

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HAROLD T. VARN

Appeal No. 2004-0367
Application No. 09/733,359

ON BRIEF

Before ABRAMS, FRANKFORT, and MCQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 4 and 6 through 11, which are all of the claims remaining in this application. Claim 5 has been canceled.

As noted on page 3 of the specification, appellant's invention is directed to a dorsal carpal tunnel splint which limits wrist flexion and extension during repetitive hand motion,

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but which because of its location on the dorsal surface of a user's arm frees the volar side of any hard material, which would interfere with everyday uses of the hand, and thus frees the volar side so that the wearer is permitted to use their fingers for everyday activities such as writing, typing, driving and grasping. Independent claims 1 and 11 are representative of the subject matter on appeal and a copy of those claims can be found in Appendix A, filed by appellant by FAX on June 16, 2003.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Klotz	5,358,471	Oct. 25, 1994
Cherubini	5,415,623	May 16, 1995
Varn	5,637,078	Jun. 10, 1997

Claims 1 through 4 and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Varn.

Claims 6, 7, 10 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Varn in view of Klotz.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Varn in view of Cherubini.

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Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the examiner's answer (Paper No. 15, mailed July 2, 2003) for the examiner's reasoning in support of the rejections¹, and to appellant's brief (Paper No. 14, filed March 12, 2003) and reply brief (Paper No. 16, filed August 18, 2003) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions

¹ MPEP § 1208 states, in part, that examiners may incorporate in the answer their statement of the grounds of rejection merely by reference to the final rejection or a single other action on which it is based, and clearly indicates that only those statements of grounds of rejection appearing in a *single* prior action may be incorporated by reference. Therefore, an examiner's answer should not refer, either directly or indirectly, to more than one prior Office action. The examiner's answer in this case, with its references to plural prior actions (answer, page 4) clearly does not comply with the foregoing requirements.

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articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

In maintaining the rejection of claims 1 through 4 and 9 under 35 U.S.C. § 102(b) as being anticipated by Varn, the examiner has urged that the volar design, rigid splint member of Varn comprises an elongated stiff splint element (e.g., col. 2, lines 10-11) having an arcuate lateral cross section (Figs. 2-3), first and second straps (34, 36), a finger strap (38) and a space for the thumb, means for detachably securing the finger strap to the lower end of the splint element, and a resilient liner pad (30) mounted on the splint element. On page 4 of the answer, the examiner has indicated that

the Examiner interpreted Varn as disclosing an orthosis that engages a major portion of the dorsal outer surfaces of the lower forearm, the wrist, and the hand of the wearer, by the upper end, the center portion, and the lower end of the splint element (fig. 2). The device may be interpreted as engaging a major portion of the outer surface of the lower forearm depending on which surface is being interpreted as the outer surface. If one were to turn the lower forearm in an opposing direction, then the device could be interpreted as engaging the dorsal outer surface of the lower forearm when in use.

We have reviewed the applied Varn patent and, like appellant, find that Varn does not disclose, teach or suggest a

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dorsal carpal tunnel splint which limits wrist flexion and extension, wherein the splint includes an elongated stiff splint member which is arcuate in lateral cross section and has an "unbroken length and lateral breadth sufficient to engage a major portion of the dorsal outer surfaces of the lower forearm, the wrist, and the hand of the wearer, by the upper end, the center portion, and the lower end of the splint element, respectively," as set forth in independent claim 1 on appeal, and in similar language in independent claim 11.

Before the USPTO, when evaluating claim language during examination of an application, the examiner is required to give the terminology of the claims its broadest reasonable interpretation consistent with the specification, and to remember that the claim language cannot be read in a vacuum, but instead must be read in light of the specification as it would be interpreted and understood by one of ordinary skill in the pertinent art. See In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); In re Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) and In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). This the examiner has clearly not done in the present case.

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In the context of appellant's invention, the "dorsal outer surfaces of the lower forearm, the wrist, and the hand of the wearer" as set forth in independent claims 1 and 11 on appeal clearly and unambiguously refer to those portions of the lower forearm, wrist and hand that are opposite the volar or palm side of the hand and forearm. In that regard, we note that appellant has specifically indicated in the specification (page 2) that volar design splints have big problems, because the metal spoon or support portions thereof make functional use of the hand difficult by hindering use of the wrist and fingers. As we noted above, on page 3 of the specification appellant then indicates that a principal objective of the invention is to provide a dorsal carpal tunnel splint which limits wrist flexion and extension during repetitive hand motion, but which because of its location on the dorsal surface of a user's arm frees the volar side of any hard material, which would interfere with everyday uses of the hand, and thus frees the volar side so that the wearer is permitted to use their fingers for everyday activities such as writing, typing, driving and grasping. In light of such express disclosure in the present application, the examiner's interpretation of the "dorsal" limitations of the claims before us on appeal, as quoted above, is wholly unavailing.

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There is no question that one of ordinary skill in the art reading the Varn patent (e.g., col. 2, lines 60-67) would understand that the resting hand orthosis therein is specifically designed and configured to be a volar splint which engages the inner or palm side of the user's hand, wrist and arm, and thus would be the very type of splint appellant's dorsal carpal tunnel splint is designed to improve upon. Nor does it appear that the orthosis in Varn would in any way be capable of use as a dorsal carpal tunnel splint like that claimed by appellant. Accordingly, we will not sustain the examiner's rejection of claims 1 through 4 and 9 under 35 U.S.C. § 102(b) as being anticipated by Varn.

Given our above-noted determination regarding the shortcomings of the orthosis in Varn, and the lack of any further teaching or suggestion in either Klotz or Cherubini supplying such deficiencies, it follows that the examiner's further rejections of claims 6, 7, 8, 10 and 11 under 35 U.S.C. § 103(a) also will not be sustained. That is, even if the hand resting orthosis of Varn were to be provided with a tubular resilient roll that surrounds a lower portion of the finger strap loop as the examiner believes is suggested in Klotz and the rigid plastic

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splint element (12) of Varn were formed of a heat moldable thermoplastic material as suggested in Cherubini, the result of any such combinations would not be a dorsal carpal tunnel splint of the type claimed by appellant.

Since we have refused to sustain any of the rejections posited by the examiner, the decision of the examiner rejecting claims 1 through 4 and 6 through 11 of the present application is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOHN P. MCQUADE)	
Administrative Patent Judge)	

CEF/lbg

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ZARLEY LAW FIRM P.L.C.
CAPITAL SQUARE
400 LOCUST, SUITE 200
DES MOINES, IA 50309-2350