

The opinion in support of the decision being entered today was *not* written for publication in a law journal and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AZORIDES R. MORALES

Appeal 2007-0099
Application 10/260,443
Technology Center 3700

HEARD: January 11, 2007

Before TERRY J. OWENS, MURRIEL E. CRAWFORD, and ANITA PELLMAN GROSS, *Administrative Patent Judges*.

GROSS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 13, 15, and 21 through 23.

Appellant's invention relates to a pathology grossing tool with two arrays of sharp tines. The gap between the two arrays is set for the desired thickness of the tissue slices to be cut using the grossing tool. Claim 13 is illustrative of the claimed invention, and it reads as follows:

13. A pathology grossing tool comprising:

- a tine supporting head;
- a plurality of tines projecting from said tine supporting head, each said tine terminating in a sharp tissue penetrating tip;
- a main body having a longitudinal axis and distal and proximal ends, said main body including a handle portion terminating at said proximal end thereof, said main body being coupled to said tine supporting head at said distal end thereof; and wherein there are first and second arrays of tines projecting distally from said tine supporting head, said arrays of tines each being defined in a plane, said tine arrays being disposed in parallel so as to define a gap therebetween, each tine of said first tine array being disposed in adjacent parallel, facing relation to a corresponding tine of said second tine array, wherein said gap defined between said tine arrays is about 1 to 2 millimeters.

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

Koppel	US 5,318,051	Jun. 07, 1994
Ford	US 5,884,633	Mar. 23, 1999

Claims 13, 15, and 21 through 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ford in view of Koppel.

Reference is made to the Examiner's Answer (mailed November 29, 2005) for the Examiner's complete reasoning in support of the rejection, and to Appellant's Brief (filed August 24, 2006) for Appellant's arguments thereagainst.

OPINION

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by Appellant and the

Examiner. As a consequence of our review, we will reverse the obviousness rejection of claims 13, 15, and 21 through 23.

Independent claim 13 recites, in pertinent part, "a plurality of tines . . . each said tine terminating in a sharp tissue penetrating tip." The Examiner asserts (Answer 3-4) that Ford discloses sharp tines because "'sharp' is a relative term. Statements of intended use have no patentable significance." Appellant, on the other hand, argues (Br. 10-11) that Ford teaches teeth with dull points so as to avoid scratching or cutting a person's scalp. Further, Appellant states (Br. 11) that it would not have been obvious to modify Ford to include sharp teeth as "such a modification would be contrary to the express teachings of Ford."

We agree with Appellant. Ford explicitly teaches dull points which will not scratch, which is the exact opposite of sharp tips that will penetrate tissue. As to the Examiner's suggestion that the limitation of a sharp tissue penetrating tip constitutes a statement of intended use, the Examiner should realize that "tissue penetrating" defines that the tip must be sharp enough to penetrate tissue. In other words, the so-called intended use defines the structure and, therefore, does have patentable significance. Since Ford expressly teaches away from the claim limitation, Ford fails to satisfy the claim language.

The Examiner combines Koppel with Ford, since, according to the Examiner (Answer 4), Ford fails to disclose the spacing between the two arrays of tines. The Examiner contends (Answer 4) that Koppel teaches spacing the tines 1-2 millimeters to remove nits, and, therefore, that it would have been obvious to space the teeth of Ford 1-2 millimeters "to provide optimum results in removing nits from human hair." Appellant explains

(Br. 11) that Koppel's teeth in one array are laterally offset from the teeth in the other array. Thus, there is no gap between the tine arrays, wherein each tine of the first array is in facing relation to a corresponding tine in the other array. Further, Appellant continues (Br. 12) that the spacing disclosed by Koppel and referenced by the Examiner is the lateral spacing between the tines, not the spacing between the arrays.

Again we agree with Appellant. The gap disclosed by Koppel for removing nits refers to the spacing between adjacent teeth, not the gap between two arrays of teeth. We also note that the gap disclosed by Koppel, 0.004-0.01 inches, converts to 0.1-0.25 millimeters, not 1-2 millimeters, as claimed. In other words, Koppel fails to disclose the claim limitation of a gap between the tine arrays of about 1 to 2 millimeters. In addition, Koppel fails to cure the deficiency of Ford noted *supra*. Accordingly, we cannot sustain the obviousness rejection of claims 13, 15, and 21 through 23 over Ford in view of Koppel.

CONCLUSION

The decision of the Examiner rejecting claims 13, 15, and 21 through 23 under 35 U.S.C. § 103 is reversed.

REVERSED

TERRY J. OWENS)	BOARD OF PATENT APPEALS AND INTERFERENCES
Administrative Patent Judge)	
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MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	
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