

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

Paper No. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte W. KEITH THORNTON

Appeal No. 2000-1998
Application No. 08/828,523

ON BRIEF

Before McKELVEY, SCHAFER 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 28-38 and 47-53¹. Claims 45 and 46, also pending in this application, were not rejected in the examiner's final rejection (Paper No. 26). However, in the answer (Paper No. 32, page 3), the examiner indicated that claims 28-34, 36-30 [*sic*, 36-38], 45 and 47 stand rejected. We interpret the statement of the rejection on page 3 of the answer to mean that claims 28-34, 36-38 and 47 remain rejected as in the final

¹ Although both the final rejection and answer indicated that claim 1 is rejected, claim 1 was canceled in an amendment filed December 22, 1994 (Paper No. 2½ in parent Application No. 08/363,639, of which the instant application is a file wrapper continuation) and, thus, is not before us on appeal.

rejection, the rejection of claims 35 and 48-53 has been withdrawn and a new rejection of claim 45 has been added in the answer. New grounds of rejection are expressly prohibited in an examiner's answer by 37 CFR § 1.193(a)(2). Nevertheless, as appellant has not objected to the entry of a new ground of rejection in the answer by petition under 37 CFR § 1.181², we shall decide the appeal of the rejection set forth in the answer.³

BACKGROUND

The appellant's invention relates to a dental device which causes a user's lower jaw to extend forward from its natural position, thereby reducing snoring (specification, page 4) and to a method of treating a user's breathing disorder using such a device. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The examiner relied upon the following prior art references in rejecting the appealed claims:

Kelly	1,146,264	Jul. 13, 1915
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² See Manual of Patent Examining Procedure (MPEP) § 1208.01.

³ In light of our treatment of the rejection, *infra*, it is apparent that appellant has not been prejudiced by our review of the new ground of rejection in the answer.

until the appliance is inserted into the user's mouth and the post contacting a surface of the lower arch after the appliance is inserted into the user's mouth to cause the user's lower jaw to extend forward from its natural position. Likewise, claim 47 recites a method comprising inserting an upper arch having a downwardly extending post into a user's mouth, inserting a lower arch into the user's mouth, the lower arch uncoupled from the upper arch, contacting a surface of the lower arch with the post and causing the user's lower jaw to extend forward from its natural position.

Kelly discloses a dental splint comprising upper and lower U-shaped members A, B connected by one or more pillars 13 which are integral with the members A, B. The connecting pillars are preferably made of malleable or pliable metal which can be bent to change the angularity of the members A, B.

The examiner, recognizing that the lower member B is not uncoupled⁴ from the upper member A, noted that Halstrom discloses upper and lower bite blocks 28, 32 that are releasably connected via a threaded post (stylus 46) and determined that

⁴ The term "couple" is defined as "to join together by fastening or by association; link; connect" (Webster's New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988)).

[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made that the threaded post as taught by Halstrom could be incorporated into the [Kelly] device in order to be able to remove the upper arch from the lower arch [final rejection, page 2].

We are compelled to point out, at the outset, that 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). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion to do so. The mere fact that the prior art *could* be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

In establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). In this instance, the examiner has not

proffered any reason why one skilled in the art would have been led to provide a threaded post on the Kelly splint to permit removal of the upper arch (member) from the lower arch (member).

In any event, even assuming that one skilled in the art would have been led to combine the teachings of Kelly and Halstrom as proposed by the examiner, this would still not arrive at the claimed invention.⁵ In particular, we note that the threaded stylus 46 of Halstrom, which the examiner apparently proposes providing on the Kelly splint in place of the integral pillar(s) 13, must be coupled, by threading, to the upper bite block 28 prior to insertion of the upper and lower bite blocks into the patient's mouth. While the base plate 56 bonded to the lower bite block 32 is provided with a central aperture 64 to allow access to the stylus head 48 to permit threading and unthreading of the stylus 46 into the upper bite block 28 (column 5, lines 56-60), it is apparent that the aperture 64, by virtue of its location on the underside of the lower bite block, can be accessed by a screwdriver or other suitable tool only prior to

⁵ 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)).

insertion of the bite blocks into the patient's mouth. Following the teachings of Halstrom, an oral appliance comprising an upper arch having a post extending downwardly therefrom, as recited in each of the independent claims, for contacting a surface of the lower arch does not result until the stylus has been threaded into the upper arch. Such threading of the stylus into the upper arch, however, also results in coupling of the lower arch to the upper arch and must occur prior to insertion of the upper and lower arches into the patient's mouth. Consequently, Kelly and Halstrom do not teach or suggest an oral appliance comprising an upper arch having a post extending downwardly therefrom and a lower arch uncoupled from the upper arch until the appliance is inserted into the user's mouth, as required by independent claims 28 and 45, or a method comprising inserting an upper arch having a post extending downwardly therefrom and a lower arch into a user's mouth, with the lower arch uncoupled from the upper arch at the time of insertion, as called for in independent claim 47.

For the foregoing reasons, we conclude that the teachings of Kelly and Halstrom are not sufficient to establish a *prima facie* case of obviousness of the subject matter of independent claims 28, 45 and 47, or of claims 29-34 and 36-38 which depend from

claim 28.⁶ Accordingly, we shall not sustain the examiner's obviousness rejection of claims 28-34, 36-38, 45 and 47.

CONCLUSION

To summarize, the decision of the examiner to reject claims 28-34, 36-38, 45 and 47 under 35 U.S.C. § 103 is reversed.

REVERSED

FRED E. McKELVEY)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
RICHARD E. SCHAFER)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JENNIFER D. BAHR)	
Administrative Patent Judge)	

⁶ Consequently, it is not necessary for us to discuss appellant's declaration under 37 CFR § 1.131 in this decision.

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