

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** MARIA PRETEL,  
CATHERINE E. HOOVER,  
ELAINE P. KELLEY and  
JUDITH M. LEON

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Appeal No. 97-4179  
Application 08/510,526<sup>1</sup>

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ON BRIEF

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Before MCCANDLISH, **Senior Administrative Patent Judge**, and,  
MEISTER and STAAB, **Administrative Patent Judges**.

MEISTER, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is an appeal from the final rejection of claims 1-14, the only claims present in the application.

We **REVERSE**.

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<sup>1</sup> Application for patent filed August 2, 1995.

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The appellants' invention pertains to a method and instrument for taking simultaneous measurements of torticollis characteristics. Independent claims 1, 9 and 12 are further illustrative of the appealed subject matter and copies thereof may be found in the appendix to the brief.

The reference relied on by the examiner is:

Schatz, Howard, "An Instrument for Measuring Ocular Torticollis (Head Turn, Tilt, and Bend)", *75 Amer. Acad. Ophthal & Otol.*, pages 650-653 (May-June 1971)

Claims 1-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Schatz.

The examiner's rejection is explained on pages 3-5 of the answer. The arguments of the appellants and examiner in support of their respective positions may be found on pages 3-8 of the brief, pages 1-4 of the reply brief and pages 5-7 of the answer.

#### **OPINION**

As a preliminary matter we base our understanding of the appealed subject matter upon the following interpretation of the terminology appearing in claims 1 and 2 (as they appear in the appendix to the brief). In lines 2 and 3 of claim 1, we interpret "head turn, head tilt and head bend" to be -- head turn

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and either head tilt or head bend -- since it is readily apparent that all three torticollis characteristics are not measured "simultaneously" as lines 1-3 now set forth. In lines 1-3 of claim 2, we interpret "said horizontal protractor means includes means, defining a cutout portion" to be -- said means for enabling manual positioning includes means defining a cutout portion -- since it is readily apparent that the latter mentioned means is a necessary part of the means for enabling manual positioning previously set forth in lines 14-17 of claim 1.

Having carefully considered the respective positions advanced by the appellants in the brief and reply brief and the examiner in the answer, it is our conclusion that the above-noted rejection is not sustainable. In rejecting claims under 35 U.S.C. § 103 the examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) and *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met does the burden of coming forward with evidence or argument shift to the applicant. *Id.* If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

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According to the examiner:

Schatz et al. discloses a device for measuring head turn, tilt, and bend, a horizontal protractor (Fig. 2), and a vertical protractor (Figs. 3,4). It would have been obvious to one of ordinary skill in the art to design a device combining both the vertical and horizontal protractors since this would reduce the time required to take the measurements and since this would provide for a more efficient device. It is noted by the examiner that the horizontal protractor is able to be positioned adjacent the vertical protractor means and positioned in a manner similar to that shown in Figs. 2-4 [of the appellants' device]. This would position the two protractor means at approximately right angles. Also, it would have been obvious to place the protractors in an adjacent relationship at right angles in view of Figs. 2-4. [Answer, page 3.]

We will not support the examiner's position. The mere fact that designing a device combining both vertical and horizontal protractors would reduce the time of making measurements and be more efficient, does not serve as a proper motivation for the proposed modifications as the examiner apparently believes. Obviousness under § 103 is a legal conclusion based on **factual evidence** (*In re Fine, supra*) and it is well settled that in order to establish a **prima facie** case of obviousness the prior art teachings must be sufficient to suggest to one of ordinary skill in the art making the modification needed to arrive at the

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claimed invention (*see, e.g., In re Lulu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984)). Here, Schatz discloses a **single** instrument which may be used in **three different positions** that are illustrated in Figs. 2-4. There is absolutely nothing in Schatz which would suggest combining vertical and horizontal protractors as the examiner suggests, much less making **simultaneous** measurements of torticollis characteristics in the manner claimed. "A rejection based on section 103 must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. . . . [The examiner] may not [,as has been done here,] . . . resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in . . . [the] . . . factual basis." *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967).

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The decision of the examiner to reject claims 1-14 under  
35 U.S.C. § 103 is reversed.

**REVERSED**

HARRISON E. MCCANDLISH, Senior	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
JAMES M. MEISTER	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	

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