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AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HANS PFINGSTL,
WALTER MARTYNIUK, ARMAND LADAGE,
TOM MCNALLY, ROBERT MYERS
and LUDWIG EBERLE

Appeal No. 94-1117
Application 07/470,923¹

ON BRIEF

Before LYDDANE, MEISTER and McQUADE, Administrative Patent
Judges.

LYDDANE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 8, 10 through 12, 21 through 24 and 26 through 36, which are all of the claims remaining in the application.

The subject matter on appeal is directed to a system utilizing a plurality of batch furnaces in staggered operation at

¹ Application for patent filed January 26, 1990.

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an electrical resistance furnace silicon carbide manufacturing plant and continuously flowing the by-product gases as emitted from the silicon carbide manufacturing plant directly to a methanol manufacturing plant for immediate processing for the production of methanol. Claim 8 is exemplary of the invention and a copy thereof, as it appears in the appendix to the appellants' brief, has been appended to this decision.

The references of record relied upon by the examiner in a rejection of the claims under 35 USC 103 are:

Dosaj et al. (Dosaj)	4,981,668	Jan. 1, 1991
Karavaev et al. (Karavaev) (GB)	1 435 253	May 12, 1976

Claims 8, 10 through 12, 21 through 24 and 26 through 36 stand rejected under 35 USC 103 as being unpatentable over Dosaj in view of Karavaev.

Rather than reiterate the examiner's statement of the above rejections and the conflicting viewpoints advanced by the examiner and the appellants, we refer to pages 3 through 7 of the examiner's answer, to pages 5 through 10 of the appellants' amended brief and to the appellants' reply brief for the full exposition thereof.

OPINION

In arriving at our decision in this appeal, we have given careful consideration to appellants' specification and

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claims, to the applied prior art, and to the respective positions advanced by the appellants and by the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to all claims on appeal. Our reasoning for this determination follows.

Each of the claims on appeal requires a system including at least a silicon carbide manufacturing plant comprising a plurality of batch furnaces, means for staggering the operation of the batch furnaces to provide a continuous flow of by-product gases therefrom, a second manufacturing plant for processing the by-product gases for production of methanol (or a hydrocarbon product), and means for continuously flowing the by-product gases as emitted from the silicon carbide manufacturing plant directly to the second manufacturing plant for immediate processing. We observe that neither of the applied references discloses a silicon carbide manufacturing plant, and in particular, neither teaches or suggests a silicon carbide manufacturing plant that includes a plurality of batch furnaces to provide a continuous flow of by-product gases or means for continuously flowing the by-product gases as emitted directly to a methanol (or hydrocarbon product) manufacturing plant.

We do not dispute the fact that silicon carbide manufacturing plants are known, that the patent to Dosaj teaches

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that it is known to produce methanol from waste gases of silicon manufacturing plants, or that Karavaev teaches that methanol can be produced from waste gases of different chemical processes. However, we find nothing in the teachings of the applied prior art or from knowledge generally available to one of ordinary skill in the art to suggest the system recited in the claims on appeal including the elements noted in the preceding paragraph. Rejections based on §103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner has the initial duty of supplying the factual basis for the rejection. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). Absent a factual basis for the examiner's position, as here, the decision cannot be sustained.

Furthermore, as stated in W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303,312-313 (Fed. Cir. 1983),

[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only

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the inventor taught is used against its teacher.

It is our conclusion that the only reason to combine the teachings of the applied references in the manner proposed by the examiner results from a review of appellants' disclosure and utilization of the teachings thereof as a blueprint to arrive at appellants' claimed invention. In our view, such can only be perceived as the application of impermissible hindsight. Therefore, we cannot sustain the examiner's rejection of appealed claims 8, 10 through 12, 21 through 24 and 26 through 36 under 35 USC 103.

Accordingly, the decision of the examiner rejecting claims 8, 10 through 12, 21 through 24 and 26 through 36 under 35 USC 103 is reversed.

REVERSED

<i>Will. E. Lyddane</i>)	
WILLIAM E. LYDDANE)	
Administrative Patent Judge)	
<i>James M. Meister</i>)	
JAMES M. MEISTER)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS
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CLAIM 8

8. A system comprising:

an electrical resistance furnace silicon carbide manufacturing plant including a plurality of batch furnaces which emit environmentally pollutant by-product gases during the production of silicon carbide;

means for staggering the operation of said batch furnaces to provide a continuous flow of the by-product gases from said silicon carbide manufacturing plant;

a methanol manufacturing plant for processing the by-product gases for production of methanol; and

means for continuously flowing the by-product gases as emitted from said silicon carbide manufacturing plant directly to said methanol manufacturing plant for immediate processing for production of methanol whereby evolution of the pollutant by-product gases into the atmosphere may be prevented.