

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RALPH L. HICKS

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Appeal No. 1997-0616  
Application No. 08/318,205

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HEARD: SEPTEMBER 13, 2001

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Before GARRIS, DELMENDO, and PAWLIKOWSKI, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 13 through 30, 32 through 53, and 55 through 57, which are all of the claims pending in the above-identified application.<sup>1</sup>

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<sup>1</sup> In response to the final Office action of February 20, 1996 (paper 19), the appellant submitted an amendment under 37 CFR § 1.116 (1981) on May 20, 1996 (paper 22), proposing the cancellation of claim 54 and changes to claims 46 and 57. The examiner indicated in the advisory action of June 13, 1996

The subject matter on appeal relates to a method of drying fuel gas containing water vapor and at least one pollutant comprising at least one member of the group consisting of volatile organic compounds, hydrogen sulfide, and other gaseous pollutants. (Appeal brief, page 3.) Further details of this appealed subject matter are recited in illustrative claim 13 reproduced below:

13. A method of drying fuel gas containing water vapor and at least one pollutant comprising at least one member of the group consisting of volatile organic compounds, hydrogen sulfide and other gaseous pollutants, said method comprising:

- A. bringing said fuel gas into contact, in a gas/liquid contact vessel, with a liquid desiccant having an affinity for said water vapor and pollutant, thereby transferring water vapor and pollutant from said fuel gas into said desiccant;
- B. reconcentrating resultant rich desiccant containing water and pollutant by introducing said desiccant into a reconcentration system comprising a reboiler having a heating vessel, liquid and gas spaces in said heating vessel, a liquid outlet from said liquid space, and a column having a gas and/or vapor transmitting connection between said heating vessel gas space and said column and a vapor outlet for discharging gas and/or vapor from said column;

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(paper 25) that the amendment will be entered for purposes of this appeal.

- C. maintaining a total pressure of at least about 25 PSIA in said heating vessel gas space while expelling pollutant from rich desiccant in said heating vessel and into said column; and
- D. discharging gaseous pollutant through said column vapor outlet, while preventing discharge of said gaseous pollutant from said reconcentration system into the atmosphere and recovering reconcentrated desiccant.

The examiner has not relied on any prior art reference as evidence of unpatentability.

Nevertheless, claims 13 through 30, 32 through 53, and 55 through 57 on appeal stand rejected under 35 U.S.C. § 102(b) as "based upon a public use or sale of the invention." (Examiner's answer, page 3; final Office action, pages 3-4.)

We reverse the aforementioned rejection.

The examiner points out that the appellant received, more than one year before the effective filing date of the subject application, a purchase order from an oil company to investigate alternatives for VOC emission control and to provide a recommendation. (Final Office action, page 3; appellant's statement captioned "INFORMATION RE PRE-CRITICAL DATE ACTIVITY," filed May 24, 1993, paper 5.) The examiner then refers to page 1 of the appellant's supplemental statement ("SUPPLEMENTAL

INVENTOR'S STATEMENT") filed August 8, 1994 (paper 11), which discusses that the oil company "engaged" an equipment fabricator to build a portion of the plant in which the claimed method "might be practiced." (Final Office action, page 3.) Further, the examiner finds: "Applicant then met with the equipment fabrication [sic] to familiarize the equipment manufacturer with the method and discuss changes in equipment design to accommodate the method if it were accepted by the oil company." (Id. at pages 3-4.) Based on these observations, the examiner concludes as follows:

[I]t appears that the oil company, equipment manufacturer and applicant were in possession of the invention and were working to manufacture and build a plant design for VOC emission control based on applicant's ideas which are directly related to the claimed invention constituting a statutory on-sale bar. [Final Office action, p. 4.]

In the answer, the examiner's position is summarized as follows:

It is maintained that the Examiner is not in error in interpreting neither the Information RE-Pre-Critical Date Activity nor the Supplemental Inventor's Statement [sic] that these documents provide that an "Offer to Sell" has been made by the Appellant Ralph Hicks and the U.S. Oil Company and therefore the invention has been reduced to practice and appellant has not established an Experimental Use Scenario and thus an exception to Public Use or Sale. [Examiner's answer, p. 5.]

On the other hand, the appellant argues that the facts and the law do not support the examiner's conclusions. (Appeal brief, pages 4-7.) The appellant further contends that the activities described in the appellant's statements did not trigger an "on-sale" bar under 35 U.S.C. § 102(b) because there was no offer, prior to the critical date of September 11, 1991, "to sell embodiments of the claimed invention." (Reply brief, pages 5-6.) We agree.

In Pfaff v. Wells Electronics, Inc., 525 U.S. 55 (1998), the Supreme Court held that an "on-sale bar" under 35 U.S.C. § 102(b) is triggered if two conditions are satisfied:

- (i) the invention must have been the subject of a commercial offer for sale more than one year before the patent application was filed; and
- (ii) the invention must have been ready for patenting more than one year before the filing of the application.

The second condition may be satisfied by (a) proof of reduction to practice prior to the critical date or (b) proof that prior to the critical date the inventor had prepared drawings or other descriptions of the invention sufficiently specific to enable a person skilled in the art.

In the case before us, we determine that the first condition is not satisfied. Our reasons follow.

We start with the statute. 35 U.S.C. § 102(b) (2001) states:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale more than one year prior to the date of the application for patent in the United States...[Underscoring added.]

Thus, the plain text of section 102(b) provides that it is the "invention" which must be "in public use or on sale more than one year prior to the date of the application for patent..." Cf. Mas-Hamilton Group v. LaGard, Inc., 156 F.3d 1206, 1217, 48 USPQ2d 1010, 1019 (Fed. Cir. 1998) (approving the district court's determination that the "on-sale bar" does not apply where the offer did not involve a sale or an offer to sell the invention itself).<sup>2</sup>

Applying this principle, we determine that the first condition of the "on-sale bar" test in Pfaff is not met in this case. Specifically, the examiner has relied on the appellant's statements regarding an offer to undertake a feasibility study on whether an embodiment of the invention should be installed in

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<sup>2</sup> See also Donald S. Chisum, Chisum on Patents § 6.02[6], at 6-67 (2000).

Appeal No. 1997-0616  
Application No. 08/318,205

one of the oil company's plants or whether an alternative system should be installed. (Appellant's statement of May 24, 1993, page 1.) In response to the appellant's offer, the oil company issued a purchase order for the offeror to "'provide process engineering services and assist buyer's...project engineer to investigate alternatives and recommend solution for VOC...emission control system...'" (Id.) It is clear, therefore, that the sale or the offer to sell did not involve an embodiment of the invention as required under § 102(b).

Since the first condition is not met, we need not discuss whether the second condition ("ready for patenting") is satisfied.

As to the examiner's allegation that the invention was in "public use" before the critical date, we note that "'[p]ublic use' of a claimed invention under section 102(b) has been defined as any use of that invention by a person other than the inventor who is under no limitation, restriction or obligation of secrecy to the inventor." In re Smith, 714 F.2d 1127, 1134, 218 USPQ 976, 983 (Fed. Cir. 1983) (citing Egbert v. Lippmann, 104 U.S. 333, 336 (1881)).

Appeal No. 1997-0616  
Application No. 08/318,205

Here, the examiner has not adequately established the elements necessary to support a conclusion of "public use" prior to the critical date.

For these reasons, we reverse the examiner's rejection under 35 U.S.C. § 102(b) of all of the appealed claims.

The decision of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
ROMULO H. DELMENDO	)	
Administrative Patent Judge	)	APPEALS AND
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BEVERLY A. PAWLIKOWSKI	)	
Administrative Patent Judge	)	

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Appeal No. 1997-0616  
Application No. 08/318,205

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