

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES V. CARTMELL, WAYNE R. STURTEVANT
and MICHAEL L. WOLF

Appeal No. 97-1029
Application 08/456,166¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, STAAB
and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed May 31, 1995. According to appellants, the application is a division of Application 08/144,003, filed November 1, 1993, now U.S. Patent No. 5,695,456, issued December 9, 1997, which is a continuation-in-part of Application 07/862,456, filed April 2, 1992, now U.S. Patent No. 5,429,589, issued July 4, 1995.

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James V. Cartmell et al. appeal from the final rejection of claims 25 through 30, all of the claims pending in the application. As the result of an amendment subsequent to final rejection, the examiner has withdrawn all rejections of claim 26 and this claim now stands objected to as depending from a rejected base claim. Thus, only the standing rejections of claims 25 and 27 through 30 remain for review.

The invention relates to "a wound packing in the form of a flexible spirally-cut layer capable of absorbing wound exudate" (specification, page 1). Claim 25 is illustrative and reads as follows:

25. A wound packing comprising:

a flexible wound packing material capable of absorbing wound exudate, said flexible material being in the form of a substantially flat, coiled, spirally-cut layer impregnated with a hydrogel material.

The references relied upon by the examiner as evidence of anticipation and obviousness are:

Romaine	4,377,160	Mar. 22, 1983
Koide et al. (Koide)	5,395,305	Mar. 7, 1995
		(filed Aug. 16, 1991)

The claims on appeal stand rejected as follows:

a) claim 27 under 35 U.S.C. § 112, second paragraph, as

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failing to particularly point out and distinctly claim the subject matter the appellants regard as the invention;

b) claims 25, 28 and 29 under 35 U.S.C. § 102(b) as being anticipated by Romaine;² and

c) claim 30 under 35 U.S.C. § 103 as being unpatentable over Romaine in view of Koide.

Reference is made to the appellants' main and reply briefs (Paper Nos. 10 and 11½) and to the examiner's main and supplemental answers (Paper Nos. 11 and 13) for the respective positions of the appellants and the examiner with regard to the merits of these inventions.

The 35 U.S.C. § 112, second paragraph, rejection rests on the examiner's determination that claim 27 is indefinite because the term "the outer surface" which appears therein lacks a proper antecedent basis (see pages 4, 6 and 7 in the main answer). The appellants, stating that they "are willing to amend claim 27 to provide proper antecedent basis by

² In the final rejection, claim 27 also was rejected under 35 U.S.C. § 102(b) as being anticipated by Romaine. The examiner has since withdrawn this rejection in view of the amendment of parent claim 26 subsequent to final rejection.

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reciting that the wound packing has outer surfaces" (reply brief, page 2), appear to acquiesce to the examiner's position. Accordingly, we shall sustain the standing 35 U.S.C. § 112, second paragraph, rejection of claim 27.

We shall not sustain, however, the standing 35 U.S.C. § 102(b) rejection of claims 25, 28 and 29 as being anticipated by Romaine, or the standing 35 U.S.C. § 103 rejection of claim 30 as being unpatentable over Romaine in view of Koide.

Romaine discloses a "compression bandage adapted to be wrapped around a selected portion of the human or animal body, for minimizing swelling caused by a sprain, contusion or bruise" (column 1, lines 6 through 9). The bandage 10 is an elongate, flat, pliant strip of flexible, open-cell, synthetic resin foam 11 impregnated with a high water content gel 12.

As explained by Romaine,

[t]he thickness of the strip is ordinarily in the range of about 3/16 to about 5/16 inch, preferably about ¼ inch. The width of the strip is selected so that the body part can be completely wrapped by making only a few turns of the bandage around the

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body part. Thus, for wrapping the extremities of the human body, such as the hand or foot, the width of the bandage is from about 1 inch to about 3 inches, preferably about 2 inches. The length of the bandage is selected so as to be effective to wrap the entire area of the human or animal body part to which the bandage is to be applied. For example, the length of the bandage can be from about 2 to about 6 feet, with a length of about 4 feet being preferred for most practical uses [column 3, lines 28 through 41].

Romaine indicates that this bandage is "packageable in a small and compact form because it can be spirally rolled for storage" (column 1, lines 57 through 59).

Claims 25, 29 and 30, the three independent claims on appeal, recite a wound packing comprising, inter alia, a flexible wound packing material "in the form of a substantially flat, coiled, spirally-cut layer." The examiner's determination that the Romaine bandage when spirally rolled for storage meets this limitation (see pages 5, 7 and 8 in the main answer) is not well taken. Although the Romaine bandage as so rolled arguably would be coiled, it still would not be a substantially flat, spirally cut layer as claimed. The examiner's finding to the contrary is unsound because it is predicated on an unreasonable interpretation of

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the claim limitation at issue, particularly when such is interpreted, as it must be, in light of the underlying specification (see pages 8 and 9). Moreover, there is nothing in the Romaine disclosure which would have suggested modifying the compression wrap bandage disclosed therein to take the form of a "substantially flat, coiled, spirally-cut layer." Since Koide does not cure this deficiency in Romaine with respect to the subject matter recited in independent claims 25, 29 and 30, the standing prior art rejections of these claims, and of claim 28 which depends from claim 25, must fall.

The following rejection is entered pursuant to 37 CFR § 1.196(b).

Claim 26, and claim 27 which depends therefrom, are rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which fails to comply with the written description requirement of this section of the statute.

The test for determining compliance with the written description requirement is whether the disclosure of the

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application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). In the present case, there is no basis in the appellants' originally filed disclosure for the recitation in claim 26 that the hydrogel impregnated in the wound packing material "is devoid of water." To the contrary, the original disclosure indicates that this hydrogel, even when dehydrated, contains at least a small degree of water (see, for example, specification pages 4, 13, 15 and 16). Thus, the disclosure of the instant application

packing comprising a hydrogel which is devoid of water as is now recited in claims 26 and 27.

In summary:

a) the decision of the examiner to reject claims 25 and 27 through 30 is affirmed with respect to claim 27 and reversed with respect to claims 25 and 28 through 30; and

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b) a new rejection of claims 26 and 27 is entered pursuant to 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37

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CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed

rejection, including any timely request for reconsideration

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thereof.

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; 37 CFR § 1.196(b)

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge))
)	
)	
LAWRENCE J. STAAB)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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JOHN P. McQUADE)	
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