

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RANDALL C. ARNOLD

Appeal No. 1999-0032
Application No. 08/525,407

ON BRIEF

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

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

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1-3, 11-17, 20 and 21. Claim 19 has been canceled, claims 18 and 22-27 have been allowed, and claims 4-10 have been indicated as containing allowable subject matter.

The appellant's invention is directed to a blower unit for a convective warming system. The claims as considered on appeal can be found in Paper Nos. 14 and 25.¹

THE APPLIED REFERENCES

Guibert 1983	4,398,535	Aug. 16,
Augustine <i>et al.</i> 1986 (Augustine)	4,572,188	Feb. 25,

THE REJECTIONS

Claims 20 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Guibert.

Claims 1-3 and 11-17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Guibert in view of Augustine.

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

¹ We note that the amendment to the claims set forth in Paper No. 16 has not been clerically entered in the file.

Examiner's Answers (Paper Nos. 15 and 19) and to the Appellant's Briefs (Paper Nos. 14 and 25).

OPINION

In reaching our decision on the issues raised in this appeal, we have carefully assessed the claims, the prior art applied against the claims, and the respective views of the examiner and the appellant as set forth in the Answers and the Briefs. As a result of our review, we have determined that neither of the rejections should be sustained. Our reasoning in support of this conclusion follows.

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. ***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).

The appellant's invention is directed to a blower unit for heating a stream of air, such as might be used to inflate a thermal blanket in the operating room of a hospital. Among the advantages of the invention are reduced noise sensed by those around the unit owing to the orientation of the inlet and outlet and the use of an elbow to direct the airstream at the outlet, and efficient heating of the air by placing the fan drive motor in the airstream (specification, page 4). As manifested in independent claim 20, the inventive blower unit comprises a housing having an inlet at one end and an outlet at the other end, a support to position the housing over a support surface so that the inlet "is substantially oriented toward the support surface," a blower "positioned between the inlet and

the outlet" to create an airstream therethrough, a motor for rotating the blower, and a heater element in the housing to heat the airstream.

Claim 20 stands rejected as being unpatentable over Guibert, which is directed to providing a heated airstream to the skin of a patient to produce hyperthermia. Guibert discloses a horizontally aligned housing mounted on a support and having an air inlet that is oriented perpendicularly to the support surface, rather than toward the support surface, as is required by the appellant's claim 20. However, the examiner makes no mention of this limitation, taking the position that "the differences [*sic*] between . . . [Guibert] and the instant invention is the location of an outlet . . . [and] it would be within the ability of [the] ordinary skilled artisan to reposition the [Guibert] device depending upon the installation site" (Answer, page 4, emphasis added). As does the appellant, we disagree with this reasoning. It is clear that the inlet in the Guibert device is not "substantially oriented toward the support surface," which feature of his invention the appellant has disclosed as being advantageous because it minimizes the effect of the noise made by the device upon

persons located close by. The question then becomes whether one of ordinary skill in the art would have been motivated to modify the Guibert device in such a fashion as to meet this limitation of the claim. From our perspective, the answer must be in the negative. It is axiomatic that the mere fact 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, for example, ***In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Since Guibert has evidenced no concern for the problem of minimizing the noise made by the airstream heater, and in the absence of other reason expressed by the examiner for the artisan to make such a modification, we fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to do so. This being the case, a *prima facie* case of obviousness has not been established with regard to the subject matter recited in claim 20, and we will not sustain the rejection.

Independent claim 21 also stands rejected as being unpatentable over Guibert. This claim requires that the outlet

be so oriented as to "direct an airstream substantially horizontally with respect to the support surface," whereas in Guibert the outlet directs the airstream perpendicularly to the support surface. On the basis of the same reasoning as we expressed above with regard to claim 20, the rejection of claim 21 is not sustained.

Independent claim 1 has been rejected on the basis of Guibert in view of Augustine. Claim 1 recites a blower unit comprising a housing having an inlet at one end and an outlet at the other end, a support for positioning the housing over a support surface, a motor and blower to produce an airstream that passes horizontally out of the housing, a heater element to heat the airstream, a delivery conduit coupled to the outlet, and "a swivelable elbow in the delivery conduit proximate the outlet." The purpose disclosed by the appellant for the elbow is noise attenuation (Specification, page 4). After admitting that Guibert fails to disclose the elbow required by the claim, the examiner opines that "Augustine shows that the use of an elbow proximate the outlet is old and well known in the art . . . [and] the purpose disclosed by Augustine would have been recognized in the pertinent art of

Guibert" (Answer, page 4). The determining factor here is not, however, whether elbows were known in the art, but whether one of ordinary skill in the art would have been motivated to add an elbow proximate the air outlet of the Guibert housing. As was the case with claim 20, we fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to do so.

As we noted above, the problem of noise reduction has not been recognized by Guibert. The air issuing from the outlet in the Guibert device is directed to the applicator by a flexible tube. The examiner has not explained, and we are at a loss to find on our own, any reason why the artisan would have added an elbow. As was the case above, the only suggestion for doing so resides in the luxury of the hindsight afforded one who first viewed the appellant's disclosure. This, of course, is an improper basis for concluding that a claim is unpatentable. As our reviewing court stated in *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992),

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight

reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" (citations omitted).

A *prima facie* case of obviousness therefore has not been established with regard to the subject matter of claim 1, and we cannot sustain the rejection of claim 1 or, it follows, of claims 2, 3 and 11-17, which depend therefrom.

SUMMARY

Neither rejection is 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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JOHN F. GONZALES)	
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