

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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte G. DELANE MARLOWE

Appeal No. 1998-2645
Application No. 08/815,747

ON BRIEF

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

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection (Paper No. 6, mailed December 19, 1997) of claims 1 and 3 to 10, which are all of the claims pending in this application.¹

¹ Claims 1 and 3 were amended subsequent to the final rejection.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a wet gas stripper which utilizes a liquid spray for separating entrained particulate matter from a moving gas stream (specification, p. 1). A copy of claim 1 under appeal appears in the appendix to the appellant's reply brief (Paper No. 16, filed July 20, 1998). A copy of claims 3 to 10 under appeal is set forth in the appendix to the appellant's brief (Paper No. 14, filed April 9, 1998).

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Clark	2,802,543	Aug. 13,
1957		

Claims 1 and 3 to 10 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 1 and 3 to 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Clark.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 15, mailed July 2, 1998) for the examiner's complete reasoning in support of the rejections, and to the brief and reply brief for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The indefinite rejection

We sustain the rejection of claims 5 to 9 under 35 U.S.C.

§ 112, second paragraph, but not the rejection of claims 1, 3, 4 and 10.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

In the final rejection (pp. 3-4) and in the answer (p. 3), the examiner set forth his rationale as to why claims 1 and 3 to 10 were considered to be indefinite.

The appellant's response to this rejection was an argument as to why the term "high velocity" as recited in claims 1 and 4 was not indefinite since the meaning thereof would be understood by one skilled in the art from a reading of the claim as a whole. Since we find ourselves in agreement with the appellant on this issue, we reverse the decision of the examiner to reject claims 1, 3, 4 and 10 under 35 U.S.C. § 112, second paragraph. The appellant has not specifically

contested the specific objections to claims 5 to 9 in the brief or reply brief.² Accordingly, we summarily sustain the rejection of claims 5 to 9 under 35 U.S.C. § 112, second paragraph.

The obviousness rejection

We will not sustain the rejection of claims 1 and 3 to 10 under 35 U.S.C. § 103.

The appellant argues that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims under appeal require a liquid stream to be projected with a velocity causing it to collide with an opposing side wall with sufficient force to generate negative ions and thereby create an electrostatically-charged mist which acts to capture particulate matter in a gas stream. However, this limitation is not taught or suggested by Clark

² Attached to the reply brief is a Corrected Appendix which the appellant states (p. 1) corrects minor errors in claims 5, 6, 7 and 9. No amendment proposing these changes is of record in the filewrapper.

for the reasons set forth in the brief (pp. 7-10) and the reply brief (pp. 2-6). Clark teaches (column 4, lines 39-62) discharging a pressurized liquid stream from nozzles 66 toward an opposing sidewall in flaring streams so as to meet at the center as depicted in Figure 2. According, Clark does not teach or suggest projecting a liquid stream with a velocity causing it to collide with an opposing side wall with sufficient force to generate negative ions and thereby create an electrostatically-charged mist. To supply these omissions in the teachings of Clark, the examiner made determinations (answer, p. 4) that this difference would have been obvious to an artisan. However, this determination has not been

supported by any **evidence**³ that would have led an artisan to arrive at the claimed invention.

In our view, the only suggestion for modifying Clark in the manner proposed by the examiner to meet the above-noted limitation stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553,

³ Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998), cert. denied, 119 S. Ct. 1804 (1999). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claims 1 and 3 to 10.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 and 3 to 10 under 35 U.S.C. § 112, second paragraph, is affirmed with respect to claims 5 to 9 and reversed with respect to claims 1, 3, 4 and 10 and the decision of the examiner to reject claims 1 and 3 to 10 under 35 U.S.C. § 103 is reversed.

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

AFFIRMED-IN-PART

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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JEFFREY V. NASE)	APPEALS
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