

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HEE K. YOON
and EDWARD L. CHO

Appeal No. 96-1100
Application 07/836,032¹

ON BRIEF

Before MEISTER, ABRAMS and McQUADE, *Administrative Patent Judges*.
ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1 through 8, which constitute all of the claims of record in the application.

¹ Application for patent filed February 14, 1992.

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The appellants' invention is directed to an orthopaedic bandage having printing material on its surface. The subject matter before us on appeal is illustrated by reference to claim 1, which reads as follows:

1. An orthopaedic bandage comprising:
 - a. a fibrous substrate having a surface at least 50% of the fibers on said surface having a Young's Modulus greater than 8×10^6 pounds per square inch;
 - b. printing material on said surface comprised of a plastisol and pigment; and
 - c. a curable resin coating on said substrate and said printing material.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Baron et al. (Baron)	4,627,424	Dec. 9, 1986
Papp, Jr. (Papp)	4,935,019	June 19, 1990
Freeman et al. (Freeman)	5,088,484	Feb. 18, 1992
Scholz et al. (Scholz)	5,342,291	Aug. 30, 1994

THE REJECTIONS

Claims 1 through 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Freeman in view of Papp and Baron.²

² A rejection based upon Papp in view of Freeman and Baron was not repeated in the Answer, and therefore is considered to have been withdrawn.

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Claims 1, 4 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Scholz in view of Baron.

The rejections are explained in the Examiner's Answer and Supplemental Answers.

The opposing viewpoints of the appellants are set forth in the Brief and the Reply Brief.

OPINION

Independent claim 1 requires, *inter alia*, that the printing material be comprised of a plastisol and a pigment, with a plastisol having been defined by the appellants as a mixture of resin and plasticizer (Paper No. 16). In the first of the two rejections, the examiner looks for this teaching to Papp, which is directed to the fabrication of a colored X-ray detectable surgical sponge. The examiner's position is that the claimed subject matter would have been obvious by modifying Freeman, the primary reference, in view of this showing of Papp. However, we agree with the appellants that Papp would not have suggested the required plastisol and pigment printing material to one of ordinary skill in the art because all of Papp's printing materials contain a radiopaque substance, which would be counter-productive if used in Freeman's orthopaedic bandage. We

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specifically reject the examiner's argument that it would have been obvious to discard the radiopaque element in the printing materials, for the only suggestion for this is found via impermissible hindsight.

Insofar as the second rejection of claim 1 is concerned, we find ourselves in agreement with the appellants' position that while Scholz teaches using a plasticizer in printing material for an orthopaedic bandage, it does not teach using a plastisol, which is not the same thing.

Among the limitations in independent claim 6 is that the printing material be comprised of a water-based acrylic and a pigment. Here, the examiner again points to Papp, which discloses an acrylic latex emulsion as an ingredient in another example of a radiopaque printing material. As was the case above, we share the appellants' view that there is no suggestion, other than hindsight, which would have motivated an artisan to separate the acrylic latex and the pigment from the remaining ingredients and utilize them as printing material on the Freeman orthopaedic bandage.

The examiner bears the initial burden of presenting a *prima facie* case of obviousness (see *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)), which is

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established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary

skill in the art (see *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)). Neither of the rejections meet this test and therefore they cannot be sustained (see *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)).

The decision of the examiner is reversed.

REVERSED

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JAMES M. MEISTER)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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JOHN P. McQUADE)	
Administrative Patent Judge)	

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Robert L. Minier
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003