

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACK B. ROBINSON, ROD J. ROHRICH and RONALD M. FRIEDMAN

Appeal No. 1999-0226
Application No. 08/447,217

ON BRIEF¹

Before METZ, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection (Paper No. 8, mailed July 31, 1997) of claims 1 to 20, which are all of the claims pending in this application.

We REVERSE.

¹ On February 28, 2000 the appellants waived the oral hearing (see Paper No. 19) scheduled for March 6, 2000.

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BACKGROUND

The appellants' invention relates to medical prostheses, particularly those medical prostheses used for a breast or testicular prosthesis (specification, p. 1). A copy of the claims² under appeal is set forth in the appendix to the appellants' reply brief (Paper No. 16, filed May 14, 1998).

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

Cohen	4,143,428	Mar. 13, 1979
Schäpel	4,404,296	Sep. 13, 1983
Van Aken Redinger et al. (Van Aken Redinger)	4,455,691	June 26, 1984
Peterson	5,246,454	Sep. 21, 1993
Tautvydas et al. (Tautvydas)	5,407,445	Apr. 18, 1995
Scopelianos et al. (Scopelianos)	5,411,554	May 2, 1995

Claims 1, 3, 4, 7, 9, 11, 12 and 16 stand rejected under

² Dependent claims 10 to 15 each recite "[t]he prosthesis of claim 9." Independent claim 9 does not recite a prosthesis. Instead claim 9 recites "[a] sealed compliant water impermeable envelope or capsule which is filled with an aqueous solution of polyethylene glycol." The appellants should correct this discrepancy.

35 U.S.C. § 102(e) as anticipated by Tautvydas or, in the alternative, under 35 U.S.C. § 103 as obvious over Tautvydas in view of Scopelianos.

Claims 2, 5, 6, 8, 10, 13 to 15 and 17 to 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tautvydas as applied to claims 1, 3, 4, 7, 9, 11, 12 and 16 above, and further in view of Van Aken Redinger.

Claim 20 stands rejected under 35 U.S.C. § 103 as being unpatentable over Tautvydas as applied in the rejection of claim 16 above, and further in view of Cohen.

Claims 1, 9 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Peterson in view of Schäpel.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 14, mailed March 11, 1998) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 13,

filed February 4, 1998) and reply brief for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and

claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The anticipation rejection

We will not sustain the rejection of claims 1, 3, 4, 7, 9, 11, 12 and 16 under 35 U.S.C. § 102(e) as being anticipated by Tautvydas.

To support a rejection of a claim under 35 U.S.C. § 102(e), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

All the claims under appeal recite a water impermeable envelope/capsule filled or containing "an aqueous solution of polyethylene glycol."

The appellants argue (brief, pp. 4-7, and reply brief, pp. 3-6) that Tautvydas does not teach or suggest "an aqueous solution of polyethylene glycol." We agree. In that regard, it is our determination that contrary to the position of the examiner³ the claimed "aqueous solution of polyethylene glycol" is not readable on⁴ the gel compositions disclosed by Tautvydas for the reasons set forth by the appellants. Specifically, the claimed "aqueous solution of polyethylene glycol" is not readable on the polyoxyethylene-polyoxypropylene block copolymers disclosed by Tautvydas.

Since all the limitations of claims 1, 3, 4, 7, 9, 11, 12 and 16 are not found in Tautvydas for the reasons set forth

³ See page 5, first paragraph, of the answer and the first three paragraphs of the examiner's Response to Argument (pages 7-9 of the answer).

⁴ The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

above, the decision of the examiner to reject claims 1, 3, 4, 7, 9, 11, 12 and 16 under 35 U.S.C. § 102(e) as being anticipated by Tautvydas is reversed.

The obviousness rejections utilizing Tautvydas

We will not sustain the rejection of claims 1 to 20 under 35 U.S.C. § 103 utilizing Tautvydas as the primary reference.

As set forth above, the claimed "aqueous solution of polyethylene glycol" is not disclosed by Tautvydas. We have reviewed the references to Scopelianos, Van Aken Redinger and Cohen but find nothing therein which would have rendered it obvious at the time the invention was made to a person having ordinary skill in the art to have modified Tautvydas to arrive at the claimed invention. Accordingly, we cannot sustain the examiner's rejection of appealed claims 1 to 20 under 35 U.S.C. § 103 utilizing Tautvydas as the primary reference.

The obviousness rejections utilizing Peterson

We will not sustain the rejection of claims 1, 9 and 16 under 35 U.S.C. § 103 utilizing Peterson as the primary reference.

The examiner determined (answer, p. 7) that (1) Peterson fails to teach the use of polyethylene glycol as the filling material as claimed; (2) Schäpel teaches that polyethylene glycols have been used as filler materials for breast prosthesis; and (3) it would have been obvious to use the gel of Schäpel in the prosthesis of Peterson so as to provide it with greater gel stability and elasticity.

The appellants argue (brief, pp. 11-12) that the gels disclosed by Schäpel are far removed from the claimed "aqueous solution of polyethylene glycol." Thus, the appellants conclude that the rejection based on Peterson in view of Schäpel is overcome.

In our opinion the combined teachings of Peterson and Schäpel are not suggestive of the claimed invention.⁵ In that regard, we have reviewed the disclosure of Schäpel and fail to

⁵ The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

find therein any teaching that an aqueous solution of polyethylene glycol has been used as a filler material for a breast prosthesis. While Schäpel does teach that polyol gels according to his invention can be used as a filling substance for breast prostheses (see column 14, lines 57-67) and that a solubilizing agent such as polyethylene glycol can be used as an auxiliary agent in the gel composition if pharmaceuticals are to be incorporated in the gel composition (see column 12, lines 10-20), Schäpel does not specifically disclose that an aqueous solution of polyethylene glycol has been used as a filler material for a breast prosthesis.⁶ Moreover, it is our opinion that the only suggestion for modifying Peterson in the manner proposed by the examiner to meet the claimed "aqueous solution of polyethylene glycol" limitation stems from hindsight knowledge derived from the appellants' own disclosure since the applied prior art lacks any teaching, suggestion or incentive supporting the combination of Peterson and Schäpel to arrive at the claimed invention. The use of

⁶ Schäpel discloses many uses for his gel composition other than being used as a filling substance for breast prostheses.

such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 1, 9 and 16 under 35 U.S.C. § 103 utilizing Peterson as the primary reference is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 20 is reversed.

REVERSED

ANDREW H. METZ)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JENNIFER D. BAHR)	
Administrative Patent Judge)	

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