

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRUCE C. JOHNSON

Appeal 2007-2783
Reexamination 90/005,509¹
Patent 5,533,499
(Technology Center 3700)

Decided: August 16, 2007

Before FRED E. McKELVEY, *Senior Administrative Patent Judge*, and
RICHARD E. SCHAFER and JAMESON LEE, *Administrative Patent
Judges*.

LEE, *Administrative Patent Judge*.

DECISION ON APPEAL

A. Statement of the Case

This is a decision on appeal by a Patentee under 35 U.S.C. § 134(a) and

¹ The Patent under reexamination is based on Application 08/183,916, filed January 19, 1994. The real party in interest is Creative Integration & Design, Inc.

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35 U.S.C. § 306 from a rejection of claims 1, 7-9, 19-49, 51, and 53-56 in Reexamination 90/005,509. We have jurisdiction under 35 U.S.C. § 6(b).

Reference Relied on by the Examiner

Davis	U S 2,399,545	Apr. 1946
Schaar	U S 4,212,296	Jul. 1980
Iriarte	Spanish Utility Model 289561	Oct. 1985

The Rejections on Appeal

The Examiner rejected claims 19-48 and 53 under 35 U.S.C. § 112, first paragraph, as without written description in the specification.

The Examiner rejected claims 1, 8, 49, and 53 under 35 U.S.C. § 102(b) as anticipated by Iriarte.

The Examiner rejected claims 19, 20, 23, 24, 26-32, 34, 51, 54, 55 and 56 under 35 U.S.C. § 103 as being unpatentable over Iriarte.

The Examiner rejected claims 7, 9, and 25 under 35 U.S.C. § 103 as being unpatentable over Iriarte, Schaar and Davis.

B. Issue

Has the Applicant shown error in the rejection of claims 1, 7-9, 19-49, 51, and 53-56?

C. Summary of the Decision

No error has been shown except for the rejection of claims 19-48 and 53 as without written description under 35 U.S.C. § 112, first paragraph.

D Findings of Fact (Referenced as FF. ¶ No.)

1. The patent under reexamination, Patent 5,533,499, was issued on July 9, 1996, based on Application 08/183,916, and filed January 19, 1994.

2. The invention is directed to a nasal dilator for preventing the outer wall tissue of nasal passages from drawing in during breathing, thus alleviating breathing difficulties. (Specification col. 1:10-32; col. 2:23-25).

3. The nasal dilator of the invention comprises a truss member having a first end region adapted to engage the outer wall tissue of a first nasal passage, a second end region adapted to engage the outer wall tissue of a second nasal passage, and an intermediate segment connecting the first and second end regions and traversing that portion of a nose between the first and second nasal passages. (Specification col. 2:24-32).

4. The Examiner has confirmed the patentability of claims 10-17 and 52. Those claims have not been rejected and are not on appeal.

5. Claim 1, rejected as anticipated by Iriarte, is reproduced below:

1. A nasal dilator for preventing outer wall tissue of nasal passages of a nose from drawing in during breathing, comprising:

a unitary truss member having an initial state, the unitary truss member including:

a first end region adapted to engage the outer wall tissue of a first nasal passage;

a second end region adapted to engage the outer wall tissue of a second nasal passage;

an intermediate segment configured to traverse a portion of a nose located between the

first and second nasal passages, the inherent tendency of the truss member to return to its initial state when flexed acting to stabilize the outer wall tissue and thereby prevent the outer wall tissue of the first and second nasal passages from drawing in during breathing; and

a resilient member secured to at least a tissue engaging portion of each of the first and second end regions, which tissue engaging portions are adapted to directly engage such outer wall tissue, and to a portion of the intermediate segment, the resilient member being capable, at least in part, of deformation that allows the truss member to conform to the outer wall tissue of the nasal passages of a nose.

6. Claim 23, rejected as unpatentable over Iriarte and also without written description in the specification, is reproduced below:

23. A nasal dilator capable of introducing separating stresses in nasal outer wall tissues, comprising:

a truss of a single body with a resilient member secured therein having a pair of spaced apart end surfaces which, if forced toward one another from initial positions to substantially reduce direct spacing therebetween by a spacing reduction force external to said truss, results in restoring forces in said truss tending to restore said direct spacing between said end surfaces, said truss being formed as a strip having a length greater than those widths thereof extending between opposite portions of side edges thereof, said resilient member having a length greater than its width and positioned separated from a portion of at

least one of said side edges by more than said width of said resilient member; and

engagement means adhered to said end surfaces and capable of engaging exposed surfaces of nasal outer wall tissues sufficiently to remain so engaged against said restoring forces, said truss and said engagement means being capable of being manually released from exposed surfaces of any nasal outer wall tissues engaged by said engagement means.

7. Iriarte discloses an orthopaedic adhesive with substantially the same use as that contemplated by the patentee. Iriarte indicates that its orthopaedic adhesive is for eliminating snoring and vestibular respiratory insufficiency. (Iriarte 2:29-33).

8. In Figure 1, Iriarte discloses an embodiment made of a single layer of elastic material for placement on the nose and which acts as a “spring” to promote nasal-sinusal respiration. (Iriarte 3:11-13).

9. In Figure 2, Iriarte discloses a second embodiment in which the elastic lamina layer 1 is first attached via one face to a larger body which is then adhered to the nose, with the elastic layer positioned between the larger planar body 2 and the nose. (Iriarte 3:19-23; 4:1-5; Figs. 2, 3). It is this second embodiment which the Examiner regards as anticipating the patentee’s claims 1, 8, 49 and 53.

10. The patentee does not dispute that plastic was a known flexible material to one with ordinary skill in the art at the time of the invention.

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E. Principles of law

To establish anticipation under 35 U.S.C. § 102, each and every element in a claim, arranged as is recited in the claim, must be found in a single prior art reference. *Karsten Manufacturing Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001).

Anticipation can be found when a claim limitation is inherent or otherwise implicit in the relevant reference. *Standard Havens Products, Inc. v. Gencor Industries, Inc.*, 953 F.2d 1360, 1369, 21 USPQ2d 1321, 1328 (Fed. Cir. 1991).

Obviousness is a legal determination made on the basis of underlying factual inquiries including (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any objective evidence of unobviousness, *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

One with ordinary skill in the art is presumed to have skills apart from what the prior art references explicitly say. *See In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). A person of ordinary skill in the art is also a person of ordinary creativity, not an automaton. *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742, 82 USPQ2d 1385, 1397 (2007).

A prima facie case of obviousness means the evidence of prior art would reasonably allow the conclusion the Examiner seeks and compels such a conclusion if the Applicant produces no evidence to rebut it. *In re Spada*, 911 F.2d at 707 n.3, 15 USPQ2d at 1657 n.3 (Fed. Cir. 1990); *RCA Corp. v. Applied Digital Data Systems Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

A nexus is required between the merits of the claimed invention and any objective evidence of nonobviousness offered, if that evidence is to be given substantial weight enroute to a conclusion on obviousness. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1539, 218 USPQ 871, 879 (Fed. Cir. 1983). Commercial success is relevant only if it flows from the merits of the invention claimed. *Sjolund v. Musland*, 847 F.2d 1573, 1582, 6 USPQ2d 2020, 2028 (Fed. Cir. 1988). Objective evidence must be commensurate in scope with the invention claimed. *In re Kulling*, 897 F.2d 1147, 1149, 14 USPQ2d 1056, 1058 (Fed. Cir. 1990); *see also In re Tiffin*, 448 F.2d 791, 792, 171 USPQ 294, 294 (CCPA 1971).

Argument of counsel cannot take the place of evidence lacking in the record. *Meitzner v. Mindick*, 549 F.2d 775, 782, 193 USPQ 17, 22 (CCPA), cert. denied., 434 U.S. 854; *see also In re Pearson*, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974) (“Attorney’s argument in a brief cannot take the place of evidence.”).

F. Analysis

In this case, as in any appeal from an Examiner’s rejection, the patentee must demonstrate error in the rejections on appeal.

Hereinafter, when we refer to Iriarte by page and line number, the reference is directed to the English translation of the cited Spanish Utility Model, that is of record.

The Anticipation Rejection

Claims 1, 8, 49 and 53 have been rejected as anticipated by Iriarte. Claim 8 depends from claim 1. Claims 1, 8, and 49 have been argued by the patentee as a group, based on the assertion that according these claims “a

tissue engaging portion of an end region is coextensive with the resilient member secured thereon and extends no further” (Brief 12:17-19). Claim 53 is argued separately, based on its recitation of an adhesive void extending between opposite portions of the side edges of the truss.

The patentee’s construction of claims 1, 8 and 49 as a group is overly narrow and not the broadest reasonable interpretation consistent with the specification. There is nothing in these claims which concerns whether the tissue engaging portion of any end region of the truss is coextensive with the resilient member and extends no further. The patentee’s view is based solely on (1) the requirement in these claims that the truss member has first and second end regions adapted to engage the outer wall tissue of a first and second nasal passage, respectively, and (2) the requirement in these claims that the resilient member is “secured to at least a tissue engaging portion of each of the first and second end regions.” (Br. 12:11-17). Those features of the claims reasonably encompass embodiments in which the resilient member is not coextensive with the tissue engaging portion of an end region. Coextensiveness does not have anything to do with these limitations, at least not as we can understand the association, if any, from the patentee’s brief. The patentee does not meaningfully articulate from where and how the “coextensive” assertion arises. An element’s being “secured to” another element manifestly does not impose any requirement on coextensiveness.

As best we can determine, and as best we can tie the patentee’s argument to the claims, the patentee is arguing that in each end region of the truss the resilient member must contact only those areas which actually

engage tissue. The key here concerns what constitutes a “tissue engaging portion” as is recited in claims 1 and 49.

According to the Examiner, it is within the scope of these claims that not the entirety of a tissue engaging portion must actually engage tissue. We agree. The Examiner’s position is within the broadest reasonable construction of these claims consistent with the specification. It is reasonable that some areas within the tissue engaging portion of an end region need not actually engage tissue, if those areas are bound by, contained within, or positioned on the back of the areas which do actually engage tissue. The patentee’s specification nowhere precludes referring to an entire end region as a tissue engaging portion even though in reality only the external surface on the underside actually engages tissue. What is internal to the end region and what is on the backside of the end region are a part of the tissue engaging portion even though they do not actually contact tissue. As is shown in the Examiner’s illustration on page 9 of the Answer in connection with a disclosed embodiment of Iriarte, a non-tissue engaging area is bounded and confined by the reverse “C” shape of the area actually engaging tissue and thus the entire region defined by the dotted lines can reasonably be regarded as the tissue engaging portion even though an area within it does not actually engage tissue. Consequently, in Iriarte’s embodiment of Figure 2, the resilient member or lamina 1 does make contact with the tissue engaging portion of the end regions of the truss.

In any event, we conclude also that the patentee’s argument is without merit because none of claims 1, 8 and 49 includes the limitation that the resilient member must contact or engage the tissue engaging portion of any

end region of the truss. These claims recite only that the resilient member is “secured to” at least a tissue engaging portion of each of the first and second end regions. An element A may be “secured to” an element B in myriad ways. Direct contact is not required. All that is necessary is that the two elements are attached or physically connected, even if the attachment or connection is through an intermediate component. The patentee’s specification does not define any special meaning for the term “secured to” unique to the involved patent. The patentee also does not argue any special meaning for the term “secured to” in the art of nasal dilators. Thus, the ordinary meaning of “secured to” in the English language applies. For instance, a bicycle may properly be referred to as “secured to” a bike rack by chain and lock even if it makes no direct contact to the rack. In the case of Iriarte’s embodiment of Figure 2, resilient lamina 1 is “secured to” areas which actually engage tissue by attachment to areas which do not.

Claim 53 recites that the truss has an intermediate segment configured to traverse a portion of a nose located between the first and second nasal passages “which includes an adhesive void extending between opposite portions of said side edges.” According to the patentee, the embodiment shown in Figure 2 of Iriarte does not include such an adhesive void because the area of the truss 2 which would traverse the nose portion between first and second nasal passages clearly includes adhesive along the peripheral edges for contacting tissue despite the presence of an adhesive void in the central region of that area. The argument is without merit.

The patentee would read “an adhesive void extending between opposite portions of said side edges” as excluding any and all adhesive

within the entire space between opposite portions of the side edges. That interpretation is overly narrow and not the broadest reasonable construction consistent with the specification. The language of claim 53 does not require the adhesive void to extend exhaustingly from end to end or from edge to edge. The adhesive void need only extend between the edges, that is, exist somewhere between the edges, as it does in the case of Iriarte's Figure 2. The presence of adhesive along the peripheral edges does not negate the fact that there is an adhesive void in the central region between the edges.

It is noted that the patentee's specification does not even contain written description of an adhesive void that extends from edge to edge. In column 5, lines 9-11, it is stated, with reference to Figure 6, that "the padded element 48 creates an absorbent adhesive void between the truss member 16 and the bridge 58. From Figure 6, because of the cross-sectional view, it is impossible to tell whether the padded element 48 extends fully from the top edge to the bottom edge of the truss. There is also no text in the disclosure to the effect that the padded element fills the entire space between the top and bottom edges of the truss. It cannot simply be assumed that it does.

For the foregoing reasons, the patentee has not shown error in the rejection of claims 1, 8, 49, and 53 as anticipated by Iriarte under 35 U.S.C. § 102.

The Written Description Rejection

The Examiner rejected claims 19-48 and 53 under 35 U.S.C. § 112, first paragraph, as lacking written description in the specification.

The stated basis for rejecting claim 53 is reproduced below (Answer 4:1-4):

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In claim 53, the specification does not provide support for the adhesive void extending from one side of the truss to the other. The disclosure identifies the void as being the area covered by the pad. However, the Examiner is unable to locate any support for the limitation that the pad extends from one side to the other.

We have already determined above, in the context of an anticipation rejection of claim 53, that the claim does not require the adhesive void to extend exhaustingly from edge to edge in the truss. Accordingly, that the Examiner can locate no support in the specification for an adhesive void that extends exhaustingly from edge to edge in the truss is of no moment. The specification discloses, in connection with Figure 6, a padded element 48 which extends somewhere between the side edges of the truss member. That is sufficient written description for supporting the recitation that an adhesive void extends between opposite portions of the side edges of the truss.

Of claims 19-48, the only independent claims are claims 23 and 35. Claim 23 recites a truss of a single body “with a resilient member secured therein.” Claim 35 recites a truss of a single body “with a resilient member and a flexible strip of material secured therein.” The Examiner’s rationale in support of the rejection is stated as follows (Final Rejection 3:22-24):

In claims 23 and 35, the device is claimed as a truss with a resilient member and/or a flexible strip of material secured

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“therein”. The specification does not support these structures being “in” the truss.

The rationale is believed to be incorrect. The specification discloses truss member 16 as “including a flexible strip of material” (Specification col. 3:43-44) and “includes resilient means 26” (Specification col. 3:55). Thus, the specification describes the flexible strip of material as well as the resilient means both as a component of the truss. Resilient means 26 is described as including a resilient band (Specification col. 3:56-57). Nothing unusual or unpredictable has been shown by the Examiner with regard to a difference between a resilient band and a resilient member. Thus, the specification describes a resilient member as a component of the truss. The patentee is correct that what are described as component parts of the truss are necessarily described as being “in” the truss.

For the foregoing reasons, the rejection of claims 19-48 and 53 under 35 U.S.C. § 112, first paragraph, cannot be sustained.

The Obviousness Rejections

a. The Prima Facie Case

The Examiner rejected claims 19, 20, 23, 24, 26-32, 34, 51, 54, 55, and 56 under 35 U.S.C. § 103 as unpatentable over Iriarte. The Examiner rejected claims 7, 9, and 25 under 35 U.S.C. § 103 as unpatentable over

Iriarte, Schaar, and Davis. However, claims 7, 9, and 25 have not been argued separately from claims from which they depend, i.e., claims 1 and 24.

The patentee asserts three arguments, each based on a separate claim feature, with respect to this rejection. The first applies to claims 19, 20, 23, 24, 26-32, and 34, and is based on the limitation in these claims that the resilient member is separated from a side edge of the truss by more than the width of the resilient member. The second applies to claims 34, 51, 54, and 55, and is based on the limitation in these claims that the intermediate segment of the truss is narrower in width than the spaced apart end surfaces of the truss. The third applies to claims 56 and 30, and is based on the limitation in these claims that the truss body is of plastic construction.

With respect to the first argument, the patentee's specification does not describe what benefits or advantages can be achieved by having the resilient member separated from an edge of the truss by more than the width of the resilient member.² The patentee also submitted no declaration testimony from anyone with at least ordinary skill in the art explaining what

² We find no description in the specification for the feature that a resilient member is separated from an edge of the truss by more than the width of the resilient member, although the claims have not been rejected by the Examiner as lacking written description on that basis. The illustration in Figure 1 actually shows the opposite, i.e., a distance of separation from the edge that is less than the width of a resilient member.

benefits or advantages may be achieved by having the resilient member separated from an edge of the truss by more than the width of the resilient member. On this record, the length of separation limitation is of no functional significance and merely results in a difference in appearance, and the greater-than-width separation is no more special than any other distance of separation. The Examiner is correct that in light of Iriarte's disclosure that flexible lamina 1 is smaller than larger body 2, it would have been obvious to one with ordinary skill in the art to set the distance of separation between flexible lamina 1 and an edge of larger body 2 to any magnitude that works, including a distance that is greater than the width of flexible lamina. The level of ordinary skill in the art is reflected by Iriarte which leaves much detail to be determined by one with ordinary skill in the art.

The patentee states in the appeal brief on page 15 that the greater-than-width separation requirement "is absolutely required at a minimum to accommodate the disclosed second resilient member that is disclosed spaced apart from the first resilient member recited in claim 23." However, none of the rejected claims recites a second resilient member, and thus the assertion is inapposite for these rejected claims. Also, attorney argument does not constitute evidence and the assertion is not supported by any testimony by

one with at least ordinary skill in the art. Moreover, the assertion is illogical in that the more separation there is from one resilient member to one edge the less room, not more, is left to accommodate a second resilient member. Moreover, the illustration in Figure 1 of the patentee's specification indicates that a greater-than-width separation from an edge is not necessary to accommodate a second resilient member, since the separation shown is evidently less than the width of a resilient band. Further still, the patentee points to nothing in the specification which indicates that having two resilient bands provides an advantage over having just one resilient band, and no declaration testimony has been submitted in that regard. In essence, the patentee is relying on advantages not indicated in its specification and unestablished by extrinsic evidence, and also on features unclaimed.

The patentee asserts that Iriarte nowhere suggests that the resilient member should be separated from an edge of the truss by more than the width of the resilient member. For reasons discussed above, the patentee has not shown that the Examiner failed to make out a prima facie case of obviousness with respect to claims 19, 20, 23, 24, 26-32, and 34.

With regard to the second argument, the specification nowhere describes what benefits or advantages can be achieved by having the

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intermediate segment of the truss narrower in width than the spaced apart end surfaces of the truss. The patentee also submitted no declaration testimony from anyone with at least ordinary skill in the art explaining what benefits or advantages may be achieved by having the intermediate segment of the truss narrower in width than the spaced apart end surfaces of the truss. On this record, whether the intermediate segment of the truss is narrower in width than the ends of the truss is of no functional significance and merely results in a difference in appearance, and the narrower intermediate segment is no more special than an intermediate segment having the same width as the ends of the truss.

On page 4 of Iriarte, from lines 13-16, it is stated:

Given the description which the foregoing report provides, it is necessary to stress that the details of the design of the idea set out may vary, that is to say that they may be subject to slight alterations, always based on the fundamental principles of the idea, which are essentially those reflected in the paragraphs of the description give[n].

Given that the width of the intermediate segment is of no disclosed functional significance in the specification of the patentee's involved patent, and in light of the above-quoted text from Iriarte, the patentee has shown no error in the Examiner's decision regarding a narrower intermediate segment as a routine variation within the fundamental principles disclosed by Iriarte.

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The patentee in the appeal brief contends that there is a function performed by narrowing the intermediate segment of the truss, i.e., reducing the amount of nasal bridge area covered by the truss, which reduces skin irritation and which simulates the same effect as an adhesive void without absorbing moisture from the skin. There are several problems with the assertion. First, the advantage is not identified or discussed in the specification. In other words, the alleged advantage is a post-filing date after thought of counsel. *Cf. Graham v. John Deere Co.*, 383 U.S. 1, 24-25 (1966), and *Lincoln Engineering Co. of Illinois v. Stewart-Warner Corp.*, 303 U.S. 545, 550 (1938) (post-issuance advantages not given much weight). Secondly, the patentee does not represent that such an advantage would have been unknown to or unexpected by one with ordinary skill in the art. Third, the patentee represents (Brief 19:25-27) that that the narrowed intermediate segment provides the same benefit as use of a pad establishing an adhesive void and without the need to absorb moisture from skin “is inherently clear to reader of the patent whether skilled in the art or not.” If that is the case, then a similar observation would have been taken with respect to observing the disclosure of Iriarte, i.e., the less the coverage over the bridge of the nose the less the skin irritation. Fourth, all we have is

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attorney argument on the issue. The patentee submitted no declaration testimony in connection with any alleged benefits whether or not expected by one with ordinary skill in the art, regarding a narrowed center segment over the bridge of the nose.

The patentee further asserts that the embodiment shown in Figure 2D of Iriarte teaches away from having a narrowed intermediate segment because in that embodiment the truss is actually wider and thicker in the center portion. The teaching away assertion is misplaced because the embodiment of Figure 2D is merely one of many alternatives disclosed by Iriarte and does not in the least suggest that the center segment cannot be made narrower in some other embodiment for a different purpose.

For reasons discussed above, the patentee has not shown that the Examiner failed to make out a prima facie case of obviousness with respect to claims 34, 51, 54, and 55.

With regard to the third argument, the specification nowhere describes what benefits or advantages can be achieved by having the body of the truss made of plastic. The patentee also submitted no declaration testimony from anyone with at least ordinary skill in the art explaining what benefits or advantages may be achieved by having the truss body be made of plastic.

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On this record, making the truss from plastic as opposed to any other type of flexible material provides no functional advantage or benefit. The patentee also does not dispute that plastic is a material whose flexible characteristics were known to one with ordinary skill at the time of the invention.

Given that plastic construction of the truss provides no disclosed advantage in the context of the patentee's involved patent, and that plastic was a known flexible material at the time of the patentee's invention, the Examiner is correct that one with ordinary skill would have known to use plastic for constructing Iriarte's device. Note that Iriarte's lamina layer is described as being elastic and acting like a spring. (Iriarte 3:19-21).

The patentee asserts that use of plastic actually solves an important problem (Brief 17:8-9). It is alleged in the appeal brief that there is an "adhesion problem" between the resilient member and the flexible strip of material within the truss, as a user's nose twists and bends, and the patentee discloses "a dilator using plastic bands which are compatible with an adhesive sufficient to maintain those bands adhered to the flexible strip of plastic material despite the bending and twisting that occurs during the mounting and wearing of the dilator on the nose of the user." There are many problems with the patentee's contention. First, the specification

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mentions no “adhesion problem” between the flexible strip and any resilient member and also mentions no solution achieved by constructing the resilient member from plastic. Secondly, what we have is only attorney argument and there is no real evidence, e.g., declaration testimony, establishing that there indeed is an “adhesion problem” unless the dilator is made of plastic. Third, the patentee expressly acknowledges that the so called “adhesion problem” does not exist in Iriarte’s disclosed embodiment, and thus it is not of relevance in considering whether one with ordinary skill in the art would know to construct Iriarte’s resilient laminate from plastic. Fourth, even assuming that an “adhesion problem” exists in the case of Iriarte’s disclosed embodiment, the patentee has not shown, that the solution provided via using a plastic construction would not have been known to one with ordinary skill in the art. Finally, a claimed invention may be obvious for reasons other than that which led the inventors to the invention, and in this case there is independent reason for one with ordinary skill to select plastic as the construction material.

For reasons discussed above, the patentee has not shown that the Examiner failed to make out a prima facie case of obviousness with respect to claims 30 and 56.

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b. Secondary Considerations

The Examiner has made out a strong prima facie case of obviousness. The patentee submitted two declarations as objective evidence of nonobviousness, which must be weighed collectively with the entirety of the evidence to arrive at a conclusion on the obviousness issue.

The two declarations pertain to only one objective indicator of nonobviousness, commercial success, and are both executed by Daniel E. Cohen, the Chief Executive Officer of CNS, Inc., a licensee of the patentee's involved patent. In his first declaration, dated February 17, 1994, Mr. Cohen represents:

that in the period from October 12, 1993 through February 11, 1994, CNS, Inc. received commercial orders for more than one million units of the product,

that neither he nor CNS, Inc. have published prior to February 11, 1994, any public advertisements concerning the product developed and subsequently sold by CNS, Inc., or paid or otherwise caused others to publish such advertisements prior to that date, and

that neither he nor CNS, Inc. have any knowledge of any similar unitary or single body dilator operable through adherence under outward stress to the outer skin of the user that is being offered for sale to the public by others as of the date of this document.

In his second declaration, dated February 13, 1995, Mr. Cohen represents:

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that CNS, Inc. received orders during December, 1994 substantially exceeding one million units for its product,

that CNS, Inc. received orders during January, 1995 substantially in excess of six million units of the product, and

that the product sold as mentioned in his previous declaration as well as the current declaration **comes within the scope of one or more of the pending claims in the above-identified application which have been rejected during the prosecution thereof, such rejection being the action from which this appeal has been taken.** [Emphasis added.]

The “appeal” mentioned in Mr. Cohen’s declaration dated February 13, 1995, is not the current appeal, as that declaration was executed on February 13, 1995, a date even prior to original issuance of the patent undergoing reexamination in this case, which reexamination proceeding resulted in the current appeal.

It is well established that when it comes to objective evidence of nonobviousness, “[a] nexus is required between the merits of the claimed invention and the evidence offered, if that evidence is to be given substantial weight enroute to conclusion on the obviousness issue.” *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d at 1539, 218 USPQ at 879. See also *In re Fielder*, 471 F.2d 640, 642, 176 USPQ 300, 302 (1973). Commercial success is relevant only if it flows from the merits of the invention claimed. *Sjolund v. Musland*, 847 F.2d at 1582, 6 USPQ2d at 2028. More specifically, as was

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indicated by the Court of Appeals for the Federal Circuit in *Richdel, Inc. v. Sunspool Corporation*, 714 F.2d 1573, 1580, 219 USPQ 8, 12 (Fed. Cir. 1983), the alleged commercial success must be shown as due to something disclosed in the application and claimed but not present in the prior art.

The two declarations submitted by the patentee are far from establishing any kind of nexus between the alleged commercial success and the merits of the invention claimed by the patentee in the claims now on appeal from a rejection for obviousness.

The declarations do not describe the product sold in any specifics. We do not know the structure and configuration of what was sold. Although there is a statement in the declaration dated February 13, 1995, to the effect that the products sold as mentioned in the declarations are all within the scope of one or more pending claims which have been rejected and from which “this appeal” has been taken, that appeal is not the current appeal, that rejection is not the current rejection, and those pending claims are not the claims at issue here. Those claims were pending on February 13, 1995, and later amended, which amendments resulted in issuance of the application as a patent on July 9, 1996, and then the issued claims are still further amended

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during the reexamination proceeding which gave rise to the present appeal.

The claims are not the same.

Even assuming that the claims are the same, a product's simply being within the scope of a claim does not establish the necessary nexus between the alleged commercial success and the merits of the claimed invention. An important feature on which the alleged commercial success might have been based and not present in the prior art may not be recited in the claim.

Evidence of commercial success must be commensurate in scope with the claims which the evidence is offered to support. *In re Tiffin*, 448 F.2d at 792, 171 USPQ at 294 (evidence of commercial success for cups does not establish nonobviousness of claims drawn broadly to containers). We note that patentee's counsel stated, during oral argument, that all of the products sold as referenced in the declarations are of the type including two spaced-apart resilient bands in the truss. That is the preferred embodiment disclosed in the patentee's specification. Claims drawn to that preferred embodiment, claims 10-17, have been allowed. None of the claims now on appeal requires two resilient bands. In any event, we have only the representation by the Chief Executive Officer of a licensee that the products sold are within

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the scope of one or more claims. We do not simply take the declarant's word as true, as the question is a legal one.

It is also not known whether the alleged commercial success is due to features which the patentee's claimed invention have in common with the prior art, since no sales data have been provided on Iriarte's device and no testimony has been submitted tending to establish that the patentee's sales were primarily due to inclusion of features not present in Iriarte's device.

Finally, it is noted that the patentee's claims on appeal are many and are varied in scope. Some require the truss to be made of plastic construction; some require a particular offset of the resilient member from a side edge of the truss; and some require the truss to have a narrower intermediate segment relative to the ends; and some even do not require any of these features. According to the patentee, each of these features has an associated benefit or advantage. The declarations do not reveal the structure of the products sold, and thus it cannot be said that the evidence of commercial success is commensurate in scope with any claim. Rather, in light of counsel's admission during argument that all of the nasal dilator units sold include a double resilient band construction like the preferred embodiment disclosed in the specification, we find that (1) there is no

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convincing evidence of commercial success, but (2) even if there were evidence of commercial success, that evidence is not commensurate in scope with any claim on appeal because none requires two resilient bands in the truss.

In light of the strong prima facie case of obviousness and the evidence of alleged commercial success which is without sufficient nexus to the merits of the claimed invention, we conclude that the patentee has not shown error in the obviousness rejection of claims 7, 9, 19, 20, 23-32, 34, 51, 54, 55, and 56 over Iriarte. And because claims 7, 9, and 25 have not been argued separately from claims 1 and 24, the patentee also has not shown error in the obviousness rejection of claims 7, 9, and 25 over Iriarte, Schaar, and Davis.

G. Conclusion

The rejection of claims 19-48 and 53 under 35 U.S.C. § 112, first paragraph, as without written description in the specification is **reversed**.

The rejection of claims 1, 8, 49 and 53 under 35 U.S.C. § 102(b) as anticipated by Iriarte is **affirmed**.

The rejection of claims 19, 20, 23, 24, 26-32, 34, 51, 54-56 under 35 U.S.C. § 103 as unpatentable over Iriarte is **affirmed**.

The rejection of claims 7, 9 and 25 under 35 U.S.C. § 103 as unpatentable over Iriarte, Schaar, and Davis is **affirmed**.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a) (1)(iv)(2005).

AFFIRMED-IN-PART

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