

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(2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DRAZEN S. CARIC,
HERMANN JORDAN
and WOLFGANG J. OBERMANN

Appeal No. 1999-0180
Application No. 08/629,260

ON BRIEF

Before CALVERT, ABRAMS and STAAB, *Administrative Patent Judges.*

STAAB, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 2-5, 14-19 and 21. Claims 6-13 and 20, the only other claims pending in the application, have been withdrawn from consideration pursuant to 37 CFR § 1.142(b) as

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not being readable on the elected species. An amendment filed subsequent to the final rejection on July 11, 1997 (Paper No. 12) has been approved for entry by the examiner. See the advisory letter mailed July 28, 1997 (Paper No. 13).

Appellants' invention pertains to a depilation apparatus comprising a depilation member for gripping hairs on human skin and pulling the hairs from the skin. Claim 21, the sole independent claim on appeal, is illustrative of the appealed subject matter. A copy of claim 21 is found in an appendix to appellants' main brief.

The references of record relied upon by the examiner as evidence of obviousness are:

Sciple 1909	919,649	Apr. 27,
Garenfeld et al. (Garenfeld) 1994	5,346,499	Sep. 13,

Claims 2-5, 14-19 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Garenfeld in view of Sciple.¹

Reference is made to appellants' main and reply briefs (Paper Nos. 16 and 18) and to the examiner's answer (Paper No.

¹A rejection of claims 2-5, 14-19 and 21 under 35 U.S.C. § 112, second paragraph, made in the final rejection has been withdrawn. See Paper No. 13.

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17) for the respective positions of appellants and the
examiner regarding the merits of this rejection.

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Looking first at appellants' specification, it is explained on page 1 that in a known depilation apparatus, the depilation member comprises a pair of cooperating rollers, while the vibration member comprises a screen plate which comprises hair passage openings and which prevents the skin from being gripped by the depilation member. The screen plate is pivotable with respect to the housing of the apparatus and is drivable by an electric motor of the apparatus into a pivoting oscillating movement. When the known depilation apparatus is placed on the skin to be depilated, the screen plate exerts mechanical vibrations on the skin. Said mechanical vibrations have an anaesthetizing effect on the skin, relieving pain sensations experienced when hair is being pulled from the skin by the depilation member.

A disadvantage of the known depilation apparatus is that the oscillating screen plate is comfortable on parts of the skin which overlie a relatively soft tissue and hence are relatively insensitive to mechanical vibrations, but rather uncomfortable on parts of the skin which closely overlie a bone and hence are relatively sensitive to mechanical vibrations.

An objective of appellants is to provide a depilation apparatus that is comfortable both on parts of the skin that closely overlie a bone and parts of the skin that overlie relatively soft tissue. To this end, appellants include a

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vibration member having flexible protrusions. As explained on page 2 of the specification,

[o]n parts of the skin which overlie a relatively soft tissue and hence are relatively insensitive to mechanical vibrations, the flexible protrusions are not bent so that the mechanical vibrations penetrate deeply into the skin and into the underlying tissue, and an adequate anaesthetizing effect is achieved. On parts of the skin which closely overlie a bone and hence are relatively sensitive to mechanical vibrations, the flexible protrusions are bent, so that uncomfortable mechanical vibrations of the bone underlying the skin are limited as far as possible.

Garenfeld, the examiner's primary reference, discloses a depilation apparatus 1 having a first depilation member 3 comprising a first set of counter rotating rollers 5, 6, and a second depilation member 4 comprising a second set of counter rotating rollers 5, 6. Garenfeld further includes a vibration member in the form of a pivotally mounted screen plate 15 having hair passage openings therethrough which prevent skin from being gripped by the rollers of the depilation members while allowing hair to pass through the openings to the rollers. The vibrations of the screen have an anaesthetizing effect on the skin to relieve pain sensations experienced when hair is being pulled from the skin. Column 2, lines 48-53. Thus, Garenfeld is akin to the known

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apparatus referred to by appellants on page 1 of the specification.

In rejecting the appealed claims under 35 U.S.C. § 103, the examiner concedes that Garenfeld does not disclose flexible protrusions on the vibration member, as called for in independent claim 21. Nevertheless, the examiner considers that it would have been obvious to one of ordinary skill in the art to provide Garenfeld's vibration member with a plurality of flexible protrusion "since the flexible protrusions are notorious[ly] old and well known in the art for the comfortableness [sic] and easily transmitting [sic] vibration forces into the body" (answer, page 5).

We will not sustain this rejection.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). The mere fact that the prior art *could* be so modified in the manner proposed by the examiner would not have

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made the modification obvious unless the prior art suggested the desirability of the modification. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Here, the applied references simply would not have suggested the desirability, and thus the obviousness, of the proposed modification. In this regard, the examiner's rationale, quoted above, for providing flexible protrusions on the screen plate of Garenfeld in view of Sciple does not suffice. First, the test for obviousness is not what is "notorious[ly] old and well known in the art." Second, it is questionable whether Sciple teaches that prongs 23 increase comfort or facilitate transmission of vibration forces into the body, as implied by the examiner. In this regard, the only instance in Sciple where the prongs 23 are mentioned occurs on page 2, lines 6-10, wherein it is stated the applicator 22 "is molded or otherwise formed of rubber or other suitable elastic material, and is preferably provided with a plurality of projecting flexible prongs 23 for application to the body of the patient." In addition, in that the provision of protrusions on the screen plate of Garenfeld would cause the screen plate, and thus the depilation members of the apparatus, to be spaced

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from the surface of the skin, it is unclear whether the apparatus of Garenfeld would still be suitable for its intended purpose if modified in the manner proposed by the examiner.

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In light of the foregoing, it appears to us that the proposed modification of Garenfeld in view of Sciple is based on the use of impermissible hindsight knowledge derived from appellants' own disclosure, rather than on the fair teachings of the references.

The decision of the examiner is reversed.

REVERSED

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IAN A. CALVERT))
Administrative Patent Judge))
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)	BOARD OF PATENT
NEAL E. ABRAMS))
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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LAWRENCE J. STAAB))
Administrative Patent Judge))

LJS:hh

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