

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(2) is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NOZOMU FUJITA and HAJIME TSUJIKAWA

Appeal No. 2000-0472
Application 08/868,536

ON BRIEF

Before CALVERT, ABRAMS and GONZALES, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 7 to 16, all the claims remaining in the application.

The claims on appeal are drawn to a stylet assembly for use with a catheter (claims 7 to 13 and 16), or to a connector

Appeal No. 2000-0472
Application No. 08/868,536

for connecting a stylet assembly to a catheter (claims 14 and 15). They are reproduced in the appendix of appellants' brief.

The references applied in the final rejection are:

Groshong et al. (Groshong) 1985	4,559,046	Dec. 17,
Folden 1996	5,536,258	Jul. 16,

(Filed Feb. 14, 1994)

Additional prior art applied herein in a rejection pursuant to 37 CFR § 1.196(b) is:

The admitted prior art described on page 1, lines 13 to 22 of the specification (APA).

The appealed claims stand finally rejected on the following grounds:

(1) Claims 7 to 11 and 14 to 16, anticipated by Groshong, under 35 U.S.C. § 102(b);

(2) Claims 12 to 15, unpatentable over Groshong in view of Folden, under 35 U.S.C. § 103(a).

Rejection (1) - 35 U.S.C. § 102(b)

The crux of this rejection is whether Groshong discloses a stylet body which is "bent adjacent the distal end thereof, forming an offset distal end portion for facilitating correct

placement of the catheter into a desired place in a blood vessel," as recited in claim 7. Although the stylet 28 shown in Groshong's Figs. 1 and 3 is straight rather than bent, the examiner proposes, on pages 5 to 7 of the examiner's answer, three different interpretations of the quoted claim language whereby that language may be read on Groshong: (1) the stylet will bend when in use, since Groshong discloses at col. 2, lines 64 to 67, that the stylet (stiffener) "is of such flexibility that it can bend to conform to the bends of the body vessel or vessels in which the catheter is inserted"; (2) the twisted wire of which Groshong's stylet is made is bent as it is twisted, and each bend is offset from the next; (3) the bends 34, 38 at the proximal end of Groshong's stylet are adjacent the distal end since "adjacent" is a relative term and appellants have made no showing of criticality for the adjacency.¹

On pages 3 to 5 of the reply brief, appellants present

¹ The question of "criticality" relates to obviousness under § 103(a) rather than anticipation under § 102(b), since it concerns the question of whether a difference between the claimed subject matter and the prior art is critical. See In re Woodruff, 919 F.2d 1575, 1577-78, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990).

Appeal No. 2000-0472
Application No. 08/868,536

arguments as to why none of the examiner's three interpretations anticipates the quoted claim language. It is unnecessary to restate those arguments here; suffice to say that we are persuaded by them that Groshong does not disclose a stylet body which is bent as recited in claim 7. Since Groshong does not disclose every limitation recited in claim 7, it does not

anticipate. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) (reference must disclose every claimed limitation, explicitly or inherently, in order to anticipate).

We therefore will not sustain the § 102(b) rejection of claim 7, or of claims 8 to 11 and 16 dependent thereon.

The examiner has included claims 14 and 15 in the § 102(b) rejection, but it is not clear how he considers the limitations of independent claim 14 to be readable on Groshong. Claim 14 requires, inter alia, a threaded sleeve rotatably carried on the tubular member for coupling with the catheter, and Groshong does not disclose any such threaded sleeve on tubular member 30 for coupling with catheter 10.

Appeal No. 2000-0472
Application No. 08/868,536

The § 102(b) rejection of claim 14 and its dependent claim 15 will accordingly not be sustained.

Rejection (2) - 35 U.S.C. § 103(a)

We first note that Folden does not supply the deficiency in Groshong discussed above. Therefore the rejection of claims 12 and 13, which are dependent or ultimately dependent on claim 1, will not be sustained, and we will confine the following discussion of the § 103 rejection to claims 14 and 15.

The basis of this rejection, as we understand it from pages 4 and 5 of the final rejection (Paper No. 18), is that it would have been obvious to utilize a "luer type fitting" as disclosed by Folden to connect the catheter 10 and connector 30 of Groshong together.

Initially, we note that the examiner's reference to Groshong's disclosure at col. 5, lines 50 to 53, of a "standard male fitting" (44) is misplaced, since fitting 44 is on adapter 42, and adapter 42 is not used to connect the stylet 28 to the catheter 10. The stylet 28 is connected to catheter 10 by connector (adapter) 30, and adapter 30, together with stylet 28, is replaced by adapter 42 after the

Appeal No. 2000-0472
Application No. 08/868,536

catheter is in place (col. 5, lines 2 to 5 and 49 to 53).

After reviewing the record in light of the appellants' brief and reply brief, the final rejection and the examiner's answer, we conclude that the § 103 rejection is not well taken. The examiner does not identify which embodiment of the Folden apparatus is relied upon, but assuming that tubing 114, 322 and/or 372 constitutes a catheter, we do not consider that one of ordinary skill would have found it obvious to utilize a connector such as disclosed by Folden to connect Groshong's connector 30 and catheter 10. In the Groshong apparatus, the end 20 of the catheter is inserted into a bore in connector 30; this would be somewhat analogous, in Folden, to tube (male member) 112 inserted into the bore of body (female member) 16 (Fig. 3), or male member 376 inserted into the bore of female member 320 (Fig. 5). However, in Folden's embodiments, the threaded collar 120 or 378 is on the member being inserted (male member) rather than on the female member. Therefore, if one of ordinary skill were to modify Groshong in view of Folden, the threaded collar (sleeve) would be carried on the catheter (male member) rather than on the connector 30 (female member), which is contrary to claim 14's recitation that the

Appeal No. 2000-0472
Application No. 08/868,536

threaded sleeve is rotatably carried on the tubular member.

Therefore, we will not sustain the § 103 rejection of claim 14 and dependent claim 15.

Rejection Pursuant to 37 CFR § 1.196(b)

Pursuant to 37 CFR § 1.196(b), claims 7 and 9 to 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Groshong in view of APA.

As indicated in our discussion of the § 102(b) rejection, supra, Groshong discloses structure meeting all the limitations of these claims except for the recitation in claim 7 that the stylet body is "bent adjacent a distal end [etc.]."

APA, which is in the section of the specification titled "Description of the Prior Art," states (emphasis added):

When inserting a venous catheter for total parenteral nutrition or an endotracheal tube, it is general practice to insert a metal wire or a stylet into a catheter to give some rigidity to the catheter or tube since such a catheter is too soft to insert into the blood vessel or trachea without causing bending of the catheter. The stylet is bent into a desired shape as occasion demands. For example, in case of intratracheal intubation, the stylet is bent into a shape corresponding to the shape of [the] respiratory tract of a patient whose larynx [is] being expanded.

As mentioned above, Groshong discloses that the stylet 28

Appeal No. 2000-0472
Application No. 08/868,536

bends to conform to the body vessels in which the catheter is inserted (col. 2, lines 64 to 67). In view of the APA's disclosure that it is known to bend the stylet as occasion demands for insertion into a blood vessel or trachea, it would have been obvious to bend the Groshong stylet 28 into such a desired shape, depending on the part of the body into which it was to be inserted; this would include bending it adjacent its distal end 21, when necessary.

Remand to the Examiner

This application is remanded to the examiner to determine whether claim 8 should be rejected as unpatentable over Groshong in view of APA and other prior art.

Conclusion

The examiner's decision to reject claims 7 to 16 is reversed. Claims 7 and 9 to 11 are rejected pursuant to 37 CFR § 1.196(b), and the application is remanded to the examiner.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997)), 1203

Appeal No. 2000-0472
Application No. 08/868,536

Off. Gaz. Pat. and Trademark Office 63, 122 (Oct. 21, 1997)).
37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

Appeal No. 2000-0472
Application No. 08/868,536

1.136(a).

REVERSED; 37 CFR § 1.196(b)and REMANDED

IAN A. CALVERT)
Administrative Patent Judge)
)
) BOARD OF PATENT
)
NEAL E. ABRAMS) APPEALS AND
Administrative Patent Judge)

) INTERFERENCES
)
)
JOHN F. GONZALES)
Administrative Patent Judge)

IAC:lmb

Appeal No. 2000-0472
Application No. 08/868,536

BIRCH, STEWART, KOLASCH & BIRCH
P.O. BOX 747
FALLS CHURCH, VA 22040-0747