

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte CHRISTIAN A. SVEJK

Appeal No. 2003-0280
Application No. 09/382,120

ON BRIEF

Before FRANKFORT, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 9, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a disposable medical electrode which provides extended use in a high humidity environment (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

| | | |
|-----------------------------------|-----------|---------------|
| Heath | 4,895,169 | Jan. 23, 1990 |
| Anderson et al. (Anderson) | 5,215,087 | June 1, 1993 |
| Montecalvo et al. (Montecalvo) | 5,330,527 | July 19, 1994 |
| Meathrel et al. (Meathrel) | 5,833,622 | Nov. 10, 1998 |

Claims 1 to 3, 8 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Montecalvo in view of Anderson and Meathrel.

Claims 4 to 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Montecalvo in view of Anderson, Meathrel and Heath.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final

rejection (Paper No. 9, mailed July 10, 2001) and the answer (Paper No. 13, mailed December 17, 2001) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 12, filed December 4, 2001) and reply brief (Paper No. 14, filed February 19, 2002) 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. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 9 under 35 U.S.C. § 103. Our reasoning for this determination follows.

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 would have led one of ordinary skill in the art 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) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Claims 1-3, 8 and 9

In the rejection of claims 1-3, 8 and 9 (final rejection, pp. 2-3), the examiner first set forth the pertinent teachings of Montecalvo. Next, the examiner stated the position that any relatively hydrophobic material possesses the functional characteristics set forth in the claims. The examiner then set forth the pertinent teachings of Anderson and Meathrel.¹

In the rejection of claims 1-3, 8 and 9, the examiner did not ascertain the differences between the prior art and the claims at issue² and did not determine that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified Montecalvo in any respect. Thus, for the rejection of claims 1-3, 8 and 9 under 35 U.S.C. § 103 to be proper, claims 1-3, 8 and 9 must be anticipated by Montecalvo since it is well settled that a disclosure that anticipates under

¹ The references to Anderson and Meathrel were cited and applied by the examiner for only one reason, to factually support the conclusion that the pressure sensitive adhesive coating 26 of Montecalvo is in fact a relatively hydrophobic material and accordingly, inherently possesses the functional characteristics set forth in the claims.

² After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgirk v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)) (internal citations omitted):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Thus, a prior art reference may anticipate when the claim limitation or limitations not expressly found in that reference are nonetheless inherent in it. See In re Oelrich, 666 F.2d at 581, 212 USPQ at 326; Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 630, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it

anticipates. See In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). However, inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art. See Mehl/Biophile Int'l Corp. v. Milgraum, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305-06 (Fed. Cir. 1999); Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1946-47 (Fed. Cir. 1999).

All the claims under appeal are directed to a medical electrode comprising, inter alia, (1) a sensor; (2) a hydrophilic hydrogel member; and (3) an adjunct adhesive member whose adhesive nature is either essentially unaffected by high humidity or able to retain its adhesiveness in environments having a relative humidity of more than about 50%.

The examiner states that Montecalvo teaches a medical electrode having a sensor (item 14); a hydrophilic hydrogel member (item 22); and (3) an adjunct member (item 24) which has a pressure-sensitive adhesive coating (26) applied to its exposed surface. The examiner believes that this pressure-sensitive adhesive coating (26) is inherently both essentially unaffected by high humidity and able to retain its adhesiveness in environments having a relative humidity of more than about 50%. The appellant disagrees with this determination of inherency (brief, pp. 7-9; reply brief, p. 3).

The pressure-sensitive adhesive coating (26) of Montecalvo is not either (1) inherently essentially unaffected by high humidity or (2) inherently able to retain its adhesiveness in environments having a relative humidity of more than about 50%. Likewise, the pressure-sensitive adhesive coating (26) Montecalvo is not inherently a relatively hydrophobic material. In our view, the prior art of pressure-sensitive adhesives clearly establishes (1) that some pressure-sensitive adhesives are essentially unaffected by high humidity and thus able to retain their adhesiveness in environments having a relative humidity of more than about 50%; and (2) that some pressure-sensitive adhesives are affected by high humidity and thus lose their adhesiveness in environments having a relative humidity of more than about 50%. As such, the pressure-sensitive adhesive coating (26) Montecalvo does not inherently possess the functional characteristics set forth in the claims under appeal.

Since the subject matter of claims 1-3, 8 and 9 is not disclosed in Montecalvo for the reasons set forth above and the examiner has not set forth any rationale as to why it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified Montecalvo to arrive at the claimed subject matter, the decision of the examiner to reject claims 1 to 3, 8 and 9 under 35 U.S.C. § 103 is reversed.

Claims 4-7

We have reviewed the reference to Heath additionally applied in the rejection of claims 4 to 7 but find nothing therein which makes up for the deficiencies of Montecalvo discussed above. Accordingly, the decision of the examiner to reject claims 4 to 7 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 9 under 35
U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)

Appeal No. 2003-0280
Application No. 09/382,120

Page 10

WILLIAM W. JONES
6 JUNIPER LANE
MADISON, CT 06443

JVN/jg