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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte EDWARD D. LIN

Appeal 2011-003806
Application 11/122,863
Technology Center 3700

Before DONALD E. ADAMS, DEMETRA J. MILLS, and
LORA M. GREEN, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 11-13, 15-17, 34, and 37-52.¹ We have jurisdiction under 35 U.S.C. § 6(b).

¹ Claims 41, 42, 45-47, and 49 are also pending, but stand objected to as being dependent on a rejected base claim (App. Br. 2).

STATEMENT OF THE CASE

Claim 11 is representative of the claims on appeal, and reads as follows:

11. A device for protecting and treating a wound, comprising:
 - a housing defining a chamber;
 - a lid integral to said housing for opening and closing a first portion of said housing and movable between open and closed positions to allow ready access to said chamber;
 - a cushion secured about a perimeter of a second portion of said housing, said second portion being open and said cushion defining an annulus; and
 - an adhesive layer attached to said cushion for securing said cushion and attached housing over the body of a patient, wherein said device is fluid tight.

The following grounds of rejection are before us for review:

- I. Claims 11-13, 15-17, 34, and 37-52 stand rejected under 35 U.S.C. § 112, first paragraph, as containing new matter (Ans. 4).
- II. Claims 11, 12, 17, and 34² stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sarason.³ As Appellant only presents separate arguments as to claims 12 and 17, we focus our analysis on claim 11, and claim 34 stands or falls with claim 11. 37 C.F.R. § 41.37(c)(1)(vii).

² Although claim 34 does not appear in the statement of the rejection, the Examiner addresses it at page 6 of the Answer.

³ Sarason, GB 288,220, issued Jul. 11, 1927.

- III. Claim 13 stands rejected under 35 U.S.C. § 103(a) as being rendered obvious by the combination of Sarason and Bear⁴ (Ans. 7).
- IV. Claims 15, 16, and 48 stand rejected under 35 U.S.C. § 103(a) as being rendered obvious by the combination of Sarason and Stevens⁵ (Ans. 8).
- V. Claim 50 stands rejected under 35 U.S.C. § 103(a) as being rendered obvious by Sarason (Ans. 9).
- VI. Claims 38-40 stand rejected under 35 U.S.C. § 103(a) as being rendered obvious by the combination of Sarason and Hickey⁶ (Ans. 9).
- VII. Claims 43 and 44 stand rejected under 35 U.S.C. § 103(a) as being rendered obvious by the combination of Sarason and Garribotto⁷ (Ans. 10).
- VIII. Claim 51 stands rejected under 35 U.S.C. § 103(a) as being rendered obvious by the combination of Sarason and Stenzler⁸ (Ans. 11).

⁴ Bear et al., EP 1,674,898 A1 issued Jul. 2006.

⁵ Stevens, US 3,026,874, issued Mar. 27, 1962.

⁶ Hickey, US 6,837,027 B2, issued Jan.4, 2005.

⁷ Garribotto et al., US 2004/0153032 A1, published Aug. 05, 2004.

⁸ Stenzler, US 2005/0137521 A1, published Jun. 23, 2005.

- IX. Claim 52 stands rejected under 35 U.S.C. § 103(a) as being rendered obvious by the combination of Sarason and Holtermann⁹ (Ans. 12).

We affirm.

ISSUE (Written Description)

Does the preponderance of the evidence of record support the Examiner's finding that the claims contain new matter?

FINDINGS OF FACT

FF1. The Examiner finds that there "is no support in the disclosure as originally filed for a fluid-tight device" (Ans. 4).

FF2. The Examiner further finds that the "chamber and the device are clearly two different entities of different scope, i.e. the device includes the chamber and other items" (*id.*).

PRINCIPLES OF LAW

The test for determining whether a specification is sufficient to support a particular claim "is whether the disclosure of the application relied upon 'reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.'" *Ralston Purina Co. v. Far-*

⁹ Holtermann, US 5,667,502, issued Sep. 16, 1997.

Mar-Co, Inc., 772 F.2d 1570, 1575 (Fed.Cir.1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375 (Fed.Cir.1983)).

Thus, “[i]t is not necessary that the application describe the claim limitations exactly, but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that appellants invented processes including those limitations.” *In re Wertheim*, 541 F.2d 257, 262 (CCPA 1976) (citation omitted); *see also Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000) (“In order to satisfy the written description requirement, the disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter at issue.”).

ANALYSIS

Appellant points to the following portion of the Specification (App. Br. 4-5 (quoting Specification 14, ll. 26-30)):

If the chamber 70 is to be used for therapies requiring fluid-tightness so that the fluids stay within the chamber, the foam should be of the closed-cell type. The term “fluid-tight” or related terms as used in this specification means sufficiently leak-resistant to allow insufflation or vacuum suction to create an intra-chamber pressure that is above or below ambient pressure, or to substantially retain fluids within. Various cyclical patterns of fluid application can be programmed to optimize the wound chamber milieu

(Spec. 14, l. 26-15, l. 2).

According to Appellant, while the above portion does not refer to a device, the chamber 70 is the device set forth in the claims (App. Br. 5).

We agree with Appellant that the above portion of the Specification is sufficient to demonstrate that the disclosure as filed supports the rejected claims. We thus reverse the rejection.

ISSUE (Anticipation)

Does the preponderance of the evidence of record support the Examiner's finding that claims 1, 12, and 17 are anticipated by Sarason?

FINDINGS OF FACT

FF3. The Examiner finds:

Sarason discloses a device for protecting and treating a wound, comprising the following: a housing in the form of ring "a" defining a chamber, a lid "d" integral to said housing for opening and closing a first portion of said housing and movable between open and closed positions to allow ready access to said chamber (Fig. 2, Page 1, lines 8-12, Page 1, line 97 - Page 2, line 1); a cushion in the form of sticking plaster "c" secured about a perimeter of a second portion of said housing, said second portion being open and said cushion "c" defining an annulus; and an adhesive layer attached to said cushion for securing said cushion and attached housing over the body of a patient. (Page 1, lines 70-78).

(Ans. 5.)

FF4. Sarason "relates to a dressing-ring with closing lid on the top end and sticking plaster on the lower open end for sticking the dressing ring on the skin around the wound" (Sarason ll. 8-12).

FF5. Sarason teaches that the "ring is made of so-called cell-rubber, i.e., of a rubber which has been made finely porous by means of nitrogen blown in under high pressure" (*id.* at ll. 14-17). As a result, Sarason teaches that

“numerous very narrow pores are produced, each pore being closed like a cell” (*id.* at ll. 38-40).

FF6. Figure 1 of Sarason is reproduced below:

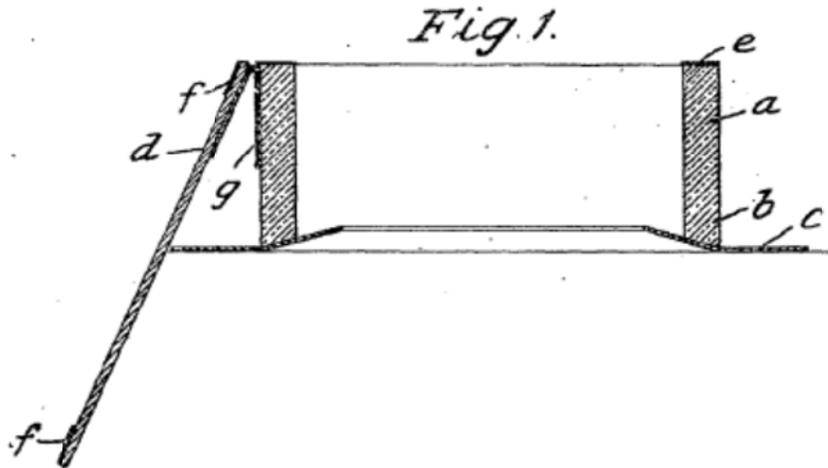


Figure 1 “shows the dressing ring in vertical section” (*id.* at ll. 26-27).

FF7. As taught by Sarason, the ring *a* is “designed to form an enclosure around the wound and a hollow space above the wound for insertion of dressing material” (*id.* at ll. 31-34).

FF8. Sarason teaches that the sticking plaster *c* surrounds the rubber ring in a ring-shape, and is stuck onto the beveled seating surface of the rubber ring *a* and projects into the space enclosed by the ring (*id.* at ll. 70-79).

FF9. Sarason teaches further that the sticking plaster *c* “is stuck onto the skin by means of an agglutinant or a rubber solution” (*id.* at ll. 77-79).

Therefore, according to Sarason, “the secretion from the wound cannot get under the seating surface of the ring *a* where it might decompose and cause inflammations of the skin” (*id.* at ll. 79-83).

FF10. As taught by Sarason, the “lid *d* is fixed on the ring *a* by a piece of fabric *g* glued onto the ring and onto the lid” (*id.* at ll. 87-89).

FF11. Sarason teaches further that the lid may be a rubber disk, and the lid resting on the upper edge of the ring *a* may be coated with a rubber solution. Sarason teaches that the lid thus can “be tightly and securely fastened on the ring with the aid of the rubber solution” (*id.* at ll. 97-99).

FF12. The Examiner finds that the sticking plaster “must be soft and/or pliable enough to conform to the user’s limb, which has a curved surface and therefore must be sufficiently pliable and soft to be fully functional as a cushion” (Ans. 14).

FF13. As to claim 12, the Examiner finds that “cushion ‘c’ is pliable, conformable and compressible inasmuch as it supports the weight of the device and is adhered in place by placing the device on the skin over the wound, which would necessarily require compression to activate the skin-adhering adhesive” (Ans. 5-6).

FF14. As to claim 17, the Examiner finds that the opening of the chamber of Sarason reads on the at least one port (*id.* at 6).

ANALYSIS

Appellant argues that Sarason’s ability “to prevent secretions from the wound from getting under the seating surface of the ring *a* where it might decompose and cause inflammation of the skin does not render the entire device fluid-tight as defined in the application” (App. Br. 10). That is, Appellant asserts, “[a] device or system, even if fluid tight in one aspect, is not fluid tight in toto” (*id.*).

Appellant further asserts that as defined by the Specification, “the term ‘fluid-tight’ means sufficiently leak-resistant to allow insufflation or

vacuum suction to create an intra-chamber pressure that is above or below ambient pressure” (*id.* (citing Specification 14, ll. 28-30)). Appellant argues that the device of Sarason is incapable of being fluid tight, as the lid is attached to the ring by a piece of fabric glued onto the ring and onto the lid, as the fabric is not fluid tight (App. Br. 11). Moreover, Appellant argues that, “the soft and readily deformable ‘cell rubber’ ring will not sustain a fluid-tight seal with the lid when subjected to positive or negative pressures” (*id.*).

Appellant’s arguments have been carefully considered, but are not found to be convincing. Sarason teaches a device made out of closed cell foam, which is the same foam used in the claimed device (Specification 14, ll. 26-30). In addition, Sarason teaches that the foam ring is attached to sticking plaster, which is then stuck to the skin via an agglutinant or a rubber solution, so that secretions cannot get under the seating surface of the ring, and also teaches that the lid, which may be a rubber disk, may be tightly secured to the ring by a rubber solution. Thus, while Appellant argues that the device of Sarason is not fluid tight, no evidence has been made of record demonstrating that, and attorney argument cannot take the place of evidence lacking in the record. *Estee Lauder Inc. v. L’Oreal, S.A.*, 129 F.3d 588, 595 (Fed. Cir. 1997).

Appellant argues further that “the Examiner has provided a definition of cushion that is not the ordinary meaning for a ‘cushion’” (App. Br. 11 (citing the definition of “cushion” from dictionary.com of “a soft bag of cloth, leather, or rubber, [that may be] filled with feathers, air, foam rubber, etc., on which to sit, kneel or lie,’ or ‘anything similar in form, used to

dampen shocks or to prevent excessive pressure or chafing.”) Appellant asserts that if the Examiner interprets the sticking plaster “c” of Sarason as the cushion, the ordinary artisan would not add “an additional and redundant prominent cell rubber cushion a above it” (App. Br. 11). According to Appellant, Sarason intends the plaster to serve as an adhesive layer (*id.* at 11-12).

Our mandate is to give claims their broadest reasonable interpretation consistent with the Specification as it would be interpreted by one of ordinary skill in the art. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). “An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.” *In re Zletz*, 893 F.2d 319, 322 (Fed. Cir. 1989).

Appellant does not point to any definition of cushion in the Specification, but points to a definition from dictionary.com, which notes that cushions may be used to dampen shocks or to prevent excessive pressure or chafing. Claim 11 recites “cushion,” but does not define any particular cushion material, but only recites that the cushion “is secured about a perimeter of a second portion of said housing, said second portion being open and said cushion defining an annulus.” As noted by the Examiner (Ans. 5), the sticking plaster meets that limitation. Moreover, as the sticking plaster is placed between the ring *a* and the adhesive (the agglutinant or rubber solution), the ordinary artisan would expect it to

prevent some level of chafing, and thus at some level, act as a cushion between the adhesive and the ring *a*.

We thus affirm the anticipation rejection as to claim 11. Claim 34 falls with that claim.

As to claim 12, Appellant notes that “the Examiner asserts that the sticking plaster ‘c’ is pliable, conformable and compressible inasmuch as it supports the weight of the device and is adhered in place by placing the device on the skin over the wound, which would necessarily require compression to activate the skin-adhering adhesive” (App. Br. 13). Appellant argues that “being able to support the weight of the device and being adhered to the skin has no bearing whatsoever on whether or not an item is a cushion” (*id.*). Moreover, Appellant asserts, there is not necessarily a requirement to use compression to apply the sticking plaster to the skin (*id.*).

Claim 12 depends from claim 11, and recites that the “cushion is pliable, conformable, and compressible.” As to the arguments that the fact that the sticking plaster is able to support the weight of the device has nothing to do with it being a cushion, as discussed above with respect to claim 11, the claims are given their broadest reasonable interpretation, and a cushion may also prevent chafing. The sticking plaster would be pliable and conformable as it acts as an intermediate between the ring *a* and the adhesive, and as Sarason teaches that there is no fluid leakage under the ring, at some level the sticking plaster must be pliable and conformable to allow for that seal to form between the ring and the skin. As to compressible,

again, no level of compression is recited, as thus reads on any level of compression. We thus affirm the anticipation rejection of claim 12.

As to claim 17, Appellant argues that the claim “has been amended to make it clear that the port for passing the therapeutic modality into or out of the chamber must remain functional with the lid closed,” and that there “is no such teaching or functionality in Sarason (App. Br. 14).

Claim 17 is drawn to the device of claim 12, “wherein said housing and said lid define a chamber over a wound when said lid is closed, said device having at least one port for passage of a therapeutic modality into or out of the chamber.” There is nothing in the claim that requires that the port for passing the therapeutic modality into or out of the chamber must remain functional when the lid is closed. We thus affirm the anticipation rejection of claim 17.

Appellant argues as to the obviousness rejections that the Examiner erred in rejecting the dependent claims for the same reasons set forth above with respect to claim 11 (App. Br. 14). Those arguments are not found to be convincing for the reasons set forth with respect to claim 11. We thus affirm the obviousness rejections.

SUMMARY

We reverse Rejection I, but affirm Rejections II-IX.

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TIME PERIOD FOR RESPONSE

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-IN-PART

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