

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WILLIAM P. PRUETER, DANIEL  
P. BIRMINGHAM and MATTHEW J. REED

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Appeal No. 1999-1199  
Application 08/695,947

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ON BRIEF

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Before COHEN, PATE, and NASE, Administrative Patent Judges.  
PATE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 21 through 28. These are the only claims remaining in the application.

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The claimed invention is directed to an apparatus for separating oil and gas as it comes from the interior of the earth at a wellhead. The claimed subject matter may be further understood with reference to appealed claim 21 which is appended to appellants' brief.

The references of record relied upon by the examiner as evidence of obviousness are:

Brahler et al. (Brahler) 13, 1967	3,324,634	June
Kidwell et al. (Kidwell) 10, 1987	4,648,890	Mar.

Claims 21 through 28 stand rejected under 35 U.S.C. § 103.

For the full details of the examiner's rejection, reference is made to the final rejection Paper No. 14. For the full details of the arguments of the appellants and the examiner, reference is made to the appeal brief, the reply brief and the examiner's answer.

#### OPINION

We have carefully reviewed the rejection on appeal in light of the arguments of the appellants and the examiner. As a result of this review we have reached the determination that

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the applied prior art does not establish the *prima facie* obviousness of claims 21 through 28. Therefore the rejection of all claims on appeal is reversed. Our reasons follow.

Turning to the claimed subject matter on appeal, we note that the first clause of claim 21 after the preamble clearly states that the appealed subject matter is an oil and gas separator claimed in combination with a hydrocarbon production system. Thus, notwithstanding the content of the prior art references to Kidwell and Brahler, since these two patents do not disclose or suggest the claimed hydrocarbon production system, the examiner's obviousness rejection can not be sustained.

It is noted that the examiner in the final rejection clearly stated the background for determining obviousness. This analysis includes ascertaining the differences between the prior art and the claims at issue. If the examiner had conducted such an analysis, she would have realized that a prime difference between

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Kidwell and Brahler and the claimed subject matter was that  
the claimed subject matter was directed to a separator in  
combination  
with a hydrocarbon production system.

REVERSED

IRWIN CHARLES COHEN	)	)
Administrative Patent Judge	)	)
	)	)
	)	)
	)	BOARD OF PATENT
WILLIAM F. PATE, III	)	)
Administrative Patent Judge	)	APPEALS AND
	)	)
	)	INTERFERENCES
	)	)
JEFFREY V. NASE	)	)
Administrative Patent Judge	)	)

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