

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(2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte CONRAD O. GARDNER

---

Appeal No. 1998-0842  
Application 08/536,350

---

ON BRIEF

---

Before CALVERT, COHEN and FRANKFORT, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 11, all the claims in the application.

The subject matter involved in this case concerns the removal of pollutants from the ambient air flowing past a moving motor vehicle, the ambient air being directed into a catalytic

Appeal No. 1998-0842  
Application No. 08/536,350

converter. The appealed claims, drawn to apparatus (claims 1 to 7, 10 and 11) and a method (claims 8 and 9), are reproduced in the appendix of appellant's brief.

The references applied in the final rejection are:

Colosimo	3,738,088	Jun. 12, 1973
Geiger	5,250,268	Oct. 5, 1993
Wells	5,509,853	Apr. 23, 1996
	(filed Jul. 11, 1994)	

An additional reference of record, applied herein pursuant to a rejection under 37 CFR § 1.196(b), is:

Olivo	5,285,640	Feb. 15, 1994
-------	-----------	---------------

Claims 1 to 11 stand finally rejected under 35 U.S.C. § 103 as unpatentable over Colosimo alone, or in view of Wells and Geiger. On page 3 of the final rejection (paper No. 7), the examiner states the basis of the rejection as:

Colosimo teaches using means attached to a car to clean ambient air. Colosimo also teaches that these means can be catalytic convertors (see column 6 line 40). Colosimo does not teach that the treating means be attached to the out side of the exhaust manifold or the use of flared scoop. It would have been obvious to a routineer in the art to attach the catalytic treating means of Colosimo to the exhaust manifold to take advantage of the heat source for the reaction and in the fact that Wells teaches attaching ambient filter means to the exhaust manifold (see figure 3, element 29) and that Geiger teaches that the temperature of the catalytic convertor should be regulated.

In col. 6, line 40 of Colosimo, to which the examiner

Appeal No. 1998-0842  
Application No. 08/536,350

refers, Colosimo discloses that the air filtering assembly 3 may include a "catalytic postfilter means" (singular) 150, which "may suitably be of the replaceable cartridge type" to clear the air of "nonparticulate pollution" such as carbon monoxide, etc. (col. 6, lines 40 to 48). This filter 150 is downstream from particulate filters 35, 37, in a housing 3 which is separate from engine 2. Colosimo does not disclose that catalytic filter 150 should be heated, and it is not clear to us that it necessarily constitutes a catalytic converter, as claimed. However, assuming that Colosimo's converter 150 may be termed a catalytic converter,<sup>1</sup> and that it would have been obvious to heat it, in view of Geiger (e.g., col. 1, lines 15 to 30), we do not agree with the examiner that it would have been obvious to obtain such heat by attaching it to the exhaust manifold, since there is no teaching or suggestion in Colosimo, Wells or Geiger of doing so. While Wells seemingly does disclose attaching a filter to the exhaust manifold (col. 5, line 35), this being but one point among numerous other locations on the vehicle, the Wells filter is not a catalytic converter, nor does it require heat for its

---

<sup>1</sup> Contrary to the examiner's statement, Colosimo does not disclose a plurality of catalytic converters.

Appeal No. 1998-0842  
Application No. 08/536,350

operation, but rather is a container 14 full of pellets 13, which entrap particulates from the ambient air passing through them. According to Wells, these containers can be attached around the engine and anywhere else on the vehicle where they will be exposed to flowing polluted ambient air; see, e.g., col. 3, line 61, to col. 4, line 2. It is not evident to us why Wells' disclosure would have made it obvious to one of ordinary skill to attach the Colosimo catalytic converter 150 to the exhaust manifold as a source of heat; rather, we view any such suggestion as being the result of improper hindsight, based on information gleaned from appellant's own disclosure.

The rejection of claims 1 to 11 therefore will not be sustained.

Rejection Pursuant to 37 CFR § 1.196(b)

Pursuant to 37 CFR § 1.196(b), claim 4 is rejected under 35 U.S.C. § 102(b) as anticipated by Olivo.

Claim 4 reads:

In combination in a motor vehicle:

an internal combustion engine;

a catalytic converter;

a flared scoop located beneath said motor vehicle for funneling ambient pollutants to said catalytic converter.

Appeal No. 1998-0842  
Application No. 08/536,350

Olivo discloses a catalytic converter/muffler for use in the exhaust system of a vehicle having an internal combustion engine (col. 4, lines 65 and 66), the device being mounted horizontally in a car or light-duty truck and having a flared scoop 40 which funnels ambient air (including pollutants) to the converter (col. 5, lines 44 to 53).

Remand to the Examiner

Claims 1 to 11 include eight independent claims of varying scope. Notwithstanding this, the examiner has treated all the claims together, even though they do not all require a catalytic converter surrounding the exhaust manifold, and may be amenable to rejection on other references of record; see, for example, our rejection of claim 4, supra.

Accordingly, this application is remanded to the examiner to consider the limitations of each claim separately, and determine whether or not each claim should be rejected as unpatentable over prior art of record, and/or other prior art. In perusing the prior art of record, we note that:

(1) Stevenson, Shimozi et al., Smith et al., Tadokoro et al. and Olivo disclose introducing ambient air into a catalytic converter, and may be pertinent to claims such as claims 5 to 8;

Appeal No. 1998-0842  
Application No. 08/536,350

and

(2) Muraki et al. disclose dual catalytic converters, which may be pertinent to a claim such as claim 10.

In addition, Cornelison et al. Pat. No. 5,170,624, cited by appellant at page 4, lines 5 and 22, discloses electrically heating a catalytic converter, and an exhaust system with two catalytic converters (Fig. 13).

The examiner should also consider whether claim 9 should be rejected under 35 U.S.C. § 112, first paragraph, as being based on a nonenabling disclosure (cf. specification page 6, lines 9 to 12).

#### Conclusion

- (a) The examiner's decision to reject claims 1 to 11 is reversed.
- (b) Claim 4 is rejected pursuant to 37 CFR § 1.196(b).
- (c) The application is remanded to the examiner.

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. and Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN

Appeal No. 1998-0842  
Application No. 08/536,350

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. . . .

Appeal No. 1998-0842  
Application No. 08/536,350

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

REVERSED, 37 CFR § 1.196(b) and REMANDED

IAN A. CALVERT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	

IAC:lmb

Appeal No. 1998-0842  
Application No. 08/536,350

CONRAD O. GARDNER  
121 VINE STREET  
UNIT 2202  
SEATTLE, WA 98121