

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(2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CATHERINE L. CHEONG

Appeal No. 1998-3144
Application 08/436,688

ON BRIEF

Before KIMLIN, JOHN DOUGLAS SMITH and PAK, Administrative
Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 6-14. Claim 15, the other claim remaining in the present application, stands withdrawn from consideration. Since the examiner has withdrawn the rejection of claims 6-14 under 35 U.S.C. § 112, first paragraph, and only claims 6, 8, 10 and 12 remain rejected under 35 U.S.C. § 103, appellant's appeal of claims 7, 9, 11, 13 and 14 is moot. The examiner has indicated the allowability of claims 7, 9, 11, 13 and 14.

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The present application is a division of U.S. Serial No. 07/971,488, filed 11/4/92. An appeal was taken to this Board in the parent application (Appeal No. 1995-2202). The present and prior appeals involve different issues regarding the subject matter claimed and the prior art applied by the examiner.

Appellant's now claimed invention is directed to a method of forming a polyurethane foam that is suitable for a wound-contacting layer. The polyurethane is formed by mixing one part by weight of an isocyanate-capped prepolymer and 0.012 to 0.21 parts by weight of a solid rubber latex in addition to water.

Appealed claims 6, 8, 10 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wood or Arnason.

Upon careful consideration of the opposing arguments presented on appeal, we concur with the appellant that the examiner's rejection is not sustainable.

The examiner appreciates that neither Wood nor Arnason discloses forming a polyurethane foam by mixing the relative amounts of isocyanate-prepolymer and solid rubber latex, i.e.,

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both Wood and Arnason "incorporate a greater amount into their formulation than appellant incorporates into her formulation."

(page 6 of answer, third paragraph). However, since the references teach that the resilient properties of the foam can be altered by varying the amount of the latex incorporated therein, the examiner reasons that "the variance of a result effect variable, such as quantity of latex used, amounts to an obvious modification well within the capabilities of the skilled artisan." (page 6 of answer, third paragraph).

The flaw in the examiner's rejection is that the examiner has failed to point to any suggestion in the prior art that using a lesser amount of latex than that disclosed by Wood and Arnason would result in a foam that is suitable for contacting a wound. Stated otherwise, the examiner has not established why one of ordinary skill in the art would have been motivated to reduce the amount of rubber latex disclosed by Arnason and Wood to form a polyurethane foam for contacting a wound. Wood discloses that his polyurethane foam is suitable for making ear plugs, tampons and packaging, and specifically teaches

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that using less than 40 parts of latex per 100 parts of prepolymer results in the resiliency of the foam being "undesirably high" (see column 2, lines 5-8). Arnason, on the other hand, is directed to making a squeezable toy with dimensional memory from polyurethane foam,

and the reference provides no teaching or suggestion that utilizing a rubber latex in the claimed amounts would render the polyurethane foam suitable for contacting wounds.

Hence, although the examiner is correct in stating that the applied prior art teaches that using less than the disclosed rubber results in the foam having a higher resiliency, the examiner has not established why one of ordinary skill in the art would have had a practical reason to do so.

Based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

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