

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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MATTHEW LAWRENCE, RICHARD REGO
and EDWARD F. DOORLEY, III

Appeal No. 2000-1934
Application No. 08/779,420

ON BRIEF

Before FRANKFORT, McQUADE 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 1-11, 14 and 15. Claims 12 and 13, the only other claims pending in the application, stand objected to as being dependent on a rejected claim.

BACKGROUND

The appellants' invention relates to a tract wound irrigation tip (claims 1-11) and a method for irrigating a tract wound (claims 14 and 15). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The examiner relied upon the following prior art references of record in rejecting the appealed claims:¹

Abramson	4,508,533	Apr. 2, 1985
Muto	5,167,622	Dec. 1, 1992

- (1) Claims 1-5, 14 and 15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Abramson.
- (2) Claims 1-3, 5, 8 and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Muto.
- (3) Claims 10 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muto.
- (4) Claims 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Abramson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted

¹ Given the subject matter of appellants' claims, it appears to us that a search of appropriate commercial databases and medical journals would be advisable in the event of further prosecution in this or a continuing application. There is no indication in the record that such a search has been conducted.

rejections, we make reference to the answer (Paper No. 26) for the examiner's complete reasoning in support of the rejections and to the brief (Paper No. 25) for the appellants' arguments thereagainst.²

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.

Rejection (1)

Independent claim 1 requires an elongate shaft which is "sufficiently longitudinally flexible to be bendable along its length, including its distal end, to a radius as small as about 5/8 inch without kinking." Independent claim 14 recites a step of advancing a flexible shaft into and through a tract wound, the shaft being "sufficiently flexible to enable it to bend through at least an angle of 90° at a radius at least as

² Appellants' "REPLY BRIEF" (Paper No. 27) has not been entered (see Paper No. 28).

small as five-eighths of an inch without adversely affecting the functioning of the lumens."

Abramson discloses a surgical drain comprising a catheter 10 made of latex, polyvinyl chloride (PVC) or, preferably, silicone rubber. Abramson is silent with regard to the dimensions or material properties of the catheter but does disclose, in column 6, lines 1-9, that the holes 57, 58 provided in the distal portions of the walls of lumens 12, 14 and 16 "weaken the wall strength of the plastic at the distal end of catheter 10" and thus permit "easier flexing, bending, and movement of that portion as it is pushed against the body tissues on insertion of the drain into the wound." Other means for providing a "softened portion at the distal end" include filamentation of the plastic walls there, forming a porous grid in them or attachment of a softer piece of material at the distal end.

In rejecting claims 1-5, 14 and 15 under 35 U.S.C. § 102(b) as being anticipated by Abramson, the examiner's position, as expressed on page 4 of the answer, is that

[Abramson's] catheter is made of polyvinyl chloride (PVC) as Applicant's (see Applicant's specification page 9 lines 9-11) and the shaft could inherently

perform the functions as claimed such as being sufficiently longitudinally flexible to be bendable along its length including its distal end. Also, by adding holes at the distal end increases the flexibility and bendability of the catheter(see col. 6, lines 1-13). An attachment of a softer piece can be adhered to the distal end of the catheter as well known in the art to be defined as an outlet nozzle or projecting part from the shaft.

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

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. [Citations omitted.] If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

In this case, the examiner concedes on page 7 of the answer that "one of ordinary skill in the art would have

recognized that there are different types of PVC material already invented having different properties and characteristics from where an artisan can chose [sic]" and somehow concludes from this that one skilled in the art would have recognized that the properties and characteristics missing from Abramson are inherent to the material. The examiner's logic in this regard is flawed. The recognition in the art of the existence of various types of PVC material having different properties leads us to conclude that the PVC catheter of Abramson *may* possess the recited flexibility properties but does not *necessarily* possess these properties. As discussed above, the mere fact that a certain thing *may* result is not sufficient to establish inherency.

It is apparent that Abramson's catheter 10 is provided, at least at the distal portion thereof, with a degree of flexibility to permit flexing and bending upon insertion. However, the examiner has not set forth a sufficient basis for concluding that Abramson's catheter inherently or necessarily comprises the particular degree of flexibility recited in claims 1 and 14, as well as claims 2-5 and 15 which depend

from claims 1 and 14. Therefore, we cannot sustain rejection (1).

Rejection (2)

The examiner rejects claims 1-3, 5, 8 and 9 as being anticipated by Muto. Independent claim 8 recites, inter alia, that the shaft is sufficiently flexible to enable it to bend through at least an angle of 90° without any substantial drop in the stagnation pressure of the emitted liquid. The examiner's sole basis for concluding that Muto's catheter inherently meets the flexibility limitations of independent claims 1 and 8 is that it is disclosed as being made of PVC (col. 5, l. 52). The examiner's position in this regard is not well taken for the very same reasons discussed above with regard to rejection (1) and we discern no other teaching in Muto which would lead us to conclude that Muto's catheter meets the flexibility limitations of claims 1 and 8, as well as claims 2, 3, 5 and 9 which depend therefrom. Accordingly, we will not sustain rejection (2).

Rejection (3)

Independent claim 10 recites a tract wound irrigation tip comprising a shaft being between four and sixteen inches long,

having an outer diameter of about 9 French to about 18 French (i.e., about 0.117 to about 0.234 inches), a modulus of elasticity between about 1000 psi to about 2000 psi, a specific gravity between about 1.05 grams per cc to about 1.25 grams per cc and a durometer between about 70 Shore A to about 90 Shore A, with the area defined by lumens comprising between about 30% and 60% of the cross-sectional area of the shaft. The examiner finds that Muto does not disclose the claimed length, diameter, modulus of elasticity, specific gravity and durometer, but considers them mere matters of "obvious design choice to fulfill Applicant's intention" (answer, p. 5). As for the material properties of the PVC, from which Muto's catheter is preferably made (col. 5, ll. 51-52), the examiner points out that one skilled in the art would have recognized that there are different types of PVC already invented having different properties and that, as such, these properties and characteristics are inherent in the material.³ This reasoning is flawed, for the reasons discussed above.

³ Although the statement of the examiner's position is confusing, it appears that the examiner is taking alternative positions with regard to the material properties of the catheter, namely, the material properties are either inherent or obvious matters of design choice.

Muto does disclose a catheter outer diameter of 0.18 inches (col. 2, l. 66), which falls within the range recited in appellants' claim 10. Further, given the inner diameter of 0.108 inches specified by Muto (col. 2, l. 67), the portion of the cross-sectional area of the catheter comprised by the lumens is 36%, thus falling within the range recited in claim 10. However, we, like the examiner, find no specific teachings with regard to the modulus of elasticity, specific gravity and durometer of Muto's catheter. It is quite apparent from appellants' disclosure (specification, p. 9) that the recited combination of dimensions and material properties assists in achieving the required softness and flexibility of appellants' catheter. Accordingly, the examiner's characterization of these properties as merely obvious design choice is, in our opinion, inappropriate. Furthermore, even assuming, as the examiner seems to suggest, that a PVC material having the recited material properties was known in the art at the time of appellants' invention, the examiner's recognition that various grades of PVC material, having different material properties, were known at the time of appellants' invention, belies the examiner's assertion that

the particular properties recited in claim 10 are inherent in the PVC material of Muto's catheter. While it is probably true that a catheter could have been made from a known PVC material having the recited properties, Muto provides no suggestion to do so. The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. See In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

For the foregoing reasons, we conclude that Muto is not sufficient to establish that the subject matter of claim 10, or claim 11 which depends from claim 10, would have been obvious to one skilled in the art at the time of appellants' invention. Thus, we will not sustain rejection (3).

Rejection (4)

Claim 6 depends from claim 1 and further recites an obturator dimensioned to be slidably receivable in the suction lumen. The examiner concedes that such an obturator is not disclosed by Abramson but contends that it would have been obvious to one skilled in the art to insert any medical instrument, including an obturator, in any of the lumens of Abramson's catheter, depending on the procedure being performed (answer, p. 6). The examiner's rejection lacks any explanation or evidence as to why one skilled in the art would have been led to provide an obturator dimensioned to be slidably receivable in the suction lumen of Abramson as recited in claim 6.

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, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). In this instance,

in the absence of any evidence which teaches or suggests the provision of an obturator for use with Abramson's catheter which is slidably receivable in the suction lumen thereof, it appears to us that the examiner's rejection of claim 6 stems from impermissible hindsight using appellants' disclosure as a template to reconstruct appellants' claimed invention.

Accordingly, we shall not sustain the examiner's rejection of claim 6, or claim 7 which depends therefrom.

CONCLUSION

To summarize, none of the examiner's rejections is sustained. The decision of the examiner is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JENNIFER D. BAHR)	
Administrative Patent Judge)	

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