

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 50

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER HABERMEYER

Appeal No. 96-3886
Application 08/275,091¹

HEARD: March 10, 1999

Before McCANDLISH Senior Administrative Patent Judges,
McQUADE and STAAB, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection

¹ Application for patent filed July 14, 1994. According to the appellant, the application is a continuation of Application 07/812,874, filed December 20, 1991 now abandoned; which is a continuation of Application 07/474,025, filed June 4, 1990, now abandoned.

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of claims 26 to 29, all the claims currently pending in the application. An amendment filed subsequent to the final rejection (Paper No. 37, filed April 10, 1996) has been entered.

By way of background, this appeal is related to an earlier appeal (No. 94-1162) in the now-abandoned parent application. The earlier appeal resulted in a decision by a merits panel of this Board reversing a rejection of the appealed claim under 35 U.S.C. § 103 and affirming a rejection of the appealed claim under 35 U.S.C. § 112, first paragraph. In rendering our decision in this appeal, we assume familiarity with the earlier decision.

Appellant's invention pertains to an apparatus for treating a fracture in an extremity. The apparatus includes a cuff-forming cushion (1) adapted to be formed into a sleeve and a protective sleeve (5) disposed about the cushion. The cushion defines a vacuum tight inner space having a plurality of filling bodies movable relative to one another disposed therein. When the inner space is evacuated the movable bodies interengage to form a stable and rigid support structure.

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Appealed claim 26, a copy of which is appended to appellant's brief, is illustrative of the appealed subject matter.

The references of record relied upon by the examiner as evidence of obviousness are:

Rose	3,745,998	Jul.
17, 1973		
Johnson	1,531,268	Nov. 8,
1978		
(Great Britain)		

Claims 26 to 29 stand rejected under 35 U.S.C. § 103 as being unpatentable over Rose and Johnson.² The examiner considers that Rose generally discloses in Figure 12 the claimed subject matter, with the exception of the use of a plastic protective sleeve that is regionally connected to the bladder 123, 124 during use (answer, page 3). However, the examiner is of the view that it would have been obvious to one of ordinary skill in the art "to modify the casting device of

² In the final rejection, claims 26 to 29 were also rejected under 35 U.S.C. § 112, first paragraph, as being based on a disclosure that fails to comply with the written description requirement of that paragraph, however, this rejection has since been withdrawn. See page 2 of the answer.

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Rose with a plastic, protective support sleeve regionally connected to his bladder as taught by Johnson" (answer, page 4). Alternatively, the examiner is also of the view that it would have been obvious "to modify the casting member of Johnson with an evacuable bladder having filling bodies as taught by Rose in order to increase the rigidity and strength of the Johnson casting device" (answer, page 4). Implicit in each of the above is the examiner's position that the devices of Rose and Johnson, modified in the manner indicated, would result in an apparatus that corresponds to the claimed subject matter in all respects.

The opposing viewpoints of appellant are set forth in the brief (Paper No. 35, filed April 10, 1996) and the conditional substitute reply brief (Paper No. 43, filed May 19, 1997), entry of which was approved by the examiner in an advisory letter (Paper No. 44, mailed January 6, 1998).³

³ We note the presence in the file of another reply brief (Paper No. 40, filed September 23, 1996) that was denied entry by the examiner (Paper No. 42, mailed March 18, 1997), and a petition by appellant pursuant to 37 CFR § 1.181 (Paper No.

Rose pertains to a vacuum formed immobilizer device comprising an interior wall 30 and an exterior wall 31 defining a vacuum tight inner space therebetween. The inner space is filled with "micro-balloon" polymer beads which flow over each other to facilitate easy manipulation of the casting device when the inner space is subject to atmospheric pressure but which stabilize and rigidify when the inner space is evacuated (col. 2, line 49 - col. 3, line 5). Rose discloses various embodiments for the immobilizer, including the leg cast of Fig. 12. The leg cast embodiment includes an outer boot 127, which may be composed of a thick sheet of flexible rubber vinyl material, bonded to the outer wall 124 of the evacuable envelope (col. 9, lines 45-50).

Rose describes the application of the Figure 12 immobilizer device to a patient's leg as follows:

43½, filed May 19, 1997) to enter this reply brief, which petition has to date apparently not been considered by the Group Director. In view of our reversal of the examiner's § 103 rejection of the appealed claims, this procedural oversight is moot.

In use, the hollow interior sleeve-like cavity of the device between walls 123 and 124 is collapsed so that the particles therein are loosely arrayed, and offer no resistance to the insertion of the patient's foot and leg 129 within the device to the position shown in Fig. 12. Additional particles of filler material may be added through the portal 126 if desired, and the encircling straps 128 may be adjusted to provide the desired reinforcement. The device is then evacuated by drawing air from the interior cavity of the device through the portal 126 The resulting pressure differential allows atmospheric pressure to urge the walls 123 and 124 together, securely clamping the filler particles therebetween in a rigid, immobilizing position, anchoring the wearer's leg 129 in position therein and inhibiting articulating movement of the wearer's knee, ankle and foot to a substantial degree. [col. 9, line 52 - col. 10, line 3.]

Johnson discloses an orthopedic leg cast comprising complementary shells 12, 14 fitted around a limb to define a tubular outer member. Adjacent longitudinal edges of the half shells overlap to allow the shells to be radially adjusted relative to each other about the limb. Inflatable air bags 30 are positioned between the inner surfaces of the shells and the patient's leg. The air bags need not be permanently fixed to the shells, but, if desired, may be attached to the shells by light adhesive (page 4, lines 121-130). Johnson describes the placement of the cast about a patient's leg as follows:

After the half-shell members 12, 14 has [sic, have] been assembled as shown in Figure 1B, . . . air or other suitable inflation medium is then introduced into each air bag 30 through their respective inlet tubes 32 to cause the air bags to inflate. Sufficient internal pressure is developed in each air bag to completely fill the annular spaces or voids existing between the inwardly facing sides or portions of the air bags and the relatively irregular contoured surface of the injured limb as shown, for example, in Figures 2 and 3. Inflation of the flexible air bags 30 causes them to conform to the portions of the limb not in indirect abutting engagement with the interior surface of the shell structure and thereby provides firm constant pressure support for these portions of the limb. . . .

. . . [I]t will be noted in accordance with an important feature of the present invention that despite inflation of the air bags 30 as described above, the portions of the immobilized limb originally in indirect abutting engagement with the interior of the telescoped shell structure will virtually retain their indirect abutting engagement with the interior surface of the two radially telescoped half-shell members. This is shown to best advantage in Figure 4, for example, at locations indicated by the letters b and c. . . . Since, as mentioned above, the immobilized limb always remains in virtual indirect abutting engagement with the interior surface of the cylindrical shell structure formed by the two radially telescoped half-shell members 12, 14 at two longitudinally spaced locations, the damaged limb is prevented from being moved or displaced relative to or within the shell structure and thus, in effect,

the shell structure itself as well as the circumferential array of air cushions provided by the inflated air bags 30 contribute to immobilization of the injured limb [page 7, lines 2-64.]

Turning now to the examiner's rationale based on Rose as the starting point of the rejection, a comparison of the Figure 12 apparatus of Rose to the claimed subject matter reveals that the Rose device lacks burr closure means coupled with the sleeve 127 for continuously adjusting the internal diameter of the sleeve to varying sizes of the cushion 123, 124 after the cushion has been evacuated, as called for in each of the independent claims. Indeed, in that the outer protective sleeve 127 and cushion of Rose combine to form a seamless boot-like enclosure for the leg, and in that the outer wall 124 of Rose's cushion is bonded (col. 9, lines 45-49) to the outer sleeve 127, presumably over its entire interface surface, there would be no apparent need for providing a separate closure means for continuously adjusting the internal diameter of the outer sleeve 127 after the cushion is evacuated. As to Johnson, while we appreciate that this reference discloses shell-like members 12, 14 secured

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together by hook and loop fasteners 50, 52, 54 for adjusting the position of the shell members relative to the limb, the fact remains that there is no apparent need for incorporating either the separate shell-like construction or hook and loop fastening means arrangement of Johnson in Rose so as to arrive at the subject matter of the appealed claims.

The examiner's alternative rationale based on Johnson as the starting point of the rejection also is not well taken. A comparison of the discussion at col. 9, line 33 - col. 10, line 3

of Rose and the discussion at page 7, lines 2-67 of Johnson makes clear that Johnson and Rose differ fundamentally in the way in which they immobilize an injured limb. In particular, the "indirect abutting engagement" of Johnson's shell members (page 7, lines 52-64) causes the shell members of Johnson to cooperate with the injured limb in a way that Rose's outer sleeve simply cannot duplicate. Also, the envelope 123, 124 of Rose and the air bags 30 of Johnson are fundamentally different in operation in that Rose's bladder is evacuated to

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transform into a rigid structure whereas Johnson's air bags are inflated to provide an air cushioning effect. Given the fundamental differences in approach of the applied references, we do not think that the disclosures of Rose and Johnson would have taught or suggested to one of ordinary skill in the art that the envelope of Rose, which is rigidified when evacuated, might be successfully substituted for the inflatable air cushions of Johnson. Instead, Rose and Johnson simply disclose two distinctly different approaches to the problem of immobilizing an injured limb. Accordingly, we conclude that the examiner's alternative rationale is the result of impermissible hindsight based on knowledge gleaned from appellant's disclosure, rather than on that which is fairly taught by the applied references.

In light of the foregoing, the standing rejection of the appealed claims as being unpatentable over the combined teachings of Rose and Johnson is reversed.

Pursuant to 37 CFR § 1.196(b), we enter the following new rejection.

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Claim 28 is rejected under 35 U.S.C. § 112, first paragraph, as being based on a disclosure that fails to provide descriptive support for the invention as now claimed.

With respect to the description requirement found in the first paragraph of 35 U.S.C. § 112,

[t]he test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. The content of the drawings may also be considered in determining compliance with the written description requirement.

In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983) (citations omitted).

Claim 28 requires that "*at least a portion of the exterior wall of the cushion is not secured to the inside of the protective sleeve to facilitate the placement of the cushion and*

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of the protective sleeve about said extremity" (emphasis added).

We find no support in the original disclosure for this claim requirement.

First, claim 28 was added by way of a preliminary amendment at the time of filing of this FWC (file wrapper continuation) application. Accordingly, it does not enjoy the status of being part of the original disclosure of the present application because it was not referred to in an oath or declaration filed with the original application papers. See MPEP § 608.04(b). Second, while we agree with the merits panel's determination on page 4 of the prior decision that the statement in original claim 6 that the protective sleeve is "connected regionally" to the cushion provides support for claiming that the protective sleeve is connected to only a portion of the protective sleeve, this determination does not provide appellant with license to expand upon that determination by now claiming that *at least a portion* of the *exterior* (3) of the cushion (1) *is not secured* to the *inside* of the sleeve (5). Nothing in original claim 6, or the

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disclosure on page 7 of the specification that the outer sleeve has a "shell-like form," or any other part of the original disclosure, supports the proposition that the term "connected

regionally" of original claim 6 would necessarily be understood by one of ordinary skill in the art as referring to the relationship between the exterior of the cushion (3) and the inside of the sleeve (5). In this regard, the circumstance that one skilled in the art might realize from reading a disclosure that something is possible is not a sufficient indication to that person that the something is a part of an applicant's disclosure. See *In re Barker*, 559 F.2d 588, 593, 194 USPQ 470, 474 (CCPA 1977), *cert. denied*, 434 U.S. 1064 (1978).

In summary:

the standing rejection of claims 26 to 29 as being unpatentable over Rose and Johnson is reversed; and pursuant to 37 CFR § 1.196(b), a new rejection of claim

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28 under 35 U.S.C. § 112, first paragraph, has been made.

The decision of the examiner is reversed.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

REVERSED; 37 CFR § 1.196(b)

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Administrative Patent Judge)	
)	
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