

**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(2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte RONALD B. LUTHER

---

Appeal No. 97-0773  
Application 08/101,391<sup>1</sup>

---

ON BRIEF

---

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

**DECISION ON APPEAL**

---

<sup>1</sup> Application for patent filed August 2, 1993. According to appellant, this application is a continuation of Application 07/856,754, filed March 24, 1992; which is a division of Application 07/669,679, filed March 14, 1991, now U.S. Patent 5,112,312.

Appeal No. 97-0773  
Application No. 08/101,391

This is an appeal from the decision of the examiner finally rejecting claims 23-28, which constitute all of the claims remaining of record in the application.

The appellant's invention is directed to a vascular access system. The subject matter before us on appeal is illustrated by reference to claim 23, which reads as follows:

23. A vascular/venous access system comprising:

(a) a flexible catheter having a distal end, a proximal end, and an axial bore extending therethrough, said catheter being configured for use in central applications; and

(b) a needle cannula disposed within the bore adjacent the distal end of the catheter with the sharp end of the needle cannula extending outwardly beyond the distal end of the catheter and the opposite end of the needle cannula extending through the wall of the catheter between the distal end and proximal end of the catheter.

#### **THE REFERENCES**

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

Guttman	3,225,762	Dec. 28, 1965
Monestere, Jr. et al. (Monestere)	3,915,168	Oct. 28, 1975
Vaillancourt	4,205,675	Jun. 3, 1980
Vaillancourt	4,863,431	Sep. 5, 1989

Appeal No. 97-0773  
Application No. 08/101,391

### THE REJECTIONS

Claims 23-28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Guttman in view of Monestere, Vaillancourt '675 and Vaillancourt '168.<sup>2</sup>

The rejections are explained in the Examiner's Answer.

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

### OPINION

In reaching our decision on the issues raised in this appeal, we have carefully assessed the claims, the prior art applied against the claims, and the respective views of the examiner and the appellant as set forth in the Answer and the Briefs. As a result of our review, we have determined that the rejection should be sustained. Our reasoning in support of this conclusion follows.

In the case of a Section 103 rejection, the examiner bears the initial burden of presenting a *prima facie* case of obviousness (see *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)), which is established when the

---

<sup>2</sup>An obviousness-type double patenting rejection was overcome by the filing of a terminal disclaimer (Paper No. 12).

Appeal No. 97-0773  
Application No. 08/101,391

teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art (see *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993))). This is not to say, however, that the claimed invention must expressly be suggested in any one or all of the references, rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art (see *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025, 226 USPQ 881, 886-87 (Fed. Cir. 1985)), considering that a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference (see *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)), with skill being presumed on the part of the artisan, rather than the lack thereof (see *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985)). Insofar as the references themselves are concerned, we are bound to consider the disclosure of each for what it fairly teaches one of ordinary skill in the art, including not only the specific teachings, but also the inferences which one of ordinary skill in the art would reasonably have been expected to draw therefrom

Appeal No. 97-0773  
Application No. 08/101,391

(see *In re Boe*, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966) and *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968)).

Claim 1 is directed to "[a] vascular/venous access system" comprising a flexible catheter having an axial bore therethrough and "configured for use in central applications," and a needle cannula disposed within the bore adjacent to the distal end of the catheter with a sharp end extending beyond the distal end of the catheter and the opposite end extending through the wall of the catheter between the distal and the proximal ends. It is the examiner's position that Guttman discloses all of the structure recited in claim 1, except for the hollow needle, a feature which would have been obvious to add in view of the teachings of Monestere. Insofar as claim 1 is concerned, the thrust of the appellant's arguments is that the Guttman catheter is not "configured for use in central applications," which require a much greater length than catheters not intended for such use, and that Guttman has a hub, which limits its length so that it can be used only in peripheral applications.

Guttman certainly discloses a "vascular/venous access system." In the embodiment shown in Figure 5, this system comprises a flexible catheter 31 having a distal end and a

Appeal No. 97-0773  
Application No. 08/101,391

proximal end, and an axial bore extending therethrough, as required by claim 1. A needle 10 is disposed within the bore of the catheter adjacent the distal end with its sharp end 11 extending outwardly beyond the distal end and its opposite end extending through a slit 33 in the wall of the catheter between the distal end and the proximal end. As is the case in the appellant's invention, intravenous access is gained by means of the sharp end of the needle, which is then withdrawn so that the catheter can be advanced.

We agree with the examiner that claim 23 does not distinguish over Guttman insofar as the "central applications" limitation is concerned. An object of the Guttman invention is to provide an intravenous catheter "which may be of any desired length" (column 1, lines 39-41), and with regard to the embodiment of Figure 5 the patentee states in column 2, lines 62-65 that

[t]his embodiment of this invention allows the insertion of a catheter of any length desired. The length of the catheter is no longer limited by the stylet 10 or other device used to insert it.

From our perspective, this would have indicated to one of ordinary skill in the art that the Guttman catheter is not limited to peripheral applications, as argued by the appellant, but also is capable of being used in applications wherein a

Appeal No. 97-0773  
Application No. 08/101,391

longer length of catheter is required, which would be the case in central applications. In this regard, we find no recitation in the Guttman patent which would suggest to the artisan that its use is restricted to peripheral applications, nor has the appellant provided evidence which would support such a position.

The fact that Guttman discloses a hub on the proximal end of the catheter does not negate the above conclusion. It is our opinion that one of ordinary skill in the art, having been taught by Guttman that the catheter can be of "any length desired," would have understood that the hub must be located a sufficient distance from the distal end of the catheter as not to foreclose inserting the "length desired" into the vascular system. Thus, the mere fact that the Guttman catheter is equipped with a hub does not mean that it is limited to peripheral applications.

Guttman discloses a boreless needle 11 installed in the distal end of the catheter, whereas claim 1 requires that the needle be a cannula. However, at the time of the appellant's invention it also was known to utilize cannulae for this purpose, as evidenced by Monestere and Vaillancourt '675. It is our view that one of ordinary skill in the art would have found it obvious to replace the boreless needle of Guttman with a cannula, for the well-known advantage of allowing flashback to a flash chamber as

Appeal No. 97-0773  
Application No. 08/101,391

an indication that access has been achieved, which would have been known to the artisan (see, for example, Monestere, column 2, line 56 *et seq.*).

For the reasons expressed above, it is our opinion that the teachings of the applied references establish a *prima facie* case of obviousness with regard to the subject matter of independent claim 23.

The appellant has taken the position that the subject matter of dependent claims 24 and 26-28 is patentable over the prior art relied upon "based upon the length of the catheter being sufficient to facilitate use in central applications" (Brief, page 5). As explained above, it is our opinion that this requirement does not patentably distinguish over Guttman. This being the case, we also will sustain the rejection of claims 24 and 26-28.

Claim 25 was separately argued. It requires that the length of the catheter inserted into a patient "is not limited by a hub so as to facilitate use in central applications." The appellant's position is that this claim is not rendered obvious by the applied prior art "based upon the omission of a hub" (Brief, page 4). However, the language recited in the claim does not omit a hub from the catheter, but requires that the catheter

Appeal No. 97-0773  
Application No. 08/101,391

not be "limited" by a hub. As we explained above, we believe one of ordinary skill in the art would have recognized that a hub on the catheter must not be placed so close to the distal end as to inhibit the catheter from being inserted to the length desired. Therefore, this requirement of claim 25 would have been *prima facie* obvious, and the rejection of this claim is sustained.

The decision of the examiner is affirmed.

AFFIRMED

Irwin Charles Cohen	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
Neal E. Abrams	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
Lawrence J. Staab	)	
Administrative Patent Judge	)	

Appeal No. 97-0773  
Application No. 08/101,391

Stetina and Brunda  
24221 Calle De La Louisa, Ste. 401  
Laguna Hills, CA 92653