

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HERBERT TRATZ, REINER ENGELHARDT
and GEORG LOSEL

Appeal No. 97-2912
Application No. 08/291,768¹

ON BRIEF

Before KIMLIN, GARRIS, and PAK, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's
refusal to allow claims 6 through 15. Claims 6, 13 and 15
were amended subsequent to the final rejection. Claims 1

¹ Application for patent filed August 17, 1994. According
to appellants, this application is a national stage
application of PCT/DE93/00119, filed February 11, 1993.

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Energie-und Umwelttechnik GmbH, Oct. 1985, pp. 97-120
(hereinafter referred to as "Kozmiensky").

The appealed claims stand rejected as follows:

(1) Claims 6 through 11 and 13 through 15 under 35
U.S.C.

§ 102(b) as anticipated by the disclosure of May; and

(2) Claim 12 under 35 U.S.C. § 103 as unpatentable over
the combined disclosures of May and Kozmiensky.

We will not sustain either of the above-mentioned
rejections. Our reasons for this determination follow.

We initially observe that the examiner relies on the May
reference to establish anticipation of the subject matter
defined by claims 6 through 11 and 13 through 15 under 35
U.S.C.

§ 102(b). It is well settled that an anticipation under
Section 102 is established only when a single prior art
reference describes, either expressly or under the principles
of inherency, each and every element of a claimed invention.
See In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed.
Cir. 1990) and **RCA Corp. v. Applied Digital Data Systems,**
Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

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However, the May reference does not describe each and every element of the claimed subject matter. Specifically, we find that the May reference does not describe:

said heating gas circuit having a combustion chamber communicating with said carbonization drum, said combustion chamber receiving and combusting a partial flow of the carbonization gas from the carbonization drum, thereby generating a heating gas, and delivering the heating gas to the carbonization drum;

In other words, the device described in the May reference does not provide a heating gas circuit which is designed to employ carbonization gas directly in the heating of a carbonization drum and to provide only a partial flow of the carbonization gas to the combustion chamber. Rather, it employs a heating gas circuit which is designed to use indirectly heated air or inert gases to heat a carbonization drum (see the paragraph bridging pages 6 and 7) and is designed to send the entire carbonization gas to a combustion chamber 8 (see page 6). Accordingly, we agree with appellants that the May reference does not anticipate the claimed subject matter within the meaning of 35 U.S.C. § 102(b).

We also observe that the examiner relies on the Kozmiensky reference, in addition to the May reference, to

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render the subject matter of claim 12 obvious under 35 U.S.C. § 103. Although claim 12 encompasses the above-mentioned limitations not taught by the May reference, in addition to a dust separator, the examiner relies on the Kozmiensky reference to show only a dust separator. See Answer, page 5. Since the examiner has not demonstrated obviousness regarding the above-mentioned limitations not taught by the May reference, we also agree with appellants that the examiner has not established a *prima facie* case of obviousness within the meaning of 35 U.S.C. § 103.

In view of the foregoing, we reverse the examiner's decision rejecting claims 6 through 15.

REVERSED

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EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
BRADLEY R. GARRIS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
CHUNG K. PAK)	
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APJ PAK

APJ GARRIS

APJ KIMLIN

DECISION: REVERSED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s): 102,
102(b) and 103

Prepared: September 21, 1999

Draft Final

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