

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAKE W. PIVAROFF

Appeal No. 2002-2305
Application No. 09/473,792

ON BRIEF

Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 9, 10, 11, 13, 15 and 17, the only claims remaining in this application. Claims 2 through 8, 12, 14, 16 and 18 have been canceled.

As noted on page 1 of the specification, appellant's invention relates to a deep muscle stimulation device which uses percussion and mechanical vibrations that reach deep into the

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muscle tissue, to stimulate proprioceptive functions. Of importance to appellant is the fact that the deep muscle stimulation device therein includes a reciprocating hollow head (44) formed of titanium and containing a quantity of granular material (50), wherein the granular material is loosely held in the head and fills only between one-quarter and one-half the volume of the hollow head. On page 4 of the specification, appellant indicates that various mixtures of granular materials, such as diamond, ruby, copper, bloodstone, garnet, malachite or carbon, produce improved and superior results, with the particular mixture of 10 grains of diamond, 25 grains of ruby, 200 grains of copper and 100 grains of carbon providing "improved and extraordinary" results.

Based on appellant's groupings of the claims found on page 6 of the brief, we see independent claim 1 and dependent claim 9 as being representative. Those claims read as follows:

1. A deep muscle stimulation device comprising, in combination:
 - a body having an elongated hollow handle with an on/off switch, an electrical connection and an electrical motor held herein;
 - a hollow top housing being connected to the elongated hollow handle;

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a cam element having a finger held therein held in the hollow top housing;

the cam element coupled to the electric motor to translate rotary motion of a shaft of the electric motor to reciprocating motion of a titanium hollow head;

the titanium hollow head being attached to a linkage means coupled to the finger to allow reciprocation of the hollow head a predetermined amount, in a rapid manner, determined by the speed of the electrical motor;

the titanium hollow head having a hollow inner chamber with granular material held therein and filing between $1/4$ and $1/2$ of the volume of the hollow inner chamber; and

the hollow inner chamber having approximately 10 grains of granular diamonds, 25 grains of granular rubies, 200 grains of granular copper and 100 grains of carbon therein.

9. The deep muscle stimulation device of claim 1 wherein the hollow head is comprised of a titanium hollow body and a titanium cap secured to the hollow body, and the titanium cap is secured to the linkage means.

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

Priest	1,787,211	Dec. 30, 1930
Kamazawa	4,827,914	May 9, 1989

Claims 1, 11, 13, 15 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kamazawa.

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Claims 9 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kamazawa in view of Priest.

Rather than reiterate the examiner's full commentary regarding the above-noted rejections and the conflicting viewpoints advanced by appellant and the examiner regarding those rejections, we make reference to the examiner's answer (Paper No. 11, mailed May 1, 2002) for the reasoning in support of the rejections, and to appellant's brief (Paper No. 10, filed December 10, 2001) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, to the declaration filed May 14, 2001,¹ and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

¹ Based on the comments found on page 7 of the examiner's answer, we understand that the 12 pages of test results filed with Paper No. 8 on October 1, 2001 have also been entered and considered by the examiner.

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The examiner's reasoning in rejecting claims 1, 11, 13, 15 and 17 under 35 U.S.C. § 103(a) on the basis of the teachings found in Kamazawa is set forth on pages 4-5 of the answer. Essentially, the examiner is of the view that Kamazawa teaches a vibrator or deep muscle stimulation device like that set forth in the independent claims on appeal, except that the device in Kamazawa does not include 1) an on/off switch, 2) the use of the particular mixture of granular material specified in the claims (i.e., a mixture including granular diamonds and rubies along with granular copper and carbon), or 3) the specified amounts of such granular materials totaling 335 grains. According to the examiner, the feature of providing an on/off switch, a particular mixture of granular material including diamonds and rubies, and the feature of choosing particular amounts of the granular materials totaling 335 grains, are each "considered as an obvious design choice." The examiner's reasons for such conclusions are set forth as follows on pages 4 and 5 of the answer:

the feature of choosing a granular material from a mixture of granular diamonds and rubies along with the copper and carbon is considered as an obvious design choice since it appears that Kamazawa's device would perform equally well with the mixture chosen formed of granular diamonds, rubies, copper and carbon. In addition, since appellant fails to provide supports on how and why the additional diamonds and rubies being able to produce improved and superior results, it is

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the examiner's position that choosing a different combination of the mixture which including granular diamonds and rubies is simply a matter of design and fails to patentably define over the prior art.

Furthermore, the feature of choosing a particular amount of the mixture such as 335 grains of a mixture of granular diamonds, rubies, copper and carbon, or approximately 10 grains of granular diamonds, 25 grains of granular rubies, 200 grains of granular copper and 100 grains of carbon is considered as an obvious design choice since it appears that such ratio does not provide any additional advantage benefit so that the specific amount of elements is not a criticality.

Kamazawa does not explicitly disclose the on/off switch. However, the feature of having a switch is considered as an obvious design choice since it is necessary and well known in the art.

In rejecting claims 9 and 10 under 35 U.S.C. § 103(a) on the basis of the collective teachings found in Kamazawa and Priest, the examiner contends that

Kamazawa's hollow head lacks a titanium cap being secured to the hollow body. However, Priest teaches vibrating head having a nut 33 (cap) being coupled to a body 32 for mounting the body 32 to a drive shaft 28. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Kamazawa's head with a cap as taught by Priest, in order to replace the head more easier. In addition, the feature of making the cap of titanium material is considered as an obvious design preference since titanium is a well known material in the art and the material is not a criticality in appellant's invention (see page 4, lines 2-3 of appellant's specification) (answer, page 6).

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Appellant disagrees with the examiner's assertions that the features noted by the examiner to be missing from Kamazawa are merely matters of obvious design choice, and contends that the examiner has engaged in a classic case of hindsight reconstruction. More particularly, appellant urges that the examiner has not given any reason or justification for why the specific choice of materials as claimed by appellant would have been an obvious design choice. Appellant also argues that since there is no motivation or suggestion in Kamazawa, alone or when considered with Priest, to use the specifically claimed materials in the specifically claimed amounts, the examiner's rejection of the claims on appeal is improper. As for the rejection of dependent claim 9, appellant notes that item (33) of Priest, pointed to by the examiner as being a "cap," is a nut to hold the applicator (32) to the shaft (31) and is not a cap, and thus would not have been suggestive of a titanium cap like that required in claim 9.

After reviewing the applied references (Kamazawa and Priest) and considering the teachings one of ordinary skill in the art at the time of appellant's invention would have fairly derived from

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them, we must agree with appellant's assessment of the rejections before us on appeal.

Kamazawa discloses a motorized vibrator (e.g., Figs. 3-4) including, *inter alia*, a titanium hollow head (casing 132) mounted for reciprocating movement, in a rapid manner, determined by the speed of the electric motor (120), said head containing a powdery or granular material (148) enclosed movably in the cylindrical space (140) defined therein and with said material being present in an amount of from about 30 to 80% of the total volume of the space (140). In column 5, lines 44+, Kamazawa notes that the powdery or granular material (148) may be formed of, for example, "a metallic material such as gold, silver, copper, iron, silicon, germanium and niobium, a material coated with such a metallic material, activated carbon, or ceramics." In the portion of the specification bridging columns 5 and 6 of the patent, Kamazawa indicates that movement of the elastic cylindrical member (142) and granular material (148) within the cylindrical space (140) of the hollow head produces heat, and that a "hot effect" on the body part may thus be obtained without using a particular heating means such as an electric heater.

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Notably absent from Kamazawa is any mention or suggestion of granular gem stones, such as diamonds or rubies, or any reason to consider such precious gems as appropriate for use in Kamazawa's vibrator. Thus, given Kamazawa's apparent preference for powdery or granular metallic material and the lack of any teaching or suggestion of granular precious gems, like the diamonds or rubies used in appellant's claimed deep muscle stimulation device, we must agree with appellant that there is no basis (i.e., motivation or suggestion) in Kamazawa, alone or when considered with Priest, to use the specifically claimed materials in the specifically claimed amounts as defined in appellant's claims on appeal, and that the examiner's rejection of claims 1, 11, 13, 15 and 17 on appeal under 35 U.S.C. § 103 is improper.²

As for the examiners reasoning in rejecting claims 9 and 10 under 35 U.S.C. § 103(a) on the basis of the collective teachings of Kamazawa and Priest (answer, pages 6 and 8), we find the proposition that one of ordinary skill in the art would have

² In light of our determination that the examiner has failed to make out a *prima facie* case of obviousness, we find it unnecessary to comment further on appellant's declaration filed May 14, 2001 or the 12 pages of test results filed on October 1, 2001.

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considered the nut (33) of Priest to be a "cap" and the examiner's conclusion (answer, page 8) that "a person of ordinary skill in the art could have appreciated that Kamazawa's head (applicator) could include a cap in view of the Priest's teaching so that the head (applicator) could be removed or replaced more easier," to be totally without support and based entirely on an improper hindsight reconstruction of the claimed subject matter clearly devised after having read appellant's specification and claims.

As is apparent from the foregoing, it is our determination that the examiner has failed to establish a *prima facie* case of obviousness with regard to the subject matter of claims 1, 9, 10, 11, 13, 15 and 17 on appeal. Thus, the rejections posited by the examiner have not been sustained and the decision of the examiner to reject those claims under 35 U.S.C. § 103(a) either on the basis of Kamazawa alone or based on the collective teachings of Kamazawa and Priest, is reversed.

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REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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JENNIFER D. BAHR)	
Administrative Patent Judge)	

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