





Claim 19

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2 Gelfer discloses “an acupuncture treatment device comprising a flexible  
3 pad adapted to be pressed against a person’s skin to stimulate blood circulation and  
4 safely relieve pain caused by stress, exercise or accident” (Gelfer, col. 1, ll. 9-13).  
5 The flexible pad comprises a flexible backing sheet (10) that “can be canvas, or  
6 heavy cloth, or a thin sheet of non-woven plastic material” (Gelfer, col. 3, ll. 7-9).  
7 In one embodiment one face of the flexible backing sheet has spaced-apart rigid  
8 blocks (11) affixed to it (Gelfer, col. 2, ll. 16-19). “Each rigid block has one or  
9 more sharp edged protuberances [14, 15] extending away from the sheet so that  
10 when the pad is pressed against a person’s skin the sharp edges penetrate or  
11 depress the skin to exert an acupuncture effect” (Gelfer, col. 2, ll. 19-23). “The  
12 protuberances may be conical in nature, in which case the sharp edges will be  
13 defined by the sharpened pointed ends of the conical elements” (Gelfer, col. 2,  
14 ll. 23-26; figs. 3, 4). In another embodiment each acupuncture block comprises an  
15 elongated, rectangular cross-section bar (19) that is adhesively attached to the  
16 flexible backing sheet and has convergent side surfaces (22) extending away from  
17 the sheet to form an elongated knife edge (23) (Gelfer, col. 4, ll. 42-48; figs. 5, 6).

18 Leupold discloses an acupuncture device comprising a plastic holder (1)  
19 having the shape of a finger ring (Leupold, col. 2, ll. 60-61). In one embodiment  
20 the holder has a flat depression surrounding a preshaped part (8) having a widened  
21 flange (9) embedded in the holder and having a dull or rounded tip (7) projecting  
22 above the flat depression (Leupold, col. 3, ll. 1-3, 6-10, 14-16; col. 4, ll. 12-13;  
23 fig. 3). The holder’s plastic is molded around the embedded widened flange to  
24 permanently affix the preshaped part to the plastic holder (Leupold, col. 3, ll. 10-  
25 16).

1           The Appellant argues that Gelfer's nonwoven plastic material (Gelfer, col. 3,  
2 ll. 8-9) is not disclosed as being elastic (Br. 14-15), and that a flexible article is not  
3 necessarily elastic (Reply Br. 3). The dictionary definitions of "elastic" include  
4 "capable of being easily stretched or expanded and resuming former shape:  
5 FLEXIBLE".<sup>1</sup> Hence, it reasonably appears that Gelfer's disclosure of a plastic  
6 material that is flexible (Gelfer, col. 3, ll. 4-9) would have fairly suggested, to one  
7 of ordinary skill in the art, a plastic material that is elastic.

8           The Appellant argues that the Appellant's claims recite needles, whereas  
9 Gelfer discloses needle-like protuberances (Reply Br. 2). Gelfer discloses that  
10 "each protuberance can be a conical needle element" (Abstract). Moreover, the  
11 dictionary definitions of "needle" include "a slender pointed object resembling a  
12 needle: as (1) : a pointed crystal (2): a sharp rock (3): OBELISK".<sup>2</sup> Thus, Gelfer's  
13 conical needle element reasonably can be considered a needle or, as a minimum,  
14 suggestive of a needle.

15           The Appellant argues that Leupold's preshaped part 8 is not a needle and  
16 does not have a sharpened end, and that Leopold's holder has a rigid pressure plate  
17 (Br. 15-16). That argument is not well taken because the Appellant is attacking the  
18 reference individually when the rejection is based on a combination of references.  
19 *See In re Keller*, 642 F.2d 413, 426, 208 USPQ 871, 882 (CCPA 1981); *In re*  
20 *Young*, 403 F.2d 754, 757-58, 159 USPQ 725, 728 (CCPA 1968). The Examiner  
21 relies upon Gelfer for a disclosure of a needle and an elastic base member  
22 (Answer 3).

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<sup>1</sup> *Webster's New Collegiate Dictionary* 365 (G. & C. Merriam 1973).

<sup>2</sup> *Webster's New Collegiate Dictionary*, *supra* note 1, at 768.

1           The Appellant argues that Gelfer's elongated bar 19 is not a needle (Br. 13).  
2   As pointed out above, Gelfer's conical needle element either is a needle, or at least  
3   would have fairly suggested a needle to one of ordinary skill in the art. Gelfer  
4   discloses attaching the elongated bar directly to the flexible backing sheet (Gelfer,  
5   col. 4, ll. 45-48; figs. 5, 6), but does not disclose such direct attachment of the  
6   conical needle element. Instead, the conical needle element is attached to a rigid  
7   block which is attached to the flexible backing sheet (Gelfer, col. 3, ll. 4-7; figs. 3,  
8   4). For attachment of the conical needle element directly to the flexible backing  
9   sheet to have been prima facie obvious to one of ordinary skill in the art, the  
10   applied prior art must have provided one of ordinary skill in the art with both a  
11   motivation to provide that attachment and a reasonable expectation of success in  
12   doing so. *See In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir.  
13   1991); *In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988).  
14   One of ordinary skill in the art would have been motivated to eliminate the rigid  
15   block to eliminate the cost associated with it. *See In re Thompson*, 545 F.2d 1290,  
16   1294, 192 USPQ 275, 277 (CCPA 1976); *In re Clinton*, 527 F.2d 1226, 1229, 188  
17   USPQ 365, 367 (CCPA 1976). Leupold discloses that embedding in plastic a  
18   widened flange at the base of a preshaped acupuncture protuberance as the plastic  
19   is molded permanently affixes the protuberance to the plastic (Leupold, col. 3,  
20   ll. 10-16). That disclosure would have provided one of ordinary skill in the art  
21   with a reasonable expectation of success in permanently affixing Gelfer's conical  
22   needle element to the flexible plastic backing sheet by forming a widened flange at  
23   the base of that element and embedding the widened flange in the flexible plastic  
24   material. Therefore, embedding the base portion of Gelfer's conical needle  
25   element in the flexible plastic backing material would have been prima facie  
26   obvious to one of ordinary skill in the art.







1 Yoneda is affirmed as to claim 25 and reversed as to claims 20, 22, 24, 26, 28, 30,  
2 and 32-34.

3 No time period for taking any subsequent action in connection with this  
4 appeal may be extended under 37 C.F.R. § 1.136(a)(2006).

5 AFFIRMED-IN-PART

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