

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(2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WALTER MCGREGOR
and
SEMYON SHCHERVINSKY

Appeal No. 97-0111
Application 08/139,251¹

ON BRIEF

Before FRANKFORT, STAAB and McQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

¹ Application for patent filed October 20, 1993.

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DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 7. Claims 8 through 12, the only other claims pending in the application, have been withdrawn from further consideration under 37 CFR § 1.142(b).

Appellants' invention relates to a process for the manufacture of suture needles. Claim 1 is representative of subject matter on appeal and a copy of that claim may be found in the Appendix to appellants' brief.

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

Chisman	3,160,157	Dec. 8, 1964
McGregor et al. (McGregor)	4,660,559	Apr. 28, 1987
Everett ² (British Patent Specification)	670,199	Apr. 16, 1952

² While the examiner and appellants have referred to this reference as "Samuel," we note that the inventor's name is "Samuel James Everett."

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Claims 1 through 7 stand rejected under 35 U.S.C. § 103
as being unpatentable over Everett in view of Chisman and

McGregor. According to the examiner,

Samuel [sic, Everett] discloses a cold-working method for manufacturing a surgical needle. Chisman teaches particular lengths may be cut from a blank material and the desired geometrical shapes may be formed. McGregor et al disclose a needle shaped before treating it. See column 6, lines 50-56. It would have been within the purview of one having ordinary skill in the art at the time of applicants' invention to form Samuel [sic] needle by first bending it then cold-working treatment (final rejection, page 2).

Rather than reiterate the examiner's full explanation of the above-noted rejection and the conflicting viewpoints advanced by the examiner and appellants regarding the rejection, we make reference to the final rejection (Paper No. 8, mailed July 21, 1995) and the examiner's answer (Paper No. 11, mailed March 19, 1996) for the examiner's reasoning in support of the rejection, and to appellants' brief (Paper No. 10, filed December 26, 1995) for appellants' arguments thereagainst.

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OPINION

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

articulated by appellants and the examiner. As a consequence of this review, we have made the determination that the examiner's rejection under 35 U.S.C. § 103 will not be sustained. Our reasons follow.

After careful review of the applied references, we must agree with appellants that there is no teaching, suggestion or incentive in the applied references which would have led one of ordinary skill in the art to their combination so as to arrive at the process for producing a suture needle as claimed by appellants. All of the applied references disclose and teach cold-working of the metal wire prior to bending the wire into its curved suture needle configuration. See Everett page 2, lines 37-63; Chisman column 3, line 56 -- column 4, line 37; and McGregor column 6, lines 22-41.

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The examiner's reference to column 6, lines 50-56, of McGregor is of no avail, since this portion of McGregor merely indicates that the needle therein may be first shaped into its curved configuration and then subjected to the laser hardening treatment that constitutes the improvement in that patent. The

reference says nothing about cold-working of the suture needle after bending, and, considered in its entirety, would appear to teach or suggest that the needle be mechanically deformed to produce the desired needle shape prior to any bending operation. In our opinion, the present combination is based entirely on impermissible hindsight derived from appellants' own teachings and not from the prior art references themselves as the teachings thereof would have been understood by one of ordinary skill in the art at the time of appellants' invention.

Lacking any reasonable teachings in the prior art itself which would appear to have fairly suggested the claimed subject matter as a whole to a person of ordinary skill in the art, or any viable line of reasoning as to why such artisan would have otherwise found the claimed subject matter to have been

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obvious in light of the teachings of the applied references, we must refuse to sustain the examiner's rejection of claims 1 through 7 under 35 U.S.C. § 103.

In light of the foregoing, the decision of the examiner is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
)	
)	
LAWRENCE J. STAAB)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

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