

**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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** ROGER L. HILDWEIN,  
ROBERT C. USCHOLD, J.D. STALEY, JR.,  
PAUL RIESTENBERG, LAURA GALLAGHER  
AND REX NAGAO

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Appeal No. 95-3582  
Application 08/179,419<sup>1</sup>

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ON BRIEF

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Before MEISTER, McQUADE and CRAWFORD, **Administrative Patent Judges**.

MEISTER, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is an appeal from the final rejection of claims 21-34, the only claims remaining in the application.

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<sup>1</sup> Application for patent filed January 10, 1994. According to applicants, this application is a division of Application 07/906,774, filed June 30, 1992.

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We REVERSE.

The appellants' invention pertains to a surgical port for insertion through a body wall. Independent claim 21 is further illustrative of the appealed subject matter and a copy thereof may be found in the appendix to the appellants' brief.

The references relied on by the examiner are:

Wismer	1,074,077	Sept. 23, 1913
Honkanen et al. (Honkanen)	4,655,752	Apr. 7, 1987
Raiken	5,073,169	Dec. 17, 1991
Horie et al. (Horie)	5,281,204	Jan. 25, 1994

Claims 21 and 26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Wismer.

Claims 22-25, 27-29 and 31-34 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wismer.

Claims 21-25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Horie in view of Honkanen.

Claims 26-34 stand rejected under 35 U.S.C. § 103 as being unpatentable over Horie in view of Honkanen and Raiken.

The examiner's rejections are explained on pages 3-5 of the answer. The arguments of the appellants and examiner in

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support of their respective positions may be found on pages 3-5 of the brief and pages 5 and 6 of the answer.

Considering first the rejections of claims 21 and 26 under 35 U.S.C. § 102(b) as being anticipated by Wismer and claims 22-25, 27-29 and 31-34 under 35 U.S.C. § 103 as being unpatent-able over Wismer, both of these rejections are based on the examiner's view that

the portions of spurs 6 of Wismer which extend vertically as seen in fig. 2 and which extend between plate 3 and the portions of spurs 6 which are bent over plate 2 form a "hollow tubular body" as claimed with slits or gaps running vertically along the tubular body between the spurs 6. The claims do not require the tubular body to be free of any slits or gaps. [Answer, page 5.]

We will not support the examiner's position. While it is true that the claims in a patent application are to be given their broadest reasonable interpretation **consistent with specification** (*In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)) and limitations from a pending

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application's specification will not be read into the claims during prosecution of a patent application (*Sjolund v. Musland*, 847 F.2d 1573, 1581-82, 6 USPQ2d 2020, 2027 (Fed. Cir. 1988)), it is also well settled that terms in a claim should be construed in a manner consistent with the specification and construed as those skilled in the art would construe them (*see In re Bond*, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990), *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 986, 6 USPQ2d 1601, 1604 (Fed. Cir. 1988) and *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983)). Here, the examiner has expanded the meaning to be given to the claimed "hollow tubular body" beyond all reason. The alleged hollow tubular body in Wismer is in reality four spike-like fingers or spurs 6 that project from a washer-like plate 3, the ends of which have been bent over a second washer-like plate 2 so as to retain the plates on opposite sides of a button hole. We can think of no circumstances under which the artisan, consistent with the appellants' specification, would construe these fingers or spurs to correspond to the claimed hollow tubular body. This

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being the case, we will not sustain either the rejection of (1) claims 21 and 26 under 35 U.S.C. § 102(b) or (2) claims 22-25, 27-29 and 31-34 under 35 U.S.C. § 103 based on the reference to Wismer.

Turning to the rejections under 35 U.S.C. § 103 of claims 21-25 as being unpatentable over Horie in view of Honkanen and claims 26-34 as being unpatentable over Horie in view of Honkanen and Raiken, each of these rejections is bottomed on the examiner's view that to include

the Honkanen et al. annular flange 35 on the Horie et al. tubular body (T or 1) in order to hold the tubular body more securely in place as described in col 4, lines 26-31 of Honkanen et al. would have been obvious. The Honkanen et al. annular flange 35 is broadly considered to be disc-shaped. Assuming arguendo that it is not disc-shaped, it would have been obvious to simply make the flange (which is described as a rib or ridge) thinner in order to be better secured in the body. [Answer, pages 3 and 4.]

We cannot agree with the examiner that the undulating thickened portions 35 on the wall of Honkanen's cannula (which are stated in line 36 of column 3 to be circumferential ribs or ridges) can fairly be construed to a "disc-shaped annular

flange" as the examiner asserts.<sup>2</sup> Moreover, there is absolutely nothing to indicate that these undulating ridges or ribs (which are depicted in Fig. 2 as being extremely thick relative to the extent of radial projection) have the capability of flexing relative to the tubular body in the manner set forth in the last three lines of independent claims 21 and 26.<sup>3</sup>

As to the examiner's contention that it would have been obvious to make the ribs or ridges of Honkanen disc-shaped "in order to be better secured in the body," we must point out that obviousness under § 103 is a legal conclusion based on **factual evidence** (*In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)) and the mere fact that such a result would occur does not serve as a proper basis for concluding that such

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<sup>2</sup> *The American Heritage Dictionary*, Second College Edition, 1982, Houghton Mifflin Company, Boston, MA defines a "disk" or "disc" as being -- A thin, flat circular plate --.

<sup>3</sup> It is well settled that an "adapted to . . ." clause sets forth a function which the article or apparatus must be structurally capable of performing (**see, e.g., In re Venezia**, 530 F.2d 956, 959, 189 USPQ 149, 151-52 (CCPA 1976)) and such a functional statement must be given full weight and may not be disregarded in evaluating the patentability of the claims (**see, e.g., Ex parte Bylund**, 217 USPQ 492, 498 (Bd. App. 1981)).

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a modification would have been obvious. Instead, it is well settled that in order to establish a **prima facie** case of obviousness the prior art teachings must be sufficient to suggest to one of ordinary skill in the art making the modification needed to arrive at the claimed invention. **See, e.g., In re Lalu**, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984). The examiner, however, has provided no factual basis whatsoever for concluding that the modification proposed would have been obvious. **See, e.g., In re GPAC Inc**, 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995) and **In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968).

As the examiner apparently recognizes, there is nothing in Wismer or Raiken (additionally relied on in the rejection of claims 26-34) which would overcome the deficiencies of Honkanen.

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In view of the foregoing, we will not sustain the rejections

under 35 U.S.C. § 103 of (1) claims 21-25 based on the combined teachings of Horie and Honkanen and (2) claims 26-34 based on the combined teachings of Horie, Honkanen and Raiken.

The examiner's rejections are all reversed.

**REVERSED**

JAMES M. MEISTER	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
JOHN P. McQUADE	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
MURRIEL E. CRAWFORD	)	

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