

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte MARTIN KORNBERGER

Appeal No. 2005-2168
Application No. 10/122,616

HEARD: DECEMBER 14, 2005

Before PATE, McQUADE, and CRAWFORD, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 12, 25 and 27 which are all of the claims pending in this application. Claims 13 to 24, 26 and 28 have been canceled.

The appellant's invention relates to fume exhaust system for cooking fumes, containing a filtering device with at least one filter in the exhaust path with a catalyst material (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

THE PRIOR ART

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

Izumo (JP' 137)	06-91137A	April 5, 1994
Kimura (JP'575)	10-328575A	Dec. 15, 1998

THE REJECTIONS

Claims 1 to 4, 6, 8, 11, 12, 25, and 27 stand rejected under 35 U.S.C. § 102 as being anticipated by JP'575.

Claims 5, 7, 9 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over JP'575 in view of JP'137.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed September 1, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed June 22, 2004) and reply brief (filed November 16, 2004) 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.

We turn first to the examiner's rejection of claims 1 to 4, 6, 8, 11, 12, 25 and 27 as being anticipated by JP'575. We initially note that 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."

In support of this anticipation rejection, the examiner finds:

Japanese '575 shows and discloses an exhaust hood (1,2) having deodorizing and sterilizing effect on air flow (1,2), including a pre-filter (3), an ionizing electrode (4) and ultraviolet lamp (5) located upstream of a photo catalytic reactive filter (6) and fan (7). [Answer at page 4].

Appellant argues that JP'575 does not describe an interaction between the ionization electrode and the stream itself.

It is true that JP'575 does not expressly disclose that the air stream is ionized. However, a prior art reference need not expressly disclose each claimed element in order to anticipate the claimed invention. See Tyler Refrigeration v. Kysor Indus. Corp., 777 F.2d 687, 689, 227 USPQ 845, 846-847 (Fed. Cir. 1985). Rather, if a claimed element (or elements) is inherent in a prior art reference, then that element (or elements) is disclosed for purposes of finding anticipation. See Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d at 631-33, 2 USPQ2d at 1052-54.

It is well settled that the burden of establishing a prima facie case of anticipation resides with the Patent and Trademark Office (PTO). See In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). When relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. See Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991); Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Patent App. & Int. 1990).

After the PTO establishes a prima facie case of anticipation based on inherency, the burden shifts to the appellant to prove that the subject matter shown to be in the prior art does not possess the characteristics of the claimed invention. See In re

Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986).

JP'575 discloses an ionization electrode 4 which creates a corona discharge when a DC current is applied. This corona discharge charges the suspended particles (0012). It is reasonable to find that this corona discharge is caused by the ionization of the air stream by ionization electrode 4 and that it is these ions which charge the suspended particles. As such, we are of the opinion that the examiner has a reasonable basis for finding that ionization of the stream in JP'575 does occur even though it is not expressly disclosed.

Therefore, the burden has shifted to the appellant to prove that ionization of the stream does not occur in the JP'575. This the appellant has not done.

In view of the foregoing, we will sustain the examiner's rejection of claim 1. We will likewise sustain the examiner's rejection of claims 2-4, 6, 8, 11, 25 and 27 as these claims stand or fall with claim 1 (brief at page 9).

In regard to claim 12, the examiner finds that the catalytic reactive filter (6) includes a titanium dioxide reaction coating on an activated carbon filter that would be inherently desorbable by heating at a temperature in the range between 120 and 180 degrees (answer at page 4). The examiner directs our attention to the patent Dougherty, US Patent No. 5,912,423 which teaches that activated carbon is disorbable when heated. In our view, the examiner has a reasonable basis for finding that the

carbon filter of JP '575 is inherently disorbable when heated to a temperature in the range between 120 and 180 degrees.

As such, the burden has shifted to the appellant to prove that the carbon fiter of JP '575 is not disorbable when heated to a temperature in the range between 120 and 180 degrees. The appellant has not come forward with any evidence to satisfy this burden. In fact, appellant does not challenge the finding of the examiner that JP'575 is inherently desorbable when heated but rather argue that even though the property may be inherent, this does not mean that the property was known or harnessable by anyone in the prior art.

This argument is not persuasive because there is no requirement that the inherent feature in the prior art references be known to establish a prima facie case of anticipation.

In view of the foregoing, we will sustain the examiner's rejection of claim 12.

We turn next to the examiner 's rejection of claims 5, 7, 9, 10 under 35 U.S.C. § 103 as being unpatentable over JP'575 in view of JP'137. Recognizing that JP'575 does not describe a honeycomb structure, as recited in claim 5, the examiner relies on JP'137 for teaching a honeycomb catalyst structure including a ceramic support, titanium oxide and a zeolite. The examiner concludes:

. . . it would have been obvious to a person having ordinary skill in the art to substitute a honeycomb catalyst structure including a ceramic support and a zeolite for the carbon fiber support of Japanese '575, in view of the teaching of Japanese '117 [sic] [Answer at page 5].

Appellant argues that JP'137 does not describe ionizing the gas stream. We do not find this argument persuasive because it is directed to JP'137 on an individual basis.

Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. See In re Merck & Co. Inc., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986). In this regard, JP'137 is not being relied on for teaching ionization of the stream, rather JP'575 is relied on for teaching this feature. As we stated above, JP'575 does describe ionizing the stream.

In view of the foregoing, we will sustain the examiner's rejection of claim 5. We will likewise sustain the rejection of claims 7, 9, 10.

The decision of the examiner is affirmed.

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

AFFIRMED

WILLIAM F. PATE, III)
Administrative Patent Judge)
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JOHN P. McQUADE) BOARD OF PATENT
Administrative Patent Judge) APPEALS
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