

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES A. WALKER

Appeal No. 1999-1042
Application No. 08/781,220

ON BRIEF

Before ABRAMS, FRANKFORT, and McQUADE, ***Administrative Patent Judges.***

ABRAMS, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 14-18. Claims 1-13 have been canceled. No claims have been allowed.

The appellant's invention is directed to a medical gas services unit. The claims before us on appeal have been reproduced in an appendix to the Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Schwartz 1982	4,354,330	Oct. 19,
Russo <i>et al.</i> (Russo) 9, 1984	4,475,322	Oct.
Kroon <i>et al.</i> (Kroon) 1991 Walker 8, 1997	5,044,135 5,644,876	Sep. 3, Jul.

(filed Aug. 26, 1994)

THE REJECTIONS¹

The following rejections stand under 35 U.S.C. § 103:

- (1) Claims 14-18 on the basis of Russo in view of Kroon.
- (2) Claims 14-18 on the basis of Schwartz in view of Kroon.
- (3) Claims 14-18 on the basis of Kroon in view of Russo.
- (4) Claims 14-18 on the basis of Kroon in view of Schwartz.

¹A rejection of claim 17 under 35 U.S.C. § 112, second paragraph, was cured by an amendment under 37 CFR § 1.116(a) which the examiner allowed to be entered. However, the rejection was repeated in the Examiner's Answer, apparently inadvertently.

Claims 14-18 also stand rejected under the judicially created doctrine of double patenting over claims 1-8 of U.S. Patent No. 5,644,876.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejection and the conflicting viewpoints advanced by the examiner and the appellant regarding the rejections, we make reference to the Examiner's Answers (Papers No. 9 and 11) and the Appellant's Briefs (Papers No. 8 and 10).

OPINION

Background

The appellant's invention is directed to a modular unit for supplying medical gas services in health care facilities such as hospitals. According to the appellant, prior art modular units very often are obstacles at the bedside of a patient, interfering with patient care in that they get in the way of the multiple medical practitioners who are attempting to administer to the patient. The appellant's invention overcomes these problems by providing a modular medical gas services unit in the form of a narrow tower or column which is accessible from all sides, occupies little space, and provides the

multiple outlets for medical gases at a convenient height. In the embodiment of Figures 6 through 9, to which the claims in the present application are directed, five vertical planar side panels are provided on the column, with each being of a width only slightly greater than the width of a conventional medical gas service outlet. This results in each assembly being mounted at an acute angle to the others, thus providing a large number of assemblies that can be used simultaneously.

The Rejections Under 35 U.S.C. § 103

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, ***In re Keller***, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See ***Ex parte Clapp***, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole

or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, **Uniroyal, Inc. v. Rudkin-Wiley Corp.**, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

As manifested in independent claim 14, the appellant's invention comprises a hollow column formed of at least five vertical planar side panels, all having the same width and each being immediately adjacent two others of the side panels. A medical gas supply assembly is supported on each of the five side panels, all at the same height and between about 40 and about 60 inches above the floor. The width of each side panel is only slightly greater than the width of the medical gas supply assembly mounted thereon. According the first two of the examiner's rejections, both Russo and Schwartz disclose the basic structure recited in claim 14, except for the five-sided assembly with gas service outlets on all five sides, the gas outlets being at equal distances and at a particular height, and the specified width of the panels. It is the examiner's position, however, that it would have been obvious to one of

ordinary skill in the art to make the columns of Russo or Schwartz of five sides, in view of the showing of Kroon, suggestion being found in the ability to service more patients. The examiner further concludes that it would have been an obvious expedient to one of ordinary skill in the art to install gas outlets on all of the sides to establish accessibility to a plurality of patients and to place the outlets at equal heights within the specified range. The claimed width relationship between the panels and the gas outlet assemblies is, in the examiner's view, met by the modified Russo and Schwartz devices.

A threshold argument raised by the appellant is that Kroon is not analogous art, and therefore cannot properly be combined with either of the two primary references. The test for analogous art is first whether the art is within the field of the inventor's endeavor and, if not, whether it is reasonably pertinent to the problem with which the inventor was involved. See *In re Wood* 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). A reference is reasonably pertinent if, even though it may be in a different field of endeavor, it logically would have commended itself to an inventor's attention in considering

his problem because of the matter with which it deals. See **In re Clay**, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992). Kroon clearly is not within the field of the appellant's endeavor in that it is directed to a cluster office work station system and not to the supply of medical gas services or the like. As for the second facet of the **Wood** test, while Kroon illustrates an arrangement of work stations that surround a five-sided central column, it has nothing to do with providing a stand-alone column which does not impede the movement of workers around it while maximizing the supply of utilities that can be provided therethrough, and thus in our view would not logically have commended itself to the attention of an inventor working on the problem to which the appellant's invention is directed. Therefore, Kroon is non-analogous art and the first two rejections are fatally defective at the outset.

Moreover, even considering, *arguendo*, the Kroon reference to be analogous art, the mere fact that it discloses a five-sided column through which utilities are supplied would not, in our view, have suggested to one of ordinary skill in the art

that the three-sided devices of Russo or Schwartz be modified so that they have five sides. That the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In the present case, we point out that neither of the primary references teaches that the devices disclosed therein are capable of or intended to service more than one patient and that the "flat-cornered triangular medical column" disclosed in each appears to be a basic feature of invention. Therefore, we fail to perceive any motivation for making the change proposed by the examiner. In addition, in the absence of a teaching to treat more than one patient from the same column, we do not agree with the examiner that one of ordinary skill in the art would have been motivated to place gas outlets on all sides of the Russo and Schwartz devices. Lastly, since minimizing the space of the base portion of the devices, through which gas is supplied, appears not to be a concern of either Russo or Schwartz, we also cannot agree that it would have been obvious to make the width of the planar side panels

only slightly wider than the width of the medical gas assembly mounted therein.

For the reasons set forth above, it is our conclusion that the neither the teachings of Russo and Kroon nor the teachings of Schwartz and Kroon establish a *prima facie* case of obviousness with regard to the subject matter recited in independent claim 14. This being the case, we will not sustain these rejections of claim 14 or of claims 15-18, which depend therefrom.

Considering the references in inverse order does not lead to a different conclusion. The content of each of these references has been discussed above. We fail to perceive any teaching, incentive, or suggestion in Russo or Schwartz which would have led one of ordinary skill in the art to add medical gas supply means to the office cubicle structure disclosed by Kroon. The rejections of Kroon in view of Russo and Kroon in view of Schwartz also fail to establish a *prima facie* case of obviousness with regard to the subject matter of claim 14, and therefore we will not sustain these rejections of claims 14-18.

The Double Patenting Rejection

The appellant's U.S. Patent No. 5,644,876, upon which the double patenting rejection is based, resulted from application Serial Number 08/297,193, filed on August 26, 1994 (hereinafter "the patent"). This application disclosed two embodiments of the appellant's invention. The first embodiment (Figures 1-5) discloses a four-sided column and maximizes the number of gas outlets that can be installed at a specified height on the column by providing a pair of angled outlet support surfaces on each side panel which are adjacent to one another in intersecting planes. The second embodiment (Figures 6-9)² accomplishes a similar objective by utilizing a five-sided column in which the width of each side panel is only slightly wider than that of the gas assembly mounted thereon. The appellant prosecuted to issuance only claims directed specifically to the first embodiment. The present application was filed on January 10, 1997 as a Rule 60 continuation of the first and presented, after entry of a preliminary amendment, claims directed to the second embodiment.

²While described in the specification as illustrating the five-sided embodiment of the invention, it appears to us that Figure 6 shows a four-sided column. However, a five-sided column clearly is shown in Figures 7-9.

The examiner has not provided a detailed explanation of the double patenting rejection. Apparently, the rejection is based on the theory that since the subject matter of the application claims was disclosed in the application from which the patent matured and the appellant chose not to claim it at that time, Section 804 of the Manual of Patent Examining Procedure (MPEP) and *In re Schneller* (397 F.2d 350, 355-56, 158 USPQ 210, 215-16 (CCPA 1968)) dictate that a double patenting rejection is proper. We do not agree with this conclusion. MPEP Section 804.II.A states "[i]n determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the same invention being claimed twice?". We answer this question in the negative, for the following reasons. Application claim 1 requires that the support column have at least five planar panels which are vertical and of the same width, that there be a medical gas supply assembly supported on each of the five panels at the same height of between about 40 and about 60 inches above the floor, and that the width of the side panels be only slightly greater than the width of the medical gas support assembly. None of these features are present in the gas service unit

defined in patent claim 1, which requires a plurality of support surfaces (panels) at least two of which support medical gas supply assemblies, and which does not recite any details concerning orientation of the support surfaces, the height of the gas support assemblies or the width of the panels as compared to the width of the gas outlet assemblies. Moreover, patent claim 1 sets forth structure that is not present in application claim 1, such as angled medical gas outlet panels having first and second angled planar outlet support surfaces and gas outlets supported by each of the angled panels.

Insofar as **Schneller** is concerned, this case does not, as it appears the examiner would have us believe, stand for the proposition that simply because the subject matter recited in the claims on appeal was disclosed in the application from which the patent matured and the events which gave rise to the situation were the result of the appellant's doing, double patenting would result if the application claims were allowed to issue. The ruling in **Schneller** that double patenting existed was based upon a factual situation which is not present here, from which the court found the inventions not to be

independent and distinct. According to *Schneller*, “[t]he controlling fact is that the patent protection for the clips, fully disclosed in and covered by the patent, would be extended by the appealed claims” (397 F.2d at 355, 158 USPQ at 215). It is clear to us that the patent claims and the application claims are directed to two separate inventions, and that the issuance of the application claims will not extend the exclusivity of the rights granted beyond the term of the patent. We therefore will not sustain the double patenting rejection.

SUMMARY

None of the rejections are sustained.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	

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