

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 65 (90/003,489)
Paper No. 54 (90/003,990)

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NOVAMEDIX LIMITED

Appeal No. 97-2766
Reexamination Control Nos. 90/003,489 and 90/003,990¹

ON BRIEF

Before CALVERT, McQUADE and CRAWFORD, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Pursuant to 37 CFR § 1.197(b), Novamedix Limited requests

¹Requests filed July 11, 1994 (Control No. 90/003,489) and October 4, 1995 (Control No. 90/003,990) by Kinetic Concepts, Inc. for the reexamination of U.S. Patent No. 4,721,101, issued January 26, 1988, based on Application 06/911,987, filed September 26, 1986. The resulting reexamination proceedings were ordered merged on February 1, 1996 (see Paper No. 18 in Control No. 90/003,489 and Paper No. 8 in Control No. 90/003,990).

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rehearing (i.e., reconsideration) of our decision dated December 4, 1998, to the extent that it sustains the examiner's 35 U.S.C. § 103 rejection of claims 7 through 14 as being unpatentable over Dreiser in view of Rastgeldi and Gaskell/Parrott.²

The positions taken by the appellant with respect to the points believed to have been misapprehended or overlooked in rendering the decision and other grounds on which rehearing is sought

pertain to the existence of a terminal disclaimer and to applicable law, including that on which the Board presumably relies, coupled with facts of record which can and should be held to establish that the Board's decision neither recognizes a *prima facie* case for the Issue on Rehearing, nor does the Board acknowledge any probative credence for rebuttal evidence which exists with preponderance in the present record [request, page 2].

The terminal disclaimer was filed in the application

² As observed by the appellant (see page 2 in the request), the decision to sustain this rejection was based on our determination that Dreiser and Rastgeldi were sufficient to establish the knowledge and level of ordinary skill in the art necessary to support the examiner's conclusion of obviousness, with the examiner's application of Gaskell/Parrott being, at worst, superfluous (see page 15 in the decision). Nonetheless, Gaskell/Parrott remains part of the evidentiary basis cited by the examiner to justify the rejection.

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which matured into the subject patent undergoing reexamination to overcome an obviousness-type double patenting rejection. It is not evident, nor has the appellant explained (see page 3 in the request), how or why this terminal disclaimer, which has no apparent relevance to the sustained rejection, is indicative of any error in our decision.

As for the merits of the sustained rejection, we have carefully considered the various arguments advanced in the request in support of the appellant's position. In essence, these arguments are a rehash of the arguments advanced in the appellant's briefs. We find them no more persuasive now than we did before, and remain of the view for the reasons detailed on pages 14 through 19 of the decision that

based on the totality of the evidence and argument of record, the differences between the subject matter recited in claims 7 and 10 and the prior art combination of Dreiser in view of Rastgeldi are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art [decision, page 19].

We add the following for emphasis.

The appellant submits, without any clarifying explanation, that it is "strange and surprising" (request,

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page 5) that the decision had nothing to say about examiner's initial burden to establish a prima facie case of obviousness with respect to the sustained rejection. The concept of the prima facie case is merely a procedural tool which allocates the burdens of going forward between the examiner and an applicant. In re Oetiker, 977 F.2d 1443, 1445-46, 24 USPQ2d 1443, 1444-45 (Fed. Cir. 1990). An ultimate conclusion of obviousness must be based on all of the evidence and argument of record. Id. As indicated in the passage from the decision reproduced above, our determination that the subject matter recited in claims 7 and 10 would have been obvious within the meaning of § 103 was so based. We therefore found it unnecessary to expressly state what was clearly implicit in this determination, i.e., that the examiner's evidentiary references, Dreiser and Rastgeldi, do establish a prima facie case of obviousness with respect to the subject matter recited in claims 7 and 10.

The appellant also makes much of the examiner's finding in the Office action appealed from that "Rastgeldi does not teach that his cuff is inflated in the time period claimed by the patentees" (see pages 5 and 6 in the request). We have no

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quarrel with this finding because Rastgeldi does not in fact "teach" or expressly disclose the inflation or pressure rise time recited in clause (a) of claims 7 and 10. As we pointed out in the decision, however, "[t]he pressure criteria at which Rastgeldi's device is operated are clearly suggestive of the operational criteria set forth in claims 7 and 10" (page 16). Attention is directed to Rastgeldi's Figures 10 through 12 and the accompanying explanations thereof.

Finally, the criticisms of Dreiser and Rastgeldi and the discussion of the evidence of non-obviousness contained in the request (see pages 7-20) suffer the same flaw as the corresponding criticisms and discussion contained in the briefs, i.e.,

they are not commensurate with the relatively broad scope of claims 7 and 10. As conceded by the appellant, "claims 7 and 10 do not exclude application of pressure to parts of the foot or leg in addition to the plantar arch" (request, page 18).

The discordance between the broad scope of these claims and the appellant's argument and evidence was noted and addressed on pages 16 through 19 in the decision.

In summary, we have reconsidered our decision to the

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extent indicated above, but decline to make any changes therein.

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

DENIED

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IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
)	
MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

JPM/caw

For patent owner:

Roy C. Hopgood & Steven Judlowe

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HOPGOOD, CALIMAFDE, KALIL & JUDLOWE
60 EAST 42ND STREET
NEW YORK, NY 10165

For reexamination requester:

Charles W. Hanor
AKIN, GUMP, STRAUSS, HALTER & FELD
1500 NATIONSBANK PLAZA 300
CONVENT STREET
SAN ANTONIO, TX 78205