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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ERIC ANDERSEN, RENE ROBERT, GARY SEARLE, and
VINCENT WALDRON

Appeal 2012-001550
Application 12/320,348
Technology Center 3700

Before DONALD E. ADAMS, LORA M. GREEN, and
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134 involves claims 1-12 and 17-19
(App. Br. 5; Ans. 3).¹ We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

The claims are directed to an apparatus for preventing gas from being
input to a patient being infused with an infusate (claims 1-8 and 18) and a

¹ Pending claims 13-16 stand withdrawn from consideration (App. Br. 5;
Ans. 3).

fluid warmer (claims 9-12 and 19). Claims 1 and 9 are representative and are reproduced in the Claims Appendix of Appellants' Brief.

Claims 1-12 and 17 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Rosner² and Hesse.³

Claims 1-12 and 17 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Rosner, Hesse, and Baker.⁴

We reverse.

ISSUE

Does the preponderance of evidence on this record support a conclusion of obviousness?

FACTUAL FINDINGS (FF)

FF 1. Appellants' figure 5 is reproduced below:

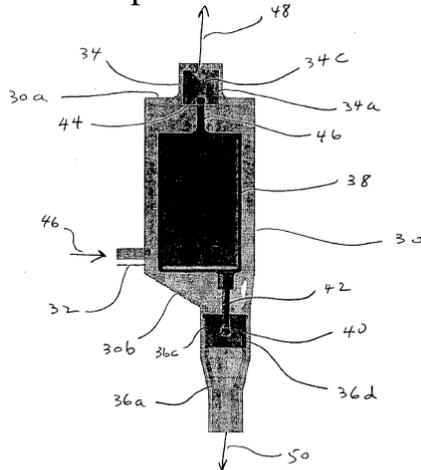


Fig 5

“Fig. 5 is a cross-sectional view showing the gas vent valve assembly of ... [Appellants'] invention” (Spec. 7: ¶ [0021]).

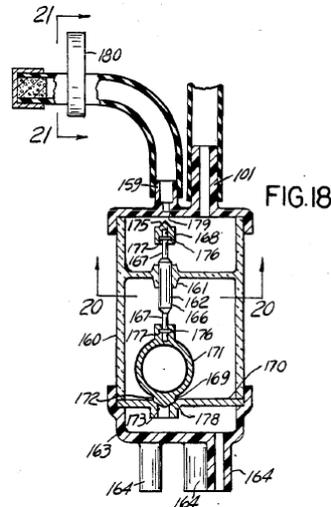
² Rosner, US 4,678,460, issued July 7, 1987.

³ Hesse et al., US 3,543,752, issued December 1, 1970.

⁴ Baker, US 6,229,957 B1, issued May 8, 2001.

FF 2. Appellants' disclose a "gas vent valve assembly ha[ving] a valve body housing [30] that has a fluid inlet [32] at a side thereof, a gas outlet [34] at its top and a fluid outlet [36] at its bottom" (*id.* at ¶ [007] and ¶¶ [0028]-[0039]).

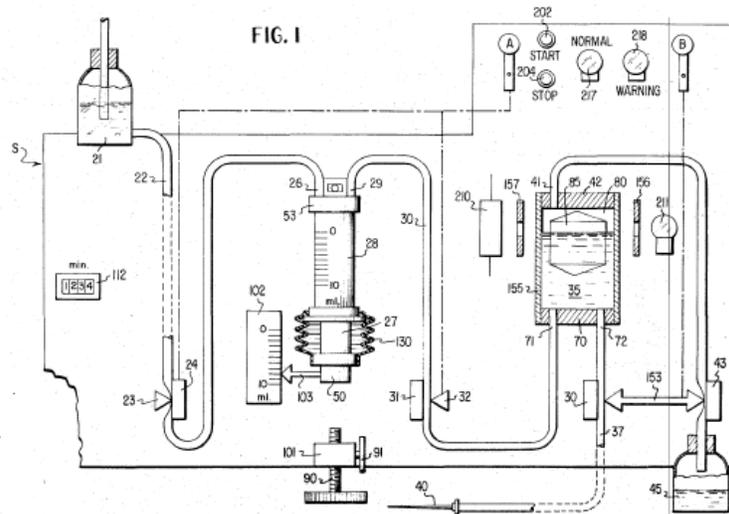
FF 3. Rosner's figure 18 is reproduced below:



Rosner's "FIG. 18 is a cross-sectional view [of Rosner's bubble trap and eliminator] ... showing the internal construction of the bubble trap and eliminator" (Rosner, col. 6, ll. 5-7).

FF 4. Examiner finds that while "Rosner discloses an apparatus ... for preventing gas from being input to a patient being infused with an infusate ... comprising ... an inlet 101 ... to enable the infusate to flow into ... [a] housing [160] from ... [the top] of ... [the] housing" to outlet ports 164 for connecting lines for infusing parenteral fluid into a patient; "Rosner does not disclose that the inlet is located at a lower portion of ... [the] housing" (Ans. 5-6; *see also id.* at 11-12; Rosner, col. 13, ll. 59-60).

FF 5. Hesse's figure 1 is reproduced below:



Hesse's "FIG. 1 is a front view representation showing the parts visible and accessible on the front side of the mounting panel of an infusion apparatus for medical purposes with attached liquid supply container and cannula" (Hesse, col. 2, ll. 54-57).

FF 6. Examiner finds that Hesse suggests a housing 35 that is substantially similar to Rosner's, which comprises "a fluid outlet 72 ... and an inlet 71 ... located at ... [the bottom] of ... [the] housing (Ans. 7; see also *id.* at 12-13).

FF 7. Examiner finds that the Random House Dictionary⁵ defines the term "side" as "one of the surfaces forming the outside of or bounding a thing, or one of the lines bounding a geometric figure" (*id.* at 18).

FF 8. Examiner finds that the Collins English Dictionary⁶ defines the term "side" as "a line or surface that borders anything" (*id.*).

FF 9. Examiner finds that Appellants' invention "as presently claimed [does not require] the 'side of said housing' ... to be a lateral side of the

⁵ Random House Dictionary (2011), <http://dictionary.reference.com/browse/side>.

⁶ Collins English Dictionary (2009), <http://dictionary.reference.com/browse/side>.

housing and does not eliminate the top and bottom surfaces from being ‘sides’” (*id.* at 18).

FF 10. Examiner finds that the combination of Rosner and Hesse fails to suggest an air detector and relies on Baker to make up for this deficiency in the combination of Rosner and Hesse (Ans. 16).

ANALYSIS

Based on the combination of Rosner and Hesse, Examiner concludes that, at the time Appellants’ invention was made, it would have been prima facie obvious “to modify Rosner to include an inlet at a lower portion of the housing, as taught by Hesse..., for the purpose of allowing flow into the housing,” and that such a modification is simply the rearrangement of parts, which involves only routine skill in the art (Ans. 7, citing *In re Japikse*, 181 F.2d 1019 (CCPA 1950); *see also id.* at 9).

Initially, we recognize, but are not persuaded by, Examiner’s reliance on *Japikse* to support a conclusion that the rearrangement of parts involves only routine skill in the art (*id.*). “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006); *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, (2007) (Obviousness requires a teaching that all elements of the claimed invention are found in the prior art and “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does”). On this record, Examiner provided no comparison between the facts of *Japikse* and the facts of the underlying application to explain how the holding of *Japikse* applies to the claims on

appeal (*see* App. Br. 15 (“no matter how much leeway is given to ‘design choice’, with Rosner and Hesse before him, a person skilled in the art could not have come up with the claimed structure of the instant invention”)). In addition, Examiner failed to establish an evidentiary basis on this record to support a conclusion that the placement of the inlet on the side of the device would have been an obvious equivalent to the placement of the inlet on the top or bottom of the device as suggested by the combination of Rosner and Hesse.

At best, Examiner attempts to support the rejections of record with an interpretation of the term *side* that is contrary to the manner in which this term is used in Appellants’ Specification and Claims, which refer to a housing comprising a: (1) top, (2) bottom, and (3) *side* (*see* Ans. 18; FF 9; *Cf.* FF 1-2; Claims 1 and 9). Therefore, we are not persuaded by Examiner’s reliance on Rosner, who suggests a fluid inlet at the *top* of a housing, or Hesse, who teaches a fluid inlet at the *bottom* of a housing, to suggest a fluid inlet at the *side* of a housing (*see* Ans. 7, 9, and 18; FF 9).

Examiner’s reliance on Baker to suggest an air detector fails to make up for the foregoing deficiencies in the combination of Rosner and Hesse.

CONCLUSION OF LAW

The preponderance of evidence on this record fails to support a conclusion of obviousness. The rejection of claims 1-12 and 17 under 35 U.S.C. § 103(a) as unpatentable over the combination of Rosner and Hesse is reversed. The rejection of claims 18 and 19 under 35 U.S.C. § 103(a) as unpatentable over the combination of Rosner, Hesse, and Baker is reversed.

REVERSED

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