

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARTHOLOMEUS W.J. VAN DER AA
and FRANCISCUS H.C. BENNING

Appeal No. 96-4139
Application 08/142,276¹

ON BRIEF

Before CALVERT, COHEN and ABRAMS, Administrative Patent Judges.
CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 5, all of the claims remaining in the application.

The subject matter in issue is a hypodermic needle. A copy of the appealed claims appears in Appendix A of appellants' brief.

¹Application for patent filed October 26, 1993.

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The reference applied in the final rejection is:

Chevalier 4,863,428 Sep. 05, 1989

Claims 1 to 5 stand finally rejected on the following grounds:

- (1) Failure to comply with 35 USC § 112, second paragraph;
- (2) Anticipated by Chevalier, under 35 USC § 102(b).

Rejection (1)

With regard to claim 1, the examiner states (answer, page 3):

Claim 1 is indefinite because various elements of the hypodermic needle have not been positively recited in the claim. For example, the base portion, the hollow shaft portion, and the tip or extremity portion have all been recited in the preamble of the claim. Such a recitation provides antecedent basis for these elements; however, further limitations are then claimed in the body of the claim which are improper.

The test for compliance with the second paragraph of 35 USC § 112 is whether the claim language, when read by a person of ordinary skill in the art in light of the specification, describes the subject matter with sufficient precision that the bounds of the claimed subject matter are distinct. In re Merat, 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975). In the present case, claim 1 recites a hypodermic needle "having at

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least a base portion, a hollow shaft portion and a tip or extremity portion all formed of the same material . . . , comprising:", and then recites "the base portion", "the hollow shaft portion", "the tip or extremity portion" and "a protrusion", together with additional limitations for each of these elements. While this format is somewhat unusual, we do not consider claim 1 to be indefinite. From his remarks on page 4 of the answer, the examiner seems to consider the language "having . . . comprising" in lines 1 to 3 of claim 1 to be the preamble of the claim, but since line 1 recites a hypodermic needle "having at least a base portion", etc., we regard the elements recited in lines 1 to 3 as constituting a part of the claimed combination, with the recitations following "comprising" merely further limiting those elements. Moreover, even if lines 1 to 3 of claim 1 are considered to be the preamble, the elements recited therein are incorporated into the claim by the references to those elements in the part of the claim following "comprising". See Bell Communications Research v. Vitalink Communications Corp., 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995).

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Turning to claim 2, the examiner finds claim 2 to be indefinite because (answer page 3):

[I]t is unclear how or where the apparatus is attached. Furthermore, the "substantially non-deformable article" has been inferentially included in the claim. Therefore, further limitations on this element are improper.

The rejection is further discussed on pages 5 and 6 of the answer.

With regard to the question of where the recited apparatus for injection is attached, we think it is evident that since claim 1 recites a "base portion for attaching said hypodermic needle to injection apparatus", the apparatus is attached to the base portion. Secondly, the examiner seems to believe that it is improper to claim "a needle pusher means . . . to move said substantially non-deformable article" unless the "substantially non-deformable article" is recited as part of the claimed combination.² However, under 35 USC § 112, sixth paragraph, appellants are entitled to claim the "needle pusher means" as a means-plus-function, which is what they have done. Appellants' non-inclusion of the "substantially non-deformable article"

²In reviewing the claims, it does not appear that "substantially non-deformable" (claims 1 and 2) has antecedent basis in the specification, as required by 37 CFR 1.175(d)(1).

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itself in the claimed combination would appear to be a question of breadth, not indefiniteness.

Accordingly, we conclude that when the claims are read in light of the disclosure, one of ordinary skill would find the bounds of the claimed subject matter to be distinct, and we will therefore not sustain the rejection under 35 USC § 112, second paragraph.

Rejection (2)

"To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently". In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

Appellants argue, *inter alia*, that Chevalier does not anticipate the claims because the protrusion 24 is not such that "the transition from the protrusion to the shaft of said needle is smooth in all directions including the portion of the protrusion closest to said base portion [of the needle]", as recited in claim 1. The examiner, on the other hand, states on page 6 of the answer that the transition between Chevalier's protrusion 24, "and in particular the area (47)", and the

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shaft 11 "appears to be smooth in Figure 5", and on page 7 that "Chevalier shows that the protrusion (24), of which lip (47) is a part, has a smooth transition to the shaft (11)".

In construing the terms in a claim:

[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.

In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). With respect to the term "smooth" as used in claim 1, the broadest reasonable meaning of the term in ordinary usage is defined in the dictionary as "having a continuously even surface: being without roughness, points, bumps or ridges, esp. to the touch".³ This is consistent with the "enlightenment" provided in appellants' specification, which states at page 2, second paragraph that "A substantially smooth transition face between the protrusion and the needle of this invention is obtained since the transition between the various parts of the protrusion is circular".

³Webster's Third New International Dictionary (1971). "Even" is defined as being "without break, indentation, roughness, or other irregularity", with "smooth" being listed as a synonym.

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In light of this definition, the transition between Chevalier's protrusion 24 and the needle shaft 11 is not "smooth in all directions", as required in claim 1. In particular, as shown in Figure 5, the transition between the protrusion 24 and the shaft 11 at the right-hand side 47 of the protrusion is a 90° corner, which is not a continuously even surface and therefore would not meet the definition of "smooth".

The examiner also seems to indicate that the apparatus shown in Figure 1 of Chevalier may constitute an anticipation. In this apparatus, indicated as prior art, the protrusion 44 is disclosed as being "a drop of silver solder on the barrel of the needle" (col. 3, lines 29 and 30). This disclosure does not anticipate the claims, however, because claim 1 requires that the protrusion be formed as part of the hollow shaft portion of the needle, whereas Chevalier's drop of solder is separately applied to the shaft. Also, it does not appear, or is at best speculative, that the transition from the drop of solder to the shaft of the needle would be "smooth in all directions", given the definition of "smooth" discussed above. Since Chevalier does not disclose,

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expressly or inherently, all of the limitations recited in claim 1, and claims 2 to 5 are dependent on claim 1, the rejection under 35 USC § 102(b) of claims 1 to 5 will not be sustained.

Conclusion

The examiner's decision to reject claims 1 to 5 is reversed.

Reversed

IAN A. CALVERT)	
Administrative Patent Judge)	
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IRWIN CHARLES COHEN)	BOARD OF PATENT
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