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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/315,537	12/01/2016	Dennis Walter	GLEISS-56921	6122
86378	7590	01/27/2020	EXAMINER	
Pearne & Gordon LLP 1801 East 9th Street Suite 1200 Cleveland, OH 44114-3108			BAHENA, CHRISTIE L.	
			ART UNIT	PAPER NUMBER
			3774	
			NOTIFICATION DATE	DELIVERY MODE
			01/27/2020	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* DENNIS WALTER

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Appeal 2019-002044  
Application 15/315,537  
Technology Center 3700

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BEFORE HUBERT C. LORIN, NINA L. MEDLOCK, and  
MATTHEW S. MEYERS, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner's decision to reject claims 3–12 and 15.<sup>2</sup> We have jurisdiction under 35 U.S.C. § 6(b).

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<sup>1</sup> We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as Uniprox GmbH & Co. KG. Appeal Br. 2.

<sup>2</sup> Appellant incorrectly states that the “application includes claims 3–10 and 15” (Appeal Br. 4). In the after-final amendment filed July 16, 2018, Appellant canceled claims 11 and 12. However, that amendment was not entered. We treat the Appellant's appeal as appealing the rejection of claims 3–12 and 15.

We REVERSE.

### CLAIMED SUBJECT MATTER

The claims are directed to a prosthesis liner for application to a limb stump. Claim 15, reproduced below, is illustrative of the claimed subject matter:

15. Prosthesis liner for application to a limb stump, with an elastic liner layer of elastomer, wherein the liner layer has pores in at least one distal portion thereof, wherein the pores are closed in a relaxed state of the liner layer and become opened by stretching of the liner layer on the limb stump during movement.

### REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Richter et al.	US 2011/0022171 A1	Jan. 27, 2011
McCarthy	US 2012/0191218 A1	July 26, 2012
John F. Schulte, <i>Prosthetic Socks The Foundation for a Good Fit</i> , inMotion Volume 11, Issue 2 March/April 2001 (“Schulte”).		

### REJECTIONS

1. Claims 3, 4, 6, 8, 9, 11, 12, and 15 are rejected under 35 U.S.C. § 102(a)(1) as anticipated by McCarthy.<sup>3</sup>
2. Claim 7 is rejected under 35 U.S.C. § 103 as unpatentable over McCarthy.

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<sup>3</sup> Although the heading of the rejection lists claim 2 (Final Act. 2; Supp. Ans. 3), claim 2 was canceled in the amendment filed August 18, 2017 and is not addressed in the body of the rejection. Claims 4, 9, 11, and 12, although not listed in the heading of the rejection, are rejected under 35 U.S.C. § 102(a)(1) as anticipated by McCarthy (Final Act. 3–4).

3. Claim 5 is rejected under 35 U.S.C. § 103 as unpatentable over McCarthy and Schulte.
4. Claim 10 is rejected under 35 U.S.C. § 102(a)(1) as anticipated by McCarthy or alternatively under 35 U.S.C. § 103 as unpatentable over McCarthy and Richter.

#### OPINION

*The rejection of claims 3, 4, 6, 8, 9, 11, 12, and 15 under 35 U.S.C. § 102(a)(1) as anticipated by McCarthy.*

Independent claim 15, and thus dependent claims 3, 4, 6, 8, 9, 11, and 12, include the limitation “wherein the pores are closed in a relaxed state of the liner layer and ***become opened by stretching of the liner layer on the limb stump during movement***” (Appeal Br. 19) (emphasis added).

The Examiner finds said claim limitation inherently disclosed in McCarthy (Final Act. 2–3, 7; Supp. Ans. 3–4). In particular, the Examiner finds that Figures 1, 1A, and 1B of McCarthy show the liner in a stretched state with open pores. According to the Examiner, “[t]hese figures clearly show the liner is stretched since it is applied to residual limb 2” (Supp. Ans. 3). And, according to the Examiner,

The pores being opened or closed when silicone is stretched is an inherent property of any pore in an elastomeric medium such as silicone. The liner of McCarthy is fully capable of meeting these limitations since the liner is made of the same material (silicone [0023]) as the instant invention and the pores are formed by the same process as the instant invention ([0021: laser ablation is a form of drilling], open cell foam [0074]).

(Final Act. 2–3).

The Appellant disagrees with the Examiner's finding that Figure 1 of McCarthy shows the liner in a stretched state (Appeal Br. 7). According to the Appellant, "FIGS. 1 & 1A of McCarthy presumably show its liner layer 4 in a relaxed state, suggesting that the pores 18 are open in their relaxed state, contrary to the claimed pores" (*id.*). And the Appellant argues, *inter alia*, that "the fact that silicone is inherently an elastic material does not mean that McCarthy's pores 18 will necessarily stretch 'closed' when its liner 20 is relaxed" (*id.* at 9). The Appellant acknowledges that "McCarthy's pores 18 will indeed stretch and contract as its liner 20 is stretched and relaxed," but the Appellant contends that "McCarthy's pores 18 could nonetheless remain open when its liner 20 is fully relaxed" (*id.*).

Responding to the Appellant's arguments in the Answer, the Examiner states that "[s]ilicone is inherently an elastic material and the pores will therefore stretch open and closed when the liner is stretched and relaxed" (Supp. Ans. 7).

There is no dispute in this case that silicone is an elastic material that can exist in a relaxed or a stretched state. And there does not appear to be any dispute that McCarthy does not *expressly* disclose a liner having pores that are closed in any state (i.e., whether the liner is relaxed or stretched). The question is whether pores of a liner layer made of silicone will necessarily be "closed in a relaxed state of the liner layer and become opened by stretching of the liner layer on the limb stump during movement" as required by claim 15. We agree with the Appellant that the Examiner has not adequately shown that this is necessarily the case.

Anticipation may be found through inherency. Given that McCarthy arguably expressly describes pores of an elastic liner layer that are open in a stretched state, it is possible that the pores are closed when the liner is in a relaxed state. “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.” *Hansgirg v. Kemmer*, 102 F.2d 212, 214 (CCPA 1939), quoted in *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991). Although it may be inevitable that some deformation of the pores will occur when the liner layer stretches or relaxes, it is not certain that McCarthy’s pores are “closed in a relaxed state of the liner layer and become opened by stretching of the liner layer on the limb stump during movement” as claimed.

The rejection as to claims 3, 4, 6, 8, 9, 11, 12, and 15 is not sustained.

*The rejection of claim 7 under 35 U.S.C. § 103 as unpatentable over McCarthy.*

Claim 7 depends from claim 15 and thus includes the subject matter of claim 15. Because McCarthy does not describe the subject matter of claim 15, and no other prior art or reasoning has been relied upon, a prima facie case of obviousness for the subject matter covered by claim 7 has not been made out in the first instance by a preponderance of the evidence. Accordingly, the rejection is not sustained.

*The rejection of claim 5 under 35 U.S.C. § 103 as unpatentable over McCarthy and Schulte.*

Claim 5 depends, indirectly, from claim 15 and thus includes the subject matter of claim 15. Because McCarthy does not describe the subject matter of claim 15, and no other prior art or reasoning has been relied upon, a prima facie case of obviousness for the subject matter covered by claim 5 has not been made out in the first instance by a preponderance of the evidence. Accordingly, the rejection is not sustained.

*The rejection of claim 10 under 35 U.S.C. § 102(a)(1) as anticipated by McCarthy or alternatively under 35 U.S.C. § 103 as unpatentable over McCarthy and Richter.*

Claim 10 depends from claim 15 and thus includes the subject matter of claim 15. Because McCarthy does not describe the subject matter of claim 15, and no other prior art or reasoning has been relied upon, a prima facie case of anticipation or obviousness for the subject matter covered by claim 10 has not been made out in the first instance by a preponderance of the evidence. Accordingly, the rejection is not sustained.

## CONCLUSION

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
3, 4, 6, 8, 9, 11, 12, 15	102(a)(1)	McCarthy		3, 4, 6, 8, 9, 11, 12, 15
7	103	McCarthy		7
5	103	McCarthy, Schulte		5
10	102(a)(1)	McCarthy		10
10	103	McCarthy, Richter		10

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<b>Overall Outcome</b>				3-12, 15
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REVERSED