<table>
<thead>
<tr>
<th>APPLICATION NO.</th>
<th>FILING DATE</th>
<th>FIRST NAMED INVENTOR</th>
<th>ATTORNEY DOCKET NO.</th>
<th>CONFIRMATION NO.</th>
</tr>
</thead>
<tbody>
<tr>
<td>11/201,829</td>
<td>08/11/2005</td>
<td>Hironao Kawano</td>
<td>19076</td>
<td>6142</td>
</tr>
<tr>
<td>7590</td>
<td>02/14/2013</td>
<td></td>
<td></td>
<td></td>
</tr>
</tbody>
</table>

Thomas Spinelli  
Scully, Scott, Murphy & Presser  
400 Garden City Plaza  
Garden City, NY 11530

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.
This is an appeal under 35 U.S.C. § 134 involving claims to a capsule medical apparatus. The Examiner rejected the claims as obvious. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.
Statement of the Case

Background

The Specification teaches “a capsule medical apparatus includes a capsule exterior member and a sensor that can detect the change of an atmospheric physical quantity” (Spec. 2, ll. 10-13).

The Claims

Claims 1, 5-9, and 12-14 are on appeal. Claim 1 is representative and reads as follows:

1. A capsule medical apparatus comprising:
   a capsule exterior member;
   an electric circuit arranged in the exterior member;
   a battery arranged in the exterior member; and
   a switch circuit for controlling to switch a state of energy supply from the battery to the electric circuit to one of an ON-state and OFF-state;
   wherein the switch circuit includes:
   a first physical quantity detecting unit which can detect a temporary change of a first physical quantity outside the exterior member and which, upon detecting the temporary change of the first physical quantity, starts the energy supply from the battery;
   a second physical quantity change detecting unit which can detect a temporary change of a second physical quantity outside the exterior member and which, upon detecting the temporary change of the second physical quantity, stops the energy supply from the battery; and
   a power supply state holding unit which holds the state of energy supply from the battery to the electric circuit to the OFF-state until the first physical quantity change detecting unit detects the temporary change of the first physical quantity, and holds the state of energy supply from the battery to the electric circuit to the ON-state until the second physical quantity change detecting unit detects the temporary change of the second physical quantity; and
   wherein the first physical quantity and the second physical quantity are physical quantities of different types from each other.
The issue

The Examiner rejected claims 1, 5-9, and 12-14 under 35 U.S.C. § 103(a) as obvious over Gazdzinski\(^1\) (Ans. 5-9).

The Examiner finds that Gazdzinski discloses a “capsule medical apparatus comprising: [03a] a capsule exterior member (‘probe 300 comprises an outer housing 302’ [0145]); [03b] an electric circuit arranged in the exterior member (‘digital processor core 1604 of the ASIC’ [0232]); [03c] a battery arranged in the exterior member (‘battery may be used’[0155])” (Ans. 5). The Examiner finds that Gazdzinski teaches “a switch circuit (‘processing logic 1709’ of ‘tag 1702’ [0231]) for controlling to switch a state of energy supply from the battery to the electric circuit to one of an ON-state and OFF-state” (Ans. 6).

The Examiner finds that “Gazdzinski does not disclose a second physical quantity change detecting unit which can detect a temporary change of a second physical quantity” (Ans. 7). The Examiner finds it obvious to “provide separate physical quantity detecting units, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art” (Ans. 7). The Examiner finds it obvious “to provide a first circuit for turning the probe ON and a second circuit for turning the probe OFF as opposed to a single circuit for turning the probe ON and OFF” (Ans. 7).

The issue with respect to this rejection is: Does the evidence of record support the Examiner’s conclusion that Gazdzinski renders claim 1 obvious?

---

Findings of Fact

The following findings of fact (“FF”) are supported by a preponderance of the evidence of record.

1. Gazdzinski teaches “the use of smart technology within miniature remote devices for the inspection, diagnosis, and treatment of internal organs of living organisms” (Gazdzinski 1 ¶ 0003).

2. Gazdzinski teaches that the “probe outer housing 302 generally contains a number of different components in its internal cavity 303 . . . A number of discrete or integrated semiconductor components are also present within the probe 300, including a ‘flash’ analog-to-digital converter ADC 512 . . . microcontroller (or microprocessor) 520” (Gazdzinski 11 ¶ 0155).

3. Gazdzinski teaches that “a battery may be used” (Gazdzinski 11 ¶ 0155).

4. Gazdzinski teaches that the probe may be completely powered down until it is awaken by the tag 1702, thereby providing significant power savings prior to in vivo operation. Such power savings are even greater than those provided by the processor “sleep mode” previously described . . . when using the RFID tag 1702 wake up feature, the digital processor core 1604 of the ASIC may be completely shut down, including clock generator, pipeline, and (static) memory. (Gazdzinski 21 ¶ 0232).

5. Gazdzinski teaches that “the tag ‘reader’ 1750 . . . interrogates the probe 1700 and RFID device 1702 at its designated frequency, causing the tag to ‘wake’ and initiate communications protocols disposed within the tag memory 1702” (Gazdzinski 21 ¶ 0231).
6. Gazdzinski teaches that once “protocols are established, the reader transmits preformatted data representative . . . prior to a given subject swallowing or having the probe introduced endoscopically, the tag memory \textsuperscript{1708} is encoded . . . via signals received from the reader \textsuperscript{1750} via the . . . processing logic \textsuperscript{1709}” (Gazdzinski 21 ¶ 0231).

7. Gazdzinski teaches that “the smart probe . . . is designed to be initially introduced into the patient after which time the probe operates autonomously; i.e., only utilizing electrical, inductive, magnetic, or radio frequency signals to enable or perform certain desired functions, with no direct external physical contact or connections” (Gazdzinski 9 ¶ 0132).

Principles of Law

An invention “composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art…. [I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” \textit{KSR Int’l Co. v. Teleflex Inc.}, 550 U.S. 398, 418 (2007).

Analysis

The Examiner finds it obvious “to provide separate physical quantity detecting units, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art” (Ans. 7). Specifically, the Examiner finds it obvious “to provide a first circuit for turning the probe ON and a second circuit for turning the probe OFF as opposed to a single circuit for turning the probe ON and OFF (‘transceiver section 1707’ as disclosed by Gazdzinski)” (Ans. 7).
Appellants contend that “there is no suggestion in Gazdzinski to use separate physical quantity detecting units to change from an ON-state to an OFF-state. As the Examiner admits, Gazdzinski only discloses turning power ON and OFF by detection of the signal with the same transceiver section (1707).” (App. Br. 7). Appellants “do not find the cited Nerwin case as holding that constructing a formerly integral structure in various elements is obvious” (App. Br. 7).

We agree with Appellants. The Examiner has provided no reason to separate the single ON-OFF circuit in Gazdzinski into two separate circuits, i.e., two separate physical quantity detecting units. Instead, the Examiner relies upon caselaw, specifically Nerwin and KSR (see Ans. 11-12), to support the obviousness position. In the context of satisfying the description requirements for an interference count in Nerwin, the BPAI found that the “mere fact that a given structure is integral does not preclude its consisting of various elements.” Nerwin v. Erlichman, 168 USPQ 177, 179 (BPAI 1969). This differs from the current situation, where the Examiner attempts to convert this written description fact pattern into a per se rule that separating a single component into two components is obvious.

We conclude that this reading of Nerwin is incorrect and does not establish that it is per se obvious to separate a single component into two components. We decline to apply such a per se rule. Along the same lines, we also disagree with the Examiner’s reading of KSR. KSR does not indicate that simply because a person of ordinary skill could have made the change disclosed in the claimed invention, that change is necessarily obvious (see Ans. 12). As we quoted above, an invention “composed of several
elements is not proved obvious merely by demonstrating that each of its
elements was, independently, known in the prior art” *KSR*, 550 U.S. at 418.
Instead, some reason must be found. *DyStar* teaches that the reason need not
be found in the prior art, but may be implicit when the “‘improvement’ is
technology-independent and the combination of references results in a
product or process that is more desirable, for example because it is stronger,
cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient.”
*DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464
F.3d 1356, 1368 (Fed. Cir. 2006).

In this case, the Examiner has not provided a reason from the
references, a technology-independent reason, or any other reason whatsoever
to separate the single circuit into two circuits, or otherwise provide two
separate physical quantity detecting units. We therefore reverse this
rejection.

*Conclusion of Law*

The evidence of record does not support the Examiner’s conclusion
that Gazdzinski renders claim 1 obvious.

*SUMMARY*

In summary, we reverse the rejection of claims 1, 5-9, and 12-14
under 35 U.S.C. § 103(a) as obvious over Gazdzinski.

*REVERSED*

dm