

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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARNOLD SCHOOLMAN

Appeal No. 1998-2656
Application No. 08/523,535

ON BRIEF

Before COHEN, FRANKFORT, and STAAB, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 9 through 15. Claim 14 was amended subsequent to the final rejection. These claims constitute all of the claims remaining in the application.

Appellant's invention addresses an anesthesia apparatus. A basic understanding of the invention can be gained from a

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reading of exemplary claim 9, a copy of which appears in the APPENDIX to the brief (Paper No. 12).

As evidence of obviousness, the examiner has relied upon the documents listed below:

Healy et al. (Healy)	4,051,522	Sep. 27,
1977		
Wells	5,003,300	Mar. 26,
1991		
Hoffman et al.	5,183,038	Feb.
2, 1993		
(Hoffman)		

Claims 9, 10, and 13 through 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hoffman in view of Wells.

Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hoffman in view of Wells, as applied to claims 9, 10, and 13 through 15 above, further in view of Healy.

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The examiner's rejections and response to the argument made by appellant appears in the answer (Paper No. 13), while appellant's argument can be found in the brief¹ (Paper No. 12).

OPINION

In assessing the obviousness issues on appeal, we have carefully reviewed appellant's specification and claims, the prior art teachings relied upon,² and the points of view of

¹ Appellant informs us (brief, page 2) of an appeal in parent application Serial No. 08/419,907. A decision was rendered in that appeal (Appeal No. 1998-0672) affirming the examiner's rejection under 35 U.S.C. § 103. It is worthy of noting that the referenced parent application appeal related to a surgical patient monitor system, as distinguished from the presently claimed anesthesia apparatus.

² In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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appellant and the examiner, respectively. As a consequence of our review, we make the determination that appears below.

We cannot sustain each of the examiner's rejections under 35 U.S.C. § 103(a).

Appellant's independent claim 9 clearly and unambiguously sets forth an anesthesia apparatus. As disclosed by appellant in the specification (pages 2, 6, 9, and 12), an anesthesia machine controls the flow and mixtures of oxygen and a gaseous anesthetic to a patient.

In support of the rejection of independent claim 9, the examiner relies upon the basic teaching of Hoffman evaluated in view of Wells.³

³ Notwithstanding appellant's argument to the contrary (brief, pages 9 and 10), the Wells patent is considered to be an appropriate reference since appellant has not made a specific showing that, in fact, the now claimed anesthesia apparatus descriptively corresponds to disclosure in an earlier application.

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A reading of the Hoffman document readily informs us that the patentee is addressing a ventilator that is used to ventilate the lungs of a patient. The ventilator relies upon a source of pressurized air P and a vacuum source V (Fig. 1).

As indicated above, independent claim 9 on appeal sets forth an anesthesia apparatus, not a ventilator. We share appellant's point of view that the applied Hoffman reference does not relate to the type of apparatus now being claimed (brief, page 10). Thus, it is quite apparent that even if the Hoffman teaching were modified by the Wells and Healy disclosures, as proposed by the examiner, the resulting entity would be a ventilator not an anesthesia apparatus. Since the evidence before us is deficient for the reason articulated above, the respective rejections of appellant's claims cannot be sustained.

REMAND TO THE EXAMINER

This application is remanded to the examiner to assess the patentability of the claimed anesthesia apparatus from the

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perspective of the knowledge in the art of anesthesia apparatus at the time of appellant's invention, as reflected, for example, in the underlying specification (pages 2 through 5 and page 12, line 15 through page 12, line 3) viewed in conjunction with other prior art, such as the Wells and Healy patents.

In summary, this panel of the board has not sustained the rejections on appeal, and has remanded the application to the examiner.

The decision of the examiner is reversed.

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REVERSED AND REMANDED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
LAWRENCE J.. STAAB)	
Administrative Patent Judge)	

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LAW OFFICE OF JOHN C. MCMAHON
P. O. BOX 30069
KANSAS CITY, MO 64112

COHEN

APPEAL NO. 1998-2656 - JUDGE

APPLICATION NO. 08/523,535

APJ COHEN

APJ STAAB

APJ FRANKFORT

DECISION:

Prepared By:

DRAFT TYPED: 14 Aug 02

FINAL TYPED: