

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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDMUND DEL GUERCIO

Appeal No. 1999-2777
Application No. 08/985,835

ON BRIEF

Before FRANKFORT, PATE, and McQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 5 through 16, which are all of the claims remaining in this application. Claims 1 through 4 have been canceled.

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Appellant's invention relates to an external catheter adapted for attachment to the urethra of a patient, which is the canal through which urine is discharged from the bladder in most mammals, and to a method of attaching such an external catheter to the patient. Independent claims 5, 9, 12 and 13 are representative of the subject matter on appeal and a copy of those claims, as reproduced from the Appendix to appellant's brief, is attached to this decision.

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

Haq	5,331,689	Jul. 26,
1994		
Block	5,632,736	May 27,
1997		

Claims 9 through 11 and 13 through 16 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim

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that which appellant regards as the invention.¹

Claims 5, 7, 13 and 15 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Block.

Claims 8, 11 and 16 stand rejected under 35 U.S.C. § 103 as unpatentable over Block.

Claims 6, 9, 10, 12 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Haq in view of Block.

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the final rejection (Paper

¹ While the § 112, second paragraph, rejection was not expressly repeated in the examiner's answer, it is apparent from appellant's brief (Paper No. 15, pages 5 and 6-8) and the examiner's answer (Paper No. 16, page 2, item (6)) and the first paragraph of the answer under the heading "Response to Argument" (page 3) that this was merely an oversight and that the rejection is maintained by the examiner and contested by appellant. Thus, we will consider the rejection under 35 U.S.C. § 112, second paragraph, in this appeal.

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No. 5, mailed

September 2, 1998) and the examiner's answer (Paper No. 16, mailed May 21, 1999) for the examiner's reasoning in support of the rejections, and to appellant's corrected brief (Paper No. 15, filed May 6, 1999) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

We turn first to the examiner's rejection of claims 9 through 11 and 13 through 16 under 35 U.S.C. § 112, second paragraph. After reviewing appellant's specification and drawings, and the claims subject to this rejection in light thereof, it is our opinion that the scope and content of the

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subject matter embraced by claims 9 through 11 and 13 through 16 on appeal are reasonably clear and definite, and fulfill the requirements of 35 U.S.C. § 112, second paragraph. More particularly, we interpret the language in claims 9 through 11 and 13 through 16 relating to the size and shape of the spongy covering and the funnel shaped receiving end in light of appellant's specification and drawings, and conclude that one skilled in this art would have understood that the requirement in independent claim 13 that the funnel shaped receiving end be "dimensioned for immediate surrounding engagement with the urethra of the penis" means that the funnel shaped receiving end (44) is of a size to completely encompass the exit opening of the urethra of a given male patient and to engage an area of the penis immediately adjacent to the opening of the urethra, as seen in Figure 4 of appellant's drawings.

As for the requirement in independent claim 9 that the spongy covering attached to the funnel shaped end is "shaped so as to conform to the area immediately surrounding the urethra," we consider that the skilled artisan would have understood from appellant's disclosure that this means that

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the spongy covering is sized and shaped as explained on pages 4 and 6 of appellant's specification and as generally seen in Figure 3 of the drawings, in the instance of a given female patient, to cover and conform to an area immediately surrounding the urethra, including the clitoris, part of the vulva, the labia and possibly a short distance into the front of the vagina (e.g., of about 2 to 3 centimeters) and to not completely cover the vaginal opening. For a male patient, an artisan would understand that the spongy covering would be sized and shaped as seen in Figure 4 of appellant's drawings, i.e., with the spongy covering (48) sized and shaped to encompass the glans of the penis.

Given the foregoing and appellant's arguments on pages 7 and 8 of the brief, we will not sustain the examiner's rejection of appellant's claims 9 through 11 and 13 through 16 under 35 U.S.C. § 112, second paragraph.

We next look to the examiner's prior art rejections of the appealed claims, turning first to the rejection of claims

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5, 7, 13 and 15 under 35 U.S.C. § 102(e) as being anticipated by Block. Like appellant, we note that the Block patent expressly describes the apparatus therein as being an extra-labia urine voiding apparatus that includes a container (22) that is shaped and sized to "externally cover a vulval region of a female anatomy"

(col. 1, lines 32-34) and has a superior end (38) adapted to align generally with the mons Veneris of the female anatomy and an inferior end (40) adapted to align generally with the perineal region of the female anatomy (col. 3, lines 29-32). In addition, the apparatus of Block includes an extra-labia sealing structure (i.e., adhesive 24 and layer of resilient material 26) that extends generally around the perimeter of the open side of the container (22) and is adapted to provide a fluid tight seal or barrier between the container and the external tissue generally surrounding the vulva region (col. 1, lines 39-44). Block's apparatus also includes a conduit (28) adapted for draining fluid from the container (22).

Independent claim 5 on appeal defines a female external catheter for attachment to the urethra, including an

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attachment portion having a funnel shaped receiving end sized to encompass the urethra, a spongy covering attached to said funnel shaped receiving end for sealing the area immediately around the urethra, and a flow tube connected at one end to the funnel shaped receiving end. Claim 7, which depends from claim 5, adds a skin adhesive applied to the spongy covering for securing the spongy covering to the area immediately around the urethra and for providing a seal around the urethra. Independent claim 13 defines a male external catheter for attachment to the penis, including an attachment portion having a funnel shaped receiving end dimensioned for immediate surrounding engagement with the urethra of the penis, a spongy covering attached to said funnel shaped receiving end for sealing the area around the penis, and a flow tube connected at one end to the funnel shaped receiving end. Dependent claim 15 adds a skin adhesive applied to the spongy covering for securing the spongy covering around the penis and for providing a seal around the urethra.

Given our determinations supra regarding the proper interpretation of the limitations in appellant's claims

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relating to the size and shape of the spongy covering and the funnel shaped receiving end of the external catheter, and appellant's arguments on pages 9 and 10 of the brief, it is apparent to us that the extra-labia urine voiding apparatus of Block which covers essentially all of the genitalia of the female and the sealing structure thereof which provides a seal against the external tissue surrounding the vulva region is not anticipatory of the external catheter for attachment to the urethra defined in appellant's claims 5, 7, 13 and 15 on appeal. Specifically, even if the apparatus of Block which covers all of the female genitalia can be said to include a funnel shaped receiving end (e.g., 22) that is broadly sized to encompass or contain the urethra, it is clear to us that the urine voiding apparatus of Block does not include a spongy covering attached to the funnel shaped receiving end for sealing the area "immediately around the urethra," as set forth in independent claim 5 on appeal. As for independent claim 13 on appeal, we note that the apparatus of Block is not a male external catheter and does not include an attachment portion having "a funnel shaped receiving end dimensioned for immediate surrounding engagement with the urethra of the

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penis," or which is capable of any such "immediate surrounding engagement with the urethra of the penis." It follows from these determinations that the apparatus of Block also does not anticipate the external catheter as further defined in appellant's dependent claims 7 and 15. Accordingly, the examiner's rejection of claims 5, 7, 13 and 15 under 35 U.S.C. § 102(e) based on Block will not be sustained.

We next consider the examiner's rejection of claims 8, 11 and 16 under § 103 as being unpatentable over Block. Even if it would have been obvious to one of ordinary skill in the art to make the flow tube (28) of Block of polyvinyl chloride, as is urged by the examiner, the external catheter of claim 8, which depends from claim 5, and the external catheter of claim 16, which depends from claim 13, would still have been unobvious given our determinations with regard to the respective independent claims 5 and 13. As for claim 11, this claim depends from independent claim 9, which was not rejected by the examiner based on Block alone. However, we note that the subject matter defined in claim 11, via its dependency from

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claim 9, includes a spongy covering attached to the funnel shaped receiving end that is "shaped so as to conform to the area immediately surrounding the urethra," which structure is not taught or suggested in Block. Thus, the examiner's rejection of dependent claims 8, 11 and 16 under 35 U.S.C. § 103 based on Block will also not be sustained.

The last of the examiner's rejections for our review is that of claims 6, 9, 10, 12 and 14 under 35 U.S.C. § 103 as being unpatentable over Haq in view of Block. In this instance, it is the examiner's view that it would have been obvious to one of ordinary skill in the art to replace the urine receiving member (22) of Haq with the urine collection device of Block so that better sealing of the device against the body of the user could be obtained. Even if such a modification of the portable urinal of Haq were to be made, for the reasons already expressed above the resulting portable urinal would not render obvious appellant's claimed external catheter for attachment to the urethra as defined in claims 5, 6, 9, 10, 13 and 14 on appeal, or render obvious appellant's method claim 12 which utilizes the external catheter of claim

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9. Thus, the examiner's rejection of claims 6, 9, 10, 12 and 14 under 35 U.S.C. § 103 based on Haq in view of Block will not be sustained.

To summarize our decision, we note that 1) the examiner's rejection of claims 9 through 11 and 13 through 16 under 35 U.S.C. § 112, second paragraph, has not been sustained; 2) the examiner's rejection of claims 5, 7, 13 and 15 under 35 U.S.C. § 102(e) based on Block has not been sustained; 3) the rejection of appealed claims 8, 11 and 16 under 35 U.S.C. § 103 based on Block has not been sustained; and 4) the examiner's rejection of claims 6, 9, 10, 12 and 14 under 35 U.S.C. § 103 relying on Haq in view of Block has not been sustained.

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Accordingly, the decision of the examiner rejecting
claims 5 through 16 on appeal is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
WILLIAM F. PATE III))
Administrative Patent Judge)	APPEALS AND
)	
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CLAIM 5

A female external catheter for attachment to the urethra comprising:

an attachment portion for engagement with the urethra, said attachment portion having a funnel shaped receiving end sized to encompass the urethra:

a spongy covering attached to said funnel shaped receiving end for sealing the area around the urethra;

an adhesive for securing said spongy covering to the area around the urethra, said adhesive providing a seal around the urethra; and

a flow tube having two ends, said flow tube connected at one end to said funnel shaped receiving end.

CLAIM 9

An external catheter for attachment to the urethra comprising:

a flow tube having a first and second end, said flow tube

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at the first end being funnel shaped;

a spongy covering attached to said funnel shaped end,
said spongy covering being shaped so as to conform to the area
surrounding the urethra;

a skin adhesive for securing said spongy covering to the
area surrounding the urethra; and

collection means connected to said second end of said
flow tube.

CLAIM 12

A method of attaching an external catheter comprising the
steps of:

selecting the catheter of claim 9;

applying a skin adhesive to the spongy portion of the
catheter;

positioning the spongy portion about the urethra;

pressing the spongy portion firmly about the urethra; and

allowing the adhesive to firmly set.

CLAIM 13

A male external catheter for attachment to the penis
comprising:

an attachment portion for engagement with the penis said

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attachment portion having a funnel shaped receiving end;

a spongy covering attached to said funnel shaped receiving end for sealing the area around the penis;

an adhesive for securing said spongy covering to the area around the penis said adhesive providing a seal around the penis; and

a flow tube having two ends, said flow tube connected at one end to said funnel shaped receiving end.