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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNITED EXCHANGE CORPORATION
Requester, Respondent

v.

HEATMAX, INC.¹
Patent Owner, Appellant

Appeal 2012-009462
Reexamination Control 95/001,311
Patent US 6,936,018 B2²
Technology Center 3900

Before JEFFREY B. ROBERTSON, DANIEL S. SONG and
RAE LYNN P. GUEST, *Administrative Patent Judges*.

SONG, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Heatmax, Inc. is the real party in interest (Appeal Brief (hereinafter "App. Br.") 1).

² Issued August 30, 2005 to Chalek (hereinafter "'018 patent").

STATEMENT OF THE CASE

The Patent Owner appeals under 35 U.S.C. §§ 134 and 315 (2002) from a Final Rejection of claims 1-6.³ In addition to its Appeal Brief (hereinafter "App. Br."), the Patent Owner also relies on its Rebuttal Brief (hereinafter "Reb. Br."). The Requester has submitted a Respondent Brief (hereinafter "Resp. Br.") in support of the Examiner's rejections as set forth in the Right to Appeal Notice (hereinafter "RAN").⁴ We have jurisdiction under 35 U.S.C. §§ 134 and 315 (2002).

The '018 patent is directed to a wrap for applying a thermal pad to a human body (Abstract). Representative claim 3 which utilizes a Jepson format reads as follows (App. Br., Claims Appendix, underlining indicating amendment to claim 3 as issued in the '018 patent):

3. An improved wrap suited for applying a thermal pad to any of various different selected body portions of different sizes, wherein the wrap has a pocket defining at least one opening adapting the pocket to receive a prepackaged thermal pad therein through said opening and has a longitudinally elongated flexible and elastic compression band that is elastic in the direction of elongation, having first and second opposite compression band portions extending away from two opposite edges of said pocket to respective first and second distal ends of said band, the band having sufficient length for applying the pocket to a selected body portion by wrapping and

³ We observe that there appears to be a typographical error in the Right to Appeal Notice which identifies claims 1-11 as being subject to reexamination and rejected (Right to Appeal Notice, pg. 1), whereas only claims 1-6 are subject to reexamination and rejected as set forth *infra*.

⁴ The Examiner's Answer dated January 25, 2012 merely incorporates by reference, the RAN mailed April 25, 2011. Thus, we refer to the RAN in the decision.

applying compression to the body portion, wherein the improvement comprises:

an attachment element carried on a first one of said respective first and second ends of said band distal from said pocket, wherein said attachment element is adapted to releasably fasten to any selected portion of said elastic band to conform and secure the wrap to a selected body portion; and

a fastening means extending along the entire surface of said elastic band, engageable with said attachment element to secure the wrap around a selected body portion while permitting any portion of the band, distal from said engaged area, to be severed from the wrap for variably adjusting the fit of the wrap to the size of the selected body portion, wherein said pocket has elasticity in the direction of elongation.

Claim 1 is also an independent claim directed to a wrap configured as a sleeve wherein "said pocket having elasticity in the direction of elongation." (App. Br., Claims Appendix).

The Examiner made the following rejections of the various claims (parenthetical identifying the actual ground in the RAN):

1. Claims 3-6 under 35 U.S.C. § 103(a) as unpatentable over the combination of Admitted Prior Art⁵, Ouellette⁶ and Rosenwald⁷ (Ground 5);
2. Claims 3 and 6 under 35 U.S.C. § 103(a) as unpatentable over the combination of Rosenwald in view of Meistrell⁸ (Ground 6);

⁵ The Examiner's position is that because claim 3 of the '018 patent is in Jepson format, the recitations prior to "wherein the improvement comprises" is admitted prior art (hereinafter "APA"; RAN 14).

⁶ International Publication No. WO 97/01315, published January 16, 1997.

⁷ U.S. Patent No. 5,496,358 to Rosenwald, issued March 5, 1996.

3. Claims 4 and 5 under 35 U.S.C. § 103(a) as unpatentable over the combination of Rosenwald, Meistrell and Ouellette (Ground 7);
4. Claim 3 under 35 U.S.C. § 102(b) as anticipated by Lerner⁹ (Ground 8);
5. Claims 1 and 2 under 35 U.S.C. § 103(a) as unpatentable over the combination of Ouellette, Rosenwald and Lemon¹⁰ (Ground 9);
and
6. Claims 3-6 under 35 U.S.C. § 103(a) as unpatentable over the combination of APA, Ouellette and Hernandez¹¹ (Ground 11).

We AFFIRM.

ISSUES

The following issues have been raised in the present appeal.

1. Whether the claim limitation "wherein said pocket has elasticity in the direction of elongation" precludes any non-elastic portion on the pocket.
2. Whether the Examiner erred in finding that Rosenwald discloses a pocket having "elasticity in the direction of elongation."
3. Whether the Examiner erred in finding Lerner discloses a pocket having "elasticity in the direction of elongation."

⁸ U.S. Patent No. 4,805,620 to Meistrell issued February 21, 1989.

⁹ U.S. Patent No. 5,956,963 to Lerner issued September 28, 1999.

¹⁰ U.S. Patent No. 3,710,790 to Lemon issued January 16, 1973.

¹¹ U.S. Patent No. 4,625,340 to Hernandez issued December, 2, 1986.

4. Whether the Examiner erred in finding that Hernandez discloses a pocket having "elasticity in the direction of elongation."

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. A. The '018 patent discloses a wrap for applying a thermal pad to a human body (Abstract). Figure 1 of the '018 patent is reproduced below.

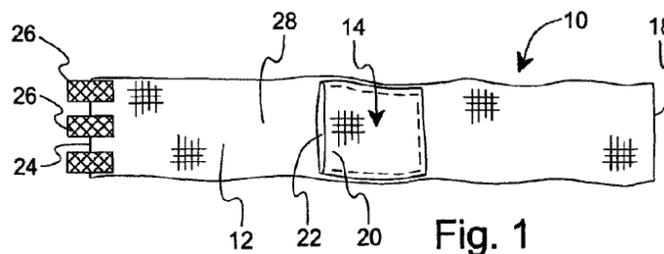


Figure 1 shows "a plan view of the inner surface of one embodiment of a thermal application device" constructed as a wrap 10 with a strip 12 made of a flexible material, and a pouch 14 formed by a layer 20 of the same material that is attached at three edges to form an end opening 22 for receiving a thermal pack (col. 4, ll. 7-10, 44-67).

B. The specification of the '018 patent states "[t]he material of the strip 12 from which the wrap 10 is constructed is preferably a material which is sufficiently flexible to provide a certain amount of elasticity or pliancy in the direction of elongation." (Col. 4, ll. 44-48; *see also* col. 3, ll. 21-23, 48-49).

C. The specification of the '018 patent further states that "the pouch is made from the same flexible woven cloth as the band and has an end opening adapted to permit access to the interior thereof for selective insertion and retrieval of a thermal pack." (Col. 3, ll. 56-60).

D. The specification of the '018 patent also states:

Given the width of the pouch **14, 16** relative to the width of the strip **12**, the end opening **22** and the interior of the pouch **14, 16** may be accessed even after the device **10, 11** or **32** has been placed on an injured party. Thus, the device **10, 11, 32** does not need to be entirely removed and [sic] order to change out the thermal pack as the heat or cold wears off. Inasmuch as there is no latex or rubber included in the strip **12**, there is no allergic reaction potential to contact with the skin of a user. However, the slight elasticity and pliancy accommodates adjustability onto an injured body portion as well as permits compression. (Col. 6, ll. 28-39).

2. A. Rosenwald discloses a thermal wrap for joints and limbs (Abstract). Figure 3 of Rosenwald is reproduced below.

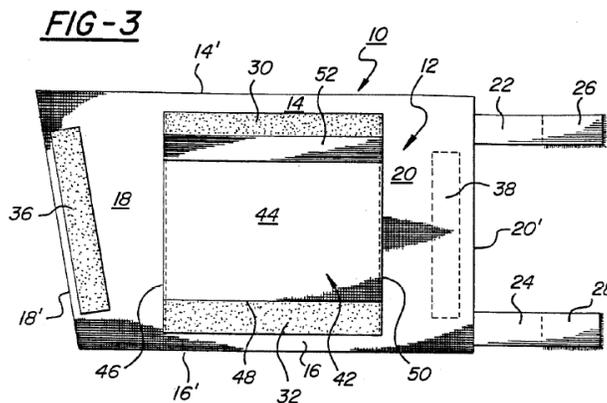


Figure 3 shows the outer surface of a knee wrap 10 laid flat, the knee wrap including a support member 12 which carries a flexible pouch 42 with panel 44, a fastener strip 30, a fastener with first and

D. Figure 13 of Rosenwald is reproduced below.

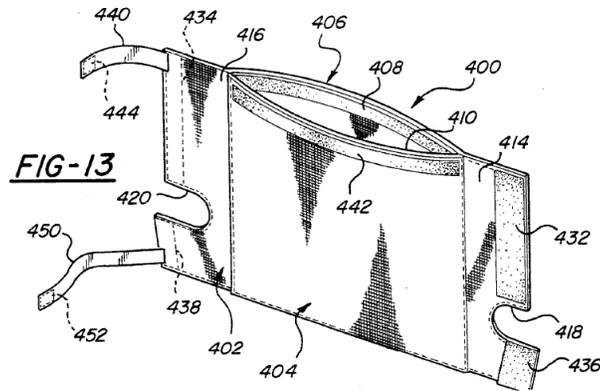


Figure 13 shows a perspective view of an embodiment of an ankle wrap 400 including flexible elastic cloth panels 402, 404 that define a flexible elastic pouch 406 which is closed by hook and loop fastener strips 408, 410, and inelastic cinch strap fastener strip 442 (col. 2, ll. 67; col. 9, ll. 7-16).

3. A. Hernandez discloses a carrier pocket textile sleeve that is worn around the calf of the user (Abstract). Figure 1 of Hernandez is reproduced below.

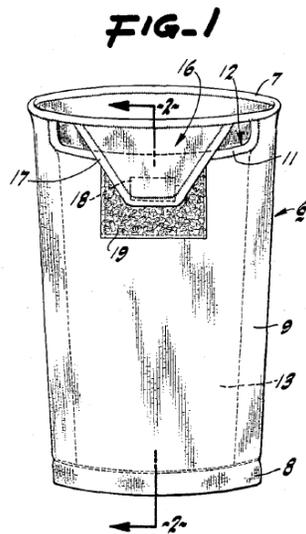


Figure 1 shows a side elevation view of the carrier which is a tubular sleeve 6 of "somewhat elastic fabric" that is "augmented by an overlying sheet 9 of a generally similar textile or knitted material" so as to form a pocket 13 with an opening 12 (col. 1, ll. 39-41, 49-65).

B. The carrier of Hernandez also includes a flap 16 that overlaps the opening 12 and includes a portion of a fastener 18 that engages a mating fastener part 19 secured to the overlying sheet 9 (col. 2, ll. 4-16).

C. Hernandez states that various personal articles can be inserted into the pocket "and are normally retained by the elasticity of the sleeve and the sheet." (Col. 1, l. 65-col. 2, l. 2).

PRINCIPLES OF LAW

Claims are to be given their broadest reasonable interpretation consistent with the specification, reading claim language in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). This is the standard for claim interpretation in both original examination and re-examination. *See In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984); *see also In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) ("During reexamination, as with original examination, the PTO must give claims their broadest reasonable construction consistent with the specification. Therefore, we look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation."). Furthermore, "[t]hough understanding the claim language may be aided by

the explanations contained in the written description, it is important not to import into a claim limitations that are not a part of the claim." *See Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004).

ANALYSIS

We address the various rejections and arguments in the appeal *infra*, albeit in an order that differs from that presented by the Patent Owner.

Rejection 1 (Ground 5)

The Examiner rejects claims 3-6 as obvious over the combination of APA, Ouellette and Rosenwald, the Examiner relying on Ouellette for disclosing the use of the claimed fastening means, and relying on Rosenwald for disclosing the limitation "a pocket having an elasticity in the direction of elongation." (RAN 15). The Examiner concludes that it would have been obvious to one of ordinary skill in the art "to construct the pocket of the APA of a material having an elasticity in the direction of elongation, as taught by Rosenwald, so that the pocket can be expanded to accommodate different sized thermal packs." (RAN 15-16).

The Patent Owner argues that Rosenwald does not disclose the limitation "wherein said pocket has elasticity in the direction of elongation" because the broadest reasonable interpretation of claim 3 in view of the specification of the '018 patent requires the "entire pocket" to have elasticity in the direction of elongation thereby precluding non-elastic portions on the pocket. (App. Br. 5-8; Reb. Br. 2-5). The Patent Owner provides a citation to

the specification of the '018 patent in support of this interpretation, and argues that the claimed wrap has a benefit in that it "does not need to be entirely removed in order to change out the thermal pack. This is due to the width of the pouch relative to the width of the strip in addition to the elastic nature of the entire pouch itself." (App. Br. 8-9, emphasis in original; Reb. Br. 6; *see also* FF 1D).

The Patent Owner argues that "[e]ach of the pocket configurations taught by *Rosenwald* includes at least a portion of the pocket that is not elastic, which ultimately affects the elasticity of the pocket as a whole." (App. Br. 9, emphasis in original). With respect to the embodiment of *Rosenwald* shown in Figure 3, the Patent Owner argues that the fastener strip 30 extending across the top of the pouch 42 is inelastic (FF 2A), and thus, the pouch is not elastic in the direction of elongation (App. Br. 6; Reb. Br. 3-4). As to the embodiment shown in Figure 6, the Patent Owner argues that because of the inelastic zipper strip 152 (FF 2C), "the opening of the pouch is not elastic." (App. Br. 7, emphasis in original; Reb. Br. 4). The Patent Owner similarly argues that the embodiment shown in Figure 13 includes inelastic cinch strap fastener strip 442 (FF 2D) so that the disclosed pocket is not elastic in the direction of elongation (App. Br. 7-8; Reb. Br. 5).

The Examiner finds that the fastener strip or zipper present in the embodiments of *Rosenwald* does not restrict the other areas of the pocket, and finds that *Rosenwald* "expressly discusses the elasticity of the panel that forms the pocket." (RAN 30). Thus, the Examiner's rejection implicitly interprets the limitation "a pocket having an elasticity in the direction of elongation" as not precluding inclusion of inelastic components. The

Requester argues that the specification of the '018 patent does not define the degree of elasticity required, and claim 3 does not recite "where elasticity is present in the pocket," or recite that the "opening" of the pouch is elastic as argued by the Patent Owner (Res. Br. 5-7).

We find no error in the Examiner's rejection. The Patent Owner's arguments for a narrow interpretation of the added limitation "wherein said pocket has elasticity in the direction of elongation" are not well founded. Whereas the Patent Owner provides a citation to the specification of the '018 patent in support of its narrow interpretation, the ability to change out the thermal pack without the entire removal of the device is attributed to the "width of the pouch **14, 16** relative to the width of the strip **12**" (FF 1D), and not to the entirety of the pocket being elastic. The specification also refers to elasticity and pliancy as merely allowing adjustability of the strip 12 and compression on the injured body portion (FF 1D). Indeed, the specification of the '018 patent does not describe "elasticity" of the pouch in a specific manner so as to preclude any inelastic portion thereon. Whereas the wrap illustrated does not include any inelastic features on the pouch, we decline to read such a limitation from the specification into the claim because the claim language is broader. *See Superguide*, 358 F.3d at 875. We find no reasonable basis to conclude that this limitation would be understood by one of ordinary skill in the art when reviewing the specification so as to preclude any inelastic portion on an elastic pocket, and the Patent Owner has not set forth any persuasive evidence that supports a different conclusion.

To the extent that the pockets disclosed in the various embodiments of Rosenwald do include a small inelastic portion at the edge thereof that forms

the opening, most of the elastic pocket is clearly unimpeded in the direction of elongation (FF 2A-2D). In this regard, Rosenwald discloses that the pouch is formed of a stretch fabric that provides "omnidirectional elasticity," and further characterizes the pouch as being "expandable." (FF 2B).

The Patent Owner's argument that the claimed invention provides the benefit of allowing exchange of the thermal pad without removal of the warp is also unpersuasive because the ability of such an exchange would be impacted by the size of the thermal pack which is not a limitation in the claims. Furthermore, a small inelastic portion at the edge of the pocket in the embodiments of Rosenwald would not preclude such exchange of the thermal pack because the opening of the pouch extends the width of the pocket. While the ability to enlarge the opening of the pouch would make such exchange of the thermal pack potentially easier, the claims are not directed to enlargement of the opening of the pocket. Instead, the claims merely require that the pocket have elasticity in the direction of elongation which the pouch of Rosenwald clearly has.

For the foregoing reasons, we disagree with the Patent Owner's asserted claim interpretation, and are not persuaded that the Examiner erred. Thus, the Examiner's Rejection 1 of claims 3-6 as being obvious over the combination of APA, Ouellette and Rosenwald is sustained.

Rejections 2, 3 and 5 (Grounds 6, 7, 9)

The dispositive issue in these rejections is the same as that of Rejection 1 discussed *supra*, namely, whether Rosenwald discloses a pocket having "elasticity in the direction of elongation." In its brief, the Patent

Owner's relies on the same arguments proffered with respect to Rejection 1 in its request to reverse Rejections 2 and 3, and submits substantially the same arguments with respect to Rejection 5 which rejects claims 1 and 2 (App. Br. 10-15). Thus, for the reasons discussed *supra* in Rejection 1, we sustain Rejections 2, 3 and 5 as well.

Rejection 6 (Ground 11)

The Examiner rejects claims 3-6 under 35 U.S.C. § 103(a) as unpatentable over the combination of APA, Ouellette and Hernandez, finding that Hernandez discloses a carrier with "a pocket having an elasticity in the direction of elongation [] and allows for some bulging or shifting of the contents of the pocket[.]" (RAN 23). The Examiner concludes that it would have been obvious to one of ordinary skill in the art "to construct the pocket of the APA of a material having an elasticity in the direction of elongation, as taught by Hernandez, so that the pocket can be expanded to accommodate different sized thermal packs." (RAN 23).

The Patent Owner's arguments proffered with respect to this rejection are substantially similar to those submitted with respect to Rosenwald in Rejection 1. In particular, the Patent Owner argues that the limitation "wherein said pocket has elasticity in the direction of elongation" recited in independent claim 3 should be narrowly interpreted to require the entirety of the pocket to have the recited elasticity (App. Br. 17-19), thereby precluding inelastic portions being present on the pocket. The Patent Owner argues that the provision of the fastener portion 19 on the sheet 9 that forms the pocket (FF 3A), "clearly restricts the elasticity of the pocket," and thus, fails to

disclose a pocket having elasticity in the direction of elongation as required (App. Br. 17).

We disagree with the Patent Owner's claim interpretation for the reasons already discussed *supra* relative to Rejection 1. In addition, we agree with the Examiner's finding that Hernandez discloses a pocket having elasticity in the direction of elongation. In particular, Hernandez discloses a tubular sleeve 6 of an elastic fabric with a pocket 13 thereon made from the same elastic material (FF 3A, 3C). Whereas the carrier of Hernandez includes a mating fastener part 19 on the pocket 13, the mating fastener part 19 is small in comparison to the pocket 13, and thus, the teaching evinces that the pocket is elastic in the direction of elongation (FF 3A-3C). We further observe that in the carrier of Hernandez, the mating fastener part 19 extends along only a portion of the edge forming the opening 12 of the pocket 13 (FF 3A). Hence, the carrier of Hernandez would allow the opening of the pocket to be enlarged so as to facilitate exchange of a thermal pack without removal of the sleeve which is purported to be the advantage of the claimed invention.

Thus, the Examiner's Rejection 6 of claims 3-6 as obvious over the combination of APA, Ouellette and Hernandez is also sustained.

Rejection 4 (Ground 8)

The Examiner rejects claim 3 as anticipated by Lerner (RAN 18). However, claim 3 has been rejected as unpatentable in three different rejections, namely, Rejections 1, 2 and 6 discussed *supra*. Thus, we find it unnecessary to reach this rejection.

CONCLUSIONS

1. The claim limitation "wherein said pocket has elasticity in the direction of elongation" does not preclude presence of a non-elastic portion on the pocket.
2. The Examiner did not err in finding that Rosenwald discloses a pocket having "elasticity in the direction of elongation."
3. We do not reach the issue of whether Lerner discloses a pocket having "elasticity in the direction of elongation."
4. The Examiner did not err in finding that Hernandez discloses a pocket having "elasticity in the direction of elongation."

ORDER

The Examiner's Rejections 1-3, 5 and 6 are AFFIRMED so that claims 1-6 subject to this reexamination stand rejected.

Requests for extensions of time in this *inter partes* reexamination proceeding are governed by 37 C.F.R. §§ 1.956 and 41.77(g).

AFFIRMED

alw

Appeal 2012-009462
Reexamination Control 95/001,311
Patent US 6,936,018 B2

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