

The opinion in support of the decision being entered today was **not** written for publication and is **not** precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT A. GALL

Appeal No. 1999-2553
Application No. 08/802,222

ON BRIEF¹

Before STAAB, McQUADE 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 1-10, which are all of the claims pending in this application.

We reverse.

¹ The oral hearing scheduled for January 11, 2001 was waived by appellant (Paper No. 22). Accordingly, this appeal is decided on brief.

BACKGROUND

The appellant's invention relates to a snore prevention device. An understanding of the invention can be derived from a reading of exemplary claims 1 and 5, which read as follows:

1. A snore prevention device for placement in the mouth of a user, the mouth having an exterior portion terminating in upper and lower lips, a posterior portion, and teeth therebetween, comprising:

an oval plate for receipt in the mouth between the teeth and the lips, the plate including an aperture centered therein for accommodating airflow into and out of the mouth; and

a rigid tab member extending lateral from a first side of the oval plate, the tab member immediately adjacent the aperture such that when the oval plate is received in the mouth and the upper and lower lips are separated, the tab member locates the aperture to allow for the flow of air into and out of the mouth therethrough.

5. A snore prevention device for placement in a human mouth having gums therein and terminating at a pair of lips, comprising:

a contoured, elliptical plate for receipt in a mouth between the gums and the lips, the plate including an air passage therethrough; and

means connected to said plate for positioning the air passage in the mouth and for allowing the continuous ingress and egress of air through the air passage when the lips are separated.

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

Moulton	746,869	Dec. 15, 1903
Steil	885,196	Apr. 21, 1908
Helmer	3,768,465	Oct. 30, 1973

The following rejections are before us for review.

(1) Claims 1, 2, 4-8 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Steil in view of Moulton.

(2) Claims 3 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Steil in view of Moulton, as applied above, and further in view of Helmer.

Reference is made to the brief and reply brief (Paper Nos. 16 and 18) and the Office action mailed May 27, 1997 and answer (Paper Nos. 11 and 17)² for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

² Rather than reiterate the explanations of the rejections, the examiner's answer (pages 2 and 3) makes reference to the final rejection. However, the final rejection (Paper No. 14), in turn, merely references Paper No. 11 for an explanation of the rejections. Such a procedure by the examiner is improper. The Manual of Patent Examining Procedure (MPEP) § 1208 (7th ed., Jul. 1998) expressly provides that incorporation by reference in an examiner's answer may be made only to a **single** other action.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims³, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. For the reasons which follow, we cannot sustain the examiner's rejections.

Independent claim 1 requires, inter alia, a plate including "an aperture centered therein for accommodating airflow into and out of the mouth." Independent claim 5, likewise, recites a plate including an air passage therethrough and means for positioning the air passage in the mouth and for "allowing the continuous ingress and egress of air through the air passage when the lips are separated." Stated differently, each of independent claims 1 and 5 requires a plate including an aperture or air passage therein which permits air flow therethrough in both directions, into and out of the mouth.

³ In claim 1, last paragraph, it appears that "lateral" should be "laterally." Additionally, "anti-snoring" in line 1 of claims 4 and 10 should be changed to "snore prevention" for consistency with the terminology used in claims 1 and 5, respectively. While these informalities do not render the scope of the claims indefinite, they are worthy of correction.

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Steil discloses an anti-snoring shield for preventing snoring and promoting the habit of breathing through the nostrils comprising an oval plate (shield A) and prongs B for controlling the position of the shield. Steil does not disclose an aperture or air passage in the shield.

Moulton discloses an anti-snoring device which has as one of its principal objects prevention of the ingress of air through the mouth when breathing and regulation of its egress, so as to cause the air to be admitted to the lungs and expelled therefrom in the natural manner through nasal passages (page 1, lines 30-37). To achieve this objective, Moulton discloses a plate provided with a centrally-disposed flap-valve 2 which normally closes an opening 3 formed in the plate, the valve being adapted "to prevent the ingress of air to the lungs through the mouth when inhaling and to permit a relatively small quantity thereof to be expelled through the opening 3 in the act of exhaling" (page 1, lines 71-78; emphasis ours). Moulton also discloses that, when the nasal passages are partly obstructed, rendering it difficult to admit air through the nose, the plate may be reversed and

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placed in the mouth with its valve opening inwardly, thereby admitting a sufficient quantity of air to supply the lungs but in volume insufficient to cause snoring, the air being forcibly expelled through the nose at each expiration (page 1, lines 88-99).

Neither Steil nor Moulton teaches or suggests a snoring prevention device comprising a plate having an aperture or air passage which permits air flow in both directions, namely, both into and out of the mouth, through the aperture or air passage, as required by independent claims 1 and 5. In this regard, Moulton expressly teaches an air passage which permits air flow in only one direction. While the flow can be in a direction either out of or into the mouth, depending on whether the plate is disposed in the first orientation or the reverse orientation as taught by Moulton, in either case, the air passage is capable of permitting flow in only one direction, not both directions as required by the claims. Thus, even if the teachings of Steil and Moulton were combined as proposed by the examiner, the claimed invention would not

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be the result. Accordingly, the examiner's rejection must fail.⁴

As we have determined that the applied references are insufficient to establish a prima facie case of obviousness of the claimed subject matter, it is unnecessary for us to consider the declaration of Dr. Bojar (Paper No. 12) submitted by appellant to establish the nonobviousness of appellant's invention.

For the foregoing reasons, we shall not sustain the examiner's rejection of independent claims 1 and 5, or of claims 2, 4-8 and 10 which depend therefrom, as being unpatentable over Steil in view of Moulton.

The deficiency noted above finds no cure in the teachings of Helmer. Therefore, we also shall not sustain the examiner's rejection of claims 3 and 9 as being unpatentable over Steil in view of Moulton and Helmer.

⁴ It is elementary that to support an obviousness rejection, all of the claim limitations must be taught or suggested by the prior art applied (see In re Royka, 490 F.2d 981, 984-85, 180 USPQ 580, 582-83 (CCPA 1974)) and that all words in a claim must be considered in judging the patentability of that claim against the prior art (In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)).

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CONCLUSION

To summarize, the decision of the examiner to reject claims 1-10 under 35 U.S.C. § 103 is reversed.

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REVERSED

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JENNIFER D. BAHR)	
Administrative Patent Judge)	

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