

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

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte BARRY FARRIS

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Appeal No. 2000-0526  
Application No. 08/818,958

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ON BRIEF

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Before COHEN, STAAB 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 1-10 as amended subsequent to the final

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rejection (see Paper Nos. 9 and 11).<sup>1</sup> No other claims are pending in this application.

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<sup>1</sup> The two amendments (Paper Nos. 6 and 9) to claim 3, line 1, actually requested by the appellant result in the term "bending" appearing twice in succession. We note, however, that the second amendment (Paper No. 9) was clerically entered so that the claim reads ". . . including bending closed a gas passageway . . ." (i.e., the term "bending" appears only once), which appears to have been the appellant's intent and which is consistent with the copy of claim 3 in the appendix to the appellant's brief. In any event, we shall interpret claim 3 as it appears in the appendix to the appellant's brief.

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BACKGROUND

The appellant's invention relates to a plungerless syringe (claims 1 and 4-8) and a method for sequestering gas from therapeutic fluid and injecting therapeutic fluid using the plungerless syringe (claims 2, 3, 9 and 10). An understanding of the invention can be derived from a reading of exemplary claims 1 and 2, which appear in the appendix to the appellant's brief.

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

Farris (Farris I)	5,102,398	Apr. 7, 1992
Farris (Farris II)	5,370,626	Dec. 6, 1994

The following rejections are before us for review.

- (1) Claims 2 and 10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Farris I.
- (2) Claims 3 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Farris I in view of Farris II.
- (3) Claims 1 and 4-8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Farris I.
- (4) Claims 1 and 4-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Farris I.

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(5) Claims 1, 2 and 4-8 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of Farris I.

(6) Claims 3, 9 and 10 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of Farris I in view of Farris II.

Reference is made to the brief and reply brief (Paper Nos. 12 and 14) and the final rejection and answer (Paper Nos. 7 and 13) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

#### 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.

At the outset, we note that, notwithstanding the appellant's groupings as set forth on page 9 of the brief, the appellant has not argued separately the patentability of claim

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10 apart from claim 2 or claim 3.<sup>2</sup> Therefore, claim 10 shall stand or fall with representative claim 2 in deciding the appeal of rejection (1) and with representative claim 3 in deciding the appeal of rejection (6) (see In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978)).

For the reasons discussed, infra, in the new ground of rejection of method claims 2, 3, 9 and 10 under the second paragraph of 35 U.S.C. § 112 pursuant to 37 CFR § 1.196(b), we have determined that claims 2, 3, 9 and 10 are indefinite. We recognize the inconsistency implicit in our holding that these claims are rejectable under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention with our holding, infra, that these claims are unpatentable under 35 U.S.C. § 102 or 103 or under the judicially created doctrine of obviousness-type double patenting. Normally, when substantial confusion exists as to the interpretation of a claim and no reasonably definite

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<sup>2</sup> Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable. 37 CFR § 1.192(c)(7).

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meaning can be ascribed to the terms in a claim, a determination as to patentability under 35 U.S.C. § 102 or 103 or under the judicially created doctrine of obviousness-type double patenting is not made. See In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962) and In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). However, in this instance, we consider it to be desirable to avoid the inefficiency of piecemeal appellate review. See Ex parte Ionescu, 222 USPQ 537, 540 (Bd. App. 1984). For the reasons outlined below, we interpret the appellant's method claims 2, 3, 9 and 10 as being directed to a method for sequestering gas from therapeutic fluid in a plungerless syringe and injecting therapeutic fluid using the syringe. We interpret claim 9 as further requiring that the body portion of the plungerless syringe be provided with a wide central portion tapering towards both the outlet and gas passageway. Therefore, we have made a determination below as to the patentability under 35 U.S.C. §§ 102 and 103 and the doctrine of obviousness-type double patenting of method claims 2, 3, 9 and 10 in the interest of judicial economy.

***Rejection (1)***

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Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984). Under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary

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skill. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

The examiner's position in rejecting claims 2 and 10 as being anticipated by Farris I, as set forth in the final rejection (pages 2-3) and repeated substantially verbatim in the answer (pages 3-4), is as follows:

Farris '398 [Farris I] discloses the method steps as claimed in column 4, lines 7-38. The only step that is not **explicitly** taught is the urging of any gas from the infusion device and the syringe into the air trap. However, Farris discloses (4:21-27) indicating that the needle is installed onto the syringe and the device horizontally oriented causing any air trapped in the syringe to move upwardly into the air trap. This also is considered to **inherently** expel air from the needle since the device will undergo shaking while the syringe needle is positioned to be inserted into the patient and will inherently urge gas toward the gas chamber. At this position, the air trap will be located at the highest elevation of the syringe. The syringe clearly includes a removable tab at 20, 20a and 20b.

The appellant's statement on page 11 of the brief that the examiner's observation that there is no "urging" step defeats anticipation is a mischaracterization of the examiner's position. The examiner has determined that air will inherently be expelled or urged from the needle (device) and the syringe by the positioning of the device for insertion

into the patient in the manner disclosed by Farris I, thereby meeting the "urging" step of claim 2.

In our opinion, the method of using a plungerless syringe disclosed by Farris I in column 4, lines 7-38, fully anticipates the subject matter of claim 2. Farris I discloses docking a syringe, which has an air trap (chamber 22) located remote from a fluid exit (outlet tip 18a), with a hypodermic needle or cannula (column 4, lines 13-14); orienting the syringe so that the air trap is at a highest elevation as shown in Figure 3, this orientation also performing the "urging" step by causing any air trapped in the syringe to move upwardly into the air trap 22 (column 4, lines 24-27); inserting the needle into the patient and injecting the therapeutic liquid by pressing the wall 12a forwardly (column 4, lines 31-33). While Farris I does not explicitly state that the disclosed "horizontal" orientation of the syringe will cause air (gas) from the device (needle or cannula) to move upwardly into the air trap, one of ordinary skill in the art would understand that the interior of the needle or cannula and the container 12 are in fluid communication and that, as such, any gas trapped in liquid which has migrated

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into the needle or cannula will also move upwardly into the air trap.

We note that claim 2 does not require that the "urging" step take place after the orienting step as the appellant's argument on page 2 of the reply brief implies. From our viewpoint, nothing in claim 2 precludes the urging taking place simultaneously with the orienting step, for example.

Moreover, the examiner's position that the step of maintaining the syringe in the horizontal orientation (after having first placed it in such orientation) while inserting it into the patient will inherently urge gas from the needle or cannula and syringe upward into the air trap, since the needle or cannula will undergo shaking, appears reasonable to us. After the PTO establishes a prima facie case of anticipation based on inherency, the burden shifts to the appellant to prove that 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). The appellant has not even specifically argued, much less proven, that such shaking and consequent gas movement will not inherently occur during insertion.

For the foregoing reasons, the appellant's arguments fail to persuade us that the examiner has committed error by determining that Farris I anticipates the method recited in claim 2. Accordingly, we shall sustain the examiner's rejection of claim 2, and of claim 10<sup>3</sup> which falls therewith, as being anticipated by Farris I.

***Rejection (2)***

Claim 3 depends from claim 10 and further recites a step of "bending closed a gas passageway which extends between the gas trap and a fluid containing body portion of the syringe just prior to the injecting step." The examiner concedes that this step is not disclosed by Farris I. However, the examiner notes that Farris I discloses that the main objective of the plungerless deformable syringe is to trap gas so that it will be prevented from being injected into the patient and that Farris II discloses closing the gas chamber of a plungerless deformable syringe prior to injection so the trapped air has no chance at all of being injected into the patient. The

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<sup>3</sup> For the record, we note that Farris I discloses (column 4, lines 7-14) a step of initially (i.e., prior to positioning a needle or cannula on the tip 18a) removing a tab at the fluid exit, as required by claim 10.

examiner then concludes that, in light of the combined teachings of Farris I and Farris II, it would have been obvious to one of ordinary skill in the art to close off the gas chamber of Farris I as taught by Farris II "since it is well desired that no gas/air be injected into the patient due to the ill effects that may occur therefrom" (answer, page 5).

The appellant argues that there is no teaching in the prior art applied by the examiner of bending the passageway closed as required by claim 3 (brief, page 12). We disagree. In column 5, lines 45-57, Farris II teaches sealing the passage 40 (and hence the chamber 22) from the container 12 by applying compressive forces to the walls of the passage to bring the inside wall surfaces 41, which either have adhesive applied thereto or are provided with tongue and groove structures as illustrated in Figures 2A and 2B, into contact to form a seal 43. From our perspective, the application of compressive forces to the passage walls bends the walls and thus is a step of bending the passageway closed, as recited in claim 3. Further, it is our opinion that the teachings of Farris II (column 3, lines 3-8; column 7, lines 20-22) are sufficient to have motivated one of ordinary skill in the art

at the time of the appellant's invention to compress the tubular connection 22a forming the passage 24 in the syringe of Farris I to seal the chamber 22 from the container 12, after urging any trapped air into the chamber, to remove any risk that air will be injected therefrom.

For the foregoing reasons, we shall sustain the examiner's rejection of claim 3 as being unpatentable over Farris I in view of Farris II.

Claim 9 depends from claim 3 and further recites, as interpreted, supra, the body portion having a wide central portion tapering both towards the outlet and gas passageway. As clearly illustrated in Figures 2 and 3, the body (container 12) of Farris I is formed with a wide central portion which tapers towards the outlet (tip 18a) and towards the gas passageway (passage 22a) (note column 3, lines 25-29 and 39). Accordingly, we shall also sustain the examiner's rejection of claim 9 as being unpatentable over Farris I in view of Farris II.

***Rejections (3) and (4)***

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Claim 1 on appeal requires, *inter alia*, "a gas trap disposed on said back wall at an opposite end of said body from said fluid outlet." The gas trap in the syringe of Farris I, as illustrated in Figures 1-4, is disposed on a side (peripheral) wall 12d rather than the back (rear) wall 12a. The examiner's position that Farris I anticipates the subject matter of claim 1 is that

Farris, however, discloses (4:39-46) that it will be recognized that the air trap can be positioned in various locations and can have various shapes. It is considered **inherent** that this includes the back wall of the device [answer, page 5].

As pointed out above, under principles of inherency, when a reference is silent about an asserted inherent characteristic (in this case, positioning of the gas trap on the rear wall 12a), it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill (Continental Can Co., 948 F.2d at 1268, 20 USPQ2d at 1749). As the court stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgirg v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)):

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Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.

We see nothing in the teachings of Farris I that the air trap can be positioned in "various" locations which would necessarily result in placement of the gas chamber on the rear wall of the syringe and thus conclude that the examiner has failed to meet the initial burden of establishing a prima facie case of anticipation based upon the theory of inherency. See In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Accordingly, we shall not sustain the examiner's rejection of claim 1, or claims 4-8 which depend therefrom, as being anticipated by Farris I.

Turning next to the examiner's alternative rejection of claims 1 and 4-8 as being unpatentable over Farris I, the examiner contends that it would have been an obvious design alternative to one of ordinary skill in the art to move the air trap to the rear wall based on the statement that the air trap can be positioned in various locations and have various shapes since this position will not compromise the intent of the syringe at all and since the syringe will be needed to be

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inserted into the patient straight up and down at times  
(answer, page 5).

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967).

As recognized by the examiner, Farris I does not teach placing the gas trap chamber on the rear wall of the syringe. In fact, Farris teaches that the air trap chamber is positioned on one side of the container in a location that is generally perpendicular to the direction that the container is squeezed to collapse it (column 2, lines 41-44). This teaching would appear to suggest that the rear wall might not be a suitable location for the gas trap chamber and that the "various locations" referred to in column 4, line 40, may, in fact, be limited to locations on the side (peripheral) wall 12d, for example. We also note that the examiner has not

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supplied any evidence that it was known in the art at the time of the appellant's invention to place the gas trap chamber of a plungerless syringe on the rear wall, opposite the liquid outlet. Having reviewed the teachings of Farris I as a whole, we fail to perceive any teaching, suggestion or incentive therein which would have motivated an artisan to modify the Farris I syringe in such a fashion as to meet the terms of claim 1. From our perspective, the only suggestion for modifying the Farris I syringe to place the gas trap chamber on the rear wall in the manner proposed by the examiner is found in the luxury of hindsight accorded one who first viewed the appellant's disclosure. This, of course, is not a proper basis for a rejection. See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

In light of the foregoing, we shall also not sustain the examiner's rejection of claim 1, and claims 4-8 which depend therefrom, as being unpatentable over Farris I.

***Rejections (5) and (6)***

The double patenting rejections are based on a judicially created doctrine of double patenting grounded in public policy so as to prevent the unjustified or improper timewise

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extension of the "right to exclude" granted by a patent by prohibiting the issuance of the claims in a second patent not patentably distinct from the claims of the first patent. See In re Longi, 759 F.2d 887, 892, 225 USPQ 645, 648 (Fed. Cir. 1985).<sup>4</sup>

Turning first to claims 1 and 4-8, the examiner concedes that none of the claims of Farris I recites that the gas trap is disposed "on said back wall at an opposite end of said body from said fluid outlet" as required by claims 1 and 4-8 on appeal. However, the examiner asserts that, in light of the disclosure in column 4, lines 39-40, of the Farris I patent that the air trap can be positioned in various locations, "the broad recitation in the patented claim would therefore cover all locations for the gas trap or would have directed one of ordinary skill in the art to moving the air trap to any location that would still perform the desired result" (answer, page 7).

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<sup>4</sup> A terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an obviousness-type double patenting rejection provided the conflicting patent is shown to be commonly owned with an application. See 37 CFR § 1.130(b).

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As discussed above, we find nothing in the disclosure of Farris I, including the teaching that the gas trap chamber may be positioned in various locations, which teaches, either explicitly or under the theory of inherency, or would have suggested to one of ordinary skill in the art placing the gas trap chamber on the back or rear wall of the syringe, at an opposite end of the body from the fluid outlet, as recited in claims 1 and 4-8 on appeal. For the foregoing reasons, we shall not sustain the examiner's rejection of claims 1 and 4-8 under the doctrine of obviousness-type double patenting as being directed to an invention which is not patentably distinct from the subject matter of claims 1-14 of the Farris I patent.

Turning next to the examiner's rejection of method claim 2 under the doctrine of obviousness-type double patenting as being directed to an invention which is not patentably distinct from the claims of the Farris I patent, we note that patent claims 13 and 14, the only claims of the Farris I patent directed to the method of injecting liquid with a plungerless syringe, do not recite a step of docking the syringe with a device at the fluid exit, as required by claim

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2 on appeal. As the examiner has not provided any evidence that the addition of such a step in the method of claim 13 or 14 of the Farris I patent would have been obvious to one of ordinary skill in the art at the time of the appellant's invention, we are constrained to reverse the examiner's rejection of claim 2 under the doctrine of obviousness-type double patenting.

For the reasons which follow, however, we shall sustain the examiner's rejection of claims 3, 9 and 10 under the doctrine of obviousness-type double patenting as being directed to an invention which is not patentably distinct from the subject matter of the claims of the Farris I patent in view of Farris II.

We note, at the outset, that none of claims 3, 9 and 10 requires that the air trap be located on the back wall. In this regard, claim 2, from which claims 3, 9 and 10 depend, recites merely that the syringe has an air trap "remote from a fluid exit." Neither of claims 13 and 14 of the Farris I patent expressly recites that the gas trap chamber is remote from the liquid outlet. However, while the patent disclosure may not be used as prior art in considering whether a claim in

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an application defines merely an obvious variation of an invention disclosed and claimed in a patent under the doctrine of obviousness-type double patenting, it is permissible to use a tangible embodiment set forth in the disclosure which falls within the scope of a patent claim to determine whether a claim in the application defines merely an obvious variant of the subject matter of the patent claim. See In re Vogel, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970).<sup>5</sup> In this instance, as clearly illustrated in Figures 1-4 of the Farris I patent, in the tangible embodiment of the method of claims 13 and 14, the gas trap chamber (22) is remote (distant in space, far off, far away)<sup>6</sup> from the liquid outlet (18a). Thus, the location of the air trap remote from the fluid outlet, as recited in the claims on appeal, does not distinguish over the method of patent claims 13 and 14.

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<sup>5</sup> As explained in Vogel, such use of the patent disclosure is permitted, and frequently required, because it is difficult, if not meaningless, to try to say what is or is not an obvious variation of a claim, which is merely a group of words defining only the boundary of the patent monopoly. The patent claim may not describe any physical thing and indeed may encompass physical things not yet dreamed of. See id.

<sup>6</sup> Webster's New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988).

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Each of claims 13 and 14 of the Farris I patent recites a step of orienting the syringe so that the air (gas) trap extends generally upwardly so that any gas in said chamber will be displaced into said chamber. As illustrated in the tangible embodiment of the method (Figures 3 and 4), the air trap is at a highest elevation of the syringe in this orientation of the syringe. It is this position of the air trap which causes any gas in the container of the syringe to be displaced into the chamber as set forth in the "orienting" step of patent claims 13 and 14. Accordingly, the step of orienting the syringe as recited in claim 2, from which claims 3, 9 and 10 on appeal depend, is met by the method of claims 13 and 14 of the Farris I patent. As for the step of urging recited in claim 2, this step is also achieved by orienting the syringe in the manner set forth in claims 13 and 14 of the Farris I patent, for the reasons discussed above in our discussion of rejection (1), supra.

In light of the preamble language "injecting liquid from a plungerless syringe" set forth in claim 13 of the Farris I patent, one of ordinary skill in the art would have understood the step of "collapsing said container in a manner such that

liquid is ejected out of said container" recited in patent claim 13 to be a step of injecting the liquid, as required by claim 3.

Claims 13 and 14 of the Farris I patent differ from the method recited in claim 3 on appeal, in that (1) the patent claims are directed to injection of "liquid" rather than "therapeutic fluid," (2) the patent claims omit a step of docking the syringe with a device at the fluid exit and (3) the patent claims do not recite a step of "bending closed a gas passageway . . . just prior to the injecting step."

Farris II, however, discloses the use of plungerless syringes as medical devices for the injection of fluids to patients (column 1, lines 11-14), teaches connecting a needle 34 or cannula 26 to the outlet portion of the syringe in a manner allowing liquids in the container of the syringe to be ejected through the needle or cannula (column 5, lines 65-68) and, as discussed above, teaches compressing (i.e., bending) the walls of a passage between a gas chamber and the container of the syringe to form a seal to prevent gas which has passed into the gas chamber from being injected into the patient.

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Farris II would have suggested to one of ordinary skill in the art filling the container of the plungerless syringe of the method of claims 13 and 14 of Farris I with a therapeutic fluid and docking the plungerless syringe with a device, such as a needle or cannula, in order to adapt the method of the patent claims for injecting a therapeutic fluid into a patient. Further, it would have been obvious to one of ordinary skill in the art at the time of the appellant's invention to provide a sealing device, such as an adhesive or tongue and groove arrangement, on the inside surfaces of the walls of the passage communicating the gas trap chamber and container in the method of claims 13 and 14 of the Farris I patent and to compress (i.e., bend closed) the passage walls to form a seal to remove any risk that air trapped in the air trap chamber will be injected into the patient, as taught by Farris II.

Claim 9 on appeal depends from claim 3 and, as interpreted, supra, further requires that the body portion of the plungerless syringe be provided with a wide central portion tapering both towards the outlet and gas passageway. We note that the body (container 12) of the tangible

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embodiment of the subject matter of claims 13 and 14 of the Farris I patent is formed with a wide central portion which tapers towards the outlet (tip 18a) and towards the gas passageway (passage 22a) (note column 3, lines 25-29 and 39). Moreover, such tapering of the container or body portion of a plungerless syringe was conventional in the art at the time of the appellant's invention, as evidenced by Farris II. Accordingly, such tapering is not a patentable distinction over the method of claims 13 and 14 of Farris I.

For the foregoing reasons, we find ourselves in agreement with the examiner that the subject matter of claims 3 and 9 on appeal is not patentably distinct from the subject matter of claims 13 and 14 of the Farris I patent. Accordingly, we shall sustain the examiner's obviousness-type double patenting rejection of claims 3 and 9, as well as claim 10 which falls with claim 3 in light of the appellant's failure to separately argue the patentability of claim 10 apart from claim 3.

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NEW GROUNDS OF REJECTION

Pursuant to our authority under 37 CFR § 1.196(b), we enter the following new grounds of rejection.

Claims 2, 3, 9 and 10 are 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 the appellant regards as the invention.

The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. See In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

The preamble of claim 2 is not commensurate in scope with the body of the claim, thereby rendering the scope of the claim confusing. The preamble of claim 2 recites a method for sequestering gas from therapeutic fluid in a plungerless syringe. The body of the claim, on the other hand, recites steps of docking, orienting and urging, which appear to comprise the method for sequestering gas from therapeutic fluid, and an additional step of injecting the therapeutic fluid, which, as we see it, is not part of the method for sequestering gas from therapeutic fluid. In light of this

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inconsistency between the preamble and body of claim 2, one of ordinary skill in the art cannot determine with any certainty whether the claim is directed to a method of sequestering gas from therapeutic fluid or to a method of sequestering gas from therapeutic fluid and injecting the therapeutic fluid. Claims 3, 9 and 10 depend, either directly or indirectly, from claim 2 and are likewise indefinite.

Claim 9 recites an additional step of "forming the body portion . . ." which is directed to a process for forming a syringe, rather than a method for sequestering gas from therapeutic fluid in a plungerless syringe, as recited in the preamble. This inconsistency between the preamble and body of the claim further confuses the scope of the claim, in that it is not clear whether the claim is directed to a method of forming a plungerless syringe or sequestering gas from therapeutic fluid in a syringe (and injecting the fluid).

Claim 2 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13 and 14 of the Farris I patent in view of Farris II.

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The reasoning set forth above in determining that the subject matter of claims 3, 9 and 10 is not patentably distinct from the subject matter of claims 13 and 14 of the Farris I patent in view of Farris II, which is incorporated herein, also mandates a conclusion that the subject matter of claim 2, from which claims 3, 9 and 10 depend, is likewise not patentably distinct from claims 13 and 14 of the Farris I patent in view of Farris II.

#### CONCLUSION

To summarize, the examiner's decision to reject claims 2 and 10 under 35 U.S.C. § 102(b) as being anticipated by Farris I, claims 3 and 9 under 35 U.S.C. § 103 as being unpatentable over Farris I in view of Farris II and claims 3, 9 and 10 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of Farris I in view of Farris II is affirmed. The examiner's rejections of claims 1 and 4-8 under 35 U.S.C. § 102(b)/103 as being anticipated by or unpatentable over Farris I and claims 1, 2 and 4-8 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of Farris I are reversed. New rejections of claims

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2, 3, 9 and 10 under 35 U.S.C. § 112, second paragraph, and of claim 2 under the judicially created doctrine of obviousness-type double patenting are added pursuant to 37 CFR § 1.196(b).

In addition to affirming the examiner's rejections of one or more claims, this decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new

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grounds 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. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejections, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejections are overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final

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action on the affirmed rejections, including any timely request for rehearing thereof.

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

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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