionary Online (Dec. 2012), available at: http://www.oed.com/view/Entry/186295? redirectedFrom=spent (last visited Feb. 15, 2013).

Rejection (1) – Claims 1-7, 9, 19-26, and 39 as unpatentable over Koslow and Ross '525

The first ground of rejection is based on a finding that Koslow discloses a process of drying spent filter material wherein the spent filter media comprises diatomaceous earth. Ans. 4 (citing Koslow, paras. [0082]-[0117]). The cited portion of Koslow relates to a method of making a microporous filter medium with an optional adsorbent prefilter. Koslow, paras. [0082], [0093]. While Koslow discloses that the filter medium may include diatomaceous earth, Koslow does not disclose mixing spent filter media comprising diatomaceous earth with a dry material as called for in claim 1. As such, the Examiner's determination of obviousness of independent claim 1, and dependent claims 2-7, 9, and 19-26, is based on an erroneous underlying finding of fact. The rejection of claim 39, which incorporates by reference the limitations of claim 1, is likewise based on an erroneous underlying finding of fact. For this reason, we do not sustain the first ground of rejection.

Rejection (2) – Claims 10-14 and 16 as unpatentable over Ross '163 and Ross '525

Appellant argues the claims subject to the second ground of rejection as a group. App. Br. 7-8. We select claim 10 as representative, and claims 11-14 and 16 stand or fall with claim 10. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2011).

Appellant argues "[n]either Ross reference discloses spent filter media, nor does either reference have anything to do with drying of spent diatomaceous earth." App. Br. 8. The Examiner found that Ross '163

discloses a "composition comprising spent filter media and a second material wherein spent filter media comprises diatomaceous earth and the composition comprises at most 18 wt % water . . . ." Ans. 5 (citing Ross '163, col. 16, ll. 3-18 and 41-48). The Examiner also found that Ross '525 discloses a "spent diatomaceous earth filter." *Id.* (citing Ross '525, col. 13, l. 47 – col. 14, l. 45).

Ross '525 claims priority under 35 U.S.C. § 120 to Ross '163, and thus the two patents contain overlapping disclosure. Both Ross references disclose "a furnace which . . . can process diatomaceous earth." Ross '163, col. 3, ll. 8-11; Ross '525, col. 3, ll. 20-22. The references disclose that the furnace can be used to calcine diatomaceous earth, and that in order to process this material, it is necessary to add a binder to the diatomaceous earth to agglomerate the material. Ross '163, col. 11, ll. 43-57; Ross '525, col. 12, ll. 43-57. The references disclose that "in the calcining of diatomaceous earth for filter aid products, there is added to the diatomaceous earth a sodium flux, such as sodium carbonate." Ross '163, col. 11, l. 68 – col. 12, l. 2; Ross '525, col. 12, l. 68 – col. 13, l. 2. *See also* Ross '163, col. 12, ll. 2-5; Ross '525, col. 13, ll. 2-5 (disclosing other sodium and corresponding potassium compounds). The agglomerated product is then heated to a high temperature without fusing the product to make the processed product 224. Ross '163, col. 12, ll. 40-43; Ross '525, col. 13, ll. 40-43. The Ross references disclose:

> In regard to diatomaceous earth which is used as a filter aid, the calcining process can be valuable in rejuvinating [sic] the filter aid. For example, the filter aid comprising spent

> diatomaceous earth can be processed and mixed with a binder, such as sodium silicate to form an agglomerated product **220** in the form of a discrete unit or a ball. Then, this discrete unit or ball **200** can be introduced into the furnace **28** and heated to a temperature in the range of about 1750°-1900° F. to form a new filter aid comprising the glazed or glassy diatomaceous earth ball or discrete unit. A result of this is the reusing of diatomaceous earth and the elimination of the step of throwing away used diatomaceous earth which has served a purpose as a filter aid.

Ross '163, col. 13, ll. 26-39; Ross '525, col. 14, ll. 26-39. *See also* Ross '163, col. 16, ll. 41-48; Ross '525, col. 17, ll. 41-48 (discussing regeneration of used filter aids including filter aids prepared from diatomaceous earth).

Based on these disclosures, contrary to Appellant's assertions, both Ross references pertain to treatment of spent filter media comprising diatomaceous earth. The Ross references disclose heating a composition comprising spent filter media and a second material (a binder) in a furnace, which results in drying of the spent filter media. Appellant has not challenged the Examiner's finding that the composition disclosed in the Ross references comprises at most 18 wt % water. As such, we find that the Examiner's findings which are challenged by Appellant are supported by a preponderance of the evidence, and thus the Examiner did not err in rejecting claims 10-14 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Ross '163 and Ross '525. Accordingly, we sustain the second ground of rejection.

Rejection (3) – Claims 18-20 and 34-37 as unpatentable over Beauman and Ross '525

The third ground of rejection is based on a finding that Beauman discloses "adding to the soil a composition comprising spent filter media and a dry material, wherein the spent filter media comprises diatomaceous earth . . . ." Ans. 6 (citing Beauman, col. 3, ll. 15-31 and col. 4, ll. 18-59). Beauman relates to a bacteriostatic filter media comprising diatomaceous earth. Beauman, col. 3, ll. 26-27. The cited portions of Beauman relate to a method of rendering the filter bacteriostatic. While Beauman discloses that the filter medium may include diatomaceous earth, Beauman does not disclose a method of treating soil comprising adding to the soil a composition comprising spent filter media comprising diatomaceous earth and a dry material as called for in claim 18. As such, the Examiner's determination of obviousness of independent claim 18, and dependent claims 19, 20, and 34-37, is based on an erroneous underlying finding of fact. For this reason, we do not sustain the third ground of rejection.

Rejection (4) – Claim 8 as unpatentable over Koslow, Ross '525, and Altmansberger

For the same reasons as discussed *supra* with regard to the first ground of rejection, we do not sustain the rejection of claim 8 as it is based on the same erroneous finding that Koslow discloses mixing spent filter media comprising diatomaceous earth with a dry material as called for in claim 1, from which claim 8 depends.

Rejection (5) – Claims 15, 27-33, and 38 as unpatentable over Ross '163, Ross '525, and Altmansberger

Appellant argues that the fifth ground of rejection should be reversed because "the Ross references and the Altmansberger references have nothing to do with the claimed subject matter." App. Br. 9. We do not find this argument persuasive in light of our analysis *supra* of the second ground of rejection and the disclosures of Ross '163 and Ross '525. As such, we sustain the fifth ground of rejection.

NEW GROUND OF REJECTION

We enter a new ground of rejection of claim 1 under 35 U.S.C. § 102(b) as anticipated by Ross '525. No inference should be drawn from the Board's failure to make a new ground of rejection for other claims.[4] With regard to appeals from adverse decisions of examiners, we are primarily a tribunal of review, and, as such, we leave it to the Examiner to further consider the patentability of the remaining claims in light of the prior art and this new ground of rejection.

Appellant's Specification describes that "[a] preferred source of dry material is lime, but other ingredients, such as clays, *binders*, surfactants, minerals, fibrous plant materials, or fertilizer ingredients that contribute plant nutrients or micronutrients may be used in conjunction with the invention." Spec., para. [10] (emphasis added). As such, we understand "a

[4] *See* 37 C.F.R. § 41.50(b). *See also Manual of Patent Examining Procedure* (MPEP), 8th ed., rev. Aug. 2012, § 1213.02 ("Since the exercise of authority under 37 CFR 41.50(b) is discretionary, no inference should be drawn from a failure to exercise that discretion.")

dry material" as recited in the claim 1 to be broad enough to encompass binders. Claim 1 employs the transitional phrase "comprising" which means that the claim is not limited to only the specific steps recited in the claim but can include additional steps, such as heating a composition in a furnace.

We enter a new ground of rejection of independent claim 1 under 35 U.S.C. § 102(b) as anticipated by Ross '525. As described *supra*, Ross '525 anticipates claim 1 in that it discloses a process of drying used (spent) filter media comprising diatomaceous earth, including mixing the spent filter media with a dry material (a binder). In particular, Ross '525 discloses calcining spent diatomaceous earth filter aid products by adding a binder to the spent filter aid material and heating the composition in a furnace. Ross '525, col. 3, ll. 20-22; col. 12, ll. 43-57; col. 12, l. 68 – col. 13, l. 5; col. 13, ll. 40-43; col. 14, ll. 26-39; and col. 17, ll. 41-48. The method disclosed in Ross '525 would inherently result in a composition having a moisture content that is sufficiently low to inhibit microbial growth in the composition in that Ross '525 discloses that calcining process forms "a new filter aid" (Ross '525, col. 14, ll. 34-35) and such a filter aid would necessarily have a moisture content sufficiently low to inhibit microbial growth. Accordingly, Ross '525 anticipates claim 1.

DECISION

We REVERSE the decision of the Examiner to reject:

- Claims 1-7, 9, 19-26, and 39 under 35 U.S.C. § 103(a) as unpatentable over Koslow and Ross '525;

- Claims 18-20 and 34-37 under 35 U.S.C. § 103(a) as unpatentable over Beauman and Ross '525; and
- Claim 8 under 35 U.S.C. § 103(a) as unpatentable over Koslow, Ross '525, and Altmansberger.

We AFFIRM the decision of the Examiner to reject:

- Claims 10-14 and 16 under 35 U.S.C. § 103(a) as unpatentable over Ross '163 and Ross '525; and
- Claims 15, 27-33, and 38 under 35 U.S.C. § 103(a) as unpatentable over Ross '163, Ross '525, and Altmansberger.

We enter a NEW GROUND OF REJECTION of claim 1 under 35 U.S.C. § 102(b) as anticipated by Ross '525.

Regarding the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides "Appellant may file a single request for rehearing within two months from the date of the original decision of the Board." In addition to affirming the Examiner's rejections of one or more claims, this decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that Appellant, <u>WITHIN TWO MONTHS FROM THE DATE OF THE DECISION</u>, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the

> Examiner, in which event the proceeding will be remanded to the Examiner. . . .
>
> (2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejections, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejections are overcome.

If 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 Patent Trial and Appeal Board for final action on the affirmed rejections, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

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