

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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LARRY H. DODGE

Appeal No. 2004-0455
Application No. 09/540,592

ON BRIEF

Before ABRAMS, NASE, and BAHR, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3, 4 and 6, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a tip for dispensing adhesive sealants and the like. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's Brief.

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

Antanavich (PCT Application)	WO 97/28834	Aug. 14, 1997
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Tovey (European Patent Application)	EP 858 775 A1	Aug. 18, 1998
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Claims 1, 3, 4 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Antanavich in view of Tovey.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the Answer (Paper No. 12) and the final rejection (Paper No. 7) for the examiner's complete reasoning in support of the rejection, and to the Brief (Paper No. 11) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the

respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The appellant's invention is directed to improvements in dispensing tips for dispensing adhesive tissue sealants and other liquid preparations that require mixing of multiple components immediately prior to use. Among the features recited in independent claim 1 are a first rigid section having at least two lumens therethrough, a second rigid section having an opening for dispensing material and comprising at least one static mixing element, and a flexible section interposed between the first and second rigid sections

wherein the flexible section has a preset bend so as to urge the first and the second rigid sections towards a preset angle to one another.

The examiner has rejected claim 1 as being obvious¹ on the basis of the teachings of Antanavich taken in view of those of Tovey. In particular, the examiner has found all of the subject matter recited in claim 1 to be disclosed or taught by Ananavich, except for the flexible section having a preset bend. However, it is the

¹The 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).

examiner's position that it would have been obvious to add this feature to Antanavich in view of the teachings of Tovey "for the purpose of altering the dispensing angle with respect to the longitudinal axis" (Paper No. 7, page 4). The appellant provides several arguments in rebuttal to this position, the essence of them being that there is no suggestion to combine the references in the manner proposed by the examiner.

Antanavich is directed to a device for dispensing two ingredients which are mixed immediately prior to exiting the dispensing tip. Disclosed in Figure 9 is a dispensing tip having a first rigid section 38 comprising a pair of lumens through which the ingredients to be mixed are passed, a flexible section 62, and a second rigid section 24 which includes a static mixing element 24. There is no disclosure or teaching that the flexible section includes a "preset bend" which will "urge the first and the second rigid sections towards a preset angle to one another." Therefore, as conceded by the examiner, the primary reference lacks disclosure or teaching of the preset bend recited in claim 1.

Tovey also is directed to an apparatus for dispensing multiple ingredients that must be mixed immediately prior to application. Among the embodiments disclosed by Tovey are, in Figures 12 and 12A, an applicator having "bellows 118 for effectuating articulation of the applicator tip 26 for altering the dispensing angle with respect to the body portion 16," to which the examiner referred in the explanation of the final rejection on page 4 of Paper No. 7 and in the response to the appellant's arguments on page 6 of the Answer, and the embodiment shown in Figures 13 and 13A, which the examiner

added in the discussion of the appellant's arguments on page 6 of the Answer. The latter embodiment provides a section of "memory metal 120" which can be pushed from the end of the straight rigid section in which it is housed, whereupon it assumes a curved shape for in order to "alter the dispensing angle as sleeve 122 is moved proximally" (column 8, lines 43-48).

What we find to be lacking in the examiner's rejection is the required suggestion to combine the references in the manner proposed. Antanavich discloses in the embodiment of Figure 9 a flexible section interposed between the two rigid sections "for application of tissue sealant at a distance from the syringe (e.g., in a body cavity made accessible by laparotomy)." From our perspective, one of ordinary skill in the art would have been taught nothing more than this by the embodiment of the Tovey invention shown in Figures 12 and 12A. With regard to the embodiment shown in Tovey's Figures 13 and 13A, 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,² and the examiner has not adduced evidence why one of ordinary skill in the art would have been motivated to install a section of curved "memory metal" or other form of "preset bend" in the Antanavich device in place of or in conjunction with the flexible section already present. It therefore is our opinion that the examiner has failed

²In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

to establish a prima facie case of obviousness with respect to the subject matter recited in claim 1, the sole independent claim, and therefore we will not sustain the rejection.

CONCLUSION

The rejection of claims 1, 3, 4 and 6 as being unpatentable over Antanavich in view of Tovey is not sustained.

The decision of the examiner is reversed.

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
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JENNIFER D. BAHR)	
Administrative Patent Judge)	

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