

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD J. GRABLE,
STEVE PONDER, STEVE GARDNER, PAUL JACKEWICZ
and G.N. PORTER

Appeal No. 2003-0303
Application 09/096,521

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 through 14 and 16 through 19,

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which are all of the claims remaining in this application.
Claims 15 and 20 through 29 have been canceled.

Appellants' invention relates to phantoms for use in optical and magnetic resonance imaging (MRI) quality control. The specification (page 1) informs us that a phantom is a test object that simulates some aspect of the anatomy of interest. An objective of appellants' invention is to provide a phantom that emulates the optical characteristics of breast tissue, that resembles the breast in shape and size, and that can be scanned by MRI and another modality (optical imaging device) to verify its make-up. Independent claims 1 and 12 are representative of the subject matter on appeal and a copy of those claims can 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:

Madsen et al. (Madsen)	5,312,755	May 17, 1994
Nelson et al. (Nelson)	5,719,916	Feb. 17, 1998

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Chance WO 96/20638 July 11, 1996
(Published International application)

In addition to the above-noted prior art references, the examiner has also relied upon applicants' admission of prior art (hereinafter the APA) set forth on pages 1 and 2 of the specification in the "Background of the Invention" section, particularly the concession relating to the known use of INTRALIPID® in medical optical imaging to simulate the optical absorption and scattering characteristics of breast tissue.

Claims 1, 3 through 7 and 9 through 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nelson in view of Chance and the APA.

Claims 2 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nelson in view of Chance and the APA as applied to claim 1 above, and further in view of Madsen.

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Claims 12 through 14 and 16 through 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nelson in view of Madsen, Chance and the APA.

Rather than reiterate the examiner's commentary regarding the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we make reference to the examiner's answer (Paper No. 18, mailed May 5, 2002) for the reasoning in support of the rejections, and to appellants' brief (Paper No. 17, filed April 3, 2002) for the arguments thereagainst.

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 our review, we have made the determinations which follow.

Having reviewed and evaluated the Nelson patent, Chance and the APA, we share appellants' assessment of the examiner's rejection of claims 1, 3 through 7 and 9 through 11 under 35 U.S.C. § 103(a), and agree with appellants that the examiner has not shown any teaching, suggestion, or incentive in the applied references or the APA for modifying the X-ray imaging phantom of Nelson to arrive at the claimed subject matter. More specifically, in our view there is no teaching or suggestion in the applied prior art of a breast-shaped phantom having both 1) a cup forming an outer skin of the phantom having a thickness similar to human skin and having optical transparency at selected optical wavelengths similar to human skin; and 2) a filler material in the cup having optical scattering and absorption characteristics to simulate human breast tissue when imaged by an optical imaging device and also detectable by magnetic resonance imaging to create an MRI image. Thus, the prior art relied upon by the examiner would not have been suggestive of modifying the phantom of Nelson for imaging by

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both MRI and an optical imaging device, as set forth in the claims before us on appeal. In that regard, we share appellants' views as expressed on pages 5 through 11 of the brief, which positions we adopt as our own.

Simply stated, we view the examiner's position regarding the proposed combination of Nelson, Chance and the APA as being based on hindsight and an improper "obvious to try" rationale relying on the general concept of a phantom for X-ray imaging as in Nelson and the known techniques of imaging tissue using MRI and optical examination in Chance, but without any guidance or suggestion in the applied references or the APA as to how to achieve a breast-shaped phantom formed specifically for imaging by both a standard magnetic resonance imaging device and an optical imaging device, or any reasonable indication that it would have been desirable or feasible to do so.

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Since we have determined that the teachings and suggestions found in Nelson, Chance and the APA would not have made the subject matter as a whole of any of claims 1, 3 through 7 and 9 through 11 on appeal obvious to one of ordinary skill in the art at the time of appellants' invention, we must refuse to sustain the examiner's rejection of those claims under 35 U.S.C. § 103(a).

Concerning the examiner's rejections of claims 2, 8, 12 through 14 and 16 through 19 relying on the collective teachings of Nelson, Madsen, Chance and the APA, we share appellants' view that the examiner's further reliance on Madsen fails to remedy the deficiencies of Nelson, Chance and the APA as set forth above. Note particularly, appellants' arguments as set forth on pages 11-14 of the brief. Thus, the examiner's rejections of claims 2, 8, 12 through 14 and 16 through 19 under 35 U.S.C. § 103(a) will likewise not be sustained.

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Since each of the examiner's rejections of claims 1 through 14 and 16 through 19 on appeal under 35 U.S.C. § 103(a) have not been sustained, it follows that the decision of the examiner is reversed.

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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