The opinion in support of the decision being entered today
is *not* binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DIETMAR NUSSBAUMER
and WOLFGANG DEMMER

Appeal 2007-3196
Application 10/461,774
Technology Center 1700

Decided: September 27, 2007

Before EDWARD C. KIMLIN, CHARLES F. WARREN, and
CATHERINE Q. TIMM, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicants appeal to the Board from the decision of the Primary Examiner finally rejecting claims 1 through 25 in the Office Action mailed May 4, 2006. 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2006).

We affirm the decision of the Primary Examiner.

Claim 1 illustrates Appellants' invention of a process for the adsorption separation of substances in liquid media, and is representative of the claims on appeal:

1. A process for the adsorption separation of substances in liquid media, comprising the steps:

(a) providing an adsorber having a flat absorbent (5) which is disposed fixed in position in housing (3) and has at least one adsorbing surface which is designed for binding an adsorbate, the housing (3) having at least one intake (1) and only one outlet (2) for liquid medium,

(b) equilibrating the adsorbent (5) with a liquid medium and

(c) contacting the flat adsorbent (5) in the housing (3) with the liquid medium which comprises at least one adsorbate by applying a pressure difference between intake (1) and outlet (2), the at least one adsorbate-containing medium flowing only tangentially over the entire outer adsorbing surface of the adsorbent (5).

The Examiner relies on the evidence in this reference:

Nussbaumer	US 6,294,090 B1	Sep. 25, 2001

Appellants request review of the grounds of rejection advanced on appeal (Br. 4): claims 1 through 25 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement (Answer 5); and claims 1 through 14, 16, and 18 through 25 under 35 U.S.C. § 102(e) as anticipated by Nussbaumer (*id.* 7).

Appellants argue the claims in each ground of rejection as a group (Br. in entirety). Thus, we decide this appeal based on claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2006).

The issues in this appeal are whether the Examiner has carried the burden of establishing a prima facie case in each of the grounds of rejection advanced on appeal.

The language of claim 1 at issue with respect to each of the grounds of rejection is "housing (3) having . . . only one outlet (2)" and "the at least one adsorbate-containing medium flowing only tangentially over the entire outer adsorbing surface of the adsorbent (5)." We interpret this language to mean that housing 3 has only the single outlet 12, and that the adsorbate-containing medium must flow tangentially over the adsorbing surface of flat adsorbent 5 and not in any other direction with respect to that surface, that is, into or through the adsorbing surface of flat adsorbent 5.

Considering first the ground of rejection of claim 1 under § 112, first paragraph, written description requirement, we agree with Appellants that the disclosure in the written description in the Specification with respect to Examples 1-4 and Figs. 6-8 establishes that Appellants were in possession of a process employing an apparatus providing tangential flow in a housing having a single outlet. Specification 22:¶¶ 0063-0065, 24:¶0076, and Figs. 6-8; Br. 4-5; Reply Br. 4. We find this disclosure sufficient to establish that Appellants were in possession of the claimed adsorber "housing (3) having . . . only one outlet (2)" as encompassed by claim 1 at the time the Application was filed, *see, e.g., In re Alton*, 76 F.3d 1168, at 1175-76, 37 USPQ2d at 1581, 1583-584 (Fed. Cir. 1996) (citing *In re Wertheim*, 541 F.2d 257, 262-64, 191 USPQ 90, 96-97 (CCPA 1976)), even though, as the Examiner contends, the Specification discloses such language as an adsorber housing having "at least one outlet." Answer 5-6 and 10; Specification 4:¶0010. In this respect, Appellants can amend the originally claimed invention to avoid prior art or for other purposes where there is adequate written description in the specification establishing that Appellants

were in possession of the invention to which they retreat at the time the Application was filed, even if Appellants thus claim less than that which is disclosed in their specification. *See, e.g., In re Johnson*, 558 F.2d 1008, 1017-19, 194 USPQ 187, 195-96 (CCPA 1977); *Wertheim*, 541 F.2d at 262-64, 191 USPQ at 96-97.

The limitation specifying "flowing only tangentially" is a different matter. We agree with the Examiner that the disclosure in the Specification only describes medium flow "between the adsorbent layers [of a flat absorbent] through which [the] flow can pass tangentially" and "particle-containing fluid is passed along tangentially to the membrane," and not that the adsorbate containing medium flows "only tangentially" along the adsorbing surface as claimed. Specification 17:¶0048 and 20:¶¶0055-0056; Answer 5 and 10. As the Examiner points out, other disclosures in the Specification describe flat adsorbent materials and processing conditions which result in adsorbate-containing medium flow into or through the adsorbing surface of the flat adsorbent material. See Answer 6 and 10-11, and citations to the Specification therein. We are not convinced otherwise by Appellants' contentions with respect to the flat adsorbent material used in Examples 1-4 because Appellants do not establish that such material restricts flow to "only tangentially." Br. 5; Reply Br. 4-5.

Accordingly, we determine the Examiner has established that prima facie, as a matter of fact, one of ordinary skill in this art would not recognize from the written description in the Specification that Appellants were in possession of the claimed process and apparatus wherein "the at least one adsorbate-containing medium flowing only tangentially over the entire outer

adsorbing surface of the adsorbent (5)" encompassed by claim 1 at the time the Application was filed. *See, e.g., In re Alton*, 76 F.3d 1168, at 1175-76, 37 USPQ2d at 1581, 1583-584 (Fed. Cir. 1996) (citing *Wertheim*, 541 F.2d at 262-64, 191 USPQ at 96-97).

Therefore, we affirm the ground of rejection of claims 1 through 25 under 35 U.S.C. § 112, first paragraph, written description requirement.

Turning now to the ground of rejection under § 102(e), we initially point out that the language of claim 1 must be considered vis-à-vis the disclosure of Nussbaumer, regardless of the Examiner's view thereof based on the disclosure in the Specification. Answer, e.g., 8 and 13; Reply Br. 6. Indeed, claims are considered with respect to all of the limitations thereof regardless of whether a limitation is not supported by the specification as filed. *Cf. Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir 1984). Thus, Nussbaumer must describe a process using an apparatus which provides for flow of adsorbate-containing medium "only tangentially" over the entire outer adsorbing surface of an adsorbent material as claimed to establish anticipation within the meaning of § 102(e). *See, e.g.*, *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) ("To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently."). We agree with Appellants that the reference describes flow permeating through the adsorbent membrane and the Examiner has not established otherwise by pointing to "cross-flow" wherein part of the medium "flows through the adsorbent." Nussbaumer col. 8, ll. 13-27; Answer 7-9 and 12-14; Br., e.g., 7-8.

Accordingly, in the absence of a prima facie case of anticipation, we reverse the ground of rejection of claims 1 through 14, 16, and 18 through 25 under 35 U.S.C. § 102(e).

In summary, we affirm the rejection of claims 1 through 25 under 35 U.S.C. § 112, first paragraph, written description requirement, and reverse the rejection of claims 1 through 14, 16, and 18 through 25 under 35 U.S.C. § 102(e).

The Primary Examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

clj

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