

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 WAYNE KELLY and DENNIS CHILCOTE

Appeal 2006-1164
Application 10/139,185
Technology Center 1700

Decided: August 30, 2006

Before GARRIS, WALTZ, and KRATZ, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1-5, 10, 13-16, 24, 25, 32 and 46.

We AFFIRM-IN-PART.

The subject matter on appeal relates to a method of minimizing particle generation during handling of ultra pure liquids and to a system for handling ultra pure liquids which reduces particle generation. This appealed subject matter is adequately illustrated by independent claims 1, 32, and 46 which read as follows:

Appeal No. 2006-1164
Application No. 10/139,185

1. A method of minimizing particle generation during handling of ultra pure liquids, the method comprising:

introducing a liquid into a container; and

controlling an air-liquid interface to minimize an amount of particles generated in the liquid.
32. A system for handling ultra pure liquids, which reduces particle generation in the liquid, the system comprising:

means for transferring a liquid having an initial particle concentration, from a first location to a second location;

means for controlling an air-liquid interface during transfer of the liquid so that a final particle concentration of the liquid is not substantially greater than the initial particle concentration.
46. A method of minimizing particle generation in ultra pure liquids during handling thereof, the method comprising:

providing a liquid;

introducing the liquid to a predetermined location; and

controlling an air-liquid interface to control particle level in the liquid.

The references set forth below are relied upon by the Examiner in the Section 102 and Section 103 rejections before us:

Appeal No. 2006-1164
Application No. 10/139,185

Stahlecker	US 5,791,385	Aug. 11, 1998
Mekata	US 6,345,739	Feb. 12, 2002

Claims 1, 10, 14-16, 32 and 46 are rejected under 35 U.S.C. § 102(b) as being anticipated by Stahlecker.

Claims 2 and 25 are rejected under 35 U.S.C. § 103(a) as being obvious over Stahlecker.

Finally, all of the appealed claims are rejected under 35 U.S.C. § 103(a) as being obvious over Mekata.

We refer to the Brief and Reply Brief and to the Answer for a complete exposition of the opposing viewpoints expressed by the Appellants and by the Examiner concerning the above noted rejections.

OPINION

For the reasons set forth below, we sustain the rejections of claim 32 but not the rejections of the other claims on appeal.

As correctly indicated by the Examiner in the Answer and not disputed by the Appellants in the Brief or Reply Brief, the system defined by independent claim 32 is not structurally distinguished by the intended use and functional statements which are recited in the claim. Stated otherwise, such statements do not make a claim to an old product or system patentable. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Similarly, the Examiner has properly determined that the systems of Stahlecker and Mekata structurally correspond to the claim 32 system (e.g., compare Stahlecker's Figure 8 disclosure with Appellants' Figure 2 disclosure and Mekata's Figure 6 disclosure

Appeal No. 2006-1164
Application No. 10/139,185

with Appellants' Figure 3 disclosure), and again the Appellants do not argue otherwise with any reasonable specificity.

These circumstances establish a prima facie case of unpatentability, which the Appellants have failed to overcome on the record before us, based on the theory that the respective systems of Stahlecker and Mekata necessarily and inherently possess the functional capability defined by the claim under review. *Id.* In this regard, we emphasize that, under these circumstances, it is the Appellants' burden to prove that the Stahlecker and Mekata systems do not necessarily or inherently possess the aforementioned capabilities and that the burden of proof is the same whether the rejection is under Section 102 or Section 103. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977).

We hereby sustain, therefore, the Section 102 rejection of claim 32 over Stahlecker and the Section 103 rejection of claim 32 over Mekata.

All of the other independent and dependent claims on appeal are directed to a method of minimizing particle generation during handling of ultra pure liquids. According to the Examiner, this claimed method "would be inherent during the normal use and operation of the Stahlecker system" (Answer 4) and "would be inherent during the normal use and operation of the Mekata system (Answer 5). However, neither of these applied references contains any express or inherent disclosure of handling liquids which are ultra pure or of minimizing particle generation during the handling of such liquids.

In this latter regard, the Examiner argues that Stahlecker's method of minimizing the generation of foam, that is, bubbles of gas and liquid, satisfies the Appellants' claim requirement of minimizing particle generation. More

Appeal No. 2006-1164
Application No. 10/139,185

specifically, the Examiner considers the foam or bubbles in patentee's method to read on the particles in the here claimed method. We agree with the Appellants' position, however, that the claim term "particle" must be read in the context of their specification (*Phillips v. AWH Corp.*, 415 F.3d 1303, 1313, 75 USPQ2d 1321, 1326 (Fed. Cir. 2005)) and that, when so read, the here claimed "particle" in an ultra pure liquid would be interpreted by an artisan as a solid in liquid rather than gas bubbles in liquid.

In any event, as previously noted, neither *Stahlecker* nor *Mekata* contains any express or inherent teaching or suggestion of handling ultra pure liquids. The Examiner's opposing viewpoint is not supported by evidence or technical reasoning of any kind.

In light of the foregoing, it is our determination that the Examiner has failed to establish a prima facie case of unpatentability under Section 102 and under Section 103 with respect to the method claims on appeal. Therefore, we hereby reverse: The Section 102 rejection based on *Stahlecker* of method claims 1, 10, 14-16 and 46; the Section 103 rejection based on *Stahlecker* of method claims 2 and 25; and the Section 103 rejection based on *Mekata* of method claims 1-5, 10, 13-16, 24, 25 and 46.

Appeal No. 2006-1164
Application No. 10/139,185

The decision of the Examiner is affirmed-in-part.

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

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