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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BREDA M. CULLEN, DEBORAH ADDISON,
DAVID GREENHALGH, ALICIA ESSLER and
SARAH-JAYNE GREGORY

Appeal 2011-001281
Application 10/527,421
Technology Center 3700

Before CHARLES N. GREENHUT, MICHAEL L. HOELTER and
BARRY L. GROSSMAN, *Administrative Patent Judges*.

HOELTER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is a decision on appeal, under 35 U.S.C. § 134(a), from a final rejection of claims 1, 5, 6, 10, 11, 13 and 16-18. Br. 3. Claims 2-4, 7-9, 12, 14 and 15 have been cancelled. Clms. App'x. 8-9. We have jurisdiction under 35 U.S.C. § 6(b). Appellants' representative presented oral argument on January 15, 2013. We AFFIRM.

CLAIMED SUBJECT MATTER

The disclosed subject matter “relates to wound dressing materials comprising complexes formed between anionic polysaccharides, such as oxidized regenerated cellulose (ORC), and silver.” Spec. 1:4-6.

Independent apparatus claim 1 and independent method claim 13 are illustrative of the claims on appeal and are reproduced below:

1. A wound dressing material comprising a complex of an oxidized regenerated cellulose with silver, wherein the the [sic] amount of silver in the wound dressing material comprises from about 0.1 wt. % to about 0.3 wt% silver.

13. A method for treating venous ulcers, decubitis ulcers or diabetic ulcers, comprising applying a wound dressing material directly to the surface of the wound; wherein the wound dressing material comprises a complex of oxidized regenerated cellulose with silver, wherein the amount of silver in the wound dressing material comprises from about 0.1 wt. % to about 0.3 wt % silver.

REFERENCES RELIED ON BY THE EXAMINER

| | | |
|------------|-----------------|---------------|
| Bechtold | US 3,032,182 | May 1, 1962 |
| Jaschinski | US 6,409,881 B1 | Jun. 25, 2002 |
| Watt | GB 2314842 A | Jan. 14, 1998 |

THE REJECTIONS ON APPEAL

1. Claims 1, 5, 6, 10, 13 and 16-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Watt and Jaschinski. Ans. 5.
2. Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Watt, Jaschinski and Bechtold. Ans. 7.

ANALYSIS

*The rejection of claims 1, 5, 6, 10, 13 and 16-18
as being unpatentable over Watt and Jaschinski*

Appellants argue claims 1, 5, 6, 10, 13 and 16-18 as a group. Br. 4-6. We select independent claims 1 and 13 for review with dependent claims 5, 6, 10 and 16-18 standing or falling with these independent claims. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2011).

The Examiner finds that Watt substantially discloses Appellants' invention but that Watt fails to disclose the use of silver or the claimed range specified for silver. Ans. 5. The Examiner relies on Jaschinski for teaching "that it is known to treat oxidized cellulose with a silver based antibacterial agent in an amount of *0.1 wt. % to 25 wt. %* (col. 24, lines 37-51) in order to confer antibacterial properties to medical products for the inherent purpose of preventing bacterial growth." Ans. 5. This same section of Jaschinski also teaches that the range is "particularly 0.1 to 0.5 wt. %." Jaschinski 24:45-47. As a result, the Examiner "contends that the claimed range lies inside the disclosed range" and further that it would have been obvious "to treat the wound dressing material of Watt et al. with a silver based antibacterial agent, in order to prevent bacterial growth." Ans. 5.

Appellants do not dispute Jaschinski's disclosure of treating cellulose-containing material (i.e., a bandage) with silver in a range that encompasses

Appellants' claimed range (*see* Jaschinski 24:37-51). Instead Appellants' contend that "the present inventors have found that such a low silver concentration range is needed in order to achieve the proliferative effect on wound healing cells" and that "[e]ven at slightly higher silver contents, e.g.,] 0.5 wt[.]% (as disclosed by Jaschinski, see below), the silver has been demonstrated to have an antiproliferative effect on wound healing cells."¹

Br. 4. Appellants distinguish between the proliferative effect of silver and the known² antibacterial or antimicrobial effect of silver and contend that "[t]he proliferative effect of silver at the low concentration range from 0.1 to 0.3 weight % is a completely new discovery, supported by the above cited data." Br. 5.

Since the disclosed range shares the lowermost end point and is only slightly larger than the range recited in the claims, the Examiner correctly concluded that a prima facie case of obviousness exists. *See In re Peterson*, 315 F. 3d 1325, 1329-30 (Fed. Cir. 2003). "[A]n applicant may overcome a prima facie case of obviousness by establishing 'that the [claimed] range is

¹ Appellants' Specification, when describing the tested examples regarding the proliferative effect of silver (i.e., Spec. 19:9 to 20:26 and Fig. 4), seems to bear this out while other portions of Appellants' Specification seems to indicate that a different, larger range of silver is preferable for proliferative effect.

The amount of silver in the wound dressing material is from about 0.1wt[.]% to about 3wt.%, preferably from more than about 0.1wt[.]% to about 1wt.%, and for example from about 0.2wt.% to about 0.6wt.%, typically about 0.3wt.%. Lesser amounts of silver could give insufficient antimicrobial effect. Greater amounts of silver could give rise to anti- proliferative effects on wound healing cells (Spec. 4:23-28).

² e.g., Jaschinski 24:37-51, Spec. 3:14-16.

critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range.’” *Id.* (citations omitted). Critical ranges generally produce a new and unexpected result which is different in kind and not merely in degree from the results of the prior art. *In re Aller*, 220 F. 2d 454, 456 (CCPA 1955). Appellant has the burden of proving such criticality. *Id.*

While the particular range recited may result in a beneficial effect not discussed in the prior art, Appellants do not offer persuasive evidence or argument to show that a decrease in the proliferative effects at a particular concentration of an antimicrobial agent would have been unexpected or unpredictable. Appellants have not established that in addition to affecting microbial activity one skilled in the art would not also expect such agents to affect cellular proliferation, thereby rendering the claimed subject matter the product of routine optimization. Considering all of the evidence and arguments before us, the evidence of obviousness outweighs the evidence against.

Regarding Appellants’ method claim 13 directed to applying a wound dressing, our reviewing court has provided instruction that while new uses of known processes may be patentable, newly discovered results of known processes directed to the same purpose are not patentable because such results are inherent. *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.* 246 F.3d 1368, 1376-77 (Fed. Cir. 2001) (“However, the claimed process here is not directed to a new use; it is the same use, and it consists of the same steps as described by [the cited art]. Newly discovered results of known processes directed to the same purpose are not patentable because such results are inherent.”) (citing *In re May*, 574 F.2d 1082, 1090 (CCPA 1978); *Verdegaal*

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Bros., Inc. v. Union Oil Co., 814 F.2d 628, 633 (Fed. Cir. 1987);
MEHL/Biophile Int'l Corp. v. Milgraum, 192 F.3d 1362, 1366 (Fed. Cir.
1999)). Here, Watt, Jaschinski and Appellants' claimed invention all have
the same purpose of being applied to wounds to further their healing, i.e., the
same use.

We also note, as does the Examiner at Answer 9, that the claims recite
a wound dressing having a certain concentration of silver and that the claims
do not recite any proliferative effect which Appellants rely on to distinguish
their invention from the Examiner's combination of Watt and Jaschinski.
Further, Appellants do not persuade us of error in the Examiner's finding
that "the addition of silver to the sponge of Watt et al. in the particular
amount of anywhere between 0.1 to 0.5 wt. % [would] have been *prima*
facie obvious in light of the teachings of Jaschinski in order to achieve the
desired effect." Ans. 9.

Appellants further contend that "there is no suggestion nor disclosure
that an oxidized regenerated cellulose-silver complex first be formed and
then incorporated as part of a wound dressing." Br. 5. We agree with the
Examiner that "the claims do not recite that an oxidized regenerated
cellulose-silver complex first be formed and then incorporated as part of a
wound dressing." Ans. 9. Further, Appellants contend that there is no
suggestion in the cited documents that the claimed range "would achieve the
proliferative and anti-inflammatory effects identified by the present
inventors." Br. 6. Again, as stated by the Examiner, "such effects are not
presented in the claims of the instant invention, and are therefore irrelevant."
Ans. 9, *see also* 10.

In view of the record presented, we are not persuaded by Appellants' arguments and accordingly, we sustain the Examiner's rejection of claims 1, 5, 6, 10, 13 and 16-18.

*The rejection of claim 11
as being unpatentable over Watt, Jaschinski and Bechtold*

Claim 11 depends from claim 10 which depends from claim 1 discussed *supra*. Appellants incorporate the arguments above with respect to claims 1 and 13 and further state that "Bachtold [sic] adds nothing further in view of the Examiner's rejection of Watt and Jaschinski to correct the deficiencies previously identified by Appellant [sic]." Br. 7. We are not persuaded that any deficiencies have been identified by Appellants regarding the Examiner's combination of Watt and Jaschinski and accordingly, we sustain the Examiner's rejection of claim 11.

DECISION

The rejections of claims 1, 5, 6, 10, 11, 13 and 16-18 are affirmed.

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

AFFIRMED

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