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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MITCHELL LEVINSON

Appeal No. 2000-0298
Application No. 08/832,013

ON BRIEF

Before PATE, McQUADE and CRAWFORD, Administrative Patent Judges.

CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 14, which are all of the claims pending in this application.

The appellant's invention relates to a sensor which includes a biasing means having an initial relaxed position which is compressed. The biasing means is expandable upon the absorption of fluid. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant’s brief.

THE PRIOR ART

The prior art references of record relied upon by the examiner rejecting appealed claims are:

Matejcek et al.	3,306,966	Feb. 28, 1967
Wood et al. (Wood)	3,903,232	Sep. 2, 1975
Chung et al. (Chung)	5,247,932	Sep. 28, 1993

THE REJECTION

Claims 1 through 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Chung in view of Wood and Matejcek.

Rather than reiterate the conflicting view points advanced by the examiner and the appellant regarding the above noted rejection, we make reference to the examiner's answer for the examiner's complete reasoning and supported rejection and to the appellant's briefs for the appellant’s arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the

examiner. As a consequence of our review, we make the determinations which follow.

We initially note that the rejection is made under 35 U.S.C. § 103, and that in rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have lead that individual to combine the relevant teachings of the references to arrive at the claimed invention see In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). With this background we analyze the prior art applied by the examiner in

the rejection of the claims on appeal. The examiner finds that Chung discloses the invention substantially as claimed except that Chung includes a biasing bladder comprised of foam which must be flattened during insertion and then re-expanded when the sensor is in the preferred region, as opposed to a pre-compressed foam. The examiner has relied on the teachings of Wood that foam can be used for a variety of medical applications and that the use of compressed foam allows the structures to be readily inserted into the body cavity with subsequent expansion upon contact with body fluids. The examiner relies on Matejcek for teaching an alternate process for preparing contact expandable foams that includes impregnating a foam with defatiguing agent, compressing the foam, and allowing the foam to dry (examiner's answer at pages 3 to 4). From these teachings the examiner concludes:

> It would have been obvious to modify the device and manufacture of Chung et al. to incorporate compressed foam formed by the method of Matejcek et al. for the biasing bladder since this would provide a more convenient form for insertion into the body as taught by Wood et al. [examiner's answer at page 4].

The appellant argues that there is no suggestion to combine the teachings of Chung with those of Wood and Matejcek

because there is no suggestion in Wood and Matejcek to use the foam therein disclosed as a biasing means. We agree with the reasoning of the appellant, and thus we will not sustain the examiner's rejection.

Chung discloses that the bladder 40 is comprised of resilient open-celled polyurethane foam. Chung also discloses that this foam may be replaced with a spring or diaphragm or other biasing mechanism. Wood while disclosing that compressed foam which is expandable may be utilized for insertion into the body, also discloses that this foam is soft and hydrophilic. Wood does not teach or suggest that the foam is resilient or can be utilized as a biasing means. Likewise, while Matejcek does disclose a compressed foam, Matejcek discloses nothing about the resiliency of this foam or the use of the foam as a biasing means. None of these mechanisms meets the limitations in independent claims 1, 10 and 13 requiring a biasing means which has an initial, relaxed, compressed position and is expandable upon the absorption of fluid.

As it is our opinion that there is no suggestion in either Matejcek or Wood for utilizing the foam therein

disclosed as a biasing means, we find no suggestion for combining the teachings as proposed by the examiner.

The decision of the examiner is reversed.

REVERSED

WILLIAM F. PATE, III Administrative Patent Judge	)	
JOHN P. McQUADE Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
MURRIEL E. CRAWFORD Administrative Patent Judge	)	

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