

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(2) is not binding precedent of the Board.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 GARY W. EDGAR

Appeal No. 1999-0739
Application 08/747,663¹

ON BRIEF

Before FRANKFORT, STAAB and NASE, Administrative Patent
Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed November 13, 1996. Accord-
ing to appellant, the application is a continuation-in-part of
Application 08/400,829, filed March 8, 1995, abandoned.

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This is a decision on appeal from the examiner's final rejection of claims 1 through 18, all of the claims pending in this application.

Appellant's invention relates to a tongue cleaning and treating device. Of importance to appellant is the requirement that the device be effective for cleaning the surface of the tongue and particularly that portion of the tongue's surface that is located under the taste buds. As noted on page 1 of the specification, much of the surface of the tongue is covered with taste buds which protrude from the tongue and provide small areas between and under such projections where bacteria, minute food particles, and cellular debris tend to accumulate. Conventional methods of cleaning the tongue and applying medication or mouth-rinse to the tongue are said to be ineffective in dealing with the area of the tongue surface under the taste buds. A preferred embodiment of appellant's invention is said to include a plurality of hollow, rigid mechanical fingers (5) which gently part the tops of the taste buds while simultaneously

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introducing a liquid under pressure, via openings (7) in the ends of the fingers, between the taste buds and onto the floor of the tongue. Independent claims 1 and 12 are representative of the subject matter on appeal and a copy of those claims can be found in the Appendix to appellant's brief.

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

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| Curtis et al. (Curtis) | 5,098,291 | Mar. 24, 1992 |
| Nack et al. (Nack) | 5,226,197 | July 13, 1993 |

As stated in the final rejection (Paper No. 6), claims 1 through 6 and 8 through 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Curtis, while claims 7 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Curtis in view of Nack.²

² While the examiner has not expressly repeated all of the rejections applicable to the claims before us on appeal in the examiner's answer (Paper No. 9), it is clear from a review of the final rejection, appellant's brief (Paper No. 8) and the totality of the examiner's answer (particularly sections 3, 6, 7 and 8) that the rejections as stated above are those that are before us for consideration on appeal. We are at a loss to understand why all of the applicable prior art references

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Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding the rejections, we make reference to the final rejection (Paper No. 6, mailed March 27, 1998) and the examiner's

answer (Paper No. 9, mailed October 16, 1998) for the reasoning in support of the rejections, and to appellant's brief (Paper No. 8, filed August 21, 1998) for the arguments thereagainst.

OPINION

and rejections were not repeated in the examiner's answer. Normally, rejections of claims which are not repeated in the examiner's answer are considered to have been withdrawn by the examiner. See, for example, Ex parte Emm, 118 USPQ 180 (Bd. App. 1957). In the present case, we note that appellant's grouping of the claims as set forth on page 3 of the brief in no way relieves the examiner of the obligation to expressly state in the examiner's answer exactly what rejections are before the Board for review.

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In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

Looking at page 3 of the brief, we note that appellant has indicated that independent claims 1 and 12 are separately patentable, that dependent claims 2 through 11 stand or fall with claim 1, and that dependent claims 13 through 18 stand or fall with claim 12. Thus, we focus our discussions below on independent claims 1 and 12, and consider that the dependent claims before us on appeal will stand or fall with their respective independent claims.

Independent claims 1 and 12 each define appellant's device for cleaning and treating the tongue as including, inter

alia, a plurality of rigid fingers. In claim 1, these rigid fingers are said to provide means for parting the taste buds of the tongue while applying a liquid directly to the surface of the tongue. In claim 12, the rigid fingers are indicated to be shaped and sized for movement across the tongue and as including openings where the fingers come into contact with the tongue for applying liquid to the tongue during use of the device.

In rejecting claims 1 through 6 and 8 through 17 under 35 U.S.C. § 103 based on the Curtis patent, the examiner has taken the position that Curtis discloses, in Figure 5, an embodiment of the invention therein that can be considered to be a tongue cleaning device and which has a plurality of hollow bristles (e.g., 43 in Fig. 5), a liquid reservoir, and means for allowing the application of liquid to the tongue through the hollow bristles (see particularly, Curtis col. 6, lines 19-60).

While recognizing that the hollow bristles of the toothbrush head (40) in Curtis Figure 5 are flexible and therefore not

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responsive to the "rigid fingers" limitation set forth in each of the independent claims on appeal, the examiner urges that the bristles of the toothbrush head in Curtis are capable of parting

the taste buds and thereby of also allowing liquid to be delivered via the hollow bristles to the surface of the tongue.

Based on this determination, the examiner concludes (final rejection, page 3) that appellant has not disclosed "the criticality of the fingers being rigid," and urges that it therefore would have been "[an] obvious matter of design choice to employ such limitation on the Curtis et al device since the applicant has not disclosed that such solves any stated problem or is for any particular purpose, and it appears the device would work equally well with flexible hollow bristles."

Like appellant (brief, pages 4-8), we find the examiner's rejection of independent claims 1 and 12 on appeal based on Curtis to be improper. In the first place, it is the applicant, not the examiner, who determines what the invention is and what features or characteristics of the invention are important or critical for carrying out the invention. In the present case, appellant has both disclosed and claimed that his device for cleaning the tongue includes a plurality of rigid fingers that gently part the tops of the taste buds while simultaneously introducing liquid between the taste buds onto the floor of the tongue. Thus, whether or not the examiner considers the limitation of "rigid fingers" to be critical to carrying out the objectives of appellant's invention, or nor, is irrelevant, since appellant discloses and expressly sets forth in the claims on appeal that the tongue cleaning device includes "rigid fingers" and provides his reasons why such fingers should be rigid. As a second point, even if the hollow, flexible bristles of Curtis might be capable of functioning to part the taste buds of a user's tongue in the manner claimed

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(a point of some debate and speculation since we have no idea exactly what the flexibility of the bristles in Curtis may be), it does not follow that the "rigid fingers" of appellant's claims on appeal lack utility or are somehow of less significance in a determination of obviousness under 35 U.S.C. § 103.

With respect to the examiner's conclusion that it would have been merely an obvious matter of design choice for one of ordinary skill in the art to employ rigid fingers on the Curtis device in place of the bristles (43), we must agree with appellant (brief, pages 6-7) that such a modification is directly contrary to the clear teachings in Curtis (col. 6, lines 55-59) regarding the need to maintain flexibility of the bristles therein, and would in fact destroy the toothbrush head embodiment

(Fig. 5) of the Curtis device for its intended purpose. As was

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pointed out by appellant (brief, page 7), the claimed invention, when considered as a whole, is not a toothbrush and has no such capability, but is intended only for cleaning the tongue and is so structured as to achieve this result. By contrast, the device seen in Figure 5 of Curtis is expressly described as being a toothbrush with flexible bristles and is clearly intended for an entirely different use, which use requires that device to have structural characteristics that are distinctly different from those of appellant's claimed tongue cleaning device.

Since the teachings and suggestions found in Curtis would not have made the subject matter as a whole of claims 1 and 12 on appeal obvious to one of ordinary skill in the art at the time of appellant's invention, we must refuse to sustain the examiner's rejection of claims 1 and 12 under 35 U.S.C. § 103.

It follows that the examiner's rejection of claims 2 through 6 and 8 through 11 (which depend from claim 1) and of claims 13 through 17 (which depend from claim 12) under 35 U.S.C. § 103 based on Curtis alone will also not be sustained.

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We have additionally reviewed the patent to Nack applied along with Curtis by the examiner against dependent

claims 7 and 18. However, we find nothing in this patent which would change our view as expressed above, i.e., nothing which would supply that which we have indicated above to be lacking in Curtis. Thus, the examiner's rejection of claims 7 and 18 under 35 U.S.C. § 103 will also not be sustained.

In view of the foregoing, the examiner's decision rejecting claims 1 through 18 of the present application under 35 U.S.C. § 103 is reversed.

REVERSED

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|--------|-----------------------------|---|-------------|
| | CHARLES E. FRANKFORT |) | |
| | Administrative Patent Judge |) | |
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| PATENT | |) | BOARD OF |
| | LAWRENCE J. STAAB |) | APPEALS AND |

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