

The opinion in support of the decision being entered today was **not** written for publication in a law journal and 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 MISAK DZHRAGATSPANYAN
and
WILLIAM A. GREENE

Appeal No. 1998-3015
Application No. 08/790,373

ON BRIEF

Before STAAB, NASE, and GONZALES, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 4 to 11, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a liquid mixture separation system. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Conley et al. 1975 (Conley)	3,878,094	Apr. 15,
Sakai 1986	4,591,441	May 27,

Claim 6 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Sakai.

Claims 1, 4 and 8 to 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Conley.

Claims 5 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sakai in view of Conley.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 11, mailed April 1, 1998) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 10, filed March 9, 1998) and reply brief (Paper No. 12, filed May 4, 1998) for the appellants' arguments thereagainst.

OPINION

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

Claim 6

We will not sustain the rejection of claim 6 under 35 U.S.C. § 102(b) as being anticipated by Sakai.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

The appellants argue (brief, pp. 7-8) that the arrangement of chamber ports as set forth in claim 6 which minimizes the amount of unfiltered liquid passed out during a flow reversal is not taught by Sakai. We agree. Claim 6 includes the limitation that the chamber walls form first and second chamber ports that "open respectively to said first and

second tubular ends at the inside of the tubular screen." The two chamber ports of Sakai that open at the inside of his tubular screen are the ports at the outlet of tube 27a and the inlet to tube 29b. However, these two ports are open to the same tubular end of the tubular screen, not first and second tubular ends of the tubular screen as set forth in claim 6. Thus, all the imitations of claim 6 are not found in Sakai.

Since all the limitations of claim 6 are not found in Sakai for the reasons set forth above, the decision of the examiner to reject claim 6 under 35 U.S.C. § 102(b) is reversed.

Claims 1, 4 and 8-11

We will not sustain the rejection of claims 1, 4 and 8 to 11 under 35 U.S.C. § 103 as being unpatentable over Conley.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of

obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The examiner determined (answer, p. 3) that Conley discloses a coalescer substantially as claimed and that while Conley does not disclose flow velocity, the claimed flow velocity would have been an obvious matter of process optimization for one skilled in the art.

The appellants argue (brief, pp. 5, 8 and 9) that Conley does not describe a screen formed of woven threads as recited in claims 1 and 4 or a woven screen as recited in claims 8 to 11. We agree. Thus, even if the examiner were correct that the claimed flow velocity would have been an obvious matter of process optimization for one skilled in the art such a modification of Conley would not have arrived at the claimed invention. We note that the examiner's belief (answer, pp. 3-

4) that Conley's pleated sheet "may obviously be of woven or non-woven fibers" was not part of the rejection before us in this appeal. Moreover, we consider this statement to be a finding of fact unsupported by the record and therefore speculative. Such an unsupported, speculative finding does not take the place of evidence and therefore is not well taken.

For the reasons set forth above, the decision of the examiner to reject claims 1, 4 and 8 to 11 under 35 U.S.C. § 103 is reversed.

Claims 5 and 7

We will not sustain the rejection of claims 5 and 7 under 35 U.S.C. § 103 as being unpatentable over Sakai in view of Conley.

Claim 7 depends from independent claim 6. We have reviewed the Conley reference additionally applied in the rejection of claim 7 but find nothing therein which makes up for the deficiencies of Sakai discussed above regarding claim

6. Accordingly, we cannot sustain the examiner's rejection of appealed claim 7 under 35 U.S.C. § 103.

Claim 5 depends from independent claim 1. Claim 5 includes the limitation that the chamber walls form first and second chamber ports that "open respectively to said first and second tubular screen ends at the inside of the tubular screen." For the reasons set forth above with respect to claims 6 and 7, this limitation is not suggested by the applied prior art. Accordingly, we cannot sustain the examiner's rejection of appealed claim 5 under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claim 6 under 35 U.S.C. § 102(b) is reversed and the decision of the examiner to reject claims 1, 4, 5 and 7 to 11 under 35 U.S.C. § 103 is reversed.

REVERSED

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
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JOHN F. GONZALES)	
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