

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

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID K. SWANSON et al.

Appeal No. 2000-0324
Application No. 08/763,874

ON BRIEF

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 31-41, 44-49 and 56-61. Claims 43 and 50-55 are allowed. Claim 42 has been objected to as depending from a non-allowed claim. Claims 1-30 have been canceled.

We REVERSE.

Appeal No. 2000-0324
Application No. 08/763,874

Page 2

BACKGROUND

The appellants' invention relates to systems and methods for sensing temperature within the body (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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

Khalil 1980	4,240,441	Dec. 23,
Desai et al. 1995 (Desai)	5,383,917	Jan. 24, (filed July 5, 1991)

Claims 31-41, 44-49 and 56-61 stand rejected under 35 U.S.C. § 103 as being unpatentable over Desai in view of Khalil.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the final rejection (Paper No. 20, mailed March 28, 1998) and the answer (Paper No. 27,

mailed March 12, 1999) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 26, filed October 22, 1998) and reply brief (Paper No. 28, filed May 18, 1999) for the appellants' arguments thereagainst.

OPINION

We will not sustain the rejection of claims 31-41, 44-49 and 56-61 under 35 U.S.C. § 103.

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).

In reaching our above-noted 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. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the

examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal.¹

The teachings of the applied prior art (i.e., Desai and Khalil)² would not have made it obvious at the time the invention was made to a person having ordinary skill in the art to have arrived at the claimed invention. While the teachings of the applied prior art may have made it obvious to such an artisan to have replaced Desai's thermistors 531 with thermocouples to sense the ablation temperature at the electrode tip of Desai's catheter, we fail to find any teaching or suggestion in the applied prior art which would have made it obvious to such an artisan to have located the

¹ In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

² The teachings of Desai and Khalil are set forth in the final rejection (pp. 2-3) and in the brief (pp. 8-9).

reference thermocouple in the location set forth by the claims under appeal (e.g., "in a blood pool" as recited in claim 44). In that regard, it is our opinion that Khalil's teaching of a carotid thermodilution catheter having thermocouple 21 and reference thermocouple 25 mounted on the catheter to provide a convenient measure of local temperature rise at heating coil 19 would not have motivated a person having ordinary skill in the art to modify Desai's catheter to include a reference thermocouple located as set forth in the claims under appeal. Rejections based on 35 U.S.C. § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. In this case, it appears to us that the examiner relied on hindsight in reaching his obviousness determination. However, our reviewing court has said, "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim

to 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, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Since the claimed location of the reference thermocouple is not taught or suggested by the applied prior art, we will not sustain the 35 U.S.C. § 103 rejection of independent claims 31, 44, 57 and 61, and of dependent claims 32-41, 45-49, 56 and 58-60.

CONCLUSION

To summarize, the decision of the examiner to reject claims 31-41, 44-49 and 56-61 under 35 U.S.C. § 103 is reversed.

REVERSED

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

Appeal No. 2000-0324
Application No. 08/763,874

Page 9

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Appeal No. 2000-0324
Application No. 08/763,874

Page 10

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