

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. 78

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte STEVEN C. JEPSON, THOMAS E. DUDAR,  
BRIAN D. DZEB and VINCENT C. DESECKI

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Appeal No. 1999-0757  
Application No. 08/699,083

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ON BRIEF

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Before CALVERT, ABRAMS, and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Steven C. Jepson et al. appeal from the final rejection of claims 17 through 19, 32, 36 and 39 through 44. Claims 27 and 28, the only other claims pending in the application, stand allowed.

This is the appellants' third appeal to this Board involving the claimed subject matter. The first appeal (Appeal No. 93-2729) was taken in grandparent Application 07/639,773, filed January 10, 1991, and resulted in a decision (Paper No. 42) sustaining the examiner's rejections. The second appeal (Appeal

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No. 96-2889) was taken in parent Application 08/183,110, filed January, 18, 1994, but was terminated before decision due to the express abandonment of the application.

#### THE INVENTION

The invention relates to "two-part coupling members with a first part including a pre-slit septum and a second part including a blunt cannula. The pre-slit septum slidably receives the blunt cannula to effect the coupling" (specification, page 1). A copy of appealed claims 17 through 19, 32, 36 and 39 through 44 appears in the appendix to the appellants' brief (Paper No. 72).<sup>1</sup>

#### THE EVIDENCE

The items relied on by the examiner as evidence of obviousness are:

Garrett et al. (Garrett)	4,197,848	Apr. 15, 1980
Buehler	4,610,374	Sep. 9, 1986

The items relied on by the appellants as evidence of non-obviousness are:

The 37 CFR § 1.132 Affidavit of Thomas E. Dudar, filed January 18, 1994 (part of Paper No. 45; copy attached to the brief as Exhibit C).

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<sup>1</sup> The recitation in claims 32 and 42 that the distal end region of the tube extends beyond the "injection site" appears to be inconsistent with the underlying disclosure which seems to indicate that the distal end region extends beyond the pre-slit sealing means of the injection site, not the injection site itself.

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The 37 CFR § 1.132 Affidavit of Madonna J. Owen, filed September 26, 1994 (Paper No. 50; copy attached to the brief as Exhibit D).

The 37 CFR § 1.132 Affidavit of Maureen R. Tierney, filed September 26, 1994 (Paper No. 50; copy attached to the brief as Exhibit E).

The 37 CFR § 1.132 Affidavit of Elinor Barsony filed, September 26, 1994 (Paper No. 50; copy attached to the brief as Exhibit F).<sup>2</sup>

The 37 CFR § 1.132 Affidavit of Nancy Hallgren, filed September 26, 1994 (Paper No. 50; copy attached to the brief as Exhibit G).

The 37 CFR § 1.132 Affidavit of Tim Huston, filed September 26, 1994 (Paper No. 50; copy attached to the brief as Exhibit H).

#### THE REJECTION

Claims 17 through 19, 32, 36 and 39 through 44 stand rejected under 35 U.S.C. § 103 as being unpatentable over Garrett in view of Buehler.

Attention is directed to the appellants' brief (Paper No. 72) and the examiner's answer (Paper No. 73) for the respective positions of the appellants and the examiner with regard to the merits of this rejection.

#### DISCUSSION

Garrett pertains to an irrigation site in a urinary drainage system. The site 30 includes a resilient latex membrane 42 having a normally closed, resiliently deformable slit 56 extending therethrough. As described by Garrett,

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<sup>2</sup> The Barsony "affidavit" has not been executed, i.e., sworn and subscribed to before a notary public.

FIGS. 2 and 4 illustrate slit 56 in a closed position. While in the closed position, membrane 42 prevents entry of air into the urinary drainage system. FIG. 3 illustrates slit 56 in a deformed position in which blunt end [58] of syringe 60 protrudes therethrough. In such condition, slit 56 closes about blunt end 58 to prevent entry of air into the urinary drainage system.

While blunt end 58 protrudes through membrane 42, irrigating fluid in syringe 60 may be introduced into the urinary drainage system . . . When blunt end [58] is withdrawn from membrane 42, slit 56 will close upon itself immediately, thereby continuing to protect the urinary drainage system from unnecessary contamination [column 5, lines 1 through 18].<sup>3</sup>

Buehler discloses a system for separately storing flowable materials and mixing them together just prior to use. The system includes a first container 10 having a dispensing member 28 and a second container 12 having a closure disc 56 which is adapted to be pierced by the dispensing member to allow the material in the first container to flow into and mix with the material in the second container. As shown in Figures 2 and 4, the dispensing member 28 has an interior flow passage 32, an exterior cylindrical region and a distal end region including a tapered surface, a pair of apertures and a radiused tip.

In combining Garrett and Buehler to reject the appealed claims, the examiner concludes that it would have been obvious at

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<sup>3</sup> Garrett is discussed on page 2 in the appellants' specification. The appellants state there that a blunt cannula of the type disclosed by Garrett will not pierce the skin of a user.

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the time the invention was made to a person having ordinary skill in the art "to have provided the cannula of the Garrett device with a tapered exterior surface, as taught by Buehler, in order to have allowed easier set-ups" (answer, page 3).

As to the proposed combination of Garrett and Buehler, the panel deciding the appeal in grandparent Application 07/639,773, agreed with the examiner that it would have been obvious in view of Buehler to provide the blunt-ended cannula disclosed by Garrett with a tapered distal end region to facilitate the insertion of the cannula into its associated injection site (see Paper No. 42, page 9). The question in this appeal, however, is whether the combined teachings of these references justify the rejection of the current claims which are amended, more specific versions of the claims in the first appeal.

Independent claim 17 now recites a cannula insertion member comprising, inter alia, a tube having (1) a central bore that extends throughout the entire length of the tube and terminates at an aperture that has substantially the same cross-sectional circumference as at least portions of the central bore, and (2) a distal end region defining the aperture in the distal end of the distal end region and including a tapered exterior surface. Garrett's blunt-ended syringe or cannula has such a central bore and aperture, but no tapered exterior surface on its distal end region. Although Buehler's dispensing member constitutes a

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cannula<sup>4</sup> having a tapered distal end region, its central bore does not terminate at an aperture having substantially the same cross-sectional circumference as at least portions of the bore.

Independent claim 32 now recites a cannula and injection site in combination comprising, inter alia, a blunt cannula having a tube with (1) a central bore that extends throughout the tube and terminates at an aperture and (2) a distal end region with a tapered surface and a blunt radiused tip that circumscribes the aperture. Garrett's cannula has a distal end region with a tip that circumscribes the aperture, but no tapered surface or radiused tip. Buehler's cannula has a distal end region with a tapered surface and a blunt radiused tip, but no aperture that is circumscribed by the blunt radiused tip.

Independent claim 36 now recites a cannula insertion member comprising, inter alia, a tube having a distal end region (1) defining at least one aperture in the distal end of the distal end region, and (2) including a tapered exterior surface and a radiused tip adjacent the tapered surface circumscribing and defining, at least in part, the at least one aperture. Garrett's cannula does not have a distal end region with a tapered exterior surface or a radiused tip. Buehler's cannula does not have an

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<sup>4</sup> Webster's New Collegiate Dictionary (G. & C. Merriam Co. 1977) defines a "cannula" as "a small tube for insertion into a body cavity or into a duct or vessel."

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aperture in the distal end of its distal end region or an aperture which is circumscribed and defined, at least in part, by a radiused tip.

Independent claim 41 now recites a cannula insertion member comprising, inter alia, a tube having a distal end region terminating in an aperture and including a blunt radiused tip and a tapered surface. Garrett's cannula does not have a distal end region with blunt radiused tip or a tapered surface. Buehler's cannula includes a distal end region having a blunt radiused tip and a tapered surface, but the distal end region does not terminate in an aperture.

Independent claim 42 now recites a cannula and injection site in combination comprising, inter alia, a blunt cannula having a tube with a distal end region having a tapered surface and defining an aperture at an extreme distal end thereof. Garrett's cannula does not have a distal end region with a tapered surface. Buehler's cannula has a distal end region with a tapered surface, but no aperture at the extreme distal end thereof.

The examiner has not cogently explained, nor is it apparent, how or why the combined teachings of Garrett and Buehler would have suggested the selective mix of the various prior art features necessary to arrive at the structure now specified by claims 17, 32, 36, 41 and 42. We are therefore constrained to

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conclude that the combined teachings of Garrett and Buehler do not establish a prima facie case of obviousness with respect to the subject matter recited in these claims.<sup>5</sup>

Accordingly, we shall not sustain the standing 35 U.S.C. § 103 rejection of claims 17, 32, 36, 41 and 42, of claims 18 and 19 which depend from claim 17, and of claims 39 and 40 which depend from claim 36, as being unpatentable over Garrett in view of Buehler.

Claims 43 and 44 recite a cannula and injection site. The appellants contend (see page 9 in the brief) that these claims require a cannula that includes an aperture defined by a blunt end and that can be used with the injection site so as to allow a septum to reseal upon removal of the cannula, and that neither Garrett nor Buehler teaches or suggests such structure either alone or in combination. Garrett, however, discloses this structure in the form of syringe 60 having blunt end 58 and injection site 30 having slit, resealable membrane or septum 42. In other words, the subject matter recited in claims 43 and 44 is anticipated by Garrett.

Lack of novelty, i.e., anticipation, is the ultimate or epitome of obviousness and cannot be rebutted by evidence of non-obviousness. In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569,

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<sup>5</sup> This being so, it is unnecessary to delve into the merits of the appellants' affidavit evidence of non-obviousness.

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571 (CCPA 1982). Thus, the appellants' affidavit evidence is of no moment here.

In this light, we shall sustain the standing 35 U.S.C. § 103 rejection of claims 43 and 44 as being unpatentable over Garrett in view of Buehler, Buehler in this instance being superfluous.

SUMMARY

The decision of the examiner to reject claims 17 through 19, 32, 36 and 39 through 44 is reversed with respect to claims 17 through 19, 32, 36 and 39 through 42, and affirmed with respect to claims 43 and 44.

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

AFFIRMED-IN-PART

IAN A. CALVERT	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
NEAL E. ABRAMS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JOHN P. McQUADE	)	
Administrative Patent Judge	)	

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