

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAMARA M. HELMING

Appeal No. 2000-0449
Application No. 08/636,614

ON BRIEF

Before CALVERT, STAAB, and GONZALES, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 2, 4 to 9, 16 and 17. The other claims in the application, 3,

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10 to 15 and 18 to 21, stand withdrawn from consideration by the examiner under 37 CFR § 1.142(b) as being directed to non-elected inventions.

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The claims on appeal are drawn to a device for applying thermal therapy to the perineal area of a patient. They are purportedly reproduced in Appendix I of appellant's brief, but the copy of claim 16 does not include the additions made thereto by the amendment filed on May 27, 1997 (Paper No. 5).

The references applied in the final rejection are:

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|---|-----------|---------------|
| Caillouette et al. 1965 (Caillouette) | 3,175,558 | Mar. 30, |
| Stanley, Jr. (Stanley) | 3,763,622 | Oct. 9, 1973 |
| Gossett | 3,950,158 | Apr. 13, 1976 |
| Angelillo et al. (Angelillo) | 5,178,139 | Jan. 12, 1993 |

The appealed claims stand finally rejected on the following grounds:¹

(1) Claim 1, unpatentable for failure to comply with the "written description" requirement of 35 U.S.C. § 112, first paragraph.²

¹ An additional rejection, under 35 U.S.C. § 112, second paragraph, is not repeated in the Examiner's Answer and presumably has been withdrawn in light of the amendment filed on March 19, 1999 (Paper No. 22)

² Since claims 2 and 4 to 9 are directly or indirectly dependent on claim 1, it is not apparent how this rejection could be applicable only to claim 1 and not to the claims

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(2) Claims 16 and 17, anticipated by Stanley, under 35 U.S.C. § 102(b).

(3) Claims 1, 2, 4 and 5, unpatentable over Stanley in view of Gossett, under 35 U.S.C. § 103(a).

(4) Claims 6 and 8, unpatentable over Stanley in view of Gossett and Caillouette, under 35 U.S.C. § 103(a).

(5) Claims 7 and 9, unpatentable over Stanley in view of Gossett, Caillouette and Angelillo, under 35 U.S.C. § 103(a).

Rejection (1)

Claim 1 recites in part (B)(v)(emphasis added):

the first compartment being fixedly encased by the second compartment at a sealed edge where the first and second compartments overlap and extending across the length of the second compartment.

The examiner takes the position that "[t]he specification does not adequately disclose the first and second compartments overlapping at a sealed edge" (final rejection (Paper No. 17), page 2). Appellant argues that the claimed structure is shown

dependent thereon, since they incorporate all the limitations of the parent claim. 35 U.S.C. § 112, fourth paragraph.

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by Figure 6³ and the description on page 6, lines 21 to 26 of the specification (brief,⁴ pages 6 and 7).

³ The embodiment shown in Figure 6 is the species elected by appellant in the amendment filed on May 27, 1997 (Paper No. 5).

⁴ All references herein to appellant's brief are to the amended brief filed on March 24, 1999 (Paper No. 23).

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Appellant has not identified, nor do we find, any specific statement in the specification that the first and second compartments 72, 78 of Figure 6 overlap at a sealed edge, as recited in the portion of claim 1 underlined above. However, "claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement [of § 112, first paragraph]." In re Smith, 481 F.2d 910, 914, 178 USPQ 620, 624 (CCPA 1973). The test is whether the specification as originally filed would convey with reasonable clarity to those skilled in the art that the applicant was in possession of the invention now claimed. Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Also, "under proper circumstances, drawings alone may provide a 'written description' of an invention as required by § 112." Id., 935 F.2d at 1565, 19 USPQ2d at 1118.

Unless the applicant claims embodiments of the invention completely outside the scope of the specification, the examiner, in making a rejection for lack of written description, must provide reasons why one of ordinary skill would not consider the description sufficient in order to make

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out a prima facie case. In re Alton, 76 F.3d 1168, 1172, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996). Here, all the examiner has done is, as noted above, to state in the final rejection that the specification does not "adequately disclose" the limitation in question; this is not sufficient to shift the burden to appellant. However, even assuming that a prima facie case had been established, we consider that it has been overcome by appellant's arguments.⁵ Specifically, appellant points out that in Figure 6 there are solid lines in the mid-regions of folded, sealed edges 82, 84 of the second compartment 78 (in line with the edges of first compartment 72), and asserts that these lines illustrate the contours of where the sheet 80 forming the second compartment overlaps the ends of the "bubble" (first compartment) 74 (brief, page 6). We agree with appellant that one of ordinary skill, contemplating Figure 6, would view it as appellant suggests, and therefore would have understood that, when the application

⁵ We note that our consideration of this appeal has not been facilitated by the fact that the Examiner's Answer does not contain a response to the arguments in appellant's brief, as required by MPEP § 1208, item (11), page 1200-16 (Rev. 1, Feb. 2000).

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was filed, appellant was in possession of the structural limitations recited in part (B)(v) of claim 1; thus, the "written description" requirement of § 112, first paragraph, is satisfied.⁶

⁶ Appellant should, however, amend the specification to provide antecedent basis for the claim language in question, as required by 37 CFR § 1.75(d)(1).

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Rejection (1) accordingly will not be sustained.

Rejection (2)

"To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." In re Schreiber, 128 F.3d 1473, 1477 44, USPQ2d 1429, 1431 (Fed. Cir. 1997). Appellant's only argument with respect to rejection (2) is that the end seams 37 of Stanley's outer shell means 31 do not constitute "at least one extension tab for attaching the device to a holding mechanism," as required by claim 16, part (B) (as amended).

We do not consider appellant's argument to be well taken. As illustrated in Figure 7, each seam 37 of the Stanley thermal pack clearly is an "extension tab." The fact that Stanley's tabs are not disclosed as being used for attaching the device to a holding mechanism, as recited in claim 16, is of no moment, because recitation of a new use for an old product does not make a claim to that old product patentable. In re Schreiber, supra. The law of anticipation does not require that the reference "teach" what appellant's application teaches, but only that the claim "reads on" something disclosed in the reference. Kalman v. Kimberly-

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Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984). That is the case here.

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Appellant argues at page 8 of the brief that:

End seams do not anticipate extension tabs that are explicitly defined as means to attach the pack to another surface. There is a structural difference between end seams and extension tabs because end seams do not possess attaching means whereas extension tabs inherently possess such attaching means.

This argument is not persuasive because, first, claim 16 does not recite the tabs as "means to attach the pack to another surface," and even if it did claim the tabs in terms of a means-plus-function under 35 U.S.C. § 112, sixth paragraph, the corresponding structure described in appellant's specification is simply the plain tabs 108 shown in Figure 8, which do not appear to differ structurally from Stanley's tabs 37. Appellant's argument that "extension tabs inherently possess such attaching means" seems to be contrary to the structure of tabs 108 as disclosed in the application.

We will therefore sustain the rejection of claim 16, and of dependent claim 17 grouped therewith (brief, page 4).

Rejection (3)

With regard to claim 1, the examiner states the basis of the rejection on page 4 of the final rejection as follows:

Gossett teaches that it is old and well known in the art to fixedly encase one compartment within the other by overlapping the compartments and sealing them at the edge where the two compartments overlap, as illustrated in Figure 1. The Gossett pack is designed to prevent undue leakage of its ingredients during either shipment, storage, or usage. It would have been obvious to one of ordinary skill in the art at the time the invention was made to fixedly encase the first compartment of Stanley, Jr. to the second compartment by overlapping the compartments and sealing the edge as taught by Gossett, to provide a pack specifically designed to prevent undue leakage of its ingredients during either shipment, storage, or usage.

Appellant argues, inter alia, that claim 1 requires that the first compartment extend across the length of the second compartment,⁷ and Stanley's first compartment 11 does not do so (brief, pages 11 and 12). The examiner has not responded to this argument.⁸

The first (inner) compartments 11 of Stanley and 2 of Gossett are both shown as having a smaller length than the length of their respective second (outer) compartments. We

⁷ This limitation is in claim 1, part (B)(v), quoted above. Although this part is so written that the antecedent of "extending" could be either "first compartment" or "sealed edge," we interpret the antecedent as "first compartment" when we read the claim in light of appellant's disclosure.

⁸ See footnote 5, supra.

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therefore agree with appellant to the extent that, even if the references were combined as proposed by the examiner, the first compartment 11 of Stanley would be sealed to the outer compartment 31 only at one end. We find no disclosure in either reference which would teach or suggest to one of ordinary skill that the first compartment should extend across the length of the second compartment, as claimed. In fact, Gossett seems to teach to the contrary, in that it discloses that the bottom margin of inner compartment 2 is at the midpoint of the outer compartment 1 (col. 5, lines 1 to 3), that it is desirable to have the inner compartment rupture as shown in Figures 5 and 6, i.e., at the seal 6 at its free end within second compartment 1 (col. 5, lines 12 to 23), and that seal 6 serves to focus the position of the rupture (col. 4, lines 59 to 66).

The device defined in claim 1 therefore would not have been obvious from the combination of Stanley and Gossett, and rejection (3) will not be sustained as to claim 1, or as to claims 2, 4, and 5 dependent thereon.

Rejections (4) and (5)

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The additional references applied in these rejections do not overcome the deficiencies of the Stanley-Gossett combination noted above, and thus rejections (4) and (5) will not be sustained.

Conclusion

The examiner's decision to reject claims 16 and 17 under 35 U.S.C. § 102(b) is affirmed; to reject claim 1 under 35 U.S.C. § 112, first paragraph, is reversed; and to reject claims 1, 2 and 4 to 9 under 35 U.S.C. § 103(a) is reversed.

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

AFFIRMED-IN-PART

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| IAN A. CALVERT |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| LAWRENCE J. STAAB |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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| JOHN F. GONZALES |) | |
| Administrative Patent Judge |) | |

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Prepared: July 13, 2001