

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MANFRED FRANETZKI

Appeal No. 96-0943
Application No. 08/142,832¹

HEARD: January 15, 1998

Before McQUADE, NASE, and CRAWFORD, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 17 through 22 and 24 through 28. Claim 23 has been objected to as depending from a non allowed claim. Claims 1 through 16 have been canceled.

We REVERSE.

¹ Application for patent filed October 25, 1993. According to the appellant, the application is a continuation of Application No. 07/913,627, filed July 16, 1992, now abandoned.

BACKGROUND

The appellant's invention relates to a hand-held dental treatment apparatus using laser light. An understanding of the invention can be derived from a reading of exemplary claim 17 which appears in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

Aihara	4,608,980	Sep. 2, 1986
Nagasawa	4,849,859	July 18, 1989
Daikuzono	5,151,097	Sep. 29, 1992

(filed Aug. 28, 1990)

Claims 17 through 22 and 24 through 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Aihara in view of Daikuzono and Nagasawa.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the § 103 rejection, we make reference to the final rejection (Paper No. 20, mailed January 3, 1995) and the examiner's answer (Paper No. 23, mailed June 12, 1995) for the examiner's complete reasoning in support of the rejection, and to the appellant's brief (Paper No. 22, filed April 26, 1995) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we have made the determination that the examiner's rejection of the appealed claims under 35 U.S.C. § 103 is not well founded and will therefore not be sustained. Our reasoning for this determination follows.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

With regard to the examiner's rejection of claims 17 through 22 and 24 through 28 under 35 U.S.C. § 103, we share the appellant's view that the combined teachings of the applied prior art would not have suggested the claimed invention. Specifically, it is our determination that the combined teachings

of the applied prior art would not have suggested the relationship between the handpiece and the carrier means as recited in independent claim 17. In that regard, independent claim 17 requires (1) a handpiece having a longitudinal axis, and (2) a carrier means oriented perpendicularly to the longitudinal axis of the handpiece wherein the carrier means causes laser light to exit the carrier means through a light exit port in a direction perpendicular to the central axis of the carrier means and parallel to the second end of the carrier means (e.g., parallel to the longitudinal axis of the handpiece). Contrary to the position of the examiner, it is our opinion that Daikuzono and Nagasawa would not have provided any motivation to an artisan to make a 90° angle between Aihara's shank 7 and holder 8. It is our view, after a careful review of the combined teachings of the applied prior art, that in searching for an incentive for modifying the laser hand piece of Aihara, the examiner has impermissibly drawn from the appellant's own teachings and fallen victim to what our reviewing Court has called "the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."

W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851

(1984). Since we have determined that the subject matter of independent claim 17 would not have been suggested by the combined teachings of the applied prior art, it follows that we will not sustain the examiner's rejection of appealed independent claim 17, or claims 18 through 22 and 24 through 28 which depend therefrom, under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 17 through 22 and 24 through 28 under 35 U.S.C. § 103 is reversed.

REVERSED

JOHN P. McQUADE)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

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APPLICATION NO. 08/142,832

APJ NASE

APJ McQUADE

APJ CRAWFORD

DECISION: **REVERSED**

Prepared By: Delores A. Lowe

DRAFT TYPED: 20 Jan 98

FINAL TYPED:

HEARD: 15 Jan 98