

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(2) is not binding precedent of the Board.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. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK S. JONES

Appeal No. 98-3327
Application 08/606,651¹

ON BRIEF

Before CALVERT, ABRAMS, and NASE, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1, 4-6 and 20. Claims 2, 3 and 7 have been canceled and claims 8-19 have been withdrawn from

¹ Application for patent filed February 26, 1996.

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consideration as being drawn to a non-elected invention. No claims have been allowed.

The appellant's invention is directed to an ophthalmic probe. The claims on appeal have been reproduced in an appendix to the Brief.

THE REFERENCE

Easley <i>et al.</i> (Easley)	5,441,496	Aug. 15,
1995		

THE REJECTION

Claims 1, 4-6 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Easley.

The rejection is explained in Paper No. 6 (the final rejection).

The opposing viewpoints of the appellant have been expressed in the Brief.

OPINION

As set forth in independent claim 1, the appellant's

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invention is directed to an ophthalmic probe for surgery and the like, which comprises a handpiece having a hollow needle extending therefrom, a connector for connecting the handpiece to a source of energy, an optical fiber for transmitting the energy to the distal end of the needle, and a soft tip molded in place on an inner bushing of the needle that extends outwardly from an outer metal tube. We agree with the examiner that Easley discloses all of the subject matter of claim 1 except for the requirement that the soft tip be "molded in place to the inner bushing," for in the Easley arrangement, the soft tip is not located at the tip of the outer metal tube of the needle, but is held in place by means of an extension that is friction fitted into the annular space between the outer metal tube and the inner bushing. However, it is the examiner's position that

[i]t is considered an obvious design consideration to have molded the soft tip to the inner bushing, as is well known in the art, in as much as this means for attachment is different in kind but not in effect (Paper No. 6, page 2).

The appellant argues that the required motivation for doing so is lacking. On this point, we find ourselves in agreement with the appellant, and it is for this reason that we cannot

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support the examiner's position.

It is axiomatic that the test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, ***In re Keller***, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). 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). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, ***Uniroyal, Inc. v. Rudkin-Wiley Corp.***, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

The examiner has stated, in so many words, that molding in place as a technique for attaching two elements of a device was known in the art at the time of the appellant's invention.

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However, no evidence has been provided in support of this conclusion, which relegates it to the status of unsubstantiated opinion. The examiner then moves on from this to the further conclusion that the presence of such knowledge in the art in and of itself would have made it obvious to substitute molding in place for other methods of attachment. We cannot agree, for even taking the examiner's first statement at face value, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See **In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The examiner has not set forth, and we are at a loss to perceive on our own, any teaching, suggestion or incentive which would have led one of ordinary skill in the art to modify the Easley probe in the manner proposed by the examiner. That is, why would one of ordinary skill in the art have been motivated to discard the attachment means disclosed by Easley in favor of the one in which the soft tip is molded in place to the inner bushing of the needle. From our perspective, the only suggestion for doing so is found in the luxury of the hindsight afforded one who first viewed the

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appellant's disclosure. This, of course, is improper. See **In re Fritch**, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

It is our conclusion that a *prima facie* case of obviousness has not been established on the record with regard to the subject matter recited in claim 1. This being the case, we will not sustain the rejection of claim 1 or, it follows, of claims 4-6 and 20, which depend therefrom.

The decision of the examiner is reversed.

REVERSED

Ian A. Calvert)
Administrative Patent Judge)
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	Neal E. Abrams)	BOARD OF
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	Administrative Patent Judge)	APPEALS AND
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