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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOHN TEMPLE

Appeal 2013-007412
Application 12/471,895
Technology Center 3700

Before EDWARD A. BROWN, JILL D. HILL, and
LEE L. STEPINA, *Administrative Patent Judges*.

BROWN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

John Temple (Appellant)¹ appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1–8. We heard oral argument on November 17, 2016. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM and enter NEW GROUNDS OF REJECTION.

INVENTION

Claim 1 is the sole independent claim, and reads:

1. A system for warming an endoscope, laparoscope, or other such instrument to minimize fogging, comprising:

¹ John Temple is identified as the real party in interest. Appeal Br. 1.

a flexible pad having a length, a width and a periphery for wrapping around the instrument;
the pad including a plurality of separate chambers defined through partitions;
each of the separate chambers including an activation disc and a mixture of water and sodium acetate to generate heat through an exothermic reaction initiated through manual manipulation of the disc for that chamber.

Appeal Br. 6 (Claims App.).

REJECTIONS

Claims 1–6 are rejected under 35 U.S.C. § 103(a) as unpatentable over Andrassy (US 3,463,161, issued Aug. 26, 1969) and Wang (US 5,205,278, issued Apr. 27, 1993).

Claim 7 is rejected under 35 U.S.C. § 103(a) as unpatentable over Andrassy, Wang, and Manker (US 4,872,442, issued Oct. 10, 1989).

Claim 8 is rejected under 35 U.S.C. § 103(a) as unpatentable over Andrassy, Wang, and Gauthier (US 5,295,964, issued Mar. 22, 1994).

ANALYSIS

Obviousness of claims 1–6 over Andrassy and Wang

Claims 1 and 2

As to claim 1, the Examiner finds Andrassy discloses a temperature maintaining device comprising a flexible pad including separate chambers 10, but does not disclose that “each of the separate chambers includ[es] an activation disc and a mixture of water and sodium acetate to generate heat through an exothermic reaction initiated through manual manipulation of the disc for that chamber.” Final Act. 2 (citing Wang Fig. 1). The Examiner finds Wang teaches a chemical bag warmer including a bag filled with sodium acetate solution provided with a metal activation disc to produce

heat. *Id.* (citing Wang Abstract, Fig. 1). The Examiner concludes it would have been obvious to include an activation disc and a sodium acetate solution in each chamber of Andrassy, as taught by Wang. *Id.* at 3. The Examiner explains the modification of Andrassy does *not* remove the existing emulsion solution, but merely combines a heating source with the invention of Andrassy. Ans. 5 (citing Andrassy col. 4, ll. 46–53).

Andrassy teaches heat retaining pads in which a portion of the water may be replaced by paraffin or higher melting hydrocarbon material. *See* Andrassy col. 3, ll. 66–70. Example V of Andrassy describes a composition for use in heating pads. *Id.* at col. 4, ll. 39–51. Wang discloses a chemical bag warmer containing a sodium acetate solution and a metal, disc-shaped triggering member used to cause the solution to crystallize and generate heat. *See* Wang col. 3, ll. 3–22, Fig. 1.

Appellant contends that Andrassy “simply states that a particular composition ‘is particularly suitable in heating pads’—not that it would be obvious to bond the device of Andrassy to the device of Wang, if in fact that’s what the Examiner means.” Reply Br. 2 (citing Andrassy col. 4, ll. 46–53).

We agree with Appellant. The Examiner does not explain adequately how Andrassy would be modified to combine Wang’s heating source with its existing emulsion solution. For example, the Examiner does not explain how the different solutions of Andrassy and Wang would be physically combined with each other, or, if not combined, kept separated from each other in each of the separate chambers of the pad.

Nonetheless, we sustain the rejection of claims 1 and 2 over the combination of Andrassy and Wang, albeit for different reasons. Figure 2 of

Wang shows sodium acetate solution 3 and triggering member 4 disposed in a chamber of bag 2. Bag 2 can be considered a “flexible pad,” as claimed. Wang does not disclose that bag 2 is “for warming an endoscope, laproscope, or other such instrument to minimize fogging,” as recited in the preamble of claim 1. However, this limitation recites an intended use of the “system.” It does not appear to impose any structural difference on the system.

Claim 1 recites that the flexible pad is “for wrapping around the instrument.” This limitation recites a function of the pad, but does not appear to further limit the shape and/or size of the pad. Wang does not appear to disclose that bag 2 is used “for wrapping around” “an endoscope, laproscope, or other such instrument.” Even if Wang does not explicitly disclose this use of the disclosed structure, “[i]t is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable.” *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). Wang’s bag is described as “a soft PVC, P.P. or P.U bag.” Wang, col. 3, ll. 6–7. Further, Wang places its triggering member within the bag, and a user triggers a heat-generating crystallization reaction by applying pressure to the trigger member in this location. *Id.* at col. 3, ll. 8–27. Thus, Wang’s bag is flexible. We find Wang’s bag 2 is capable of providing the claimed function of the flexible pad, as the claim recites no limitation on the size of the instrument.

Wang does not disclose that bag 2 “include[es] a plurality of separate chambers defined through partitions,” and “each of the separate chambers includ[es] an activation disc and a mixture of water and sodium acetate to generate heat through an exothermic reaction initiated through manual

manipulation of the disc for that chamber,” as claimed. However, it would have been obvious to one of ordinary skill in the art to modify Wang’s bag 2 to include these limitations. Wang discloses that the bag is sealed. Wang col. 4, ll. 8–12. It would have been obvious to provide two or more separate chambers through partitions in the modified bag. This could be achieved by forming a seal extending parallel to opposed sides of bag 2, at a location between the opposed sides shown in Figure 1. In this regard, Andrassy discloses lines 4, 6 defining compartments in the pad for containing a composition used for heating purposes. The sealed regions would form partitions between the chambers, or bags, making plural separate chambers in Wang an obvious variant.

Alternatively, two or more bags 2 shown in Figure 1 of Wang could be combined with each other, effectively duplicating bag 2 and producing a bag defining a plurality of separate chambers. The separate chambers would be defined by partitions between adjacent bags. Although Wang does not disclose a plurality of separate chambers, “[i]t is well settled that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669, 671 (CCPA 1960). Appellant has not established any unexpected result associated with the claimed system. Modifying Wang’s bag 2 to include two or more separate chambers, each including an activation disc and sodium acetate mixture, would allow selective activation and heating of each chamber, and would provide the expected advantage of permitting a user to selectively control heating of an object by the bag.

We therefore exercise our discretion under 37 C.F.R. § 41.50(b) and designate our affirmance of the rejection of claim 1 and dependent claim 2,

which Appellant does not separately argue, over Andrassy and Wang as a new ground the rejection under 35 U.S.C. § 103(a).

Claims 3–6

Claims 3–6 each depend from claim 1, and require at least some of the partitions to establish fold lines in the pad. Appeal Br. 6 (Claims App.). As discussed above, the modified bag of Wang would include partitions defining two or more separate chambers. The bag would be foldable along at least some of the partitions, allowing it to conform to an object to be heated by the bag. Accordingly, the partitions would provide “fold lines,” as claimed. We also note that Figure 2 of Andrassy shows a cap 20 applied to a user’s head, and Figure 3 shows pads applied to a user’s shoulder at 26, elbow at 28, and wrist at 30. These figures show that Andrassy’s pads have the capability of being flexed or folded along lines.

Regarding the orientation of the partitions, we conclude that it would have been obvious to one of ordinary skill in the art to form the partitions in the modified bag of Wang such that either “at least some of the partitions establish lengthwise fold lines in the pad” (claim 4), or “at least some of the partitions establish widthwise fold lines in the pad” (claim 5). The direction(s) of the fold lines in the modified bag would allow the bag to be folded, for example, for storage purposes, as well as to conform to objects having different and/or complex shapes.

We affirm the rejection of claims 3–6 as unpatentable over Andrassy and Wang, and designate our affirmance as a new ground the rejection.

Obviousness of claim 7 over Andrassy, Wang, and Manker

Claim 7 recites that “each activation disc is made of perforated stainless steel.” Appeal Br. 7 (Claims App.). Although Wang discloses that

triggering member 4 is made of metal, Wang does not specify that the metal is stainless steel.

The Examiner finds Manker teaches use of an activator in the form of a stainless steel disc for initiating a reaction in a heat pack. Final Act. 4–5 (citing Manker col. 5, ll. 20–37). Manker discloses that the aqueous salt solution in which a crystallization reaction is activated or initiated can contain sodium acetate in water. *See* Manker col. 6, ll. 54–62. In view of this teaching, we conclude that it would have been obvious to make Wang’s triggering member 4 of stainless steel to initiate or activate a crystallization reaction in Wang’s sodium acetate solution 3. Such a modification would have been merely a combination of prior art elements according to known methods to yield predictable results. One of ordinary skill could have implemented the stainless steel material taught by Manker in the bag of Wang just as Manker does in its own device, and the material would merely perform the same function it already does in Manker’s device, and Wang’s metal triggering member 4 does in its device. Accordingly, we affirm the rejection of claim 7 as unpatentable over Andrassy, Wang, and Manker, and designate our affirmance as a new ground the rejection.

Obviousness of claim 8 over Andrassy, Wang, and Gauthier

Claim 8 depends from claim 1 and recites “further including one or more pieces of tape or other tabs to secure one edge of the pad to another once wrapped around an instrument to be warmed.” Appeal Br. 7 (Claims App.). Appellant’s Specification describes “fasteners such as hook-and-loop tabs.” Spec. ¶ 33.

The Examiner finds that Gauthier teaches this limitation. Final Act. 5 (citing Gauthier col. 2, ll. 24–33). Gauthier discloses the use of suitable fasteners, such as hook-and-pile fasteners, for securing a heat pack. *See* Gauthier col. 2, ll. 30–33.

In Andrassy, Figure 2 shows strap 24 provided on cap 20, and Figure 3 depicts a fastening element provided on a pad covering elbow 28. *See also* Andrassy col. 5, ll. 56–65. In view of these teachings in Gauthier and Andrassy, we conclude that it would have been obvious to one of ordinary skill in the art to modify Wang to include one or more tabs, such as hook-and-loop tabs, to secure one edge of the pad to another edge once the pad is wrapped around an object to be warmed. This modification would allow the modified bag of Wang to be retained on an object to provide effective heating. The recitation of “an instrument” in claim 8 is an intended use of the pad. We find Wang’s modified pad would be capable of being wrapped around such an instrument to be warmed, as the claims do not recite any limitation on the size of the instrument. Accordingly, we affirm the rejection of claim 8 as unpatentable over Andrassy, Wang, and Gauthier, and designate our affirmance as a new ground the rejection.

DECISION

The Examiner’s decision rejecting claims 1–6 under 35 U.S.C. § 103(a) as unpatentable over Andrassy and Wang is affirmed and designated as a NEW GROUND OF REJECTION.

The Examiner’s decision rejecting claim 7 under 35 U.S.C. § 103(a) as unpatentable over Andrassy, Wang, and Manker is affirmed and designated as a NEW GROUND OF REJECTION.

The Examiner's decision rejecting claim 8 under 35 U.S.C. § 103(a) as unpatentable over Andrassy, Wang, and Gauthier is affirmed and designated as a NEW GROUND OF REJECTION.

FINALITY OF DECISION

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” 37 C.F.R. § 41.50(b) also provides:

When the Board enters such a non-final decision, [Appellant], within two months from the date of the decision, must exercise one of the following two options with respect to the new ground[s] of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground[s] of rejection [are] binding upon the Examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground[s] of rejection designated in this decision. Should the examiner reject the claims, [Appellant] may again appeal to the Board pursuant to this subpart.
- (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

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Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED; 37 C.F.R. § 41.50(b)