

**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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* GARY W. CUMMINGS and ROBERT CUMMINGS

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Appeal No. 97-1836  
Application No. 08/324,818<sup>1</sup>

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ON BRIEF

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Before ABRAMS, McQUADE and GONZALES, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

**DECISION ON APPEAL**

This is an appeal from the decision of the examiner finally rejecting claims 54-56, 58, 60-66, 68, 69, 71-74 and

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<sup>1</sup> Application for patent filed October 17, 1994. According to appellants, this application is a continuation of Application No. 08/088,625 filed July 1, 1993, now pending; which is a continuation of Application No. 07/780,619 filed October 23, 1991, now abandoned.

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76, which constituted all of the claims remaining of record. However, the examiner has since indicated that claims 71-73 contain allowable subject matter, which leaves claims 54-56, 58, 68, 69, 74 and 76 before us on appeal.

The appellants' invention is directed to a composite dressing applicable to a wound. The subject matter before us on appeal is illustrated by reference to claim 54, which has been reproduced in an appendix to the Brief (Paper No. 19).

**THE REFERENCES**

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

Sims	4,638,796	Jan.
27, 1987		
Gilman	5,106,362	Apr. 21,
1992		

**THE REJECTION**

Claims 54-56, 58, 60-66, 68, 69, 74 and 76 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sims in view of Gilman.

The rejection is explained in the Examiner's Answer.

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The appellants' arguments in opposition to the positions taken by the examiner are set forth in the Brief and the Reply Brief.

### OPINION

In reaching our decision on the issues raised in this appeal, we have carefully assessed the claims, the prior art applied against the claims, and the respective views of the examiner and the appellants as set forth in the Answer and the Brief. As a result of this review, we have concluded that the teachings of the references relied upon fail to establish a *prima facie* case of obviousness with respect to the claimed subject matter. This being the case, we will not sustain the rejection. Our reasons for arriving at this decision follow.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness under 35 U.S.C. § 103, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the

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art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972, 973 (BPAI 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellants' disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1052 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

The appellants' invention provides a two part wound dressing that can be applied in one step and allows redressing of the wound without disturbing it. As pointed out in the opening pages of the specification, this solves a number of problems that were present in the prior art systems, wherein an essentially non-adherent contact component was installed upon the wound in a first step, to be followed by the installation of an absorbent material in a second step. The Sims patent, which the examiner has applied as the primary reference, is cited on page 3 of the appellants' specification

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as an example of the type of system over which they believe their invention to be an improvement. It is the examiner's position that Sims discloses all of the structure set forth in the three independent claims except for the direct attachment of the contact component to the absorbent dressing component, but that Gilman

teaches that direct attachment of a removable absorbent layer from [sic] a wound contact component would have been obvious . . . in order to improve the contact between the two devices over the whole surfaces thereof and for the same reasons that Gilman ('362) does the same (Answer, page 4).

We have a number of problems with this conclusion.

Sims is illustrative of the prior art, in that it teaches a two-step process in which a substantially non-adherent contact component is installed upon the wound and then is covered with an absorbent dressing component. There is no teaching of attaching the dressing component to the contact component, much less releasably attaching it thereto, as is required by all of the independent claims on appeal. Gilman discloses a number of embodiments of a dressing in which the primary objective is to allow the wound to be vented. The examiner refers specifically to the embodiment of Figure 7,

where an absorbent component (44) is "secured" to the back surface of a base sheet (12) which, in turn, is secured to the skin of the patient such that an opening (22) therein is over the wound. The absorbent component is not releasably attached to the base sheet. See column 3, line 64 *et seq.* The examiner also refers to the embodiment of Figures 10-12, wherein an absorbent component (76) is "releasably secured in place over the second vent sheet 68," which is two layers removed from the component that is in contact with the patient. See column 5, line 15 *et seq.* The manner in which this absorbent pad is "releasably secured" is not disclosed in the discussion of the embodiment of Figures 10-12 but, in our view, one of ordinary skill in the art would have understood it to be in the same manner as is shown in Figure 2, where it also is releasably attached, and that is by taping it to the patient's skin. See column 3, line 37 *et seq.* Thus, while Gilman teaches that some components may be attached together, and that an absorbent pad may be releasably secured to the patient's skin, it does not teach releasably securing an absorbent pad directly to the component that is in contact

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with the patient's skin, nor does it teach a one step installation in those embodiments in which the absorbent component is removable.

The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The examiner has offered very sparse explanations of his rationale in constructing the rejection and, even when viewing the situation in the most charitable light, we fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to modify the Sims dressing in the manner proposed by the examiner. From our perspective, the only suggestion for accomplishing this is found in the luxury of the hindsight afforded one who first viewed the appellants' disclosure. Suggestion arising from the appellants' disclosure is, of course, impermissible as the basis for a rejection. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

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It therefore is our opinion that the combined teachings of Sims and Gilman fail to establish a *prima facie* case of obviousness with regard to the subject matter recited in the three independent claims and, it follows, of any of the claims depending therefrom. This being the case, the rejection cannot be sustained.

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The decision of the examiner is reversed.

**REVERSED**

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
JOHN P. McQUADE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
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	)	
JOHN F. GONZALES	)	
Administrative Patent Judge	)	

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