

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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS A. JENNINGS, THEODORE A. PIERCE,
EUGENE C. PIERCE and CHRISTOPHER A. ONUFRIK

Appeal No. 2003-0161
Application No. 09/578,575

ON BRIEF

Before ABRAMS, OWENS and NASE, *Administrative Patent Judges*
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the final rejection of claims 17-20,
which are all of the claims remaining in the application.

THE INVENTION

The appellants claim a method for vending chilled dairy
products and claim a chilled item server. Claims 17 and 18 are
illustrative:

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17. A method for vending dairy products comprising:

depositing crated dairy products in a server that maintains the dairy products at an effective chilled temperature without ice or electricity;

placing the server in an accessible location for a consumer; and

selling individual dairy products from the server.

18. A chilled item server comprising:

means for holding crates of milk;

means for cooling and maintaining the milk at an effective temperature for consumption without using ice or electricity.

THE REFERENCES

References relied upon by the examiner

Christiansen	3,491,548	Jan. 27, 1970
Cook et al. (Cook)	5,669,233	Sep. 23, 1997

Reference relied upon by the board¹

Hotta ²	4,238,934	Dec. 16, 1980
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THE REJECTION

Claims 17-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Christiansen in view of Cook.

¹ The board also relies upon Christiansen.

² A copy of Hotta is provided to the appellants with this decision.

OPINION

We reverse the aforementioned rejection, enter a new ground of rejection of claims 18-20 under 37 CFR § 1.196(b), and remand the application to the examiner.

The applied references

Christiansen discloses a display canister for retaining and displaying point of purchase food items (col. 1, lines 13-14). The canister includes a generally cup-shaped storage vessel (13) having an insulated wall (45). The storage vessel contains perforated cup-shaped food item storage members (22) and, in an annular zone (26) between the insulated wall and the storage members, a refrigeration coil (28) (figure 2). Coolant in the coil is cooled using a compressor (29). A baffle plate (35) is positioned on support posts (36) in the center of the storage vessel between the perforated food item storage members (figure 2). A fan blade (34) between the perforated food item storage members blows air upwardly against the baffle plate, and the baffle plate deflects the air through the perforated food item storage members, thereby effectively eliminating hot spots and enabling the canister to retain and display items without risk of damage of the items due to unfavorable temperature environments (col. 1, lines 61-67; col. 3, lines 18-20).

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Cook discloses a collapsible and reusable shipping container that maintains its temperature sensitive contents, such as pharmaceuticals, within a desired temperature range (col. 1, lines 5-9 and 15-21). Cooling is provided by frozen gel-containing polymer pouches (heat sinks 48) which are placed in slots in the bottom, sides and top of the container during the process of filling the container, and then the container is shrink wrapped and shipped (col. 7, lines 15-55).

Rejection of claims 17-20

The appellants' claim 17 requires that dairy products in a server are maintained at an effective chilled temperature without ice or electricity. The appellants' claim 18, which is the sole apparatus claim, requires means for cooling and maintaining milk at an effective temperature for consumption without ice or electricity.

During patent prosecution, claims are to be given their broadest reasonable interpretation consistent with the specification, as the claim language would have been read by one of ordinary skill in the art in view of the specification and prior art. See *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

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The server disclosed in the appellants' specification contains molded thermoplastic polymer freezer panels (36, figures 2-4) filled with a cooling agent such as saline solution (water containing a small amount of sodium chloride)³ that has been frozen in a freezer (specification, page 2, lines 25-26). Thus, when we give the "without ice or electricity" in the appellants' claims 17 and 18 its broadest reasonable interpretation in view of the specification, we construe it as excluding only direct contact by ice of the material being cooled, and direct use of electricity in the server. We interpret the term as including the appellants' use of ice in the form of frozen saline solution contained in molded polymer freezer panels, and including the appellants' use of electricity provided to a freezer having therein freezer panels which have been removed from the server.

The examiner argues that it would have been "obvious to modify Christiansen so that the food items therein are chilled without ice or electricity, in view of Cook et al, for the purpose of making it easier and more convenient for consumers to use the server" (final rejection mailed February 8, 2002,

³ See *Hackh's Chemical Dictionary* 594 (Julius Grant, ed., McGraw-Hill 4th ed. 1969).

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paper no. 11, page 2), and that "[t]he Examiner is merely substituting one well-known type of cooling means (the heat sinks 48 of Cook et al) for the conventional compressor-type cooling system used in Christiansen to arrive at the claimed invention of cooling and maintaining the products in the server at an effective temperature without using ice or electricity" (answer, page 3).

For a *prima facie* case of obviousness to be established, the applied prior art must be such that it would have provided one of ordinary skill in the art with both a motivation to carry out the claimed invention and a reasonable expectation of success in doing so. See *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988).

The examiner has not established that the applied prior art itself would have motivated one of ordinary skill in the art to substitute Cook's shipping container frozen cooling panels for Christiansen's electrical system for cooling and blowing cooled air across food items. The examiner's argument that replacement of Christiansen's electrical cooling system by Cook's frozen cooling panels would make it easier and more convenient for consumers to use the server is not supported by any evidence or

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reasoning. The examiner's mere speculation is not a sufficient basis for a *prima facie* case of obviousness. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968); *In re Sporck*, 301 F.2d 686, 690, 133 USPQ 360, 364 (CCPA 1962). Also, the examiner's argument that both frozen panels and electrical cooling systems are well-known cooling means does not take into account the context in which they were known and explain why one of ordinary skill in the art would have been motivated to substitute frozen panels which were known in the context of cooling shipping containers for an electrical cooling system which was known in the context of cooling food items in a display canister.

In addition, the examiner has not taken into account Christiansen's teaching that the cooling system maintains the items at a reasonably constant temperature throughout the entire area of the storage zone (col. 2, lines 31-35), and provided evidence or reasoning which shows that one of ordinary skill in the art would have had a reasonable expectation of success in obtaining such cooling using Cook's frozen panels instead of Christiansen's electrical system.

Because the examiner has not established that the applied references would have provided one of ordinary skill in the art

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with a motivation to carry out the appellants' claimed invention and a reasonable expectation of success in doing so, the examiner has not carried the burden of establishing a *prima facie* case of obviousness of the appellants' claimed invention. Accordingly, we reverse the examiner's rejection.

New ground of rejection

Claims 18 and 19 are rejected under 35 U.S.C. § 103 as being unpatentable over Hotta.

Claim 18: Hotta discloses a constant temperature box for foodstuffs or beverages (col. 1, lines 4-8), comprising a container (3) which can be filled with water, put into a freezer to freeze the water, and then placed in a body (1) of the constant temperature box (col. 1, lines 62-65; col. 2, lines 1-5, 50-52 and 62-65; col. 3, lines 52-54). The interior of the body is closed tight by the container to preserve the cold within the box for a long time (col. 3, lines 20-22). Thus, Hotta's container is capable of cooling and maintaining milk at an effective temperature for consumption without using ice or electricity as required by the appellants' claim 18.

The appellants' claim 18 requires "means for holding crates of milk". Such means include the corresponding structure disclosed in the appellants' specification and equivalents

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thereof. See *In re Donaldson*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994). The means for holding crates of milk disclosed in the appellants' specification is a container, having a bottom and side walls, surrounding the crates (figure 2). The appellants' disclosure does not require that the crates are of any particular size, and the appellants acknowledge that "[c]rates of other items such as bottled water, fruit drinks, food products, soft drinks or beer that are suitably sized could also be located in the server in appropriate circumstances" (brief, page 3).

Thus, the body (1) of Hotta's constant temperature box, having a bottom and side walls (figure 2), is the corresponding structure in the appellants' specification to "means for holding crates of milk" in the appellants' claim 18. Hotta does not disclose that the box is sufficiently large to be capable of holding crates of milk. However, Hotta teaches that such constant temperature boxes can be large in size for storing significant amounts of foodstuffs and beverages (col. 1, lines 30-32). This teaching would have fairly suggested, to one of ordinary skill in the art, a constant temperature box having a sufficient size for storing the desired significant amount of

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beverages, including a size which is large enough that the box is capable of holding at least small crates of milk.

The appellants' claim 18 requires "means for cooling and maintaining the milk at an effective temperature for consumption without using ice or electricity." This means includes the corresponding structure in the specification and equivalents thereof. See *Donaldson*, 16 F.3d at 1195, 29 USPQ2d at 1850. For Hotta's structure to be equivalent to that of the appellants, the differences must be insubstantial, i.e., Hotta's structure and the appellants' structure must perform the same function in substantially the same way to produce substantially the same result. See *Odetics Inc. v. Storage Technology Corp.*, 185 F.3d 1259, 1267, 51 USPQ2d 1225, 1230 (Fed. Cir. 1999).

The structure in the appellants' specification which corresponds to the means for cooling and maintaining the milk at an effective temperature for consumption without using ice or electricity is freezer panels positioned within the container, adjacent to the food or beverage items (page 3, line 2; figure 2). The only disclosed freezer panels are made of blow molded thermoplastic material filled with an approximately 2% saline solution (page 6, lines 8-12).

Hotta's cooling device is a container (3) which is positioned within the box adjacent to the food or beverage items (figure 2). The cooling container can be made of synthetic resin (col. 2, lines 59-61) and can be filled with water and frozen (col. 2, lines 62-65). Synthetic resins can be thermoplastic materials.⁴

Hotta's cooling container is an equivalent structure to the appellants' freezer panels because, as discussed below, it performs the same function in substantially the same way to produce substantially the same result.

The function of the appellants' freezer panels is to cool and maintain food or beverage items at a chilled temperature (specification, page 3, lines 1-2 and 10-12). Hotta's cooling container performs this same function (col. 1, lines 4-8; col. 2, lines 50-52).

The way the appellants' freezer panels function to cool and maintain the food or beverage items at a chilled temperature is by absorbing heat from the food or beverage items, through the thermoplastic freezer panel wall, into frozen saline solution enclosed by the freezer panel wall (page 6, lines 12-15).

⁴ See Hackh's, *supra* note 3, at 579.

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Hotta's cooling container functions by absorbing heat from the food or beverage items, through a wall which can be made of synthetic resin, into frozen water (col. 2, lines 59-65). As mentioned above, a synthetic resin can be thermoplastic, and Hotta's water differs from the appellants' saline solution only in that the saline solution contains a small amount, i.e., about 2%, of salt (specification, page 6, lines 11-12). Thus, Hotta would have fairly suggested, to one of ordinary skill in the art, a cooling container which cools and maintains the food or beverage items at a chilled temperature in substantially the same way as the appellants' freezer panels.

Due to the above-discussed similarity in the positioning and materials of the appellants' freezer panels and Hotta's cooling container, they produce substantially the same result with respect to cooling and maintaining the food or beverage items at a chilled temperature.

Claim 19: The appellants' claim 19, which depends from claim 18, requires "means for insulating the holding means". The corresponding structure in the appellants' specification is insulating material such as polystyrene placed in an annular wall space of the chilled item server (specification, page 5, line 6 - page 6, line 2). Hotta's means for holding the crates of milk,

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i.e., the body of the constant temperature box, is insulated (col. 2, lines 31-32; figure 2). Hotta's insulation, therefore, is the corresponding structure in the appellants' specification to the "means for insulating the holding means" in claim 19.

Claim 20 is rejected under 35 U.S.C. § 103 as being unpatentable over Hotta in view of Christiansen.

The appellants' claim 20, which depends from claim 18, requires "means for conveniently moving the server to a desired location". The corresponding structure in the appellants' specification is casters mounted on the bottom of the chilled item server (specification, page 7, lines 11-14).

Hotta discloses a band (7), inserted through holders (8), for carrying the box (col. 2, lines 48-49; figure 1), but does not disclose casters. However, Hotta teaches that constant temperature boxes can store significant amounts of foodstuffs and beverages (col. 1, lines 30-32). This teaching would have fairly suggested, to one of ordinary skill in the art, when Hotta's container is large for storing significant amounts foodstuffs or beverages, use of a device which is more suitable for moving a large, heavy container than Hotta's band which requires lifting the container. Such a device is casters, as disclosed by Christiansen (col. 1, lines 39-42; col. 2, lines 23-24), which

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enable a container to be moved by being pushed rather than having to be lifted.

REMAND

The appellants' claim 17 encompasses maintaining any crated dairy product at a chilled temperature in a server without direct use of ice or electricity, and otherwise only requires that the server is placed in an accessible location for a consumer and that individual dairy products are sold from the server. The application is remanded to the examiner to determine whether frozen liquid-containing plastic cooling containers like that of Hotta, or other frozen liquid-containing plastic containers, such as frozen water-filled plastic ice cubes, were known in the art for cooling, in a server, crated beverages such as dairy products which are sold as individual items from the server.

The application also is remanded to the examiner for the examiner to consider, with respect to claims 18-20, any prior art disclosures of frozen liquid-containing plastic cooling containers such as frozen water-filled plastic ice cubes which, like that of Hotta, were known to be effective for cooling beverages. The examiner should determine whether such cooling containers 1) are equivalent structures to the appellants' freezer panels, and 2) were known in the art to be suitable for

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cooling and maintaining items at a chilled temperature in a container large enough to be capable of holding at least small crates of milk.

DECISION

The rejection of claims 17-20 under 35 U.S.C. § 103 over Christiansen in view of Cook is reversed. Under 37 CFR § 1.196(b), a new ground of rejection of claims 18-20 has been entered. The application is remanded to the examiner.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, a new ground of rejection shall not be considered final for purposes of judicial review.

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED, 37 CFR § 1.196(b), REMANDED

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Administrative Patent Judge)	
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