

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JAMES J. PASSALAUQA,  
DUSTIN T. LYLE,  
SUSAN C. GORSKI,  
TERI G. JOHNSTON and  
MICHAEL A. METZ

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Appeal No. 98-2788  
Application 08/542,180<sup>1</sup>

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ON BRIEF

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Before CALVERT, FRANKFORT and McQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 9 through 12, which

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<sup>1</sup> Application for patent filed October 12, 1995.

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are all of the claims remaining in the application. Claims 1 through 8 have been canceled.

Appellants' invention relates to a combination of a male external catheter and applicator therefor. More particularly, as is apparent from pages 4, 5, 7 and 8 of the specification, it is the sizing of the annular flap (16) of the male external catheter which appellants view as being the most important and critical aspect of the invention. Independent claim 9 is representative of the subject matter on appeal and a copy of that claim may be found in the Appendix to appellants' brief.

The sole prior art reference of record relied upon by the examiner as evidence of obviousness of the claimed subject matter is:

Metz	5,336,211	Aug. 9, 1994
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Claims 9 through 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Metz.

Rather than reiterate the examiner's position on the above-noted rejection and the conflicting viewpoints advanced by the examiner and appellants regarding the rejection, we refer to pages 4 through 6 of the examiner's answer (Paper No. 10, mailed September 24, 1997) and to pages 8 through 14 of appellants' brief (Paper No. 9, filed June 25, 1997) for the full exposition thereof.

OPINION

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In reviewing the obviousness issue raised in this appeal, we have carefully considered appellants' specification and claims, the applied reference, and the respective viewpoints advanced by appellants and the examiner. As a consequence of our review, we have come to the conclusion, for the reasons which follow, that the examiner's rejection of the appealed claims is not well founded, and that the evidence relied upon by the examiner does not support a conclusion of obviousness with respect to the subject matter of claims 9 through 12 on appeal.

In evaluating the examiner's rejection of claims 9 through 12 under 35 U.S.C. § 103, we agree with the examiner that the only difference between the combination of a male external catheter and applicator as seen in Metz and that set forth in the claims before us on appeal is the particular size relationship of the flap (16) as required in the claims on appeal as compared to the inner sleeve section (15) of Metz. The examiner, recognizing this deficiency in the applied reference, has urged that

“In applicant's [sic] specification, none of these particulars are taught to solve any particular problem or produce any unforeseen result, and therefore are considered an obvious matter of design choice to one of ordinary skill in the art.

Accordingly it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Metz with the circular opening with a diameter in the range of 75 to 92% of the inside diameter of the cylindrical portion and the annular flap having a length between 0.25 to 0.65 inches as a

matter of routine engineering choice barring some convincing evidence of criticality.”  
(Answer, page 5)

After reviewing appellants’ specification and drawings, and for the reasons set forth by appellants in the brief (pages 8-14), it is clear to us that the size limitations at issue cannot be dismissed as merely being a matter of "obvious design choice," based solely on the examiner's bald assertion that such is the case. Appellants’ specification in the paragraph bridging pages 4 and 5, and on pages 6 through 8, describes the critical nature of the sizing and function of the flap (16) of the invention as compared to the sizing and function of the inner sleeve (15) of the Metz patent, which is referred to on page 4 of appellants’ specification. In a proper obviousness determination, the examiner is required to consider the totality of the record and to evaluate even what he might perceive as minor changes in terms of the invention as a whole and in the context of whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to have made the changes that would produce appellants’ claimed combination. See, for example, In re Chu, 66 F.3d 292, 298-99, 36 USPQ2d 1089, 1094-1095 (Fed. Cir. 1995) and In re Gal, 980 F.2d 717, 25 USPQ2d 1076 (Fed. Cir. 1992) which notes that a finding of “obvious design choice” is precluded where the claimed structure and the function it performs are different from the prior art.

For the above reasons, the decision of the examiner rejecting claims 9 through 12 under 35

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U.S.C. § 103 is reversed.

REVERSED

IAN A. CALVERT	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JOHN P. McQUADE	)	
Administrative Patent Judge	)	

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JOHN B. LUNGMUS  
TILTON FALLON LUNGMUS  
and CHESTNUT  
100 SOUTH WACKER DRIVE  
STE. 960  
CHICAGO, IL 60606-4002