

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(2) is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MATTHEW T. SCHOLZ,
DENNIS C. BARTIZAL, MARK A. BERMAN,
and MICHAEL D. DELMORE

Appeal No. 96-4158
Application 08/404,242¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, COHEN
and GONZALES, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed March 15, 1995. According to appellants, this application is a division of Application 08/048,738, filed April 16, 1993, now U.S. Patent No. 5,603,691.

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This is a decision on an appeal from the examiner's final rejection of claims 1 through 6, 8 through 19 and 27. No other claims are pending in the application.

Appellants' invention relates to an orthopedic casting article in the form of a tape which is applied by wrapping the tape around a broken or otherwise injured body limb to immobilize the limb. According to appealed claim 1, the tape is in the form of a roll and comprises a fabric sheet (2), a curable resin coated on the fabric sheet, and a water soluble liner (3) contacting the fabric sheet to separate adjacent layers or convolutions of the fabric sheet in its rolled or wound configuration.

A copy of the appealed claims is appended to appellants' brief.

The following references are relied upon by the examiner as evidence of obviousness in support of his rejection under 35 U.S.C. § 103:

Laufenberg	4,454,873	Jun. 19, 1984
Blott et al. (Blott) (PCT)	WO 90/14060	Nov. 29, 1990

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Claims 1 through 6, 8 through 19 and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Blott in view of Laufenberg. The examiner concedes that Blott's liner 8 for separating adjacent convolutions of the rolled, resin coated, tubular casting structure in Figure 4 of the reference is not soluble in water as required by the appealed claims. He nevertheless contends:

However, Laufenberg et al teaches that it has been known to use water soluble interliners in similar rolled casting bandages; see Col. 1, lines 34-55; Col. 2, lines 29-63; Col. 3, lines 10-33. Hence, it is the Examiner's position that it would have been obvious to use a water soluble liner in the Blott invention for the same reasons that Blott uses an insoluble interliner; i.e. in order to prevent contact and reaction between adjacent layers of the roll. [Answer, pages 3-4]

In Laufenberg's rolled orthopedic casting sheet of thermoplastic material, a layer of release material is located adjacent to casting sheet for a purpose corresponding to that of appellants' liner, namely to prevent attachment of adjacent convolutions of the casting sheet in its rolled configuration. Laufenberg teaches the art to form the release layer from a water soluble material for the self-evident purpose of eliminating the need to physically remove the release layer as required with Blott's insoluble liner.

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However, even if we were to agree that Laufenberg's teachings would have made it obvious to replace Blott's water insoluble liner with a water soluble liner for the reason stated supra, such a modification would not meet the terms of independent claims 1 and 15. Blott's orthopedic casting article is in the form of a multi-layer tube, not a tape as defined in independent claim 1 or a casting article comprising a fabric sheet in the form of a roll as defined in independent claim 15. The modification needed to meet these terms of claims 1 and 15 would require a complete reconstruction of Blott's multi-layered tubular casting structure. Such a reconstruction, however, is not suggested by the applied references. These references also lack a suggestion of forming the water soluble "liner" as a bag to receive the rolled resin coated sheet as defined in claim 15. Lacking a suggestion of these features, we cannot agree that the prior art relied upon by the examiner establishes a prima facie case of obviousness with regard to the subject matter of claims 1 and 15. Accordingly, we cannot sustain the § 103 rejection of claims 1 through 6 and 8 through 19.

With regard to independent claim 27, the examiner states:

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. . . since the curable material of Blott as well as the softenable material of Laufenberg could be activated in less than 30 seconds contact with water that [sic, then?] the claimed dissolve time is obvious in view thereof. In other words, the dissolve time of less than 30 seconds logically flows from the fact that the softenable material of Laufenberg would be softened in less than 30 seconds. [Answer, page 6]

The difficulty with the examiner's position as quoted supra is that it is based on speculation. Obviousness, however, may not be based on speculation or what could have been done. See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Instead, a prima facie case of obviousness must be supported by evidence as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed Cir. 1988). The speculation that Laufenberg's thermoplastic material "could be activated in less than 30 seconds" is not tantamount to a teaching or a suggestion of dissolving the liner in less than 30 seconds. Accordingly, we cannot sustain the examiner's § 103 rejection of claim 27.

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The examiner's decision rejecting claims 1 through 6, 8
through 19 and 27 is reversed.

REVERSED

	Harrison E. McCandlish, Senior)	
	Administrative Patent Judge)	
)	
)	
)	
	Irwin Charles Cohen)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	
INTERFERENCES)	
)	
	John F. Gonzales)	
	Administrative Patent Judge)	

tdc

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