

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TREVOR J. POWLES, MIR A. IMRAN,
DEEPAK GANDHI and BABER R. SYED

Appeal No. 97-4459
Application No. 08/421,063¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge,
McQUADE and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 4. Claims 5 through 7 have been allowed. Claims 8 through 16 have been withdrawn from consideration under 37 CFR § 1.142(b) as being drawn to a nonelected invention.

¹ Application for patent filed April 13, 1995.

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Application No. 08/421,063

We REVERSE.

BACKGROUND

The appellants' invention relates to an aspiration needle. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' brief.

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

Luther et al. (Luther) 1988	4,762,516	Aug. 9,
Sundberg 1996	5,494,044	Feb. 27,
	(effectively filed Dec. 23,	
1991)		
Suzuki et al. (Suzuki) 1996	5,520,193	May 28,
		(filed Feb. 22,
1994) ²		

² According to the appellants, this application is a continuation-in-part of Application No. 08/228,551, filed April 15, 1994, which was continuation-in-part of Application No. 08/049,998, filed April 20, 1993. We note, however, that the appellants have not argued that these prior applications are sufficient under 35 U.S.C. § 120 to remove Suzuki as prior art.

Claims 1 through 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sundberg in view of Suzuki.

Claims 1 through 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sundberg in view of Suzuki and Luther.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 9, mailed November 8, 1996) and the examiner's answer (Paper No. 18, mailed July 8, 1997) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 17, filed April 15, 1997) and reply brief (Paper No. 19, filed September 17, 1997) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the

respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejections of claims 1 through 4 under 35 U.S.C. § 103. Our reasoning for this determination follows.

Before addressing the examiner's rejections based upon prior art, it is an essential prerequisite that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art under 35 U.S.C. §§ 102 and 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. First, claim interpretation must begin with the language of the claim itself. See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988). Second, claims are to be construed in the light of the specification and both are to be read with a view to ascertaining the invention. United States v. Adams, 383 U.S. 39, 49, 148 USPQ 479, 482 (1966).

Accordingly, we will initially direct our attention to appellants' claim 1 to derive an understanding of the scope and content thereof.

Claim 1 recites an aspiration needle comprising, inter alia, (1) a rigid elongate tubular member having a bore and an opening at the distal extremity in communication with the bore, (2) a body secured to the proximal extremity of the tubular member and having a cell collection chamber therein and a hub proximal of the cell collection chamber for receiving a source of vacuum, and (3) the body having an enlarged portion adjacent the proximal extremity of the tubular member **permitting** magnified viewing of the cell collection chamber.

The term **permitting** in the context as used in claim 1 is capable of two distinct meanings. The first is that the enlarged portion provides magnified viewing of the cell collection chamber. The second is that the enlarged portion allows magnified viewing of the cell collection chamber

(e.g., the enlarged portion is transparent to allow magnified viewing of the cell collection chamber by other means.

The specification at page 24, lines 15-23, provides support for the body having an enlarged portion adjacent the proximal extremity of the tubular member permitting magnified viewing of the cell collection chamber. The specification states that body 241 (shown in Figure 18) is provided with an enlarged spherical portion 261 which serves as a convex lens which provides magnification of the interior of the conical chamber 246 so as to make it possible to readily envision when aspirate is drawn through the tubular member 232 into the conical chamber 246. The specification provides no support that the enlarged portion is transparent to allow magnified viewing of the cell collection chamber by other means.

For consistency with the above-noted disclosure and the argument raised by the appellants in their brief and reply brief that the claimed magnified viewing caused by the enlarged portion is not taught or suggested by the applied prior art, we interpret the claimed limitation that the body

has "an enlarged portion adjacent the proximal extremity of the tubular member permitting magnified viewing of the cell collection chamber" to mean that the body has an enlarged portion adjacent the proximal extremity of the tubular member **providing** magnified viewing of the cell collection chamber. Thus, the enlarged portion must magnify the cell collection chamber.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Furthermore, the conclusion that the claimed subject matter is obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being

interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

With this as background, we analyze the prior art applied by the examiner in the rejection of the claims on appeal.

Figures 4 and 5 of Sundberg are diagrammatic side views of a sampling device illustrating the device during suction and pressure strokes, respectively. The sampling device is intended to take out a sample of a cell-containing amniotic fluid from an amniotic cavity by penetrating the wall of the amniotic cavity by means of a hollow needle or cannula and extracting a volume of cell-containing amniotic fluid therethrough. The sampling device includes (1) a syringe having a cylinder 10, a piston 11, a piston rod 12, a cone 14

and a cylinder chamber 13 having a volume which may be changed by displacing the piston 11, (2) a standard needle 15, and (3) a filtering unit 25 having a housing 26 with an outwardly extending socket 27 for receiving the cone 14 of the syringe cylinder 10 and an oppositely directed cone 28 for mounting the needle 15 thereon. A plate or disc-like filtering member 17 is arranged within the housing 26 so as to be freely movable between a first position in which the filtering member is in abutting engagement with an inner annular shoulder formed in the housing 26 (Figure 5) and an open position in which the filtering member is in abutting engagement with spacer members 29 projecting into the housing from an inner wall part adjacent to the socket 27 (Figure 4).

Suzuki discloses a needle assembly for evacuated blood collection tubes or containers. As shown in Figure 15, the needle assembly includes (1) a needle 15, (2) a translucent or transparent resinous cover or support 16, and (3) a rubber cap 18. A hole 14 is made at the middle portion of the needle 15 and a middle hollow portion 17 is provided in the support 16. Suzuki teaches (column 6, lines 16-19) that when the end tip

of the needle 15 correctly enters the vein of a blood examinee, blood flows into the middle hollow portion 17 of the transparent support 16, so that the correct insertion of the needle can be confirmed with unaided eyes.

Luther discloses an assembly of a needle and a device for protecting the needle tip. As shown in Figure 1, the assembly 10 includes a rectangular, elongate housing 11 of clear plastic and a needle 22. Luther teaches (column 1, lines 63-66) that the clear plastic enables flashback to be readily observed and that the housing includes a magnification portion 13 to better enable viewing blood flashback.

Rejection based on Sundberg and Suzuki

We will not sustain the examiner's rejection of claims 1 through 4 under 35 U.S.C. § 103 as being unpatentable over Sundberg in view of Suzuki for the following reason.

The combined teachings of Sundberg and Suzuki fail to teach or suggest providing Sundberg's body (i.e., housing 26)

with an enlarged portion **providing** magnified viewing of the cell collection chamber (i.e., the interior of housing 26). It is our opinion that the examiner's view (answer, p. 4) that Suzuki's teaching of a transparent cover or support 16 "would result in a relative change in magnification" is pure conjecture without any support. Thus, the combined teachings of Sundberg and Suzuki would not have suggested the claimed invention. Accordingly, the decision of the examiner to reject claims 1 through 4 under 35 U.S.C. § 103 as being unpatentable over Sundberg in view of Suzuki is reversed.

Rejection based on Sundberg, Suzuki and Luther

We will not sustain the examiner's rejection of claims 1 through 4 under 35 U.S.C. § 103 as being unpatentable over Sundberg in view of Suzuki and Luther for the following reason.

The combined teachings of Sundberg, Suzuki and Luther fail to teach or suggest providing Sundberg's body (i.e., housing 26) with an enlarged portion **providing** magnified

viewing of the cell collection chamber (i.e., the interior of housing 26). It is our opinion that combined teachings would have only suggested modifying the cylinder 10 of Sundberg's syringe to include a magnification portion. We see no reason in the applied prior art why one skilled in the art would provide Sundberg's housing 26 with a magnification portion. Thus, the combined teachings of Sundberg, Suzuki and Luther would not have suggested the claimed invention. Accordingly, the decision of the examiner to reject claims 1 through 4 under 35 U.S.C. § 103 as being unpatentable over Sundberg in view of Suzuki and Luther is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 4 under 35 U.S.C. § 103 is reversed.

REVERSED

HARRISON E. McCANDLISH, Senior)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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APPLICATION NO. 08/421,063

APJ NASE

SAPJ McCANDLISH

APJ McQUADE

DECISION: **REVERSED**

Prepared By: Delores A. Lowe

DRAFT TYPED: 13 Jul 98

FINAL TYPED: