



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
**United States Patent and Trademark Office**  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/741,053	01/14/2013	Scott D. Hodges	VARIAM P01AUS	8524
26936	7590	10/01/2019	EXAMINER	
SHOEMAKER AND MATTARE, LTD c/o DAVIS & BUJOLD, P.L.L.C. 112 PLEASANT STREET CONCORD, NH 03301			NGUYEN, CAMTU TRAN	
			ART UNIT	PAPER NUMBER
			3786	
			NOTIFICATION DATE	DELIVERY MODE
			10/01/2019	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@SHOMAT.COM  
patent@nhpat.com  
tclark@nhpat.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* SCOTT D. HODGES and CHRISTOPHER B. YOUNG

---

Appeal 2018-004050  
Application 13/741,053  
Technology Center 3700

---

Before WILLIAM A. CAPP, BRANDON J. WARNER, and  
PAUL J. KORNICZKY, *Administrative Patent Judges*.

WARNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Variamed, LLC (“Appellant”)<sup>1</sup> appeals under 35 U.S.C. § 134(a) from the Examiner’s decision rejecting claims 1 and 3–12, which are all the pending claims. Appeal Br. 3; Final Act. 1 (Office Action Summary). We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

---

<sup>1</sup> Variamed, LLC is the applicant, as provided in 37 C.F.R. § 1.46, and is identified as the real party in interest. Appeal Br. 3.

CLAIMED SUBJECT MATTER

Appellant's disclosed invention "relates to a sterile patient drape for surgical operations, especially spinal procedures." Spec. ¶ 2. More specifically, the invention relates to a sterile patient drape "having a transparent window with vertical expansibility" for accommodating instruments that may be "protruding from the incision," while preventing contamination of the site and providing a clear view of the site. *Id.* ¶ 5. Claims 1, 8, and 12 are independent. Claim 1, reproduced below with emphasis added, is illustrative of the subject matter on appeal.

1. A drape for protecting an open site of a patient from contamination during a surgical operation while providing visibility of instrumentation which has been placed on the patient at the open site, said drape comprising[:]
  - a first fabric panel (10),
  - a second fabric panel (12) joined to the first fabric panel along a separation zone,
  - a fenestration (18) formed in at least one of the fabric panels [(10) or] (12) for providing visual access to said open site, and
  - a transparent window bonded to said at least one of the fabric panels [(10) or] (12) around said fenestration,
    - said transparent window being substantially expansible, out of [a] plane in which the fenestration lies, to provide clearance for said instrumentation present at the open site,*
    - wherein gussets (20) are formed at the corners of the transparent window to enhance its expansibility.*

## EVIDENCE

The Examiner relied on the following evidence in rejecting the claims on appeal:

Bauer	US 3,383,709	May 21, 1968
Elliott	US 4,384,573	May 24, 1983
Alpern	US 5,392,917	Feb. 28, 1995
Bohn	US 5,592,952	Jan. 14, 1997
Diao	US 5,640,975	June 24, 1997
Butterworth	US 6,213,124 B1	Apr. 10, 2001
Block	US 2008/0283064 A1	Nov. 20, 2008
Rotolo	US 8,011,371 B2	Sept. 6, 2011

## REJECTIONS

The following rejections are before us for review:

- I. Claim 11 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.<sup>2</sup> Final Act. 5; Ans. 2.

---

<sup>2</sup> We note that the Final Office Action (dated June 14, 2017) also includes a rejection of claims 1 and 3–10 under 35 U.S.C. § 112, second paragraph, as being indefinite. Final Act. 4–5. Many of the claim phrases identified as being problematic for claims 1, 8, 9, and 10 no longer appear in the current version of these claims. *See* Appeal Br., Claims App. However, neither of the Advisory Actions (dated Oct. 4, 2017, and Nov. 15, 2017) nor the Examiner’s Answer (dated Dec. 28, 2017) formally withdraws these bases for the rejection. As these bases for the rejection are not contested by the Examiner (they are not included in the grounds of rejection applicable to the appealed claims in the Examiner’s Answer (Ans. 2)), and the Examiner does not respond to Appellant’s arguments directed thereto (*see* Appeal Br. 6; Ans. 13–15), we consider these bases to be effectively withdrawn and conclude that they are not before us for review as part of the instant appeal. Should there be further prosecution of this application, the Examiner may wish to address a formal withdrawal of these bases for the rejection.

- II. Claims 1, 3, 5, and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bohn, Diao, and Alpern. Final Act. 6–7; Ans. 3–5.
- III. Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Bohn, Diao, Alpern, and Butterworth. Final Act. 8; Ans. 5–6.
- IV. Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Bohn, Diao, Alpern, and Block. Final Act. 9; Ans. 6.
- V. Claims 8 and 10–12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Elliot and Bauer. Final Act. 9–14; Ans. 6–12.
- VI. Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Elliot, Bauer, and Rotolo. Final Act. 15; Ans. 12–13.

## ANALYSIS

### *Rejection I – Indefiniteness*

Appellant does not address the indefiniteness rejection of claim 11. *See* Appeal Br. 6. Therefore, in the absence of any argument, we summarily sustain this rejection of claim 11. *See* MPEP § 1205.02 (An appellant may, of course, choose not to present arguments or rely upon particular evidence as to certain claim rejections; however, such arguments and evidence are waived for purposes of the appeal and the Board may summarily sustain any grounds of rejections not argued.); *see also In re Berger*, 279 F.3d 975 (Fed. Cir. 2002) (confirming same).

*Rejections II–VI – Obviousness*

Independent claim 1 recites, in relevant part, a drape including “a transparent window” that is “bonded to” at least one fabric panel “around” a fenestration formed in the panel, where the transparent window is “substantially expansible, out of [a] plane in which the fenestration lies,” and where “gussets . . . are formed at the corners of the transparent window to enhance its expansibility.” Appeal Br., Claims App. Similarly, independent claim 8 recites, in relevant part, a drape including “a transparent window” that is “bonded to” a fabric panel “around” a fenestration formed in the panel, where the transparent window is “larger in size than a size of the fenestration so as to be able to expand out of [a] plane in which the fenestration lies,” and where the transparent window is “folded, in each of the corners thereof, to form gussets . . . which enhance expansion of the transparent window.” *Id.* Independent claim 12 recites, in relevant part, a drape including “a transparent window” that is “bonded to” a fabric panel “around” a fenestration formed in the panel, where the transparent window is “substantially expansible, out of [a] plane in which the fenestration lies.” *Id.*

Although recited in slightly different ways, one of ordinary skill in the art would readily appreciate that all of the claims require a transparent window that is both (1) “bonded to” a panel around a fenestration formed in the panel and (2) “substantially expansible” out of a plane in which the fenestration lies. *See id.* Upon review of Appellant’s disclosure, in light of which the claims must be interpreted, the only disclosed structure that provides for both of these recited features is a window that is necessarily larger in size than a size of the fenestration (expressly recited in independent

claim 8). *See* Spec. ¶¶ 13–14 (it is this larger size of the window relative to the fenestration, since the window must be “bonded to” the panel “around” the fenestration, that forms “gussets” when the fenestration is “folded” to lie in the same plane as the fenestration, and it is this “gusseted construction” that “enables [the window] to expand vertically” above the plane of the fenestration).

Resolution of this appeal, then, turns on whether such structure is accounted for in the prior art cited by the Examiner. Upon review of Appellant’s arguments, we agree with Appellant that it is not. *See* Appeal Br. 6–13.

In rejecting the claims, the Examiner relies on either Bohn (Rejections II–IV) or Elliot (Rejections V and VI) for this structure. However, Appellant persuasively argues that Bohn’s transparent panel 14 “is not secured to [(bonded to)] the base sheet ‘around said fenestration,’ as recited in” the claims. Appeal Br. 8. From Bohn’s disclosure, panel 14 is only secured to the base sheet along the top edge thereof (along 48) but is otherwise moveable by lifting panel 14 away from panel 12 using 48 as a hinge (*see* Bohn, Figs. 1–5) “specifically . . . for allowing a body part, such as a leg of a patient, to protrude therethrough” (Appeal Br. 8). Accordingly, Bohn’s hinged transparent panel 14 does not meet the combination of requirements (1) and (2) identified above.

Similarly, Appellant persuasively argues that Elliot’s window 20 or 34, which appears to be bonded to a panel around a fenestration formed in the panel (requirement (1)), “is not disclosed to be [expansible],” let alone substantially so (requirement (2)). Appeal Br. 11; *see id.* at 11–12. From Elliot’s disclosure, although the window is “fixedly attached to” the cover

“around the cooperating opening by means of adhesive” (Elliot, col. 2, ll. 39–41), there is no suggestion that the static window would have any reason to move at all, let alone be “substantially expansible” out of a plane in which the opening lies. Accordingly, Elliot’s transparent window 20 or 34 does not meet requirement (2) identified above.

Rejections based on obviousness must rest on a factual basis; in making such a rejection, the Examiner has the initial burden of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions, or hindsight reconstruction to supply deficiencies in the factual basis. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967).

Because of the deficiencies in the factual findings relied on by the Examiner in making the obviousness rejections, we do not sustain them.

## DECISION

We AFFIRM the Examiner’s decision rejecting claim 11 under 35 U.S.C. § 112, second paragraph, as being indefinite.

We REVERSE the Examiner’s decision rejecting claims 1, 3, 5, and 7 under 35 U.S.C. § 103(a) as being unpatentable over Bohn, Diao, and Alpern.

We REVERSE the Examiner’s decision rejecting claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Bohn, Diao, Alpern, and Butterworth.

We REVERSE the Examiner’s decision rejecting claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Bohn, Diao, Alpern, and Block.

Appeal 2018-004050  
Application 13/741,053

We REVERSE the Examiner's decision rejecting claims 8 and 10–12 under 35 U.S.C. § 103(a) as being unpatentable over Elliot and Bauer.

We REVERSE the Examiner's decision rejecting claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Elliot, Bauer, and Rotolo.

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

AFFIRMED-IN-PART