

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte

THEODORE WELT and JONATHAN H. WEISBERG

Appeal 2008-4404
Application 10/390,047
Technology Center 3700

Decided: September 22, 2008

Before DONALD E. ADAMS, DEMETRA J. MILLS, and
LORA M. GREEN, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 18-30. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

The claims are directed to a gum massager. Claim 18 is representative of the claims on appeal, and reads as follows:

18. A device for massaging the gum of a user comprising:
an elongate handle having a first end portion and a second end portion; and
a gum massaging head including a resilient massaging element mounted on said second end portion of said elongate handle member, wherein said massaging head is mounted on said second end portion by means of a ball and socket type of joint, configured such that said gum massaging head can perform limited oscillation movement in a plurality of planes relative to said elongate handle, such that said resilient massaging element adapts to the contours of said gum being massaged when pushed thereagainst.

The Examiner relies on the following references:

Wheeler	US 1,153,409	Sep. 14, 1915
Metzler	US 1,892,068	Dec. 27, 1932
Youngclaus, Jr.	US 4,347,839	Sep. 7, 1982

We affirm.

ISSUE (New Matter)

The Examiner rejects claim 18 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement (Ans. 6). Specifically, the Examiner contends that the claim contains the limitation that “the gum massaging head can perform limited oscillation movement ‘*in a plurality of planes*’, which was not described in the original disclosure . . . in such a way as to reasonably convey to one skilled in the relevant art that

the inventor(s), at the time the application was filed, had possession of the claimed invention.” (*Id.* at 6-7.)

Appellants argue that the use of the phrase “oscillating movement” “is definitive in describing movement **in a plurality of planes.**” (Reply Br. 10.) Moreover, Appellants assert, “it is clear to one skill in the art, that a ball and socket joint, by its very nature, is associated with the provision of motion **in a plurality of planes.**” (*Id.* at 12.) Thus, Appellants contend, “the added matter is supported by the original disclosure” (App. Br. 12).

Thus, the issue on appeal is: Whether the disclosure of “oscillating movement,” as well as the disclosure of a “ball and socket joint” in the application as originally filed provides written description support for the limitation that the gum massaging head can perform limited oscillation movement “in a plurality of planes”?

PRINCIPLES OF LAW

The disclosure as originally filed need not provide “*in haec verba* support for the claimed subject matter at issue,” rather, the disclosure should convey to one skilled in the art that the inventor had possession of the invention at the time of filing. *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000) (citations omitted).

ANALYSIS

We agree with Appellants for the reasons set forth in the Reply Brief (Reply Br. 9-13) that the disclosure as filed provides written description support for the limitation objected to by the Examiner.

CONCLUSION

Thus, we conclude that the disclosure of “oscillating movement,” as well as the disclosure of a “ball and socket joint” in the application as originally filed provides written description support for the limitation that the gum massaging head can perform limited oscillation movement “in a plurality of planes,” and the rejection is reversed.

ISSUE (Anticipation)

The Examiner contends that claims 18, 19, 21, and 26-28 are anticipated by Wheeler.

Appellants contend that the gum massager of Wheeler is not capable of performing “limited oscillation movement in a plurality of planes relative to said elongate handle, such that said resilient massaging element adapts to the contours of said gum being massaged when pushed thereagainst.”

Thus, the issue on Appeal is: Whether the Examiner has established by a preponderance of the evidence that the gum massager of Wheeler is capable of performing “limited oscillation movement in a plurality of planes relative to said elongate handle, such that said resilient massaging element adapts to the contours of said gum being massaged when pushed thereagainst”?

FINDINGS OF FACT

FF1 “The present invention relates to a gum massager device.” (Spec. ¶1.)

FF2 The gum massager is made of a resilient rubber or plastic material (Spec. ¶45).

FF3 According to Appellants, Figure 15 shows a ball and socket type joint as recited in claim 18 (Reply Br. 11).

FF4 Figure 15 of the instant disclosure is reproduced below.

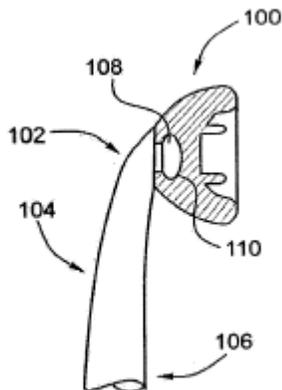
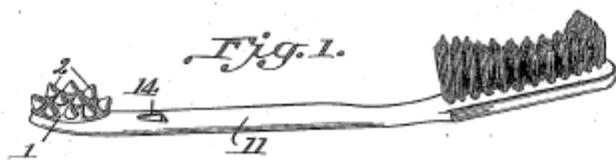


FIG. 15

Figure 15 shows a replaceable gum massager head (100), which has a ball shaped portion (108) that press-fits into a corresponding shaped socket (110) (Spec. ¶64). The Specification teaches that “[a]part from providing a replaceable gum massaging head 100, there is also provided a limited oscillation of gum massager head 100 relative to elongate handle member 106 by virtue of the ball-and-socket connection 108 and 110 respectively.” (*Id.*)

FF5 The Examiner rejects claims 18, 19, 21, and 26-28 under 35 U.S.C. § 102(b) as being anticipated by Wheeler (Ans. 3).

FF6 The Examiner relies on Figures 1-3 of Wheeler, reproduced below.



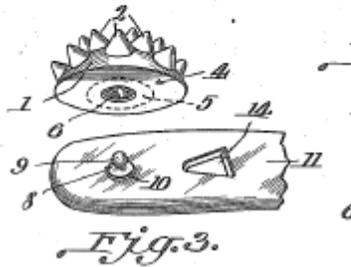
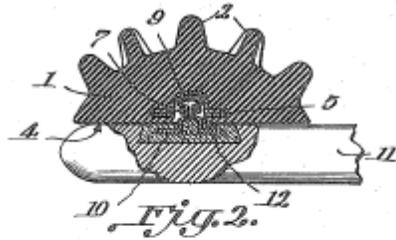


Figure 1 of Wheeler shows a gum massager applied to a tooth brush handle (Wheeler, ll. 54-55). Figure 2 shows an enlargement of the gum massager, showing the pivot on which it is mounted, and Figure 3 shows the gum massager detached from the pivot to which it is mounted (*id.* at ll. 55-62).
FF7 According to the Examiner, the gum massager of Wheeler comprises “an elongate handle 11 . . . having a first end portion and a second end portion . . . ; a gum massaging head 1 mounted on said second end portion of said elongate handle member . . . , wherein said gum massaging head is mounted on said second end portion by means of a ball 9 and socket type of joint 6 (best seen in figs. 2-3).” (Ans. 3.)

FF8 The Examiner finds that the use of a ball head 9 to attach the massager, wherein the ball head is received in opening or socket 6, allows the massager to rotate with limited angular movements in a plurality of angular directions relative to said elongate handle and allows the head to maintain contact with the natural contours of the surface of said gum (Ans. 3-4).

FF9 The Examiner finds further that the massaging head is generally configured as a bell shape and “includes at least one resilient protrusion 2 extending from said recessed inner surface so as to improve the massaging contact thereof on the gums; wherein said at least one resilient protrusion includes a plurality of said protrusions 2 (fig. 1-2); wherein said at least one resilient protrusion includes at least one protrusion having a predetermined geometric shape of a cylindrical shape (fig. 2).” (Ans. 4.)

FF10 Wheeler teaches a gum massager that may be mounted to a tooth brush handle, being capable of rotary movement (Wheeler, ll. 16-21).

FF11 The massager may be made of rubber or another resilient material (Wheeler, ll. 22-26). The massager is “covered with small conical projections, the axes of the cones being substantially coincident with the radii of [the] semi-spherical surface, the whole being mounted to rotate.” (Wheeler, ll. 35-38.)

FF12 According to Wheeler, the massager is “detachably mounted to rotate on a pivot at substantially right angles to the longitudinal axis of a tooth brush or other suitable handle.” (Wheeler, ll. 27-30.)

PRINCIPLES OF LAW

In order for a prior art reference to serve as an anticipatory reference, it must disclose every limitation of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997).

Moreover, our mandate is to give claims their broadest reasonable interpretation. *In re American Academy Of Science Tech Center*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). “An essential purpose of patent examination is

to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.” *In re Zletz*, 893 F.2d 319, 322 (Fed. Cir. 1989). In addition, it is during prosecution that applicants have “the opportunity to amend the claims to obtain more precise claim coverage.” *American Academy*, 367 F.3d at 1364.

ANALYSIS

The contested limitation of claim 18 recites: “wherein said massaging head is mounted on said second end portion by means of a ball and socket type of joint, configured such that said gum massaging head can perform limited oscillation movement in a plurality of planes relative to said elongate handle, such that said resilient massaging element adapts to the contours of said gum being massaged when pushed thereagainst.”

Appellants do not argue that the massaging head of Wheeler: is mounted on said second end portion and a ball and socket type of joint; or that the massaging head of Wheeler is made from a resilient material. Rather, the issue is whether the massaging head “can perform limited oscillation movement in a plurality of planes relative to said elongate handle, such that said resilient massaging element adapts to the contours of said gum being massaged when pushed thereagainst.”

Giving that limitation its broadest reasonable interpretation, a massaging head that can perform any oscillation movement in a plurality of planes, even a very limited amount, that allows any portion of the resilient

head of the massaging element to adapt to the contour of the gum, would anticipate the massaging head of claim 18.

Appellants argue that “the massaging head shown therein has a structure that specifically constrains the head to perform movement **in one plane only**, namely, the plane perpendicular to the pivot of the head.” (Reply Br. 13.) Wheeler teaches, Appellants assert, that the movement of the gum massaging “is constrained ‘to rotate on a pivot at substantially right angles to the longitudinal axis of the . . . handle.’” (Reply Br. 14 (quoting Wheeler col. 1, ll. 27-30).) Moreover, Appellants argue, Wheeler teaches, and claims in claim 2, “that the back surface of the massaging head is substantially flat,” and thus the “only intended motion of the massaging head is to rotate about its pivot.” (Reply Br. 14.)

Appellants’ arguments are not found to be convincing. Wheeler teaches the use of a resilient material in conjunction with a ball and socket joint, and as Appellants note, “it is clear to one of skill in the art, that a ball and socket joint, by its very nature, is associated with the provision of motion **in a plurality of planes.**” (Reply Br. 12.) Moreover, while Wheeler teaches that the massager is “detachably mounted to rotate on a pivot at substantially right angles to the longitudinal axis of a tooth brush or other suitable handle” (FF12), the use of “substantially” implies that while most of the movement may be at right angles to the longitudinal axis of a tooth brush, there would be a small amount of movement that would not occur at those right angles. Thus, we agree with the Examiner’s finding that the combination of the ball and socket joint and the use of a resilient material in

the massaging head of Wheeler would allow for some oscillating movement in a plurality of planes.

Appellants assert that in Wheeler, “additional structural elements were specifically required in order to limit the motion of the massing head in a single plane only. These additional structural elements are the substantially flat back surface of the semi-circular massaging head and the matching flat surface of the handle.” (App. Br. 12-13.)

As discussed above, all that is required by claim 18 is any amount of limited oscillation that allows any part of the gum massager of Wheeler, including the resilient conical projections, to move in a plurality of planes. Moreover, while Appellants argue that the flat back surface of the semi-circular massaging head and the matching flat surface of the handle would eliminate such movement (and based on the claim construction, they would have to completely eliminate such movement), they have not provided any evidence to that effect, and arguments of counsel cannot take the place of evidence in the record. *In re Scarbrough*, 500 F.2d 560, 566 (CCPA 1974).

Appellants argue further that “the ball and socket joint shown in Wheeler is not an essential element of the device, and is not used to bestow the special properties of a ball and socket joint, but is only one optional manner of constraining the head to perform the planar rotational movement described in Wheeler.” (Reply Br. 14.) Moreover, Appellants assert, Wheeler specifically teaches the advantages of having a single axis of rotation, such as reducing the danger of injury to the gums (Reply Br. 14). According to Appellants,

[n]owhere, to the best of the appellants’ understanding, does Wheeler mention or suggest the use of a ball and socket type of

joint to enable the gum massaging head to perform “limited oscillation movement in a plurality of planes relative to said elongate handle, such that said resilient massaging element adapts to the contours of said gum being massaged when pushed thereagainst”, as recited in claim 18.

(Reply Br. 15.)

Moreover, Appellants argue, while Wheeler recognizes “the need for flexibility to aid in the manipulation of the gum massaging device, . . .

Wheeler did not suggest the use of the ball and socket joint to provide this function.” (Reply Br. 15.)

The fact that the ball and socket joint of Wheeler is “not an essential element of the device” is irrelevant to the anticipation analysis; all that is required is that the prior art teach every limitation of the claimed invention, whether inherently or explicitly. *See, e.g., Upsher-Smith Laboratories, Inc. v. PamLab, LLC*, 412 F.3d 1319, 1323 (Fed. Cir. 2005) (noting that the question of whether a reference teaches away from the invention is inappropriate under the anticipation analysis). Moreover, as to the fact that Wheeler did not teach that the ball and socket joint to allow movement in a plurality of planes also does not preclude a finding of anticipation, as inherent anticipation does not require intent or recognition that a prior art process achieve a result which is claimed. *MEHL/Biophile Intern. Corp. v. Milgraum*, 192 F.3d 1362, 1365 (Fed. Cir. 1999). Finally, as we have already noted, Wheeler’s use of the term “substantially” in noting that the massager is “mounted to rotate on a pivot at substantially right angles to the longitudinal axis of a tooth brush or other suitable handle” (FF12) implies that there is some small amount of movement that is not at right angles to the

longitudinal axis, and all that is required by the claim is that small amount of movement.

CONCLUSION

Thus, we agree that the Examiner has established by a preponderance of the evidence that the gum massager of Wheeler is capable of performing “limited oscillation movement in a plurality of planes relative to said elongate handle, such that said resilient massaging element adapts to the contours of said gum being massaged when pushed thereagainst,” and the rejection is affirmed as to claim 18. As Appellants do not argue claims 19, 21, and 26-28 separately, the rejection is affirmed as to those claims as well. 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE (Obviousness)

The Examiner contends that claims 20, 22-25, 29, and 30 are obvious over Wheeler alone, or in combination with another reference.

Appellants contend “the currently claimed invention cannot be regarded as being obvious in the light of Wheeler alone, or in the light of Wheeler in combination with any other prior art, since **over 90 years** has elapsed since issue of Wheeler.” (Reply Br. 20.)

Thus, the issue on Appeal is: Whether the age of the Wheeler reference, in and of itself, is sufficient to overcome the Examiner’s rejections of obviousness over Wheeler alone, or in combination with another reference?

FINDINGS OF FACT

FF13 The Examiner rejects claim 20 under 35 U.S.C. § 103(a) as being obvious over Wheeler alone (Ans. 4).

FF14 The Examiner rejects claim 22 under 35 U.S.C. § 103(a) as being obvious over Wheeler as combined with Youngclaus, Jr. (Ans. 5).

FF15 The Examiner rejects claims 23-25, 29, and 30 under 35 U.S.C. § 103(a) as being obvious over Wheeler as combined with Metzler (Ans. 5).

PRINCIPLES OF LAW

The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) secondary considerations of nonobviousness, if any. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). The Supreme Court has recently emphasized that “the [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 1739. Moreover, an “[e]xpress suggestion to substitute one equivalent for another need not be present to render such substitution obvious.” *In re Fout*, 675 F.2d 297, 301 (CCPA 1982).

Finally, “[t]he mere age of the references is not persuasive of the unobviousness of the combination of their teachings, absent evidence that, notwithstanding knowledge of the references, the art tried and failed to solve the problem.” *In re Wright*, 569 F.2d 1124, 1127 (CCPA 1977).

ANALYSIS

Appellants assert that “the number of prior art patents cited, both by [A]ppellants in an Information Disclosure Statement, and by the [E]xaminer, indicate that the art **did** try to solve the same problem, and did have assumed knowledge of all previous references, but did not suggest the invention as described in claims 20, 22-25 and 29-30 of the present application.” (Reply Br. 20.) The number of references alone, however, is not evidence that the art tried and failed to solve the problem. In addition, Appellants point to nowhere in those references where it is shown that the art tried, and failed, to solve the problem.

CONCLUSIONS OF LAW

Thus, we conclude that the age of the Wheeler reference, in and of itself, is not sufficient to overcome the Examiner’s rejections of obviousness over Wheeler alone, or in combination with another reference, and the obviousness rejections are affirmed.

SUMMARY

In summary:

Appeal 2008-4404
Application 10/390,047

We reverse the rejection of claim 18 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement;

but

we affirm the rejection of claims 18, 19, 21, and 26-28 under 35 U.S.C. § 102(b) as being anticipated by Wheeler;

the rejection of claim 20 under 35 U.S.C. § 103(a) as being obvious over Wheeler alone;

the rejection of claim 22 under 35 U.S.C. § 103(a) as being obvious over Wheeler as combined with Youngclaus, Jr.; as well as

the rejection of claims 23-25, 29, and 30 under 35 U.S.C. § 103(a) as being obvious over Wheeler as combined with Metzler.

TIME LIMITS

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

AFFIRMED

cdc

VeriFresh Ltd.
P.O.B. 4604
Jerusalem 91046 IL ISRAEL