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MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			EIDE, HEIDI MARIE	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JEFF COHEN

Appeal 2013-006162
Application 13/192,680¹
Technology Center 3700

Before MICHAEL C. ASTORINO, BRUCE T. WIEDER, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

WIEDER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1, 3–9, and 11. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

CLAIMED SUBJECT MATTER

Appellant's claimed invention "relates to covers for dental mirrors."
(Spec. 1.)

¹ According to Appellant, the real party in interest is DENGUARD LLC.
(Appeal Br. 1.)

Claim 1 is the sole independent claim on appeal. Claim 1 recites:

1. A dental mirror apparatus cover comprising:

A. a generally round and planar back portion suitable for covering a dental mirror frame and

B. a curved side portion extending from the round and planar back portion with curved walls for extending over and around sides of a frame of a dental mirror and of a length suitable for securing said dental mirror cover to a frame of a dental mirror without obstructing a mirror surface of the dental mirror and wherein an inner surface of said curved side portion consists of a single curve or is flat and wherein said round and planar back portion and curved side portion comprise soft elastic material, and

wherein portions A and B comprise one piece.

REJECTIONS

Claims 1, 3–5, 8, and 11 are rejected under 35 U.S.C. § 103(a) in view of Meyerhof (US 6,666,682 B1, iss. Dec. 23, 2003), Meliconi (US 5,265,720, iss. Nov. 30, 1993), and Wickman-Dykes (US 2011/0183107 A1, pub. July 28, 2011).

Claims 6 and 7 are rejected under 35 U.S.C. § 103(a) in view of Meyerhof, Meliconi, Wickman-Dykes, and Cooper (US 4,757,381, iss. July 12, 1988).

Claim 9 is rejected under 35 U.S.C. § 103(a) in view of Meyerhof, Meliconi, Wickman-Dykes, and Jodaikin (US 2009/0042161 A1, pub. Feb. 12, 2009).

ANALYSIS

The Examiner finds that “Meyerhof teaches a dental mirror apparatus cover” but that it “does not specifically teach the cover comprises a

generally round and planar back portion from with [sic] the curved side portion extend from and wherein the back and curved side portions are a single piece.” (Final Action 2.) The Examiner also finds that “Meliconi teaches a cover comprising a planar back portion and curved side walls extending from the planar back portion, wherein the back portion and side walls are of a single piece (see fig. 6).” (*Id.* at 2–3.) The Examiner then determines that

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the bumper taught by Meyerhof with the cover comprising a back portion connected to the side portions as taught by Meliconi in order to protect the patient from the back surface of the hard mirror while only exposing the working surface.

(*Id.* at 3.)

Meyerhof relates to an “intra-oral mirror.” (Meyerhof, Title.) Wickman-Dykes relates to a “dental mirror protective cover.” (Wickman-Dykes, Title.) Meliconi relates to a “shock-proof protective jacket for a remote control unit.” (Meliconi, Title.)

Appellant argues that Meliconi is non-analogous art (Appeal Br. 5–6) and that the Examiner relies on impermissible hindsight (Reply Br. 5). Specifically, Appellant argues that “[i]n the current case, the purpose of the dental mirror cover is to protect the teeth from a dental mirror frame when in use. The purpose of the remote control cover is to protect the remote control from damage not to protect the hand using it or the table it rests on when not in use.” (Appeal Br. 6.) In other words, Appellant argues “that one of ordinary skill in the art would not look to prior art teachings regarding remote control covers when constructing a dental mirror cover” (*id.* at 5) and “that the basic knowledge (common sense) of a dental mirror cover artisan is

likely to be different from the basic knowledge in the possession of a remote control cover artisan” (*id.* at 6).

The pertinence of the reference as a source of solution to the inventor’s problem must be recognizable with the foresight of a person of ordinary skill, not with the hindsight of the inventor’s successful achievement. *See In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992) (“Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant’s invention”); *see also KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421, 127 S. Ct. 1727, 167 L. Ed. 2d 705 (2007) (“A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning.”).

Scientific Plastic Prods., Inc. v. Biotage AB, 766 F.3d 1355, 1362 (Fed. Cir. 2014).

The Examiner finds that

Meliconi is reasonably pertinent to the particular problem with which the applicant is concerned. It teaches a cover which covers an entire instrument except for the working surface which protects the instrument. The prior art of Meyerhof teaches a cover for protecting the instrument and teeth as discussed in detail above. Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the cover of Meyerhof with the cover of Meliconi in order to protect the entire instrument and the users [sic] teeth from the entire instrument, expect [sic] for the working portion which cannot be covered.

(Answer 4.)

Meliconi “relates to a shock-proof protective jacket, particularly suitable for portable remote control units of televisions, recording instruments and in general remote-control units, such as for example portable telephones, alarm clocks, professional instruments such as calculators, measuring instruments and suchlike.” (Meliconi, col. 1, ll. 6–

11.) Figure 6 of Meliconi, relied on by the Examiner, “illustrates the jacket in longitudinal section . . . and according to an embodiment variant which can be effected in the case of instruments or portable remote control units with one end substantially cusp-shaped or in any case tapered.” (*Id.* at col. 2, ll. 15–19.)

We agree with Appellant that the Examiner relied on impermissible hindsight. It is not clear to us, and the Examiner has not shown, that the pertinence of the Meliconi reference as a source of solution to the inventor’s problem would have been recognizable with the foresight of a person of ordinary skill, absent the hindsight of the inventor’s achievement. *See Scientific Plastic Prods., Inc. v. Biotage AB*, 766 F.3d at 1362; *see also* Reply Br. 5.

Therefore, we are persuaded that the Examiner erred in rejecting claim 1 under § 103 in view of Meyerhof, Meliconi, and Wickman-Dykes. For the same reason, we are persuaded that the Examiner erred in rejecting dependent claims 3–9 and 11.

DECISION

The Examiner’s rejections of claims 1, 3–9, and 11 under 35 U.S.C. § 103(a) are reversed.

REVERSED