

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 23

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte MARIANNE JOSLIN

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Appeal No. 2002-2319  
Application No. 09/129,197

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ON BRIEF

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Before COHEN, ABRAMS and BAHR, Administrative Patent Judges.  
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 10-12 and 19. Claims 13 and 14, the only other claims pending in this application, stand objected to as depending from a rejected claim but are otherwise indicated to be allowable.

We AFFIRM.

BACKGROUND

The appellant's invention relates to slings for optionally supporting a person's left or right arm (specification, page 1). Further understanding of the invention may be obtained from a reading of independent claims 10 and 19, which are reproduced below in the opinion section of this decision.

The examiner relied upon the following prior art references in rejecting the appealed claims:

Blatt	4,232,664	Nov. 11, 1980
Ackley	4,510,928	Apr. 16, 1985
Christensen	4,622,961	Nov. 18, 1986

The following rejections are before us for review.<sup>1</sup>

Claim 19 stands rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claim 19 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

Claims 10, 11 and 19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ackley.

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<sup>1</sup> The rejection of claims 10, 11 and 19 as being unpatentable over Blatt in view of Burkhead set forth in the final rejection (Paper No. 17) has been withdrawn (see page 3 of the answer - Paper No. 21).

Claims 10-12 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Blatt in view of Christensen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 21) for the examiner's complete reasoning in support of the rejections and to the brief (Paper No. 20) for the appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Claims 10 and 19, the two independent claims before us for review, read as follows (*italics added for discussion infra*).<sup>2</sup>

10. A sling adapted to be applied over and supporting an arm of a patient, the sling comprising a panel constructed of a stretchable material and having a closed aft end and an open front end and defining a trough adapted to receive the arm so that an elbow end of the arm is disposed at the closed end and a hand of the arm is disposed at the open end of the trough when in use, *a member* secured to the panel proximate the front end thereof *which* is formed to engage a portion of the hand and, when the patient's arm is

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<sup>2</sup> We note that the amendments of Paper Nos. 11 and 13 have been clerically entered in the application file in reverse order. Upon return of this application to the Technology Center, the examiner should take appropriate action to have this corrected.

disposed in the trough, *limits relative movement of the panel towards the elbow end, the panel being constructed of a material which is stretchable in a longitudinal direction of the arm and, in its relaxed state, having a lesser length than the length of the patient's arm from the elbow end to the portion of the hand so that the panel material is longitudinally stretched and substantially evenly engages the patient's elbow, arm and hand substantially free of localized pressure points* when the sling is applied to the patient's arm, and a strap attached to the panel and adapted to suspend the panel from a shoulder of the patient.

19. A sling applied over and supporting an arm of a patient, the sling comprising a panel having a closed aft end and an open front end and defining a trough receiving and supporting the arm so that an elbow end of the arm is disposed at the closed end and a hand of the arm is disposed at the open end of the trough, *the panel being constructed of a material which is stretchable in a longitudinal direction of the arm, a member secured to the panel proximate the front end thereof which engages a portion of the hand and limits relative movement of the panel towards the elbow end, the panel, when the material is in its relaxed state, having a lesser length than the length of the patient's arm from the elbow end to the portion of the hand so that the panel material is longitudinally stretched and substantially evenly engages the patient's elbow, arm and hand substantially free of localized pressure points*, and a strap attached to the panel and adapted to suspend the panel from a shoulder of the patient.

*The indefiniteness rejection*

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity.

In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977).

In rejecting claim 19 as being indefinite, the examiner is concerned that (1) “claim 19 makes the arm, elbow and hand positive limitations or integral components of the claim, and these limitations are viewed as non-statutory subject matter,” (2) claim 19, in defining the panel as having a lesser length, in a relaxed state, than the length of a patient’s arm from the elbow end to the portion of the hand, describes the invention in terms of a particular user, thereby rendering it impossible to determine whether a device falls within the scope of claim 19 until a particular user engages the device and (3) since the particular points along the elbow end and the portion of the hand of the patient at which the recited arm length are measured have not been provided in the record, this length for each patient is uncertain (answer, pages 5-6). For the reasons which follow, we do not share these concerns.

First, we note that claim 19 positively recites only a sling; claim 19 does not recite a combination of a sling and an arm of a patient. Observing, as the examiner does, that claim 19 recites the sling as being “applied over and supporting an arm of a patient” and comprising a panel defining a trough “receiving and supporting the arm” and a member which “engages a portion of the hand and limits relative movement of the panel towards the elbow end,” we acknowledge that the claim, when read in a vacuum, is somewhat ambiguous as to whether it is directed to the sling alone or a combination of the sling and an arm of a patient. The definiteness of the language employed in the claims, however, must be analyzed, not in a vacuum, but always in

light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

We thus turn to appellant's specification to determine whether one of ordinary skill in the art would interpret claim 19 as being directed to the sling alone or to the combination of the sling and an arm of a patient. Appellant's specification informs us, for example, on page 1, in lines 12-13, that the "invention relates to slings for optionally supporting a person's left or right arm" and, on page 2, in lines 14-15, that "[t]he present invention provides a simple, practical and lightweight arm sling." We thus conclude from appellant's underlying disclosure that the claimed invention is directed to the sling and not to a combination of an arm of a patient (or a patient) and the sling. This is also consistent with appellant's brief wherein appellant acknowledges that "the human body, or parts thereof, cannot be claimed" and confirms that "claim 19 does not claim body parts, it only refers to them" (page 6) and emphasizes that "the body parts [referred to in claim 19] do not constitute an 'integral component' of the claim, but only points of reference for defining the structure of the sling when it supports an arm" (page 7).

In short, consistent with appellant's underlying disclosure and arguments in the brief, we interpret claim 19 as being directed solely to a sling, with the references to the patient's body parts defining the environment in which the sling is to be used.

Therefore, in our view, the examiner's position that the reference to body parts in claim 19 renders the claim indefinite is not well founded.

The examiner's position that claim 19 is indefinite because it describes the invention in terms of a particular user is likewise not well taken. The claim at issue in Ex parte Brummer, 12 USPQ2d 1653 (Bd. Pat. App. & Int. 1989), relied upon by the examiner (answer, page 5), recited the spacing between the front and rear wheels of a bicycle relative to "the height of the rider *that the bicycle was designed for*" (emphasis ours). The Board found in Brummer that there was no evidence of record to show that a known standard existed in the field of bicycle manufacturing for sizing a bicycle to a rider and consequently that one of ordinary skill in the art would not have known what size rider a particular bicycle was "designed for" and thus would have been at a loss to determine whether a particular bicycle was covered by that claim. Id. at 1655. We agree with appellant (brief, page 9) that claim 19 is more akin to the claim at issue in Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1575, 1USPQ2d 1081, 1088 (Fed. Cir. 1986) reciting a wheelchair "wherein said front leg portion is so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats thereof." The Federal Circuit in Orthokinetics determined that the claims therein were intended to cover the use of the invention with various types of automobiles and considered the fact that a particular chair on which the claims read may fit within some automobiles and not others to be of no moment, the phrase "so dimensioned" being "as accurate as the subject matter permits, automobiles being of various sizes." Id. Appellant's claim 19 recites the length of the panel of the

sling with reference to the length of an arm of a patient. Inasmuch as patients, like automobiles, come in various sizes, it is true that a particular sling on which appellant's claim 19 reads may have a panel, when in a relaxed state, having a lesser length than the length of one patient's arm but not another patient's arm. This, in our opinion, merely gives the scope of the claim some breadth; it does not render the claim indefinite. Just because a claim is broad does not mean that it is indefinite. See In re Johnson, 558 F.2d at 1016 n.17, 194 USPQ at 194 n.17; In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971); In re Gardner, 427 F.2d 786, 788, 166 USPQ 138, 140 (CCPA 1970) and Ex parte Scherberich, 201 USPQ 397, 398 (Bd. App. 1977).

As to the examiner's third criticism of claim 19, with regard to the points of measurement of the arm length, the claim is quite clear that the arm length at issue is measured from the elbow end (i.e., the outside of the elbow) to the portion of the hand which is engaged by the recited member. Claim 19 does not limit the portion of the hand engaged by the member to a particular portion of the hand, although the specification (page 4) specifies the portion of the hand between the thumb and fingers. Thus, claim 19 is sufficiently broad to encompass a sling having a member which would engage any portion of the hand of a patient wearing the sling. Any sling meeting the panel length limitation of claim 19 must have a panel which has a lesser length than the length of a patient's arm from the elbow end to the portion of the hand which the member of the sling would engage. The fact that one sling having a member which

would engage the fingertips of a patient's hand might meet the length limitation by having a lesser panel length than the length from the patient's elbow end to the fingertips while another sling having a member which would engage the portion of a patient's hand between the thumb and fingers might meet the length limitation by having a lesser panel length than the distance from the patient's elbow end to said portion, for example, simply gives the scope of the claim breadth. It does not render the claim indefinite.

For the foregoing reasons, we conclude that none of the criticisms of claim 19 raised by the examiner renders the claim indefinite. Accordingly, we shall not sustain the examiner's rejection of claim 19 under the second paragraph of 35 U.S.C. § 112.

*The rejection under 35 U.S.C. § 101*

The examiner considers claim 19 to be directed to non-statutory subject matter because, according to the examiner, it positively recites the arm, elbow and hand of the patient as integral components of the sling (answer, page 4). The examiner cites as authority for this position Ex parte Grayson, 51 USPQ 413, 414 (Bd. App. 1941) (claim directed to a shrimp with certain parts removed considered to be still in its natural state and thus not an article of manufacture and not patentable subject matter). Specifically, the examiner is concerned that the claim recites a sling "applied over and supporting an arm of a patient," the sling comprising a panel "defining a trough receiving and supporting the arm so that an elbow end of the arm is disposed at the closed end and a

hand of the arm is disposed at the open end of the trough,” a member which “engages a portion of the hand and limits relative movement of the panel towards the elbow end,” and the panel, in a relaxed state, having a lesser length than the length of the patient’s arm from the elbow end to the portion of the hand “so that the panel material is longitudinally stretched and substantially evenly engages the patient’s elbow.”

For the reasons discussed above with regard to the examiner’s indefiniteness rejection of claim 19, we have determined that claim 19 does not recite the arm, elbow and hand of a patient. Rather, these body parts are simply referred to in the claim to define the environment in which the sling is to be used. As discussed above, appellant’s invention is directed to the sling and not to a patient or to the parts of the patient’s body. A sling is an article of manufacture and thus is statutory subject matter under 35 U.S.C. § 101. It thus follows that we shall not sustain the examiner’s rejection of claim 19 under 35 U.S.C. § 101.

*The prior art rejections*

Turning first to the rejection of claims 10, 11 and 19 as being anticipated by Ackley, appellant argues that Ackley fails to disclose the limitations of claims 10 and 19 italicized in our reproduction of these claims, supra. For the reasons which follow, we do not find appellant’s arguments persuasive.

Ackley discloses a sling adapted for fitting closely around an arm and cast assemblage, the sling comprising an over-the-shoulder strap, an elongated tubular

member 11 formed of a sheet of fabric having two-way stretch characteristics and having a width slightly greater than the circumference of the arm and cast to be accommodated to provide overlapping edges on which hook and loop pile fasteners are mounted and a puppet-like head 14 joined to the tubular member 11. The puppet-like head 14 incorporates upper and lower lip portions 15, 16 of a size to accommodate the fingers and thumb respectively of the user and an appropriate shaping insert 28 is provided to maintain the desired head contour (column 4, lines 52-60). Ackley teaches the tubular member 11 is of a length to extend around the elbow and onto the upper arm to a point close to the armpit of the intended wearer so as to envelop any arm cast normally encountered, including those in which the cast 19 extends onto the upper arm (column 4, lines 15-20).

Appellant argues that Ackley's sling is not applied to an arm but rather to an arm and cast assemblage and consequently is not concerned with alleviating pressure points when a patient's arm is directly supported in the sling (brief, page 11), that the puppet head 14 cannot limit relative movement of the panel towards the elbow end because, in Figure 2, Ackley shows the filler 28 being spaced from the patient's fingers and hand (brief, page 12) and that Ackley nowhere teaches or suggests that the stretch characteristic of the material, coupled with a closed aft end and member engaging a portion of the hand, does or should limit relative movement of the panel towards the

elbow or that the panel has a lesser length than the patient's arm measured from the elbow end to the hand (brief, page 12).

It is critical to note that claim 10 is directed solely to a sling and not to a method of sizing or applying the sling to a patient's arm. All references to the patient's body parts in claim 10 simply serve to define the intended use of the recited sling. It is well settled that the recitation of an intended use for an old product does not make a claim to that old product patentable. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). While it is true that Ackley's sling is not specifically disclosed for use in the manner recited in claim 1, Ackley's sling appears reasonably capable of being applied to the arm of an appropriately sized patient<sup>3</sup> such that the length of such patient's arm from the elbow end to the knuckles is longer than the distance from the portion of the tubular member engaging the outer elbow (the closed aft end) to the shaping insert 28 of the puppet-like head and so that the tubular member is stretched from the elbow end to the hand end and the insert 28 engages the patient's fingers to thereby limit movement of the sling toward the elbow end, thereby permitting the tubular member to evenly engage the patient's elbow, arm and hand substantially

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<sup>3</sup> The sling is illustrated in Figure 4 applied to the arm of a child. If applied to a larger child or to an adult with a longer arm, the dimensional relationships with the arm and stretch of the panel called for in claim 10 would seemingly result. That Ackley's sling may not be capable of fitting all patients in the manner called for in claim 10 is of no moment, as claim 10 does not require this.

free of localized pressure points as called for in claim 10 and appellant has not offered any reasoning or evidence to show that Ackley lacks such inherent capability.<sup>4</sup>

For the foregoing reasons, appellant's arguments fail to persuade us of any error in the examiner's determination that claim 10 is anticipated by Ackley. Thus, we shall sustain the rejection of claim 10 and claim 11 which appellant has grouped therewith (brief, page 6).

Appellant's arguments with regard to the rejection of claim 19 as being anticipated by Ackley are substantially the same as those discussed above with regard to claim 19. As pointed out in our discussion of the rejections of claim 19 under 35 U.S.C. §§ 112 and 101, supra, claim 19, like claim 10, is directed solely to a sling. Appellant concedes that "the body parts [referred to in claim 19] do not constitute an 'integral component' of the claim, but only points of reference for defining the structure of the sling when it supports an arm" (brief, page 7). Our conclusions above with regard to the inherent capability of Ackley's sling to be applied to an arm of a patient such that the length of such patient's arm from the elbow end to the knuckles is longer than the distance from the portion of the tubular member engaging the outer elbow (the closed aft end) to the shaping insert 28 of the puppet-like head and so that the tubular member is stretched from the elbow end to the hand end and the insert 28 engages the patient's

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<sup>4</sup> After the PTO establishes a prima facie case of anticipation based on inherency, the burden shifts to the appellant to prove that the subject matter shown to be in the prior art does not possess the characteristics of the claimed invention. See In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986).

fingers to thereby limit movement of the sling toward the elbow end, thereby permitting the tubular member to evenly engage the patient's elbow, arm and hand substantially free of localized pressure points apply equally to claim 19. It follows that we shall also sustain the rejection of claim 19 as being anticipated by Ackley.

Turning now to the examiner's rejection of claims 10-12 and 19 as being unpatentable over Blatt in view of Christensen, we note that appellant does not dispute the examiner's determination that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to include a mitt on Blatt's sling, as taught by Christensen, in order to keep the user's hand warm. Rather, appellant argues that, even if Blatt were so modified, neither Christensen nor Blatt teaches or suggests constructing the sling of Blatt such that its length is less than the length between the corresponding parts of the arm and hand so that the mitt engages a portion of the hand and so that rearward movement of the sling along the arm is prevented (brief, pages 15-16). According to appellant (brief, page 16), a sling which is shorter than the corresponding length of the arm would be undesirable because it would cause discomfort.

Blatt discloses a sling in the form of an L-shaped arm envelope made of a flexible laminate of a urethane foam layer and a brushed nylon pile layer which is "slightly stretchable" (column 3, line 46). Blatt lacks a member secured to the panel proximate the front end thereof for engaging a portion of the hand of the patient and

limiting relative movement of the panel toward the elbow end as called for in claims 10 and 19. To overcome this deficiency, the examiner relies on the teaching of Christensen to provide integral hand-receiving mitt sections formed by inside panel portions 20, 22 stitched on the inside of the sling. Christensen (Figure 1) illustrates a spacing between the user's fingers and the front end of the mitt section. In light of this illustration, appellant argues that Christensen would not have suggested sizing Blatt's sling such that the user's hand engages the front end of the mitt section so as to limit rearward movement of the sling.

While appellant may be correct that Blatt and Christensen provide no specific teaching or suggestion to size Blatt's sling for a particular patient such that its length is less than the length of that patient's arm from the elbow end to the fingers and the fingers engage the front end of the mitt section so that the panel is stretched as called for in claims 10 and 19 when applied to the patient's arm and to apply the sling to that patient, we reiterate that claims 10 and 19 are directed solely to the sling and not to a method of sizing or applying the sling to a particular patient. As discussed repeatedly above, appellant concedes that the references to the patient's body parts form no part of the claimed invention and serve merely to define the structure of the sling when it supports an arm. Blatt's sling, when modified to provide an integral mitt section on the front end thereof as suggested by Christensen, appears reasonably capable of being applied to an arm of a patient such that the length of such patient's arm from the elbow

end to the fingertips is longer than the distance from the elbow end to the front end of the mitt section so that the L-shaped arm envelope is stretched from the elbow end to the hand end and the front end of the mitt section engages the patient's fingers to thereby limit movement of the sling toward the elbow end, thereby permitting the arm envelope to evenly engage the patient's elbow, arm and hand substantially free of localized pressure points, as called for in claims 10 and 19 and appellant has presented no evidence that Blatt's sling is not so capable.

For the foregoing reasons, appellant's arguments fail to persuade us of any error on the part of the examiner in rejecting claims 10 and 19 as being obvious over Blatt in view of Christensen. Thus, we shall sustain the rejections of these claims, as well as claims 11 and 12 which appellant has grouped with claim 10 (brief, page 6).

#### CONCLUSION

To summarize, the rejections of claim 19 under 35 U.S.C. §§ 101 and 112, second paragraph, are reversed and the rejections of claims 10, 11 and 19 under 35 U.S.C. § 102(b) and claims 10-12 and 19 under 35 U.S.C. § 103(a) are sustained. As a rejection of each claim on appeal has been sustained, the examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
NEAL E. ABRAMS	)	APPEALS
Administrative Patent Judge	)	AND
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JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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