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Silvia Salvadori, P.C. Silvia Salvadori 270 Madison Avenue, 8th Floor New York, NY 10016			SOLIMAN, HAYTHAM	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MARCO MASTRODONATO, MASSIMO PRATI, and  
IOANA VERONICA MICU

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Appeal 2019-001055  
Application 13/510,157  
Technology Center 1700

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Before LINDA M. GAUDETTE, JAMES C. HOUSEL, and  
MONTÉ T. SQUIRE, *Administrative Patent Judges*.

SQUIRE, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

Appellant<sup>2</sup> appeals from the Examiner's decision to finally reject claims 14–20, which are all of the claims pending in this application.

35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> In this Decision, we refer to the Specification filed May 16, 2012 (“Spec.”); Final Office Action dated Aug. 21, 2017 (“Final Act.”); Appeal Brief filed Mar. 22, 2018 (“Appeal Br.”); Examiner’s Answer dated Sept. 20, 2018 (“Ans.”); and Reply Brief filed Nov. 19, 2018 (“Reply Br.”).

<sup>2</sup> We use the word “Appellant” to refer to “Applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies GRAFCO2 S.R.L as the real party in interest. Appeal Br. 3.

*The Claimed Invention*

Appellant's disclosure relates to a mold made of a material that is said to be capable of adsorbing carbon dioxide, which is obtainable by isostatic compression of a mixture of a carbonious material selected from fossil carbon and/or graphite and a binder. Spec. 1, 2; Abstract. Claim 14 is illustrative of the subject matter on appeal and is reproduced below from the Claims Appendix to the Appeal Brief:

14. A mold made of a material able of adsorbing carbon dioxide ***obtained by cold isostatic compression independently of external energy sources of a mixture of anthracite and solid binder***, the solid binder consisting of disaccharide or glucose in powder form, wherein the weight ratio anthracite/binder is between 1:100 and 100:1.

Appeal Br. 16 (key disputed claim language italicized and bolded).

*The References*

The Examiner relies on the following prior art references as evidence in rejecting the claims on appeal:

Meissner et al. ("Meissner")	US 5,736,076	Apr. 7, 1998
Ryan et al. ("Ryan")	WO 02/25190 A1	Mar. 28, 2002

*The Rejections*

On appeal, the Examiner maintains (Ans. 3) the following rejections:

1. Claims 14–17 are rejected under 35 U.S.C. § 103(a) as obvious over Meissner ("Rejection 1"). Ans. 3; Final Act. 2.
2. Claims 18–20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Meissner in view of Ryan ("Rejection 2"). Ans. 5; Final Act. 4.

## OPINION

Having considered the respective positions advanced by the Examiner and Appellant in light of this appeal record, we affirm the Examiner's rejections based on the fact-finding and for the reasons set forth in the Answer to the Appeal Brief and Final Office Action, which we adopt as our own. We add the following for emphasis.

### *Rejection 1*

Appellant argues claims 14–17 as a group. We select claim 14 as representative and remaining claims 15–17 stand or fall with claim 14. 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner determines Meissner teaches or suggests a molding satisfying all of the limitations of claim 14 and concludes the reference would have rendered the claim obvious. Ans. 3–4. On the record before us, we find that a preponderance of the evidence and sound technical reasoning support the Examiner's analysis and determination that Meissner teaches or suggests a molding satisfying all of the limitations of claim 14, and conclusion that the reference would have rendered the claim obvious. Meissner, Abstract, 1:1–5, 1:11, 1:47–52, 1:63, 2:15–24.

Appellant argues the Examiner's rejection of claim 14 should be reversed because Meissner does not teach or suggest the “obtained by cold isostatic compression independently of external energy sources of a mixture of anthracite and solid binder” recitation of the claim. Appeal Br. 6; Reply Br. 2. Rather, Appellant contends Meissner “only provides for graphite mixtures subjected to heat treatment at from 300° to 800° C . . . in the absence of oxygen.” *Id.* at 2 (citing Meissner 1:47–53). Appellant also contends that because inventive Examples 2–5 of Meissner are all heat

treated at 500° C and Comparative Example 1 of Meissner, which is not heat treated, produces “negative results,” one of ordinary skill in the art would not have been led to the claimed invention, which does not include a heat treatment. *Id.* at 11.

We do not find Appellant’s argument persuasive of reversible error in the Examiner’s rejection because Meissner’s teachings are not limited to the disclosures in its examples or preferred embodiments. *See In re Mills*, 470 F.2d 649, 651 (CCPA 1972) (“[A] reference is not limited to the disclosure of specific working examples.”); *see also In re Susi*, 440 F.2d 442, 445-46 (CCPA 1971) (holding disclosure of a particular preferred embodiment does not teach away from a prior art reference’s broader disclosure).

As the Examiner finds (Ans. 3–4, 8) and contrary to what Appellant argues, Meissner teaches that the prior art material is “preferably subjected to a heat treatment” (Meissner, 1:51–52), which would reasonably suggest to one of ordinary skill that heat treatment is optional and the disclosed material may be obtained with or without the heat treatment. *See In re Preda*, 401 F.2d 825, 826 (CCPA 1968) (explaining a prior art reference’s disclosure must be considered for all that it teaches, including “the inferences which one skilled in the art would reasonably be expected to draw therefrom”).

Meissner’s disclosure is also not limited to graphite mixtures, as Appellant argues. Rather, as the Examiner finds (Ans. 3–4), Meissner teaches the use of various mixtures, including, for example, mixtures of anthracite and solid binders, as recited in the claim. *See Meissner* 1:9–13, 1:60–63.

Appellant further argues the Examiner's rejection should be reversed because the material Meissner discloses and the claimed material are not the same materials. Appeal Br. 6–7. Relying on the declaration of Piero Sozzani (“Sozzani Declaration”), Appellant contends that because Meissner describes material treated at temperatures above 300° C to 800° C, there are “substantial differences” in the carbonaceous nature of the material disclosed by Meissner. Appeal Br. 7. Appellant contends that, in contrast to the claimed material, the carbonaceous raw material described in Meissner is graphite. *Id.* at 8 (citing Sozzani Decl. ¶ 16). Appellant also contends the claimed material is “necessarily different” from the material disclosed in Meissner because the claimed material contains “intact sucrose, not subjected to coking in the absence of oxygen, a process which inevitably would degrade sucrose.” *Id.* at 11.

We do not find Appellant's arguments persuasive of reversible error in the Examiner's rejection based on the fact-finding and for the reasoning provided by the Examiner at pages 3–4 and 7–8 of the Answer. As previously discussed above, in addition to disclosing graphite mixtures, Meissner discloses the use of various other carbonaceous raw materials, including, anthracite. *See* Meissner 1:9–13, 1:60–63.

Moreover, we find a preponderance of the evidence supports the Examiner's determination that claim 14 is a product-by-process claim, and Appellant has not established, either by persuasive technical reasoning or evidence, that the claimed product is patentably distinct from Meissner's prior art product. “The patentability of a product does not depend on its method of production. If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable

even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 697 (Fed. Cir. 1985) (citations omitted); *see also In re Pilkington*, 411 F.2d 1345, 1348 (CCPA 1969) (“[The] patentability of a claim to a product does not rest merely on a difference in the method by which that product is made. Rather, it is the product itself which must be new and unobvious.”).

Thus, even if Meissner did not explicitly teach or suggest the method of practicing cold isostatic pressure independently of external energy sources, this fact, without more, is insufficient to outweigh the Examiner’s determination of unpatentability, where the claimed product is the same as or obvious from the product of the prior art. *Thorpe*, 777 F.2d at 697.

Appellant’s argument is also misplaced because it is premised on Appellant’s erroneous contentions that Meissner’s disclosure is limited to graphite mixtures subjected to heat treatment and that heat treatment of Meissner’s material is required. As previously discussed above, Meissner’s disclosure is not limited to heat treating the material. Meissner, 1:46–53 (disclosing that the material can be “preferably subjected to a heat treatment”).

Appellant’s contentions regarding the Sozzani Declaration also are not persuasive because the declaration is not commensurate in scope with Meissner’s teachings regarding the prior art product and thus, is not sufficient to establish that the claimed invention is patentably distinct from the prior art. For example, as the Examiner correctly points out (Ans. 7), the Sozzani Declaration does not compare the claimed material to Meissner’s prior art material, which has not been subjected to a heat treatment. *See*

Sozzani Decl. ¶ 17 (reporting results based on a “compound after the curing procedure”).

Appellant’s contention that “Meissner is silent about the capacity of absorbing carbon dioxide” and comments regarding the claimed material’s “heat transfer property” at page 12 of the Appeal Brief are equally unpersuasive because, as the Examiner finds (Ans. 8), they are based on limitations not recited in the claims. *See In re Van Geuns*, 988 F.2d 1181, 1184-85 (Fed. Cir. 1993) (“[L]imitations are not to be read into the claims from the specification.”).

Accordingly, we affirm the Examiner’s rejection of claims 14–17 under 35 U.S.C. § 103(a) as obvious over Meissner.

#### *Rejection 2*

The Examiner rejects claims 18–20 under 35 U.S.C. § 103(a) as obvious over the combination of Meissner and Ryan, which we refer to above as “Rejection 2.” Ans. 5–6. Appellant, however, does not present any new or additional substantive arguments for the patentability of claims 18–20 in response to the Examiner’s rejection. Instead, Appellant states “all the reasons discussed . . . above with regard to Meissner apply as well to the combination of Meissner in view of Ryan.” Appeal Br. 15; *see also* Reply Br. 4 (“Appellants respectfully submit that claims 18–20 are patentable over the combination of cited references for all of the reasons discussed with regard to claims 14–17.”).

Accordingly, based on the findings and technical reasoning provided by the Examiner and for principally the same reasons discussed above for affirming Rejection 1, we affirm Rejection 2.

CONCLUSION

In summary:

<b>Claim(s) Rejected</b>	<b>Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
14-17	§ 103(a) Meissner	14-17	
18-20	§ 103(a) Meissner, Ryan	18-20	
<b>Overall Outcome</b>		14-20	

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

AFFIRMED