

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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES F. MANKER

Appeal No. 95-1064
Application 07/995,347¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, COHEN and
ABRAMS, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final
rejection of claims 10 through 19 and 32 under 35 U.S.C. § 103.
No other claims are pending in the application.

¹ Application for patent filed December 22, 1992. According to
applicant, this application is a continuation of Application 07/824,045, filed
January 23, 1992.

The subject matter here claimed is a warming device of the type having a heat-producing fluid in a fluid tight chamber. The device is disclosed as a heat pack adapted to be wrapped around an infant's heel to warm the heel just prior to removing a blood sample by pricking the heel.

Claims 10 and 32, the only independent claims on appeal, are directed to the embodiment shown in Figures 5 and 6 of appellant's drawings. According to this embodiment, a pre-attached flexible strip (14) is provided with adhesive (29, 30) at its ends for securing the heat pack in place around the infant's heel. The adhesive is disposed on only one side of the strip in the form of patches. Prior to wrapping the heat pack around the infant's heel, the flexible strip is folded around a sealed edge of the heat pack such that the adhesive patches contact opposed, chamber-defining walls of the pack to releasably secure the ends of the strip to the walls of the pack, whereby the strip is adapted to be detached from either one of the opposed walls of the pack and then reattached to the opposite wall of the pack after the pack is wrapped around the infant's heel to secure the pack in place.

Appeal No. 95-1064
Application 07/995,347

Appealed claim 10 is representative of the claimed subject matter. A copy of this claim, as it appears in the appendix to appellant's brief, is appended to this decision.

The following references are relied upon by the examiner as evidence of obviousness in support of his rejections under 35 U.S.C. § 103:

Damico	4,500,316	Feb. 19, 1985
Smith	5,188,103	Feb. 23, 1993
		(Filed July 29, 1991)

WarmGel Brochure, "The Prism Infant Heel Warmer with WarmGel", Prism Technologies (1991).

Claims 10, 12, 13, 15, 17 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over the Warmgel publication in view of the Damico patent, and claims 11, 14, 16, 18 and 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Warmgel in view of Damico and Smith.² In support of these rejections, the examiner concludes that the teachings of Damico would have made it obvious to provide the Warmgel heat pack with a folded adhesive tape, and that the teachings of Smith would have made it obvious to provide the

² In addition to rejecting claim 11 on the combined teachings of Warmgel, Damico and Smith, the examiner inadvertently included claim 11 with claim 10 in the rejection based only on Warmgel and Damico. It is apparent, however, that the examiner considered the Smith patent necessary to support the rejection of claim 11.

Appeal No. 95-1064
Application 07/995,347

folded tape with an adhesive-free central portion. Reference is made to the examiner's answer for further details of these rejections.

In support of patentability, appellant argues, inter alia, that the Damico reference is non-analogous art because it relates to diapers rather than warming devices, that the Smith reference also is non-analogous art because it relates to wound dressings rather than warming devices and that, in any event, the examiner's proposed combination of reference teachings does not meet the terms of the appealed claims.

We have carefully considered the issues raised in this appeal together with the examiner's remarks and appellant's arguments. As a result, we conclude that the rejections of the appealed claims cannot be sustained. Our reasons for this conclusion follow.

It is well settled that a rejection under § 103 must rest on a factual basis. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Furthermore, the modification suggested by the prior art must arrive at the claimed invention. See In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed Cir. 1984).

In the present case, the examiner concedes that the Warmgel heat pack has no pre-attached tape or securing element of any type. Instead, a strip of conventional adhesive tape is apparently cut from a roll and is applied to the heat pack only after the heat pack is wrapped around the infant's heel. The Damico patent, on the other hand, does disclose pre-attached adhesive strips on a garment, namely a diaper, for securing the diaper in place. Damico's adhesive strips, however, do not correspond to the flexible strips defined in independent claims 10 and 32 in that they are not releasably secured to both the inner and outer sheets of the diaper to enable the strips to be detached from either sheet and then attached to the other sheet. In fact, such an arrangement appears to be undesirable in Damico's diaper to avoid the possibility of putting the diaper on inside out.

Thus, even if we were to agree that the Damico reference constitutes analogous art under the second part of the test set forth in In re Clay, 966 F.2d 656, 658, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992) (A reference is analogous if it is reasonably pertinent to the particular problem with which the inventor was involved.) and even if we were to agree that there is a prior art suggestion to substitute one of Damico's pre-attached tapes for

Appeal No. 95-1064
Application 07/995,347

the conventional adhesive tape employed with the Warmgel heat pack, the modification still would not arrive at the claimed invention. The examiner has presented no factual basis for concluding that, after modifying Warmgel to incorporate one of the pre-attached adhesive tapes of Damico, it would have been obvious to one of ordinary skill in the art to further modify Warmgel in order to meet the terms of appealed claims 10 and 32. For this reason alone, the § 103 rejection of independent claims 10 and 32 and, hence, dependent claims 11 through 19 cannot stand.

The examiner's decision rejecting the appealed claims is therefore reversed.

REVERSED

HARRISON E. McCANDLISH, Senior)
Administrative Patent Judge)
)
)
)
IRWIN CHARLES COHEN) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
)
)
NEAL E. ABRAMS)
Administrative Patent Judge)

Appeal No. 95-1064
Application 07/995,347

John Kilyk, Jr.
Leydig, Voit & Mayer
Two Prudential Plaza
Suite 4900. 180 North Stetson
Chicago, IL 60601-6780

McC/cam