

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOICHI CHIKUMA

Appeal No. 95-4745
Application 07/977,968¹

HEARD June 3, 1996

Before MEISTER, ABRAMS and STAAB, Administrative Patent Judges
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

Toichi Chikuma (appellant) appeals from the final rejection of claims 2-10, all the claims remaining in the application. We reverse.

¹ Application for patent filed November 18, 1992.

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PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

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The appellant's invention pertains to an improved semiconductor medical treatment device comprising a first pair of diodes and a second pairs of diodes, with the diodes of each pair being antiparallel² orientation relative to each other. In addition, the diodes of the first pair are disposed orthogonally with respect to the diodes of the second pair. Referring to pages 6 and 7 of the specification, the medical treatment device is further described as follows:

As shown in Fig. 2, each set of two diodes 3 is embedded in or laid under a retainer 4 which is made of an electric insulator such as synthetic resin or the like.

As shown in Figs. 3 and 4, the retainer 4 is made of soft synthetic resin, and is stuck onto an adhesive layer 7 which is applied to one side of a circular sticking sheet 6 formed therein with a plurality of through bores 5. A protective sheet 8 made of metal, paper, synthetic resin or the like is stuck onto an upper surface of the adhesive layer 7. Thus, the semiconductor medical treatment instrument 1 is formed.

According to appellant, the device, when applied to the skin, reduces muscular pain. Independent claim 10 is illustrative of the subject matter at issue, and reads as follows:

10. A semiconductor medical treatment instrument,

²Diodes are in antiparallel orientation relative to each other means when paired diodes are disposed parallel to each other with their respective anodes and cathodes pointed in opposite directions. See specification, page 6, lines 10-20; brief, page 3, lines 14-20.

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comprising:

a first diode set having a first diode and a second diode in an antiparallel orientation relative to each other; and

a second diode set having a third diode and a fourth diode in an antiparallel orientation relative to each other, said third and fourth diodes being disposed orthogonally with respect to said first and second diodes.

No references are relied upon by the examiner in rejecting the appealed claims.

The sole ground of rejection of the appealed claims is lack of utility under 35 U.S.C. § 101.³ The examiner states:

[T]he utility of the device [is] in question in that it is questionable, from the Examiner's point of view as to whether the disclosed invention would operate as an analgesic as claimed. One of ordinary skill in the art would question the external application of semiconductor elements, i.e., diodes, on the body for the alleviation of pain. [answer, page 3]

The issue, therefore, is whether the subject matter of appellant's claims fails to meet the utility requirement of 35 U.S.C. § 101 because it is directed to an inoperative device, i.e., a device that fails to produce the result intended.

³In the advisory letter dated August 9, 1994 (Paper No. 13), the examiner indicated that a rejection of the appealed claims under 35 U.S.C. § 112, second paragraph, has been overcome by the amendment submitted July 25, 1994 (Paper No. 10).

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Where an applicant has specifically asserted an invention has a particular utility, that assertion cannot simply be dismissed by an examiner as being "wrong", even when the examiner may believe the assertion is not accurate beyond a reasonable doubt. Rather, the examiner must determine if the assertion of utility is credible. If it is, the examiner should not reject the claimed invention under 35 U.S.C. 101.

To assess credibility, the examiner should determine if one of ordinary skill in the art would consider the assertions of the applicant to have any reasonable scientific basis. If they do, they should not be challenged as not being credible. Only where they do not (e.g., if the assertion is "incredible in view of contemporary knowledge"), should the examiner challenge the statement as not being credible. In making credibility determinations, the examiner must consider the full record of evidence related to the asserted utility. . . .

. . . "Incredible utility", however, is a conclusion, not a starting point for analysis under 35 U.S.C. 101. A conclusion that an asserted utility is "incredible" thus can be reached only after the examiner has evaluated both the assertions of the applicant regarding utility and any evidentiary basis for those assertions. An examiner should be particularly careful not to start with the presumption that an asserted utility is, per se, "incredible" and then proceed to base a rejection under 35 U.S.C. 101 on that presumption.

As made clear from the above quoted portion of the answer, the linchpin of the rejection is the examiner's belief that one of ordinary skill in the art would question the external application of semiconductor elements, i.e., diodes, on the body for the alleviation of pain. The examiner has provided no

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factual basis (e.g., prior art patents or scientific treatises) or technical or logical reasoning supporting this position.⁴ The examiner also has not adequately addressed, in the first instance, appellant's evidence in the record in support of the asserted utility⁵ in arriving at the conclusion that one of ordinary skill in the art would question the alleged utility of the claimed device. Rather, the examiner's view regarding the credibility of the asserted utility is based solely upon the examiner's subjective opinion that one of ordinary skill in the art would question the asserted utility of the claimed device. In effect, the examiner has used her own skepticism of the

⁴The examiner's query on page 4 of the answer as to how the diodes will distinguish "abnormal" electrical activity from "normal" electrical activity of the body is noted. This query does not constitute a technical or logical argument as to why one of ordinary skill would question the asserted utility of the claimed device. Rather, it goes to how the device works and why the diode as applied would function to provide an analgesic benefit. As correctly noted by appellant on page 7 of the reply brief, it is not a requirement of patentability that an inventor know how or why the invention works. *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U.S. 428, 435-36 (1911); *Fromson v. Advance Offset Plate, Inc.*, 720 F.2d 1565, 1570, 219 USPQ 1137, 1140 (Fed. Cir. 1983).

⁵These include, (1) "Japanese Medical Guidance (Nihon of Ido) No. 421 and 422" referred to on page 1 of the specification, translations of which have been submitted; (2) a translated copy of the published article "Development of Granulated-Diode Acupuncture Device and Its Effect" by Torao Hosi, Ryousuke Fujii and Touichi Chikuma, submitted September 7, 1993; and (3) 37 CFR 1.132 declarations of Torao Hosi and Ryousuke Fujii, submitted July 25, 1994.

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asserted utility as the starting point for analysis under 35 U.S.C. § 101 rather than a conclusion based on a well reasoned examination of appellant's statements of utility and evidence in the record in support thereof. As is clear from the above quoted portion of the MPEP, this type of analysis is inappropriate. Accordingly, it is doubtful that the examiner has satisfied her initial burden of establishing a prima facie case of lack of utility. See *In re Langer*, 503 F.2d 1380, 1391, 183 USPQ 288, 297 (CCPA/1974).

While arguing that the specification itself contains sufficient evidence of utility, appellant submitted a translated copy of the published article "Development of Granulated-Diode Acupuncture Device and Its Effect" by Torao Hosi, Ryoussuke Fujii and Touichi Chikuma, and 37 CFR 1.132 declarations of Torao Hosi and Ryoussuke Fujii, submitted July 25, 1994, as further evidence of utility.⁶ In our view, this evidence supports the proposition that semiconductor diode devices similar to the claimed semiconductor diode device have been recognized by individuals in the field of oriental medicine as having a certain degree of

⁶Appellant also submitted additional evidence in a letter dated June 14, 1995 (Paper No. 23) subsequent to the examiner's answer. This additional evidence has not been entered by the examiner and therefore will not be considered. However, whether or not this additional evidence forms part of the record on appeal is moot in view of our reversal of the examiner's rejection.

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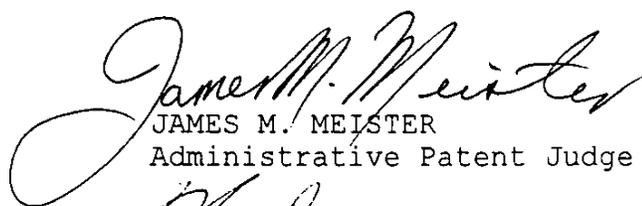
analgesic advantages in the relief of muscular pain. See, for example, the Hosi et al article⁷ (group of subjects complaining of shoulder stiffness treated with semiconductor diode device reported relief of pain as compared to control group of subjects complaining of shoulder stiffness treated with placebo device), and the declarations of Hosi and Fujii (declarants express the opinion, based, inter alia, on clinical tests, that externally applied semiconductor diode device beneficial in the relief of muscle pain). In opposition to this evidence is the examiner's skepticism, unsupported by either evidence or convincing technical or logical reasoning, that "[o]ne of ordinary skill in the art would question the external application of semiconductor elements, i.e., diodes, on the body for the alleviation of pain" (answer, page 3). As was the case in *In re Gazave*, 379 F.2d 973, 978, 154 USPQ 92, 96 (CCPA 1967), appellant's assertion of usefulness in the specification appears to us to be believable, at least in the absence of reason or authority in the record to the contrary. Accordingly, we will not sustain the standing § 101 rejection.

⁷The examiner's criticism of this evidence as being entitled to relatively little weight because it is co-authored by appellant is noted. It is not apparent to why evidence should be dismissed simply because it is authored, in whole or in part, by an appellant.

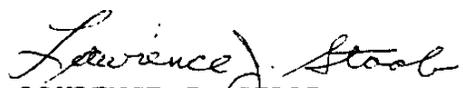
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The decision of the examiner is reversed.

REVERSED


JAMES M. MEISTER)
Administrative Patent Judge)


NEAL E. ABRAMS)
Administrative Patent Judge)


LAWRENCE J. STAAB)
Administrative Patent Judge)

) BOARD OF PATENT
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) INTERFERENCES

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