

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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 RICHARD G. RINCOE and PAUL J. MOORE, JR.

Appeal No. 97-4293
Application No. 08/138,396¹

ON BRIEF

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

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1, 3-5, 9-11, 14-16, 18, 22-29, 41

¹ Application for patent filed October 18, 1993. According to appellants, this application is a division of Application 07/704,615 filed May 23, 1991, now U.S. Patent No. 5,253,656 issued October 19, 1993.

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and 42, which constitute all of the claims remaining of record in the application.

The appellants' invention is directed to an apparatus and method for monitoring contact pressure between body parts and contact surfaces. The subject matter before us on appeal is illustrated by reference to claims 1 and 27, which have been reproduced in an appendix to the Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Fraser et al. (Fraser) 1987	4,649,934	Mar. 17,
Bourland et al. (Bourland) 1989	4,827,763	May 9,

THE REJECTIONS

Claims 1, 3-5, 9-11, 14-16, 18 and 22-26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bourland in view of Fraser.

Claims 27-29, 41 and 42 stand rejected under the judicially created doctrine of double patenting.

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The rejections are explained in the Examiner's Answer.

The viewpoints of the appellants in opposition to the positions taken by the examiner are set forth in the Brief.

OPINION

In reaching our decision on the issues raised in this appeal, we have carefully assessed the claims, the prior art applied against the claims, and the respective views of the examiner and the appellants as set forth in the Answer and the Brief.

The Rejection Under 35 U.S.C. § 103

In rejections under Section 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)), which is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art (see *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)). This is not to say, however, that the claimed invention must expressly be suggested in any one or all of the

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references, rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art (see *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025, 226 USPQ 881, 886-87 (Fed. Cir. 1985)).

Independent claims 1 and 18 stand rejected as being unpatentable over Bourland in view of Fraser. Both of these claims are directed to an apparatus for monitoring the pressure at a plurality of locations along an exterior surface of a body part of a user. The apparatus set forth in each comprises a plurality of pressure sensors adapted to be interposed between the body part and a surface with which it is in contact and operative in response to the compressive pressure between the two to generate a signal proportional to this pressure, monitor means for receiving the force signal and producing an output signal corresponding thereto, processing means including command means for generating a read signal to cause the monitor means to generate the output signals, and at least one switch means adapted to be positioned remotely of the processing means for producing a

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signal to cause the monitor to initiate a read event. It is the examiner's position that Bourland discloses all of the structure recited in these two claims except for the switch means, which is taught by Fraser, and that it would have been obvious to replace the computer-initiated system of Bourland with the remote switch of Fraser (Answer, page 4). We find ourselves in agreement with the appellants that this rejection is not sustainable.

The language of the two claims in reciting the switch means is identical:

[A]t least one switch means adapted to be positioned remotely of said processing means and in proximity to said body part, said switch means for producing a switch active signal in response to one of a plurality of events initiated by force caused by said body part acting on said switch means and indicative of specific pressure states on said body part (emphasis added).

The switch means disclosed in Fraser is activated by the operator of the joint laxity measuring device that is operating upon the joint of the patient. The examiner's opinion is that "the applicant's [sic] intended use of the patient initiating the switch means rather than the operator does not serve to structurally differentiate the claimed

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apparatus since the patient could initiate the switch means of the modified device" (Answer, page 5). In our opinion, however, this ignores the limitation underlined in the portion of the claim quoted above which, in view of the description of the invention in the specification we interpret to mean that the switch be adapted to be so positioned as to be operated by "said body part," which means the body part of the patient that is the subject of the force profile, and not just any body part of any person. There is no such teaching in Fraser. From our perspective, the most that Fraser might have suggested to one of ordinary skill in the art is to provide the Bourland apparatus with a switch so located as to be activated by the operator, as is pictured in Fraser's Figure 1.

It is our conclusion that the teachings of Bourland and Fraser fail to establish a *prima facie* case of obviousness with regard to the subject matter of independent claims 1 and 18. We therefore will not sustain the rejection of those claims or, it follows, of claims 2-5, 9-11, 14-16 and 22-26, which are dependent therefrom.

The Double Patenting Rejection

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The examiner has rejected claims 27-29, 41 and 42 under the judicially created doctrine of double patenting, on the theory that the allowance of these claims would extend the rights to exclude already granted to the appellants in U.S. Patent No. 5,253,656. By way of background, on May 23, 1991, the appellants filed the application that matured into the cited patent and also forms the basis for the present application, which is a division thereof. This occurred at the appellants' bidding, when they chose to cancel the claims in the earlier application that were under rejection so that a patent could be issued on those claims which the examiner had indicated contained patentable subject matter.

The proper test in the present situation is whether the claims of the application are merely an obvious variation of the claims of the patent. See *In re Goodman*, 11 F.3d 1046, 1052, 29 USPQ2d 2010, 2015 (Fed. Cir. 1993). The appellants point out that claim 27 calls for "disposing at least one switch on said prosthesis" for producing a switch active signal "whereby said step of executing a read event occurs in response to said switch active signal," as opposed to patent claim 13, which does not recite a switch on the prosthesis and

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requires only that the read event be accomplished "at a selected time." They also note that claim 27 requires that an array of sensors be scanned, a limitation not present in claim 13.

As to the first situation, it is our view that, notwithstanding the failure of patent claim 13 to recite a "switch," it would be understood that there must in fact be such a device in order to activate the apparatus so that a read event will occur at a "selected time." And, because claim 13 requires that the selected time be "during an interval within which the person employs said prosthesis whereby each respective force signal is used to generate an output signal indicative of the pressure sensed by the respective sensor," we believe one would recognize that the switch that accomplishes this must be disposed on the prosthesis. As for the requirement in claim 27 of scanning an array of sensors to generate the required output signals, claim 13 recites "a plurality of pressure sensors," the force signals of which are monitored as a read event. In our view, this could be accomplished only by scanning an array of sensors.

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The appellants' arguments have not convinced us that the invention set forth in application claim 27 is patentably distinct over the one described in the claims of the patent. At best, it is an obvious variation of the invention defined in the patent claims. As stated in *In re Schneller*, 397 F.2d 350, 355, 158 USPQ 210, 215 (CCPA 1968), "[t]he controlling fact is that patent protection for the [invention] . . . covered by the claims of the patent, would be extended by allowance of the appealed claims". We conclude that to be the case here. The double patenting rejection of claim 27 is sustained, along with the rejection of claims 28 and 29, for which separate arguments were not provided.

The same rationale dictates the same result with regard to claims 41 and 42. The appellants note here that claim 41 recites a single switch disposed on a portion of the prosthesis, whereas claim 1 of the patent requires a plurality of switch means, and thus is more limiting in scope. This being the case, they argue, claim 1 "would not encompass a device having a single switch" (Brief, pages 14 and 15). This argument fails, however, for claim 41 does not recite a single switch, but "a switch" (emphasis added), and since it presents

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its elements in the "comprising" format, it is not limited to a single switch. The invention of application claim 41 thus is not patentably distinct from the invention recited in patent claim 13 but is at best an obvious variation thereof. The rejection of independent claim 41 and dependent claim 42, the separate patentability of which was not argued, is sustained.

The double patenting rejection of claims 27-29, 41 and 42 is sustained. It can be overcome only by the filing of a terminal disclaimer.

SUMMARY

The rejection of claims 1, 3-5, 9-11, 14-16, 18 and 22-26 under 35 U.S.C. § 103 is not sustained.

The rejection of claims 27-29, 41 and 42 under the judicially created doctrine of double patenting is sustained.

The decision of the examiner is affirmed-in-part.

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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
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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LAWRENCE J. STAAB)	
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