

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DASAN POTTI, JON L. RICHTER and GORDON NEUFELD

Appeal No. 1999-0706
Application No. 08/665,835

ON BRIEF

Before ABRAMS, GONZALES and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 21, which are all of the claims pending in this application. We affirm-in-part.

BACKGROUND

The appellants' invention relates to a tongue cleaner having a shank portion (16), an edge portion (22) for scraping the tongue and a support portion (20) which supports the edge portion. The support portion is skewed relative to the shank portion to slope downwardly, following the downward slope of the posterior portion of the tongue, for effective engagement of the edge with the posterior portion of the tongue without the user having to uncomfortably tilt the shank toward the roof of the mouth (specification, page 2). In another aspect of the invention, the edge portion of the tongue cleaner is contoured to have a relatively deep central portion (38), in order to effectively reach into a depression of the tongue (specification, page 4). A copy of the claims on appeal appears in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Potti	Des. 221,036	Jun. 29, 1971
Robinson	3,635,222	Jan. 18, 1972
Yen-Hui	5,005,246	Apr. 9, 1991

The following rejection is before us for review.

Claims 1-21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Potti in view of Robinson and Yen-Hui.

Reference is made to the brief (Paper No. 13) and the answer (Paper No. 14) for the respective positions of the appellants and the examiner with regard to the merits of this rejection.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

At the outset, appellants' brief (page 4) states that claims 1-3, 5, 7-10, 12 and 14 stand or fall together, claims 4, 6, 11, 13 and 21 stand or fall together and claims 15-20 stand or fall together. We note, however, that appellants have not argued separately the patentability of claims 15-20 apart from claim 1. Therefore, claims 15-20 shall stand or fall with representative claim 1 (see In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978)). In accordance with 37 CFR § 1.192(c)(7), we have selected claims 1 and 21 as the representative claims to decide the appeal of this rejection, with claims 2, 3, 5, 7-10, 12 and 14-20 standing or falling with claim 1 and claims 4, 6, 11 and 13 standing or falling with claim 21.

Turning first to the examiner's rejection of claim 1, the examiner finds that Potti discloses a tongue cleaner as claimed with the exception of the angle between the shank portion

and the supporting portion (answer, page 3). To overcome this deficiency, the examiner relies on the teachings of Robinson.¹

Robinson teaches offsetting the head (the portion of the curette which supports the scraping surface) of a curette relative to the stem thereof in order to facilitate placement of the head in engagement with a wall (the tissue surface to be scraped) without the need for lateral manipulation of the curette and the associated discomfort to the patient (column 1, lines 5-13). We agree with the examiner that it would have been obvious to one of ordinary skill in the art, in view of the teachings of Robinson, to have angled the supporting portion of the Potti tongue scraper relative to the shank portion in order to obtain the self-evident advantages thereof (namely, to facilitate engagement of the supporting portion, which carries the scraping edge portion, with the downwardly sloping posterior portion of the tongue without the need for manipulation of the shank portion up to the roof of the mouth and the discomfort associated therewith).

Appellants argue (brief, pages 5 and 6), in effect, that the curette disclosed by Robinson is for use on a patient by highly trained medical personnel rather than by ordinary individuals on themselves and, further, is directed to unrelated and remote parts of the human body and not specifically to the tongue. Thus, according to appellants, Robinson is non-analogous art to the instant invention. For the following reasons, we do not find this argument persuasive.

¹ While the examiner also finds that Potti lacks the edge portion being contoured to have a relatively deep central portion, this feature is not recited in claim 1.

Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. In re Clay, 966 F.2d 656, 658-59, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986); In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). In this case, we are informed by appellants' specification (page 1, first paragraph) that appellants' invention "relates generally to tongue cleaners, i.e., articles which are used to scrape the upper surface of a person's tongue." As disclosed in column 1, line 2, Robinson is directed to "curette devices generally." Accordingly, we find that Robinson is within appellants' field of endeavor, i.e., scraping devices for scraping tissue from within body cavities, and thus falls within the first category of analogous art. Moreover, appellants' specification (page 1, lines 21-29) further informs us that appellants' invention addresses the problem of reaching the posterior portion of the tongue without the need for the uncomfortable tilting of the shank up to the roof of the mouth. Similarly, Robinson is directed to facilitating engagement of a tissue scraper with the tissue to be scraped without the need for uncomfortable lateral manipulation of the stem portion. For that reason alone, even if

Robinson were not considered to be directed to the same field of endeavor as appellants' invention, Robinson is reasonably pertinent to the particular problem with which appellants are involved.

We are also not persuaded by appellants' further arguments (brief, pages 6 and 7) regarding the perceived structural differences between Robinson's curette and appellants' tongue cleaner. The assertion that the Robinson curette as shown in Figure 1 has the head (18) angled upwardly (not downwardly, as claimed) relative to the insertion tube (12) ignores the teaching by Robinson (column 2, lines 64-68) that the head may be moved to any desired portion of the walls merely by rotating the tube (12) about its longitudinal axis. In other words, Robinson clearly teaches orientation of the device such that the head portion is appropriately angled from the stem (insertion tube) to engage the desired tissue. One of ordinary skill in the art applying this teaching to a tongue scraper would have understood that an orientation in which the supporting portion angles downwardly from the shank portion would have been desirable for engaging the posterior portion of the tongue. As to appellants' argument regarding the flexibility of the branches (24) of the Robinson head, appellants have not alleged that the supporting portion of Potti is not "relatively rigid" and we are at a loss to understand why such flexibility in the preferred embodiment disclosed by Robinson would have dissuaded one of ordinary skill in the art from disposing the supporting portion of Potti at an angle relative to the shank portion to facilitate engagement with the posterior portion of the tongue.

Therefore, in light of appellants' arguments, we find the teachings of Potti and Robinson sufficient, even without the additional teachings of Yen-Hui, to have suggested the subject matter of claim 1. Accordingly, we shall sustain the examiner's rejection of claim 1, and of claims 2, 3, 5, 7-10, 12 and 14-20 which stand or fall with representative claim 1.

Claim 21 recites, *inter alia*, the edge portion "extending generally cross-wise relative to said shank portion and being contoured over its length to have a relatively deep central portion." We find nothing in Yen-Hui which would have suggested provision of such a contour on the Potti edge portion of the Potti tongue scraper. Specifically, while Yen-Hui does illustrate a bulge or thickening (unnumbered) in the tongue scaler (5), such thickening appears to be in the lateral direction and not in the depth and, as such, would not have suggested the modification to the Potti edge portion proposed by the examiner.² Moreover, we have carefully reviewed the teachings of Robinson but find nothing therein which would overcome the above-noted deficiencies of the combination of Potti and Yen-Hui.

Accordingly, we cannot sustain the examiner's rejection of claim 21, or claims 4, 6, 11 and 13 which stand or fall therewith and also require the "relatively deep central portion" on the edge portion.

² To the extent that the examiner may be relying on the central slide rib (42) of the head cover (4) for a teaching of a relatively deep central portion, such reliance is misplaced. Although this rib does form a relatively deep central portion, it is disposed on the bottom of the head cover (4), which covers the removable bristle holder (3), and not on the tongue scaler (5).

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-21 under 35 U.S.C. § 103 is affirmed as to claims 1-3, 5, 7-10, 12 and 14-20 and reversed as to claims 4, 6, 11, 13 and 21. The examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN F. GONZALES)	APPEALS
Administrative Patent Judge)	AND
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JENNIFER D. BAHR)	
Administrative Patent Judge)	

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JB/pgg
Hodgson Russ Andrews Woods and Goodyear
Intellectual Property Practice Group
1800 One M&T Plaza
Buffalo, NY 14203-2391