

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY W. MORSE

Appeal No. 97-1030
Application 08/368,261¹

ON BRIEF

Before MEISTER, ABRAMS and NASE, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner refusing to allow claims 1 through 9 as amended after the final rejection. These are all of the claims of record in the application.

The appellant's invention is directed to a cap, apparatus and method for wound and lavage irrigation. The subject matter

¹ Application for patent filed December 27, 1994.

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before us on appeal is illustrated by reference to claims 1, 4 and 7, which can be found in an appendix to the appellant's Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Schwartz	4,421,505	Dec. 20, 1983
Hyans	4,459,318	Jul. 10, 1984
Kensey et al. (Kensey)	5,380,275	Jan. 10, 1995

(filed Apr. 23, 1993)

THE REJECTIONS

Claims 1, 4 and 7 stand rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Kensey.

Claims 5 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kensey in view of Schwartz.

Claims 2, 3, 6 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kensey in view of Hyans.

The rejections are explained in the Examiner's Answer and Paper No. 5.

The opposing viewpoints of the appellant are set forth in the Brief.

OPINION

The Rejection Under 35 U.S.C. § 102(e)

Independent claims 1, 4 and 7 stand rejected as being anticipated by Kensey. It is axiomatic that anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See *In re Paulsen*, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

Kensey discloses a device for irrigating a body orifice. It comprises a threaded cap having threads at one end for attachment to a container and a nozzle at the other end which attaches to a conduit (Figure 1). The appellant argues that the claim requires that the nozzle have the size and shape of a syringe tip such that it can friction fit inside the hub of a standard IV catheter,² and that such is not taught by Kensey. The examiner's

² From the appellant's specification (page 9) and the arguments in the Brief (page 6), we understand that there is a conventional or "standard" IV catheter in the field, which has a "luer" hub. We further note that "standard" appears as a modifier for "IV catheter" in all of the claims except claim 1, but we shall interpret claim 1 in the same fashion because it is our belief that the appellant so intended. However, we suggest that consideration be given to adding this term to claim 1, also.

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position is that this limitation "does not patentably distinguish over the prior art of record" (Answer, page 3). We do not agree. From our perspective, the size and shape requirement constitutes a structural limitation of the claim which must be present in order for a reference to be anticipatory. The size and shape of the inlet to tube 78 cannot be determined from the Kensey disclosure, much less that it corresponds to that of a "standard" IV catheter hub.

Therefore, Kensey does not anticipate the subject matter of claims 1, 4 and 7.

The Rejections Under 35 U.S.C. § 103

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). However, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Claims 5 and 8 stand rejected as being obvious in view of the teachings of Kensey and Schwartz. As we stated above, Kensey fails to teach that the nozzle on the cap be of such size and

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shape as to friction fit the inside of the hub of a standard IV catheter. To the extent that the examiner's comments are intended to mean he considers that it would have been obvious to modify Kensey so that the nozzle would meet this condition, we fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to do so. Schwartz was cited for its teaching of "the attachment of a tube/catheter to a fluid source for the purpose of irrigation" (Paper No. 5, page 3). Be that as it may, Schwartz does not, in our view, cure the deficiency present in Kensey, for it clearly does not disclose a "standard" IV catheter, nor does it suggest that such is usable with its irrigation apparatus. In fact, the opposite is true, for the catheter disclosed in Schwartz is a very specialized one.

The combined teachings of Kensey and Schwartz fail to establish a *prima facie* case of obviousness with regard to the subject matter of claims 5 and 8.

Claims 2, 3, 6 and 9 have been rejected on the basis of Kensey in view of Hyans, the latter being cited for its disclosure of a fill tube having a plurality of annular ridges for enhancing the security of connecting it to a tube (Figure 4). The claims in issue here contain the limitation regarding the fit

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of the nozzle with the hub of a standard IV catheter, which we have decided above is lacking in Kensey, and which we here state is also lacking in the secondary reference. These claims also require the presence of annular ridges on the nozzle, so that the claimed nasogastric tube can be attached over the nozzle. While Hyans discloses such ridges, the examiner has not articulated, nor can we discern on our own, any reason why one of ordinary skill in the art would have been motivated to add these ridges to the Kensey device as an adjunct to the existing nozzle, that is, add a second type of connection means.

For these two reasons, the references applied here fail to establish a *prima facie* case of obviousness with regard to the subject matter of claims 2, 3, 6 and 9.

SUMMARY

None of the rejections are sustained.

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The decision of the examiner is reversed.

REVERSED

JAMES M. MEISTER)	
Administrative Patent Judge))	
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NEAL E. ABRAMS)	BOARD OF PATENT
Administrative Patent Judge))	APPEALS AND
)	INTERFERENCES
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge))	

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