

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(2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LARRY L. HITE
and
STEPHEN M. BECK

Appeal No. 96-1391
Application 08/170,503¹

ON BRIEF

Before CALVERT, STAAB and McQUADE, Administrative Patent
Judges.

CALVERT, Administrative Patent Judge.

¹ Application for patent filed December 20, 1993.

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Application 08/170,503

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 11, all the claims in the application. In the examiner's answer, the examiner states that claims 5 to 11 are allowed, leaving claims 1 to 4 for our consideration.

Claim 1, the only independent claim on appeal, is illustrative of the subject matter in issue:

1. A femoral artery compression device for post operative use in closing an incision, puncture or cut in the femoral artery, comprising:

inflatable means for adjustably creating compressive pressure,

first means for receiving said compressive pressure and applying that pressure to said femoral artery,

self contained means for applying reduced temperatures at least to the tissue adjacent to said femoral artery, and

adjustable means for securing said first means and said self contained means to a predetermined location adjacent said femoral artery.

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The references applied by the examiner in rejecting the claims now before us are:

Sconce 1975	3,901,225	Aug. 26,
Byrd 1993	5,228,448	July 20,

Claims 1 to 4 stand rejected as follows:

(1) Claims 1 and 4, anticipated by Sconce, under 35 U.S.C. § 102(b);

(2) Claims 2 and 3, unpatentable over Sconce in view of Byrd, under 35 U.S.C. § 103.²

We have fully considered the record in light of the arguments presented in appellants' brief and reply brief, and in the examiner's answer and supplemental answer. Our conclusions as to each of the two grounds of rejection are discussed under separate headings below.

Rejection (1)

² This was a new ground of rejection made in the examiner's answer. Appellants filed a reply to this new ground, and the examiner issued a supplemental answer (Paper No. 11).

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As appellants correctly state on page 5 of their
brief:

In order to properly reject claims under [35 U.S.C.] 102(b), the single cited reference must show each and every feature of the claimed invention either expressly or under principles of inherency. Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 771 [, 218 USPQ 781, 789] (Fed. Cir. 1983) [, cert. denied, 465 U.S. 1026 (1984)]. If an element of the claim is expressed in terms of a means plus function, "absent structure which is capable of performing the functional limitation of the 'means,'" the prior art reference is not anticipating. In re Mott, 557 F.2d 266, 269 [, 194 USPQ 305, 307] (C.C.P.A. 1977). Means plus function limitations of a claim "cannot be met by an element in a reference that performs a different function, even though it may be part of a device embodying the same general overall concept." RCA Corp. v.

Applied Digital Data Systems, et al., 730 F.2d 1440, at footnote 5 [, 221 USPQ 385, 389 n.5] (Fed. Cir. 1984). When anticipation is based upon principles of inherency, the structure of the prior art reference must necessarily function in accordance with the function of the limitations of the claims in issue. In re King, 801 F.2d 1324, 1326 [, 231 USPQ 136, 138] (Fed. Cir. 1986).

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However, applying these principles, we do not agree with appellants that Sconce is not anticipatory of claims 1 and 4.

Appellants argue that Sconce does not disclose or teach using the inflatable device disclosed "for post operation nor in closing an incision, puncture or cut in the femoral artery," as recited in the preamble of claim 1. Nevertheless, Sconce does disclose an inflatable splint for immobilizing an injured extremity and for "applying thermal [e.g., cold] pressure to an injured area" of an immobilized extremity, including a bladder releasably secured "around an injured arm or leg" and which "also can act as a tourniquet by restricting the flow of blood to the injured area in accordance with the amount of pressure it exerts" (col. 1, lines 4 to 13). Sconce further expressly discloses application of the splint to a patient's leg as follows: The splint "can be applied in a large number of configurations throughout the body, such as at the . . . legs of the patient" (col. 1, lines 33 to 36) and "the [inflatable] bladder [of the splint] can surround various areas of any extremity of a patient which may

become injured, such as a patient's . . . leg" (col. 2, lines 56 to 59).

Since Sconce discloses that his inflatable splint may be applied to the leg, and the femoral artery is located in the leg, it follows that Sconce's splint is capable of performing the functions of the means recited in claim 1, i.e., it has (1) inflatable means 12, 14 "for adjustably creating compressive pressure"; (2) a cold pack 63 or 64 which receives the compressive pressure and would be capable of both "applying that pressure to said femoral artery" and of "applying reduced temperatures at least to the tissue adjacent to said femoral artery"; and (3) tabs 22, 26 capable of "securing [the device] to a predetermined location adjacent said femoral artery." Appellants argue that Sconce does not refer to the femoral artery or to localized compression to close an incision, puncture or cut in the femoral artery. However, in order to anticipate a claimed means plus function, the function need not be expressly disclosed in the reference. In the present case, Sconce's inflatable splint, disclosed as being applicable to the leg, anticipates the recited means in that

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it clearly is inherently capable of applying both pressure and reduced temperatures to the femoral

artery. It is pointed out that appellants are here claiming apparatus, not a method of use.

With regard to claim 4, the examiner takes the position that (answer, pp. 6 to 7):

The claimed invention recites no specified pressure reduction rate achieved by the quick release element. Thus, in the Examiner's view, any reduction in compressive pressure provided by the Sconce reference is considered to be rapid. Accordingly, both the release of the tab fasteners [22, 26 of Sconce], even if only one is released, and the opening of the screw cap fittings [61 on valves 60 of Sconce] are considered to provide a "rapid" reduction in compressive pressure.

We agree. Although the release of Sconce's tabs or the opening of the opening of Sconce's valve screw caps might not release the pressure as fast as appellants' disclosed quick release valve 36, the claim is not so limited. Also, we note that certainly the release of the last of Sconce's tabs to be

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undone would cause a very rapid reduction in compressive pressure.

Accordingly, we conclude that claims 1 and 4 are anticipated by Sconce, and will sustain rejection (1).

Rejection (2)

The examiner asserts that the subject matter recited in claims 2 and 3 would have been obvious over Sconce in view of Byrd because (supplemental answer, p. 2):

Since [sic] the Byrd reference recognizes that cuffs positioned on a patient become contaminated with bacterial colonizations (see column 1, lines 11-23). In view of this recognition, it is the Examiner's position that it would have been obvious to one skilled in the art to provide the Sconce device with a sterile surface to prevent contamination of the device. The provision of a sterile surface would not require the use of the Byrd protective cover, but merely the provision of sterile overlying sheets. We note that on pages 9 to 10 of their brief,

appellants argue:

Moreover, the Examiner has ignored the definition of a "packaging element" in Claim 2 and the specific orientation of elements in that packaging element defined in Claim 3. These features are not found in Sconce. Instead, the cited reference shows the thermal elements (64) alone to be packaged within pockets on the interior surface of the air bladder. The air

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bladder itself is not packaged within another element. This distinction has practical importance, for example, when combined with the teaching of using a sterile packaging surface in contact with the body tissue. The present invention provides separate elements such that the sterile surface can be constructed, cleaned and/or replaced independently of the air bladder.

The examiner does not appear to have responded to this argument.

Looking first at claim 3, it is recited that "said inflatable means is disposed within said packaging element." This limitation is not found in Sconce, since the one wall 14 of the inflatable means constitutes part of the "packaging element," rather than the inflatable means being within a packaging element. We find nothing in the combination of Sconce and Byrd which would suggest this claimed construction, and therefore will not sustain the rejection of claim 3.

Claim 2, on the other hand, recites only that "said inflatable means, first means, and self contained means are included at least in part within a packaging element" (emphasis added). This limitation is met by Sconce, in that

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Sconce's cold pack 63 or 64, which constitutes both the "first means" and the "self contained means," is located within the "packaging element" formed by walls 14 and 42; therefore, the three recited means are included "at least in part" within Sconce's packaging element in that two of them are so included.

Column 1, lines 11 to 23 of the Byrd reference, cited by the examiner, discloses that the blood-pressure cuffs of sphygmomanometers can become contaminated from use on patients, and that it has been recommended that the problem be solved by using a sterilized cuff. Although appellants argue on page 9 of their brief that "unless a penetrating wound is involved, the use of a sterile surface is unnecessary," Byrd's teaching is to the contrary. The noted disclosure of Byrd would, in our view, have

suggested to one of ordinary skill that other "cuffs," such as the inflatable splint of Sconce, may become contaminated by use on patients, and that the surface which contacts the

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patient's skin (i.e., sheet 42 of Sconce) should be sterilized. We therefore conclude that the subject matter recited in claim 2 would have been obvious to one of ordinary skill over Sconce in view of Byrd, and will sustain this rejection.

Conclusion

The examiner's decision to reject claims 1, 2 and 4 is affirmed. Her decision to reject claim 3 is reversed.

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

AFFIRMED-IN-PART

	IAN A. CALVERT)	
	Administrative Patent Judge)	
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)	BOARD OF
PATENT)	
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