

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(2) is not binding precedent of the Board.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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE MICHAEL CHRISTY

Appeal No. 1999-2773
Application No. 08/977,002

ON BRIEF

Before CALVERT, STAAB, and MCQUADE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 9, all the claims in the application.

The subject matter on appeal is defined by claim 1, the only independent claim on appeal, as:

Appeal No. 1999-2773
Application No. 08/977,002

1. In a device for testing for peripheral nerve sensory function in a human patient, said device comprising a handle and extending from said handle, a length of filament for contacting body surface areas of said patient by pressing said filament against said body surface areas until said filament bends and determining if said patient feels said filament, the improvement comprising constructing said filament of nitinol.

The references applied in the final rejection are:

Kanatani	4,313,446	Feb. 2,
1982		
Weinstein et al.	5,492,132	Feb. 20,
1996		
(Weinstein)		

The following reference is applied herein in a rejection pursuant to 37 CFR § 1.196(b):

Nitinol . . . The Material of Choice for Safer, More Effective Medical Procedures (FlexMedics Corp., 1989, 2 pages)
(FlexMedics)

Claims 1 to 9 stand finally rejected under 35 U.S.C. § 103(a) as unpatentable over Weinstein in view of Kanatani.¹

Neither Weinstein nor Kanatani discloses the improvement recited in claim 1, i.e., "constructing said filament of

¹ In the examiner's answer (Paper No. 8), the examiner referred to two additional references, Berg et al and Behl. In response to a remand by this Board on January 27, 2000 (Paper No. 9), the examiner has issued a supplemental answer (Paper No. 10, February 29, 2000; incorrectly numbered Paper No. 8) deleting all mention of the Berg et al and Behl references.

Appeal No. 1999-2773
Application No. 08/977,002

nitinol." Nevertheless, the examiner, noting Kanatani's disclosure that for the filament "wires of other metals or materials having similar physical characteristics [to steel] may be employed" (col. 7, lines 39 to 43), states that the selection of nitinol wire would have been obvious "because it is well known in the medical art that nitinol and steel wires are interchangeable as materials for providing strength, durability, and kink resistance to medical apparatuses." (supplemental answer, page 4).

We will not sustain this rejection. To support a rejection under § 103, evidence of a suggestion, teaching or motivation to modify the prior art is required. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), and cases cited therein. A rejection based on § 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art.

In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), quoted in In re GPAC, Inc., 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995). In the present case, there is no evidence in either of Weinstein or Kanatani to

Appeal No. 1999-2773
Application No. 08/977,002

support the examiner's above quoted statement that the interchangeability of nitinol and steel wires is well known in the medical art. Thus, the examiner's statement appears to be based on impermissible hindsight gleaned from appellant's own disclosure, rather than from the applied prior art.

Rejection Pursuant to 37 CFR § 1.196(b)

Pursuant to 37 CFR § 1.196(b), claims 1 to 7 and 9 are rejected under 35 U.S.C. § 103(a) as unpatentable over Weinstein in view of FlexMedics. The pertinent disclosure of Weinstein is summarized by appellant on pages 4 to 5 of the brief. The FlexMedics publication discloses the advantages of Nitinol for use in medical devices, including, under "The Nitinol Advantage" (second page):

Low Kink Resistance

Because of their shape memory, Nitinol alloys do not take a kink or a permanent set as easily as stainless steel wires. Your initial shape is retained during use.

Reliability

Built-in springback and thermal recovery characteristics return Nitinol components to specified shape repeatedly even after mechanical deformations as high as ten times greater than competitive materials.

Appeal No. 1999-2773
Application No. 08/977,002

In view of this disclosure of FlexMedics, it would have been obvious to one of ordinary skill in the art to use Nitinol instead of nylon for the filament 200 of the Weinstein apparatus. The above-quoted disclosure of FlexMedics would have suggested such a modification of the Weinstein apparatus in order to have a filament which was more resistant to kinking and more reliable in returning to its original shape after deformation.

With regard to claims 4 to 7, Weinstein discloses melting the tip of the filament to give a tip 100 of expanded cross-sectional area. We note that on page 7 of the brief, appellant seems to argue that it would not have been obvious to expand the contact end of a metal filament, i.e., the filament of Kanatani. However, Weinstein's teaching of providing an expanded size end on the filament to prevent slipping and twisting would appear to be equally applicable to metal filaments. The fact that appellant provides an expanded size end for a different purpose does not affect our conclusion that the claimed structure would have been obvious. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992)(references need not be combined for the

Appeal No. 1999-2773
Application No. 08/977,002

reasons contemplated by the inventor). We note that the claims do not require that the expanded cross-section be of any particular size.

Conclusion

The examiner's decision to reject claims 1 to 9 is reversed. Claims 1 to 7 and 9 are rejected pursuant to 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. and Trademark Office 63, 122 (Oct. 21, 1997)). 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 (37 CFR § 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

Appeal No. 1999-2773
Application No. 08/977,002

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. . . .

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)

	IAN A. CALVERT)
	Administrative Patent Judge)
)
) BOARD OF PATENT
	LAWRENCE J. STAAB)
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Appeal No. 1999-2773
Application No. 08/977,002