

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(2) is not binding precedent of the Board.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 DANIEL H. OLSON

Appeal No. 96-1819
Application 08/112,151¹

ON BRIEF

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

MEISTER, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 8-10,
the only claims remaining in the application.

¹Application for patent filed August 26, 1993. According to Appellant, this application is a continuation of application SN 07/896,078, filed Jun. 03, 1992, now US Patent no. 5,275,585, issued Jan. 04, 1994.

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The appellant's invention pertains to a system for collecting blood and other liquids from the wound of a patient and for reinfusing collected blood back into the patient. Independent claim 10 is further illustrative of the appealed subject matter and a copy thereof may be found in the appendix to the appellant's brief.

The references relied on by the examiner are:

Marx	4,573,992	Mar. 04, 1986
Choksi et al. (Choksi)	5,074,839	Dec. 24, 1991

Claims 8-10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Marx in view of Choksi.

The examiner's rejection is explained on pages 2 and 3 of the answer. The arguments of the appellant and the examiner in support of their respective positions may be found on pages 2-5 of the brief and page 4 of the answer.

OPINION

We have carefully reviewed the appellant's invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellant in the brief and by the examiner in the answer. As a consequence of this review we will (1) reverse the rejection of claims 8-10 under 35 U.S.C. § 103, (2) enter a new rejection

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of claims 8 and 10 under 35 U.S.C. § 112, first paragraph, and (3) enter new rejections of claims 8-10 under 35 U.S.C. § 112, second paragraph.

Considering first the rejection of claims 8-10 under 35 U.S.C. § 103 based on the combined teachings of Marx and Choski, we have carefully considered the subject matter defined by these claims. However, for reasons stated *infra* in our new rejections entered under the provisions of 37 CFR § 1.196(b) no reasonably definite meaning can be ascribed to certain language appearing in the claims. In comparing the claimed subject matter with the applied prior art, it is apparent to us that considerable speculations and assumptions are necessary in order to determine what in fact is being claimed. Since a rejection on prior art cannot be based on speculations and assumptions (*see In re Steele*, 305 F.2d 859, 862-63, 134 USPQ 292, 295-96 (CCPA 1962) and *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)), we are constrained to reverse the examiner's rejection of claims 8-10 under 35 U.S.C. § 103. We hasten to add that this is a procedural reversal rather than one based upon the merits of the § 103 rejection.

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Under the provisions of 37 CFR § 1.196(b) we make the following new rejections.

Claims 8 and 10 are rejected under 35 U.S.C. § 112, second paragraph. In order to satisfy the second paragraph of § 112, a claim must accurately define the invention in the technical sense. *See In re Knowlton*, 481 F.2d 1357, 1366, 178 USPQ 486, 492-93 (CCPA 1973). Moreover, while the claim language of claims 8-10 may appear, for the most part, to be understandable when read in abstract, no claim may be read apart from and independent of the supporting disclosure on which it is based. *See In re Cohn*, 438 F.2d 989, 993, 169 USPQ 95, 98 (CCPA 1971). Applying these principles to the present case, we fail to understand how (as claim 8 expressly requires) the system can be considered as

being connectable in a **second mode** wherein said manually operable vacuum source is disconnected and disassociated from the collecting means, the interstitial space being in flow communication with ambient atmosphere and said outlet port adapted for connection to transfusion tubing, in the **second mode** the manually operable vacuum source is adapted for direct connection to said drainage tubing and **is activated** to draw fluid from said wound into the manually operable vacuum source. [Emphasis ours.]

Thus, in the **same** "second mode" the appellant has set forth that, on the one hand, the vacuum source is "disconnected and disasso-

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ciated" with the collecting means and the outlet port is adapted for connection to the transfusion tubing but, on the other hand, this same vacuum source is adapted for direct connection to the drainage tubing and "is activated" to draw fluid from the wound. How can a vacuum source that is "disconnected and disassociated" be "activated" to draw fluid from the wound? This is simply inaccurate on its face. That is, the vacuum source 14 is neither "adapted for" direct connection to drainage tubing 68 nor "activated" to draw blood when it (1) is "disconnected and disassociated" from the collecting means and (2) the outlet port is "adapted for connection to transfusion tubing."

Similarly, we fail to understand how (as claim 10 expressly requires) the system can be considered as

being connectable in a **second mode** wherein the interior of the collecting means is in flow communication with abient [sic, ambient] atmosphere and said outlet port adapted for connection to transfusion tubing, the manually operable portable vacuum source is adapted for direct connection to said drainage tubing and **is activated** to draw fluid from said wound into the manually operable vacuum source. [Emphasis ours.]

Thus, in the **same** "second mode" the appellant has set forth that, on the one hand, the outlet port is adapted for connection to the transfusion tubing but, on the other hand, the vacuum source is

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adapted for direct connection to the drainage tubing and "is activated" to draw fluid from the wound. This is simply inaccurate on its face. That is, the vacuum source 14 is neither "adapted for" direct connection to drainage tube 68 nor "activated" to draw blood when the outlet port is "adapted for connection to transfusion tubing."

In contradistinction to what is being claimed, the appellant has actually disclosed three separate and distinct modes of operation. A first mode, depicted in Figs. 1 and 4-6, wherein the vacuum source 14 is in flow communication with the interior of the collecting means so as to draw blood from the wound of a patient. A second mode, depicted in Fig. 3, wherein (1) the vacuum source 14 is completely disconnected and disassociated from the collecting means, (2) the interior of the collection means is in fluid communication with ambient atmosphere via airway 24 and (3) the outlet port is connected to transfusion tubing 74. A third mode, depicted in Fig. 2 wherein the vacuum source 14 is (1) adapted for direct connection to drainage tube 68 via male connector 50 and (2) activated to draw fluid from the wound of a patient.

In view of the foregoing, it is readily apparent that the language in claims 8 and 10, when read in light of the

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specification, results in an inexplicable inconsistency that renders them indefinite.

Claim 9 is rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention. This claim depends on **canceled** claim 1 (i.e., a non-existent claim) and it is thus unclear what subject matter the appellant intended to cover.

Claims 8 and 10 are rejected under 35 U.S.C. § 112, first paragraph, as being directed to an nonenabling disclosure. There is no disclosure of an embodiment having a "second mode" wherein, on the one hand, the vacuum source is "disconnected and disassociated" with the collecting means and the outlet port is adapted for connection to the transfusion tubing but, on the other hand, this same vacuum source is adapted for direct connection to the drainage tubing and "is activated" to draw fluid from the wound. Similarly, there is no disclosure of an embodiment having a "second mode" wherein, on the one hand, the outlet port is adapted for connection to the transfusion tubing but, on the other hand, the vacuum source is adapted for direct connection to the drainage tubing and "is activated" to draw fluid from the wound as claim 10 sets forth.

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In summary:

The examiner's rejection of claims 8-10 under 35 U.S.C. § 103 is reversed.

New rejections of claims 8-10 have been made under 35 U.S.C. § 112, second paragraph.

A new rejection of claims 8 and 10 has been made under 35 U.S.C. § 112, first paragraph.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

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(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED

37 CFR § 1.196(b)

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