

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CONSTANCE V. WASSERMAN

Appeal No. 1998-1608
Application No. 08/429,926¹

ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 4 through 8, which are all of the claims pending in this application.

We REVERSE and REMAND.

¹ Application for patent filed April 27, 1995.

BACKGROUND

The appellant's invention relates to an anklet for a foot orthosis. An understanding of the invention can be derived from a reading of exemplary claims 1 and 8, which appear in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Incorvaia 30, 1983	4,401,113	Aug.
Hicks 1994	5,372,576	Dec. 13,

Claims 1 and 4 through 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hicks in view of Incorvaia.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the final rejection (Paper No. 5, mailed January 15, 1997) and the answer (Paper No. 11, mailed December 8, 1997) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 10,

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filed September 19, 1997) for the appellant's arguments
thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 and 4 through 8 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, 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). A prima facie case of obviousness is established by presenting **evidence** that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d

1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576,

1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977). See also In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Hicks discloses a therapeutic foot orthosis. As shown in Figures 2, 4, 5 and 7, the therapeutic foot orthosis includes a liner 30 which is formed to provide an extension or flap 50 adapted to overlie the foot 22 of a user. The outer surface of the flap 50 carries areas or patches 50a of a heavy duty fabric, exemplified by nylon, having releasable fastening means of the hook type provided thereon which cooperate with releasable fastening means of the loop type provided on one surface of an elongated strip 52 of a heavy duty fabric secured as by stitching to the outer margin of the foot engaging portion of the liner 30 opposite to that on which the flap 50 is carried. Hicks teaches (column 3, line 50, to column 4, line 25) that

the heel 18 of a user is maintained in fixed, stable, spaced relation to the inner surface 16 of the heel portion 16 of the structure 10 by means of a padded member 60 secured at one of its ends to a strap 62 attached as by stitching to the reinforcing layer 40

provided on the backing of the liner 30 adjacent to the opening 32 formed therein. The free end 62a of the strap 62 is adapted to pass through the slot 26a formed in the extension 26 of the heel portion 16 of the structure 10, and to be folded back in superimposed relation on the area of the strap 62 which is secured to the reinforcing layer 40. The strap 62 desirably is provided with releasable fastening means of the hook and loop type to enable the free end 62a thereof to be disengaged from the heel portion 16. The other end of the padded member 60 has a strap 64 secured thereto, the free end 64a thereof being adapted to pass through the slot 24a formed in the extension 24 of the heel portion 16, and, like the free end 62a of the strap 62, to be folded back in superimposed relation on itself. As with the strap 62, the strap 64 is provided with releasable fastening means of the hook and loop type to enable the free end 64a thereof to be disengaged from the heel portion 16.

As shown in FIGS. 5 and 7 of the drawings, the padded member 60 snugly overlies the foot engaging portion of the liner 30 when the straps 62 and 64 are connected to the extensions 24 and 26 of the heel portion 16. This arrangement acts to prevent the heel 18 of a user of the device from coming into contact with the inner surface 16a of the heel portion 16. The fixed, stable position of the heel portion 16 in relation to the heel 18 of a user is enhanced, augmented and promoted by the reinforced areas of the panel 40 which are positioned along the edges of the heel accommodating opening 32 formed in the liner 30. These features of the device of this invention effectively prevent heel decubitus from occurring, and can aid in the healing of such a condition in the event it has occurred for some other reason. The fixed, stable, spaced positioning of the heel of a user with relation to heel portion 16 of the device also enables observation during healing of any surgical procedures performed on the heel of the user, and enables heavier, more absorbent bandaging materials to be used on incisions made during such procedures.

Incorvaia discloses a sponge splint compression dressing. As shown in Figure 1, the injured foot is placed against the sponge side of the dressing which is folded over the foot with the toes being uncovered. Thereafter, an ankle section 22 is folded around the upper portion of the ankle. Incorvaia teaches (column 3, lines 39-45) that

the dressing can be held in place by standard wrapping such as the elastic wrap illustrated at 16 in FIG. 1 or by means of Velcro strips 18 as illustrated for the foot area in FIG. 1. The use of the elastic wrap provides more rigidity and equalized compression whereas the Velcro strip provides for ease of application.

Claim 1

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).

The examiner ascertained (final rejection, p. 2) that

[a]lthough Hicks discloses a fastening strap extending over the flap element, the strap does not detachably affix to "said other flap element" as recited in claim 1.

With regard to this difference, the examiner then determined that

such detachable affixation would, however, have been obvious to a person of ordinary skill in the art given the teaching of Incorvaia which discloses a similar sheet member also having an overlapping flap configuration secured by a hook and loop strap which affixes to the outer surface of the flaps. Accordingly, claim 1 is rendered obvious.

We agree with the appellant that claim 1 is not obvious over the applied prior art. In that regard, it is our view that the teachings of Incorvaia would not have rendered it obvious to one of ordinary skill in the art at the time the invention was made to have modified Hicks in a manner to arrive at the subject matter of claim 1. Specifically, Incorvaia would only have suggested replacing Hicks releasable fastening means on patches 50a and strip 52 with Velcro® strips as taught by Incorvaia's strips 18. Thus, it is our opinion that Incorvaia would not have suggested any changes to Hicks' fastening strap (i.e., padded member 60 and straps 62 and 64). Thus, there is no **evidence** in the applied prior art that would have rendered it obvious to one of ordinary skill in the art at the time the invention was made to have modified

Hicks' fastening strap so as to arrive at the subject matter of claim 1.

For the reasons stated above, the decision of the examiner to reject claim 1 under 35 U.S.C. § 103 is reversed.

Claims 4 through 7

The decision of the examiner to reject dependent claims 4 through 7 under 35 U.S.C. § 103 is reversed for the reasons stated above with respect to parent independent claim 1.

Claim 8

With respect to claim 8, the examiner ascertained (final rejection, p. 3) that

Hicks does not anticipate the strap to be releasably attachable to the first flap (i.e., the overlapping one of the two flaps).

With regard to this difference, the examiner then determined that

permanent affixation of the strap to either the overlapping flap or the overlapped flap would have been obvious to a person of ordinary skill in the art given Hicks' teaching of overlapping flaps being secured with

strap [60] as a simple matter of design. Moreover, as identified by the applicants, Incorvaia teaches a strap affixed to both of two overlapping flaps (see Fig. 1). This teaching further bolsters the examiner's argument that detachably attaching the Hicks strap to one of the flaps would have been obvious.

We agree with the appellant that claim 8 is not obvious over the applied prior art. In that regard, it is our view that the teachings of Incorvaia would not have rendered it obvious to one of ordinary skill in the art at the time the invention was made to have modified Hicks in a manner to arrive at the subject matter of claim 8. As stated previously,

Incorvaia would only have suggested replacing Hicks releasable fastening means on patches 50a and strip 52 with Velcro® strips as taught by Incorvaia's strips 18. Thus, it is our opinion that Incorvaia would not have suggested any changes to Hicks' fastening strap (i.e., padded member 60 and straps 62 and 64).

Additionally, the examiner has supplied no **evidence** (other than Incorvaia) as to why it would have been obvious to permanently affix Hicks' fastening strap to either the overlapping flap or the overlapped flap. The examiner's statement that such is "a simple matter of design" is not **evidence**. Thus, there is no **evidence** in the applied prior art that would have rendered it obvious to one of ordinary skill in the art at the time the invention was made to have modified Hicks' fastening strap so as to arrive at the subject matter of claim 8.

For the reasons stated above, the decision of the
examiner to reject claim 8 under 35 U.S.C. § 103 is reversed.

REMAND

This application is remanded to the examiner for consideration of conducting a further search of the claimed subject matter.

Since the claimed subject matter is directed to providing a foot orthosis that is easily attached to and detached from a person's foot and to effectively hold the orthosis on the person's foot, the examiner should consider other fields of search as set forth below.

The examiner's field of search as indicated on the filewrapper was limited to Class 602, SURGERY. Consideration should be given to searching the following: Class 24, BUCKLES, BUTTONS, CLASPS, ETC., especially Subclasses 712+, DRAWSTRING, LACED-FASTENER, OR SEPARATE ESSENTIAL COOPERATING DEVICE THEREFOR, and Class 36, BOOTS, SHOES, AND LEGGINGS, especially Subclasses 113+, OCCUPATIONAL OR ATHLETIC SHOE, and 50.1+, CLOSURE. These classes and subclasses appear to be reasonably pertinent to the above-noted problems addressed by the appellant's invention and thus may contain relevant subject

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matter and therefore a search therein would seem to be
appropriate.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 and 4 through 8 under 35 U.S.C. § 103 is reversed. In addition, the application has been remanded to the examiner for consideration of a further search.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (Seventh Edition, July 1998).

REVERSED; REMANDED

IRWIN CHARLES COHEN)	
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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DECISION: **REVERSED; REMANDED**

Prepared By: Gloria Henderson

DRAFT TYPED: 14 Sep 99

FINAL TYPED: