

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARCO SUCCI and CAROLINA SOLCIA

Appeal No. 1998-2002
Application 08/690,016

ON BRIEF

Before GARRIS, HANLON and TIMM, Administrative Patent Judges.
HANLON, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the final rejection of claims 33-40 and 42-57, all of the claims pending in the application.¹ The claims on appeal are

¹ Claims 41 and 58 were also finally rejected. However, those claims were canceled in an Amendment under 37 CFR § 1.116(a). Paper No. 22. That amendment was entered by the examiner. See Paper No. 23 ("Upon the filing of an appeal, the proposed amendment will be entered."). Therefore, the

directed

to an apparatus for removing gaseous impurities from a hydrogen gas stream. Claim 33 is illustrative and reads as follows:

33. An apparatus for the removal of gaseous impurities from an impure hydrogen gas stream contaminated with carbon monoxide, and with one or more additional impurities selected from the group consisting of carbon dioxide, oxygen, nitrogen, water, methane, and mixtures thereof, to produce thereby a purified gas stream; said apparatus comprising:

A. a first reaction zone containing elemental nickel and nickel-carbonyl supported on a carrier selected from the group consisting of silicate, titanium silicate and silica;

B. means for maintaining said first reaction zone under nickel-carbonyl forming conditions to convert thereby substantially all the carbon monoxide to nickel carbonyl, thereby producing an effluent stream from the first reaction zone which effluent stream is a partially purified hydrogen gas stream;

C. a second reaction zone containing Ti_2Ni ;

D. means for conveying the partially purified hydrogen gas stream from the first reaction zone to the second reaction zone; and

E. means for maintaining the second reaction zone under methane reacting conditions to produce a purified hydrogen gas stream.

patentability of claims 41 and 58 is not an issue in this appeal.

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The references relied upon by the examiner are:

Tanaka et al.	4,075,312	Feb. 21, 1978
Reilly et al. (Reilly)	4,769,225	Sept. 6, 1988
Tamhankar 1987 (European Patent Document)	0 240 270	Oct. 7,

The following rejections are at issue in this appeal:

(1) Claims 33-40 and 42-57 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

(2) Claims 42-49 are rejected under 35 U.S.C. § 103 as being unpatentable over Reilly in view of Tanaka.

(3) Claims 33-40 and 50-57 are rejected under 35 U.S.C. § 103 as being unpatentable over Reilly in view of Tanaka and further in view of EP '270.

(4) Claims 33-40 and 42-57 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of U.S. Patent No. 5,492,682.

The rejections

A. Double patenting rejection

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According to the examiner, the obviousness-type double patenting rejection is based on the following (Answer, p. 4):

The instant claims [(claims 33-40 and 42-57)] are broader than the claims recited in Patent 5,492,682, since they merely recite the corresponding "means" for carrying out the process recited in the claims of Patent 5,492,682.

Manifestly, claims 33-40 and 42-57 recite structural limitations in "means-plus-function" format which do not appear in the process claims of U.S. Patent No. 5,492,682. Therefore, it is unclear how the various "means" recited in claims 33-40 and 42-57 render those claims "broader" than the process claims of U.S. Patent No. 5,492,682.

Furthermore, the examiner has failed to interpret claims 33-40 and 42-57 in accordance with 35 U.S.C. § 112, sixth paragraph, and explain why the apparatus defined by claims 33-40 and 42-57 would have been obvious in view of the process claimed in U.S. Patent No. 5,492,682 which does not recite the claimed "means." See Reply brief. Therefore, for the sole reason that the examiner failed to set forth a prima facie case of unpatentability, the rejection of claims 33-40 and 42-57 under the judicially created doctrine of obviousness-type double patenting is reversed.

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The dissent points out that appellants did not respond to the obviousness-type double patenting rejection in the brief but rather responded to the rejection for the first time in the reply brief. The dissent would remand this application to the examiner for the purpose of supplementing the record with a response to the arguments presented in the reply brief. Although the majority does not condone the fact that appellants responded to the rejection for the first time in the reply brief, the majority disagrees that a remand is proper in this case.

First, the examiner bears the initial burden of presenting a prima facie case of unpatentability regardless of any arguments advanced by appellant. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) (the examiner bears the initial burden of presenting a prima facie case of unpatentability). Second, the very fact that the examiner entered the reply brief appears to suggest that no response was deemed necessary. See MPEP § 1208.03 (7th ed., July 1998) ("The acknowledgment of receipt and entry of a reply brief under 37 CFR 1.193(b)(1) is an indication by the

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examiner that no further response by the examiner is deemed necessary."). According to MPEP § 1208.03 (7th ed., July 1998), if a response is deemed necessary, the examiner is to reopen prosecution. Finally, unlike the dissent, the majority is of the opinion that a remand would not cure the deficiencies of the examiner's rejection. Therefore, a reversal of the obviousness-type double patenting rejection is considered proper at this time.

B. Rejection under 35 U.S.C. § 112, second paragraph

Claims 33-40 and 42-57 are rejected under 35 U.S.C. § 112, second paragraph, for improperly reciting a method limitation. According to the examiner (Answer, pp. 4-5):

The recitation of "nickel-carbonyl supported on a carrier" is tantamount to a method limitation in an apparatus claim, in that nickel-carbonyl would not be formed until and unless the impure hydrogen gas stream contaminated with carbon monoxide is contacted with the elemental nickel in the first reaction zone. It is well-settled that method limitations are improper in apparatus claims. In re Peters, 1923 C.D. 291.

As pointed out by appellants, In re Peters, 1923 C.D. 291, involved a rejection under 35 U.S.C. § 102, not 35 U.S.C. § 112,

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second paragraph. See Brief, p. 3. Nevertheless, in contrast to Peters, appellants explain (Brief, p. 4):

Appellants are claiming a structure which is formed when their apparatus is in use and some of the elemental nickel in the first reaction zone reacts with an impure gas stream and forms nickel carbonyl. In other words, Appellants are claiming the actual structure of their apparatus as it is used during the purification of gases. The Peters case stands for the proposition that a structure which is shown in the prior art is not rendered patentable by the recitation of process features specifying the manner in which the structure is used. Accordingly, the Peters case does not compel the conclusion that claims defining a structure which is formed when an apparatus is in use, such as the claims in the subject application, are inherently indefinite.

Consistent with appellants' arguments and the specification, one of ordinary skill in the art would have understood claims 33-40 and 42-57 to be directed to an apparatus wherein a reaction between some amount of nickel and carbon monoxide has already occurred in a first reaction zone to form some amount of nickel carbonyl. See Miles Labs., Inc. v. Shandon Inc., 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993), cert. denied, 510 U.S. 1100 (1994) (the test for definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification). This interpretation appears to render the

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issues raised in the rejection under 35 U.S.C.

§ 112, second paragraph, moot. See Answer, pp. 7-9 ("nickel carbonyl would not be formed until and unless the impure hydrogen gas stream contaminated with carbon monoxide is contacted with the elemental nickel in the first reaction zone").

For the reasons set forth above, the rejection of claims 33-40 and 42-57 under 35 U.S.C. § 112, second paragraph, is reversed.

C. Rejections under 35 U.S.C. § 103

The rejections under 35 U.S.C. § 103 are based on (1) a combination of Reilly and Tanaka and (2) a combination of Reilly, Tanaka and EP '270. Reilly, Tanaka and EP '270 are directed to processes which absorb hydrogen for different purposes. According to the examiner, Reilly suggests that any transition metal is suitable for absorbing hydrogen, and Tanaka discloses that alloys of titanium and nickel are useful for absorbing hydrogen. Furthermore, EP '270 discloses that elemental nickel is useful for purifying an inert gas, such as nitrogen or argon. See Answer, pp. 5-7. However, as pointed out by appellants, neither Reilly, Tanaka nor EP '270 disclose

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"a first reaction zone containing elemental nickel and nickel-carbonyl" as claimed. The examiner appears to recognize as much. See Answer, pp. 5-7.

Therefore, the rejection of claims 33-40 and 42-57 under 35 U.S.C. § 103 is reversed.

REVERSED

ADRIENE LEPIANE HANLON)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
CATHERINE TIMM))
Administrative Patent Judge)	

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GARRIS, Administrative Patent Judge, Concurring-in-part,
Dissenting-in-part

I concur with the majority's reversal of the examiner's section 112 and section 103 rejections, but dissent with respect to the majority's reversal of the examiner's obviousness-type double patenting rejection. The reversal of this last mentioned rejection is inappropriate for a number of reasons.

The majority's reasons for reversing the double patenting rejection amount to little more than an unacknowledged reiteration of arguments advanced by the appellants in their Reply Brief. These are the first and only arguments presented by the appellants in opposition to the double patenting rejection in the record of this application file. Although the examiner has consistently made this rejection since the first office action, no arguments thereagainst were made by the appellants in the amendment filed April 14, 1997 responding to the first office action or in the amendment filed August 8, 1997 responding the final office action or in the Brief filed February 12, 1998 in pursuit of this appeal.

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Thus, it is only in the Reply Brief that the appellants have ever offered any reasons for contesting the rejection under consideration. Significantly, the examiner has not provided the application file record with a rebuttal to the aforementioned arguments but instead has simply entered the Reply Brief without comment regarding these arguments.

Under these circumstances, it is clear that the record of this appeal is not in condition for an informed and meaningful appellate review concerning the double patenting issue raised by the examiner. In practical effect, a majority's decision to reverse the double patenting rejection is based on an appeal record which contains a Brief but no Answer.

Manifestly, this application should be remanded to the examiner so that he can provide the record with a response to the double patenting arguments made for the first and only time in the Reply Brief. For unknown reasons, the majority has unwisely chosen to resolve the double patenting issue raised by the examiner based on the inchoate record of this appeal.

Compounding this lack of wisdom is the majority's decision to reverse the examiner's obviousness-type double

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patenting rejection. Nothing in the appellants' Reply Brief or the majority's reiteration thereof vitiates the merit in the examiner's point that the appealed claims merely recite the corresponding apparatus or "means" for carrying out the process recited in the claims of Patent No. 5,492,682. The process claimed in this patent can be practiced only by way of suitable apparatus, namely, apparatus of the type defined by the claims here on appeal. By contending that the claimed process of the patent would not have rendered the here claimed apparatus obvious to an artisan with ordinary skill, the majority and the appellants implicitly cast a degree of doubt on whether the artisan would be able to practice the process defined by the patent claims.

The very general arguments presented in the Reply Brief and reiterated in the majority opinion do not support a conclusion of nonobviousness with respect to the here claimed apparatus and do not justify doubting enablement with respect to the process claims of the patent. On the other hand, the legal presumption that an artisan processes skill rather than stupidity (In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985)) supports a conclusion that the claimed

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process of the patent would have suggested an apparatus having the reaction zones, conduits and valves necessary for practicing this process in accordance with the argued claims on appeal. Thus, the inchoate record of this appeal, on balance, weighs most heavily in favor of a conclusion of obviousness rather than nonobviousness.

In summary, the majority should have remanded this application to the examiner prior to deciding the double patenting issue advanced on this appeal, or having failed to take such action, should have affirmed the examiner's obviousness-type double patenting rejection.

PATENT	BRADLEY R. GARRIS)	BOARD OF
	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES

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