

**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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

**Ex parte** DURWARD I. FARIES, JR.,  
BRUCE R. HEYMANN and  
MARK LICATA

---

Appeal No. 97-3002  
Application 08/529,477<sup>1</sup>

---

ON BRIEF

---

Before MEISTER, MCQUADE, and CRAWFORD, **Administrative Patent Judges**.

MEISTER, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is an appeal from the final rejection of claims 2-11, the only claims remaining in the application.

---

<sup>1</sup> Application for patent filed September 18, 1995. According to appellants, this application is a continuation-in-part of Application 08/399,976, filed March 7, 1995, which is a continuation-in-part of Application 08/274,869, filed July 14, 1994, now Patent No. 5,400,616, issued March 28, 1995; which is a division of Application 08/125,279, filed September 23, 1993, now Patent No. 5,331,820, issued July 26, 1994.

Appeal No. 97-3002  
Application 08/529,477

We REVERSE.

The appellants' invention pertains to a method and apparatus for maintaining replenishable supplies of surgical sterile fluids at a preselected temperature. As set forth in the appellants'

ABSTRACT:

Sterile surgical fluid is maintained in one or more temperature controlled basins provided at the top of a cabinet. One or more insulated temperature controlled compartments are formed in the cabinet for storing supplemental supplies of the surgical fluid at the temperatures close to the temperatures of the basins to facilitate replenishing and/or replacing the fluid in the basins. The storage compartments can be used for long-term temperature controlled fluid storage when basin temperature is not being controlled (i.e., between surgical procedures.

The references relied on by the examiner are:

Menzel	4,522,041	June 11, 1985
Templeton	4,934,152	June 19, 1990
Gordon	5,363,746	Nov. 15, 1994

Claims 2, 3, 5-9 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Templeton in view of Menzel.

Claims 4 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Templeton in view of Menzel and Gordon.

We initially note that in rejecting claims under 35 U.S.C. § 103 the examiner bears the initial burden of presenting a **prima facie** case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d

Appeal No. 97-3002  
Application 08/529,477

1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met does the burden of coming forward with evidence or argument shift to the applicant. **Id.** If the examiner fails to establish a **prima facie** case, the rejection is improper and will be overturned. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Here, each of the above-noted rejections is bottomed on the examiner's view that "[i]t would be obvious to provide Templeton with a storage compartment for storing containers of sterile fluid, in view of Menzel, for the purpose of precooling the sterile fluid prior to use" (final rejection, page 2). We do not agree. Templeton is directed to a method and apparatus for maintaining sterile surgical fluid at a desired temperature in a temperature controlled basin provided at the top of a cabinet. As the examiner recognizes, Templeton has no storage compartments whatsoever.

In an attempt to overcome this deficiency the examiner turns to the teachings of Menzel. Menzel, however, is directed to a completely disparate method and apparatus from that of Templeton. That is, Menzel is directed a method and apparatus for making ice cream. To this end, Menzel provides a heating and cooling chamber 2 for accommodating one or more transportable storage

Appeal No. 97-3002  
Application 08/529,477

containers 4 containing ice cream mix. Each storage container is provided with an outlet 6 having a shut-off valve 7 that in turn may be connected to a pump 36 for the purpose of pumping the ice cream mix to a freezing tank 24. Also connected to the top of each storage container 4, is a compressed air line 12 and a return-flow line 14. Thus, while the storage containers 4 of Menzel are removable from the cabinet 1, there are apparently three separate fluid connections on each storage container which must be disconnected prior to removal. From the above, it is readily apparent that while Menzel, at the broadest level, does teach maintaining a storage compartment for fluid containers at a controllable temperature prior to use, it is done so in a completely disparate type of apparatus and environment. Absent the appellants' own disclosure we are at a complete loss to understand why one of ordinary skill in this art would have been motivated to single out the storage compartment having a controllable temperature from Menzel's ice cream making machine and incorporate it into the surgical apparatus of Templeton.

Moreover, even if the teachings of Templeton and Menzel were combined in the manner proposed by the examiner, the claimed invention would not result. More specifically, there is absolutely nothing in the combined teachings of Templeton and

Appeal No. 97-3002  
Application 08/529,477

Menzel which would fairly suggest (1) selectively manually removing the storage containers from a temperature controlled storage compartment and thereafter **pouring** the fluid contents into a basin (independent claims 5 and 11), (2) two storage compartments (independent claim 5), and (3) first and second temperature control means (independent claim 7).

With respect to claims 2 and 10, we have carefully reviewed the teachings of Gordon, but find nothing therein which would overcome the deficiencies of Templeton and Menzel that we have noted above.

The decision of the examiner to reject claims 2-11 under 35 U.S.C. § 103 is reversed.

**REVERSED**

JAMES M. MEISTER	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
JOHN P. MCQUADE	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
MURRIEL E. CRAWFORD	)	
Administrative Patent Judge	)	

Appeal No. 97-3002  
Application 08/529,477

Epstein, Edell & Retzer  
Suite 220  
1901 Research Blvd.  
Rockville, MD 20850

JMM/cam