

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CRAIG J. HARDY

Appeal No. 1997-2175
Application No. 08/201,522¹

ON BRIEF

Before GARRIS, OWENS and KRATZ, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed February 25, 1994.

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This is a decision on an appeal from the final rejection of claims 1 through 19 which are all of the claims in the application.

The subject matter on appeal relates to a water swellable wound dressing material comprising from 5 to 50% of an alginate ester of a C₁-C₆ polyhydric alcohol, from 50 to 95% of a humectant and less than 1.5% of polyvinyl alcohol. This appealed subject matter is adequately illustrated by independent claim 1, the sole independent claim on appeal, which reads as follows:

1. A water swellable wound dressing material comprising, by weight based on the weight of the material when anhydrous:

from 5% to 50% of an alginate ester of a C₁-C₆ polyhydric alcohol;

from 50% to 95% of a humectant consisting of one or more C₁-C₆ monohydric or polyhydric alcohols; and

from 0% to 30% of water,

provided that the wound dressing material comprises less than 1.5% by weight of polyvinyl alcohol.

The reference relied upon by the examiner as evidence of obviousness is:

European Patent Application
(Nambu)

0 095 892

Dec. 7, 1983

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Claims 9, 15 and 16 stand rejected under the second paragraph of 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which the appellant regards as his invention. According to the examiner, these claims are indefinite by virtue of the recitation "biopolymers other than an alginate" in claim 9, "polysaccharide other than an alginate" in claim 15, and "derivative" in claim 16.

All of the claims on appeal stand rejected under 35 U.S.C.

§ 103 as being unpatentable over Nambu. While acknowledging that "Nambu does not teach that the polyvinyl alcohol is present in less than 1.5 weight percent," the examiner nevertheless has taken the position that a conclusion of obviousness is appropriate and that the "[b]urden is shifted to Applicant to establish the criticality and/or asserted differences and properties due to the differences in weight percentages of polyvinyl alcohol" (Answer, page 3).

We refer to the Brief and to the Answer for a complete exposition of the opposing viewpoints expressed by the

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appellant and the examiner concerning the above noted rejections.

OPINION

Neither of these rejections can be sustained.

We consider the examiner to have provided little if any rationale or evidence in support of her burden of establishing a prima facie case of claim indefiniteness with respect to the § 112, second paragraph, rejection of claims 9, 15 and 16. In any event, whatever case for indefiniteness the examiner may have established is more than counterbalanced by the argument and evidence provided by the appellant in support of his contrary view. Thus, for the reasons expressed in the Brief, we will not sustain the rejection under consideration.

The examiner's § 103 rejection of the appealed claims likewise cannot be sustained. As properly noted by the appellant, the examiner's obviousness conclusion appears to be based upon her clearly incorrect view that Nambu discloses a wound dressing material of the type here claimed wherein the polyvinyl alcohol component thereof may be present in an amount as small as 1.5% by weight. The appellant has

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thoroughly explained in the Brief, however, that the 1.5% concentration disclosed by Nambu relates to the aqueous solution used for producing Nambu's dressing material, and, because this solution is ultimately subjected to a required dehydration step, the final concentration of polyvinyl alcohol will necessarily be greater than 1.5%.

The examiner in her Answer has not disputed or even acknowledged the above noted explanation. Further, the examiner has offered utterly no reason as to why one with ordinary skill in the art would have lowered the polyvinyl alcohol concentration of Nambu's dehydrated product from a value which is above 1.5% (i.e., the lowest value of Nambu's range) to less than 1.5% (i.e., the highest value of the appellant's claimed range). Indeed, Nambu teaches away from lowering his polyvinyl alcohol concentration to a value within the here claimed range for the reasons detailed in the Brief.

In light of the foregoing, it is clear to us that the examiner has failed to carry her burden establishing a prima facie case of obviousness and accordingly that the examiner improvidently shifted to the appellant the burden of establishing "criticality" or nonobviousness. Under these

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circumstances, it is clear that the examiner's § 103 rejection is inappropriate and cannot be sustained.

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The decision of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
TERRY J. OWENS))
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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PETER F. KRATZ))
Administrative Patent Judge)	

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