

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD L. KRONENTHAL, ARTHUR A. GERTZMAN
and DOUGLAS R. VALENTINE

Appeal No. 97-0774
Application 08/121,525¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, and ABRAMS
and NASE, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's rejection of claims 1, 2, 8, 10, 11, 18, 26, 29 and 45 under 35 U.S.C. § 103. The only other claims still pending in the application have been withdrawn from consideration as being directed to a non-elected invention.

¹ Application for patent filed September 16, 1993.

Appeal No. 97-0774
Application 08/121,525

The invention disclosed in the subject application relates to a surgical sponge assembly having a plurality of individual sponge members (12) slidably mounted on a flexible strand (16) between a retaining stop (32) and a slide member (18) to form a surgical nasal pack for insertion into a patient's nasal passage. The slide member (18) is selectively slidable along the flexible strand (16) to compress the individual sponge members between the slide member and the retaining stop.

A copy of the appealed claims, as these claims appear in the appendix to appellants' brief, is appended to this decision.

The following reference is relied upon by the examiner as evidence of obviousness in support of his rejection under § 103:

| | | |
|-----------------------------------|-----------|---------------|
| Schoenholz et al. (Schoenholz) | 3,965,905 | June 29, 1976 |
|-----------------------------------|-----------|---------------|

Claims 1, 2, 8, 10, 11, 18, 26, 29 and 45 stand rejected under 35 U.S.C. § 103 as being unpatentable solely over Schoenholz.

We have carefully considered the issues raised in this appeal together with the examiner's remarks and appellants' arguments. As a result, we conclude that the rejection of the appealed claims cannot be sustained. Our reasons for this conclusion follow.

Independent claims 1 and 45 call for a surgical sponge assembly having a plurality of sponge members for contacting

Appeal No. 97-0774
Application 08/121,525

fluid in a patient's cavity. Claim 26, the only other independent claim on appeal, specifically recites that the sponge members form a nasal pack to absorb body fluids. Furthermore, all of the appealed independent claims recite that the sponge members are slidably mounted on a flexible strand means. All of the independent appealed claims additionally recite that the sponge members are adapted to be moved along the flexible strand means to engage adjacent sponge members.

Contrary to the examiner's findings on page 3 of the answer, Schoenholz does not disclose a *surgical* sponge assembly as such. Instead, this reference discloses a catamenial tampon having a plurality of absorbent masses 1, such as sponges, mounted on a thread 2. In contrast to appellants' claimed invention, Schoenholz's sponge members are attached at spaced apart intervals to thread 2 as shown in the embodiment of Figure 2 of the patent drawings.

The examiner concedes on page 3 of the answer that Schoenholz's sponge members are fixedly attached to the thread rather than being slidably mounted thereon. He nevertheless concludes as follows:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to omit the securing means on elements 1 in Figs. 2, 3 or 4 to allow the sponge material to move along the thread 2, when the function of the attachment is not desired. The elimination of the attachments allow the device to operate in the manner of applicant's device. The

Appeal No. 97-0774
Application 08/121,525

omission of the securing elements still allows the device to function and it is well settled, that the omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 135 [sic, 136] USPQ 184 (CCPA 1963). [Answer, pages 3-4].

As an apparent alternative position, the examiner states:

Furthermore, Schoenholz discloses that it was known to attach absorbent disc [sic, discs] or blocks along a string such that the string "simply functioned to align the individual components so that this lengthwise-movement would be optimized." (1:23-35, description of Graham U.S. [Patent] 2,858,831). [Answer, page 4.]

With regard to the examiner's first position quoted *supra*, we agree that, as a general rule, the elimination of an element and its function would have been an obvious expedient. *See, for example, In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975). That legal principle, however, is not applicable here in the manner proposed by the examiner.

In the present case, no evidence has been proffered by the examiner to show that the "attachment" for each of Schoenholz's sponges is an element which is separate from the sponge members and the thread to make possible the elimination of the attachments as proposed by the examiner without eliminating a portion of the sponge members and/or the thread needed for fixing the sponge members to the thread. In fact, the Schoenholz specification states in column 2, lines 33-37, that the thread itself is

Appeal No. 97-0774
Application 08/121,525

attached to the disc sponges 1 at the X-shaped apertures of the sponges. It therefore appears that the attachments are parts of the thread and parts of the sponge members as confirmed by the examiner's finding that Schoenholz's sponge members 1 "are fixedly attached to the thread . . ." (answer, page 5).

Thus, what the examiner proposes in substance is not the elimination of an element, such as each sponge member or the thread itself, but rather only a portion of each sponge member and, presumably, any attaching portion of the thread. Neither *Karlson* nor *Kuhle*, however, supports the notion of eliminating just a selected portion of an element based on the improper hindsight benefit of appellants' own disclosure. Furthermore, if the attaching portions were somehow eliminated, Schoenholz's thread would no longer perform its function of fixedly mounting the sponge members as required by *Karlson*. Moreover, the elimination of the attachment of Schoenholz's sponge members to the thread 2 is directly contrary to Schoenholz's invention. As a result, it is not seen how one of ordinary skill in the art would have been motivated to do so without the hindsight benefit of appellants' disclosure in view of the fact that such a modification would have led away from Schoenholz's teachings.

As we understand the examiner's alternative position as quoted *supra*, he is not relying on the Graham patent itself, but

instead is merely relying upon Schoenholz's description of the Graham patent in column 1, lines 23-35, of the Schoenholz specification.² Admittedly, Schoenholz states in column 1, lines 33-35, that Graham's string for the tampon absorbent discs simply functions to align the individual components so that a "lengthwise movement would be optimized." However, it does not necessarily follow from this description that Graham's discs are necessarily slidably mounted on the string as urged by the examiner on page 5 of the answer.

Instead, the lengthwise movement mentioned in lines 33-35 of column 1 of the Schoenholz specification refers to lengthwise expansion of the tampon discs as described in the preceding sentence of the specification. As evidenced from the description of the Schoenholz invention itself, it is not necessary to slidably mount the tampon discs on the string or thread in order to facilitate such an expansion of the discs upon absorbing body fluids.

With particular regard to claim 26, the recitation of a surgical nasal pack does not appear in just the preamble itself as the examiner seems to suggest in the paragraph bridging pages

² We hasten to add that reliance on the Graham patent itself, rather than Schoenholz's description of the Graham patent, would clearly be improper in the present case because the Graham patent was not included in the statement of the rejection. See *In re Hoch*, 428 F.2d 1341, 1342, 166 USPQ 406, 407 (CCPA 1970).

Appeal No. 97-0774
Application 08/121,525

5 and 6 of the answer. Instead, the body of this claim expressly recites that the slide is adapted to be moved along the flexible strand means to drive the sponge members together so that each sponge member "engages the adjacent sponge body member forming a rigid nasal pack . . ." This claim recitation cannot be dismissed or ignored and, instead, must be given effect as a limitation of the claim. See *In re Angdstadt*, 537 F.2d 498, 501, 190 USPQ 214, 217 (CCPA 1976) in which the predecessor of our current reviewing court gave effect to the claim limitation "to form . . . hydroperoxides." There is no teaching or suggestion of a nasal pack in the Schoenholz patent.

For the foregoing reasons, the rejection of appealed claims 1, 2, 8, 10, 11, 18, 26, 29 and 45 cannot stand. The examiner's decision rejecting the appealed claims is therefore reversed.

REVERSED

| | | |
|------------------------------------|---|-----------------|
| HARRISON E. McCANDLISH |) | |
| Senior Administrative Patent Judge |) | |
| |) | |
| |) | |
| NEAL E. ABRAMS |) | BOARD OF PATENT |
| Administrative Patent Judge |) | APPEALS AND |
| |) | INTERFERENCES |
| |) | |
| |) | |
| JEFFREY V. NASE |) | |
| Administrative Patent Judge |) | |

Appeal No. 97-0774
Application 08/121,525

Gipple & Hale
6667-B Old Dominion Dr.
McLean, VA 22101

APPENDIX

Claim 1. A surgical sponge assembly comprising a plurality of absorbent, compressed sponge members slidably mounted on a flexible strand means, each of said compressed sponge member being adapted to be moved along said strand means to obtain engagement with adjacent sponge member surfaces, a retaining means providing a stop for the last sponge member located at the distal end of said flexible strand means, said sponge assembly when its sponge members are in engagement allowing direct placement of the sponge assembly in a cavity of a patient and when coming in contact with fluid, swelling to move along said strand means and form an enlarged flexible cross sectional configuration which substantially fills at least a portion of the cavity.

Claim 2. A surgical sponge assembly as claimed in claim 1 wherein said each sponge member has a rectangular cross section.

Claim 8. A surgical sponge assembly as claimed in claim 1 wherein said retaining means comprises a loop.

Claim 10. A surgical sponge assembly as claimed in claim 1 where said flexible strand means is a monofilament.

Claim 11. A surgical sponge assembly as claimed in claim 1 where said flexible strand means is a multifilament.

Appeal No. 97-0774
Application 08/121,525

Claim 18. A surgical sponge assembly as claimed in claim 1 wherein said flexible strand means has a slide mounted on one end.

Claim 26. A surgical nasal pack comprising a plurality of absorbent sterile sponge body members with fast wicking capability allowing immediate absorbtion [sic] of body fluids slidably mounted on a flexible strand means, a stop provided on the distal end of said strand means, a slide moveably mounted on the proximal end of said strand means, said slide being adapted to be moved along said strand means toward the distal end of said strand means to engage one of said sponge body members and drive the sponge body members together so that each sponge body engages the adjacent sponge body member forming a rigid nasal pack allowing insertion of the nasal pack into a nasal cavity, said slide being adapted to be moved away from the distal end to allow sponge body members to move apart in relation to each other providing flexibility of the nasal pack, the nasal pack when placed in a patient cavity and contacting fluid, expanding to occupy said patient cavity placing gentle pressure on the patient and absorbing body fluids.

Claim 29. A surgical sponge assembly as claimed in claim 26 wherein each sponge member has a rectangular cross section.

Appeal No. 97-0774
Application 08/121,525

Claim 45. A surgical sponge assembly comprising a plurality of absorbent, compressed sponge members slidably mounted on a flexible unitary strand means which extends through said sponge members, a slide member slidably mounted on said flexible strand means, each of said compressed sponge members being adapted to be moved along said unitary strand means by the slide member for selective engagement with adjacent sponge member surfaces, a distal end of said flexible strand means providing a retaining means acting as a stop for the last sponge member positioned at the distal end of said flexible strand means, said sponge assembly when its sponge members are in engagement allowing direct placement of the sponge assembly in a cavity of a patient and when coming in contact with fluid, swelling to move along said unitary strand means and form an enlarged flexible cross sectional configuration which substantially fills at least a portion of said cavity.