

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JAMES J. ELTING  
and  
VINCENT N. TOSCANO

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Appeal No. 97-2226  
Application No. 08/203,789<sup>1</sup>

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ON BRIEF

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Before ABRAMS, NASE, and CRAWFORD, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 1 through 3, 10, 11, 22, 30 and 31, which are all of the claims pending in this application.<sup>2</sup>

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<sup>1</sup> Application for patent filed March 1, 1994.

<sup>2</sup> While the examiner has approved entry of the amendment after final rejection (Paper No. 10, filed September 12, 1995), we note that this amendment has not been clerically entered.

Appeal No. 97-2226  
Application No. 08/203,789

We REVERSE and enter new rejections pursuant to 37 CFR  
§ 1.196(b).

BACKGROUND

The appellants' invention relates to a surgical garment. An understanding of the invention can be derived from a reading of exemplary claims 1 and 22, which appear in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

Thompson	1,489,046	Apr. 1, 1924
Boettcher	2,374,643	May 1, 1945
Kephart et al. (Kephart)	2,504,534	Apr. 18, 1950
Schuessler	2,735,283	Feb. 21, 1956
Spriggs	4,622,699	Nov. 18, 1986
Dye et al. (Dye)	5,097,535	Mar. 24, 1992
Mucci et al. (Mucci)	5,222,258	June 29, 1993

The appealed claims stand rejected under 35 U.S.C. § 103 as set forth in the examiner's answer (Paper No. 16, mailed August 14, 1996) as follows:

a) claims 1 and 10 as being unpatentable over Boettcher in view of Dye, Kephart, Mucci and Schuessler;

b) claims 2 and 3 as being unpatentable over Boettcher in view of Dye, Kephart as applied to claim 1 and further in view of Spriggs;

c) claim 11 as being unpatentable over Boettcher in view of Gershman<sup>3</sup>;

d) claims 30 and 31 as being unpatentable over Boettcher in view of Dye as applied to claim 1 and further in view of Thompson; and

e) claim 22 as being unpatentable over Boettcher in view of Dye, Kephart Mucci and Gershman.<sup>4</sup>

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the § 103 rejections, we make reference to the examiner's answer for the examiner's complete reasoning in support of the rejections, and to the

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<sup>3</sup> We are unable to locate a copy of Gershman in the application filewrapper. Additionally, we are unable to find Gershman cited on any of the Notices of References Cited (Form PTO-892) or the Information Disclosure Statements (Form PTO-1449) of record in the application file. Accordingly, we are unable to consider the teachings of Gershman. However, since the examiner relied upon Gershman for only a teaching of Velcro® and we are reversing the rejections made by the examiner for other reasons as explained infra, we see no need to remand this application to the examiner to provide a copy of Gershman.

<sup>4</sup> Id.

appellants' brief (Paper No. 15, filed February 15, 1996) and  
reply brief (Paper No. 17, filed October 21, 1996) for the  
appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Initially we note that the appellants' argument that the examiner's answer set forth new grounds of rejections relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Accordingly, we cannot review this issue raised by the appellants on pages 1-2 of the reply brief.

The two independent claims<sup>5</sup> (i.e., claims 1 and 22) on appeal each recite that the form-fitting surgical garment

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<sup>5</sup> For consistency with the original disclosure which disclosed only a single opening 16 in the hood piece 18, the phrase "closable openings" in claim 1, paragraph b, and claim 22, paragraph b, has been treated in this decision as having been replaced by the phrase "a closeable opening." The appellants should amend claims 1 and 22 accordingly.

includes "two separate bottom pieces for covering lower extremities of the patient."

All the rejections set forth by the examiner rely on Dye for the suggestion of modifying Boettcher "to include a bottom piece with openings" (answer, p. 3).

The appellants argue (brief, p. 7) that they claim a garment which includes, inter alia, "two bottom pieces which are separate, not unitary (See specification, page 8, lines 13-15)." The appellants then contrast this claimed feature with Dye's pants 14 which "consists of two leg portions interconnected to one another by means of a lower torso portion integral with each leg portion."

The examiner responded (answer, pp. 7-8) to this argument by stating that

[a]pplicant is arguing more limiting than what has been claimed. The claims do not recite the bottom pieces of two non-connected pieces. Conventionally, speaking when one speaks of a bottom piece was shown the same include two separate pieces joined by a seam. Applicant's arguments, are therefore moot because the terms "non-connected bottom pieces" are not in the claim.

It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

The appellants' specification (page 8, lines 13-14) states that "[t]he bottom pieces may be attached together, or preferably may be detached from one another."

The American Heritage Dictionary, Second College Edition, (1982) defines "separate" as "set apart from others; detached . . . existing as an entity; independent."

It is our determination that the broadest reasonable interpretation consistent with the specification of the claimed phrase two "separate" bottom pieces for covering lower extremities of the patient is that the two bottom pieces exist as independent entities. When claims 1 and 22 are given this interpretation, it is clear to us that the prior art as applied by the examiner would not have suggested two "separate" bottom

pieces for covering lower extremities of the patient since Dye teaches only a single bottom piece for covering the lower extremities of the patient.

Since all the limitations of independent claims 1 and 22 are not suggested by the applied prior art, we cannot sustain the examiner's rejection of appealed claims 1 and 22, or claims 2, 3, 10, 11, 30 and 31 which depend therefrom, under 35 U.S.C. § 103.

New grounds of rejection

Under the provisions of 37 CFR § 1.196(b), we enter the following new grounds of rejection.

Claims 1, 10, 11 and 30 are rejected under 35 U.S.C. § 103<sup>6</sup> as being unpatentable over Thompson in view of Dye and Boettcher.

Thompson discloses a sectional garment for use upon persons who have sustained an injury or upon whom operations are to be or

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<sup>6</sup> The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

have been performed. As shown in Figures 1, the sectional garment includes a garment in the form of an undershirt, comprising, a back section 10, front sections 11 and 12, and sleeve sections 13. Any suitable fastening devices, such as buttons, hooks and eyes, or snap-fasteners, are used to secure the sections together. As shown in Figure 1, the sections provide openings along the anterior midline, the left lateral line and the right lateral line. As shown in Figure 3, each sleeve section 13 can be formed in two sections 17 and 18, thus providing openings along the left forearm and the right forearm. Additionally, Thompson discloses that his sectional garment may be in the form of pajamas by including leg sections constructed in the same manner as the arm sections. Thus, the leg sections include two separate upper leg sections 19 and two separate lower leg sections 21. As shown in Figure 5, the closable openings in the leg sections are provided along the right lateral line of the left leg portions and along the left lateral line of the right leg portions.

Dye discloses a garment which resembles pajamas and includes a shirt 12 and pants 14. The shirt 12 has openable sleeves and the pants 14 have openable legs. The sleeves and legs are

openable for the entire length thereof so some or all of the wearer's limbs and body can be exposed for providing health care to that wearer. The legs and arms can be closed by suitable fastener means to cover the wearer so the garment can be both aesthetically pleasing, warm and yet still provide access to the patient for the purposes of providing health care. Dye teaches that the preferred form of the fastener means is hook-and-loop fasteners, such as Velcro®, however, other forms of fastener means, such as snaps, buttons, or zippers can be used. As shown in Figure 2, a plurality of buttons 32 are fixed to one side of the shirt front section and are engaged with the other portion via button holes to close the shirt about the wearer. Dye teaches at column 1, lines 44-48, that many patients find traditional hospital gowns, "not only displeasurable, but physically uncomfortable, especially if the environmental temperature in the room is lower than they are comfortable with." Dye teaches that her garment will keep a patient warm and that the shirt and pants can be made of any suitable material.

Boettcher discloses a patient's gown. The gown is so constructed that it can be readily put on and removed from the patient while in bed, while at the same time providing slits,

arranged at certain positions, so that the patient can be properly examined and injections made, as desired. As shown in Figure 1, in addition to the gown a hood 15 can be provided. As shown in Figures 1-3, the hood and gown are provided with openings 3, 9, 10, 11 and 19 which are closable by zippers. Lastly, Boettcher teaches that his gown and hood are particularly adapted for use in the care of patients in oxygen tents wherein such patients are sometimes exposed to temperatures below 65°F.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Thompson and claims 1, 10, 11 and 30, it is our opinion that the only differences are the limitations that the garment include (1) a hood piece for covering the head and neck of the patient and having a closable opening therein along an anterior neck line; and (2) closable openings in the leg sections provided along the left lateral line of the left leg portions and along the right lateral line of the right leg portions.

We agree with the appellants' argument (reply brief, pp. 9-10) that the recitation "form-fitting" in the preamble of claim 1 must be given weight. However, the recitation "form-fitting" reads on<sup>7</sup> the garments disclosed by Thompson, Dye and Boettcher.

Based upon the combined teachings of Thompson, Dye and Boettcher, it is our opinion that it would have been obvious to one of ordinary skill in the art at the time of the appellants' invention to have (1) provided Thompson's garment with a hood piece for covering the head and neck of the patient as suggested and taught by Boettcher's hood 15 for the self evident advantage of protecting the head and neck of the patient from low temperatures and drafts, (2) modified the leg sections of Thompson to provide openings along the left lateral line of the left leg portions and along the right lateral line of the right leg portions as suggested and taught by Dye, and (3) provided a closable opening along an anterior neck line of the hood piece to permit access to the front portion of the neck of the wearer in

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<sup>7</sup> Terms in a claim under examination are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. See In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

view of the overall teachings of the applied prior art which suggests providing closable openings at wherever a need might arise.

Claims 2, 3, 22 and 31 are rejected under 35 U.S.C. § 103 as being unpatentable over Thompson in view of Dye and Boettcher as applied above with respect to claim 1 and further in view of Spriggs.

In addition to the differences set forth above with respect to claims 1, 10, 11 and 30, it is our opinion, based on our analysis and review of Thompson, that the only additional difference is the limitation that the garment be made of a fabric selected from the group consisting of polypropylene; a water-proof, breathable fabric; an insulating, water absorbent fabric; silk; wool; cotton; rayon and polyester (claim 2) or from polypropylene (claims 3, 22 and 31).

Spriggs discloses a hospital gown 10. Spriggs teaches that the gown may be made of any of the materials heretofore well known to the art for hospital gown use. Spriggs discloses (column 3, line 64, to column 4, line 6) that

useful materials for fabrication of the gown include continuously extruded, synthetic material or composites of such materials, particularly in continuous sheet form prior to fabrication; woven natural fiber or synthetic fiber materials, including woven cloth and other woven fabric-like material constructed from cotton, cotton blended with synthetics (such as polyester, nylon, polypropylene and the like), and polyester, nylon, polypropylene or other synthetics; and non-woven natural fiber or synthetic fiber materials.

Based upon the combined teachings of Thompson, Dye, Boettcher and Spriggs, it is our opinion that it would have been further obvious to one of ordinary skill in the art at the time of the appellants' invention to make the modified garment of Thompson from polypropylene as suggested and taught by Spriggs especially since Thompson is silent as to the material from which her garment is made.

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 3, 10, 11, 22, 30 and 31 under 35 U.S.C. § 103 is reversed and a new rejection of claims 1 through 3, 10, 11, 22, 30 and 31 under 35 U.S.C. § 103 has been added pursuant to provisions of 37 CFR § 1.196(b)

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, 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 (§ 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. . . .

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

REVERSED; 37 CFR § 1.196(b)

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
MURRIEL E. CRAWFORD	)	
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APPEAL NO. 97-2226 - JUDGE NASE  
APPLICATION NO. 08/203,789

APJ NASE

APJ ABRAMS

APJ CRAWFORD

DECISION: **REVERSED;**  
**37 CFR § 1.196(b)**

Prepared By: Delores A. Lowe

**DRAFT TYPED:** 12 Mar 98

**FINAL TYPED:**