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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO. Includes application details for 13/197,313 and 58249 7590, listing inventor XingQuan (Peter) REN and attorney COOLEY LLP.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte XINGQUAN REN, JIM O'BRIAN, and TOM PISTELLA

Appeal 2015-004644
Application 13/197,313
Technology Center 1700

Before CHUNG K. PAK, JEFFREY T. SMITH, and
WESLEY B. DERRICK, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 10 through 20¹. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

Appellants' invention is generally directed to a dye-free medical towel comprising an absorbent cotton cloth. App. Br. 7.

¹ Claims 1–9 stand withdrawn from consideration. Final Office Action entered September 20, 2013 ("Final Act."), 2.

Claim 10 illustrates the subject matter on appeal and is reproduced below:

10. A dye free medical towel, comprising:
 - a cotton absorbent cloth having:
 - a reflectance percentage value of greater than about 25 and less than about 75, between about 360 nm and about 750 nm,
 - a whiteness value of less than about 50% WI-CIE,
 - an absorbency rate of greater than about 2 millimeters per second; and
 - a lint release less than 700,000 particles of 0.5 micron size or greater.

App. Br. 16, Claims Appendix.

Appellants (*see generally* App. Br.) request review of the Examiner's final rejection of claims 10–20 under 35 U.S.C. § 102(a) or § 102(e) as anticipated by Kapik et al. (US 2009/0270824 A1, published October 29, 2009, hereinafter “Kapik”), or alternatively under 35 U.S.C. § 103(a) as unpatentable over Kapik.

OPINION

After review of the respective positions provided by Appellants and the Examiner, we REVERSE the Examiner's rejection of claims 10–20 under 35 U.S.C. § 102(a) or § 102(e), or alternatively under 35 U.S.C. § 103(a). We add the following.²

² For the purposes of this appeal, we select claim 10, the broadest claim on appeal, as representative, and decide the propriety of the rejection based on this claim alone.

The critical issue on appeal is whether the Examiner has established that the surgical towel disclosed in Kapik would inherently have a whiteness value and a reflectance percentage within the respective ranges recited in claim 10. *In re Napier*, 55 F.3d 610, 613 (Fed. Cir. 1995) (“[t]he inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness.”)

The Examiner finds that Kapik discloses a dye-free, pigment-free surgical towel made of absorbent cotton cloth that has a lint release of less than 500 for particles 0.5 micron or greater in size. Final Act. 2. The Examiner determines that because Kapik’s dye-free, pigment-free cotton cloth has substantially the same structure and chemical composition as the medical towel recited in claim 10, Kapik’s surgical towel would inherently have a whiteness value and a reflectance percentage as recited in claim 10. Final Act. 3. On this record, however, the Examiner has not established that the surgical towel disclosed in Kapik would *necessarily* or *inherently* have a whiteness value of less than about 50% WI-CIE, and a reflectance percentage value of greater than about 25 and less than about 75 at between about 360 nm and about 750 nm as recited in claim 10.³

Appellants’ Specification explains that the procedure used to produce the claimed medical towel eliminates bleaching and dyeing, and consolidates degreasing and washing into one step under high-temperature/high-pressure. Spec. ¶¶ 23–24. Appellants’ Specification further explains that this manufacturing process that does not involve bleaching reduces the lint levels in the towel, increases the towel’s absorbency, retains the natural color of

³ An inherent characteristic must be inevitable. *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981).

the cotton, and results in favorable glare characteristics (reflectance) under operating room lighting conditions. Spec. ¶¶ 22, 25, and 31.

Kapik does not explain how its disclosed surgical towel is produced, and thus Kapik does not disclose whether or not the surgical towel is treated with bleach or is subjected to degreasing and washing in one step under high-temperature/high-pressure. As Appellants point out (App. Br. 11 referring to Spec. ¶ 23), one of ordinary skill in the art would have reasonably understood that the process used to produce a medical or surgical towel, including conducting degreasing and washing in one step under high-temperature/high-pressure without bleaching, affects the whiteness and reflectance of the towel. The Examiner fails to account for Kapik's lack of disclosure of how the surgical towel is produced and processed, including Kapik's failure to indicate whether or not degreasing and washing is carried out in one step under high-temperature/high-pressure without bleaching. In other words, because Kapik does not disclose that the surgical towel is produced by the same or substantially similar process as the claimed medical towel, the Examiner does not show that Kapik's surgical towel will necessarily or inherently have the same or substantially similar whiteness and reflectance values as the claimed towel. *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990) (explaining that it was reasonable for the PTO to infer that Smith teaches the claimed polymers because the PTO shows "the polymerization by both Smith [(prior art)] and Spada [(Appellant)] of identical monomers, employing the same or similar polymerization techniques....") In other words, the Examiner does not supply sufficient evidence to establish that Kapik's dye-free, pigment-free surgical towel necessarily or inherently has a whiteness value and reflectance percentage as

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recited in claim 10. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (“Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”)

Therefore, we do not sustain the Examiner’s rejection of claims 10–20 under 35 U.S.C. § 102(a) or § 102(e). Although the Examiner alternatively rejects claims 10–20 as obvious over Kapik, the Examiner fails to provide any explanation or reasoning as to why Kapik’s disclosures would have rendered claim 10 obvious. Accordingly, we also reverse the Examiner’s rejection of claims 10–20 under 35 U.S.C. § 103(a).

DECISION

For the reasons set forth above, the decision of the Examiner to reject claims 10–20 is reversed.

REVERSED