

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHUAN QIN, PARTRICK T. RYAN, DONNA L.
ROSTRON, BIRENDRA K. LAL, YUANPANG S. DING, SUSAN
R. MIZENER, LECOND WOO and MICHAEL T. K.
LING

Appeal No. 1999-2329
Application 08/642,278

ON BRIEF

Before CALVERT, STAAB, and BAHR, Administrative Patent Judges.
CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 10, all the claims in the application.¹

¹ An amendment after final rejection seeking to add claims 11 to 30 was denied entry by the examiner (Advisory Action, Apr. 10, 1998 (Paper No. 15)).

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The claims on appeal are drawn to a method for using medical tubing for infusing therapeutic fluids to a patient, and are reproduced in the appendix of appellants' brief. ²

The references applied in the final rejection are:

Fairchild et al. (Fairchild) 16, 1991	5,032,112	Jul.
Fanselow et al. (Fanselow) 1996	5,562,127	Oct. 8,

(Filed Jul. 18,
1995)

The appealed claims stand finally rejected on the following grounds:

(1) Claims 1 and 6 to 9, anticipated by Fanselow, under 35 U.S.C. § 102(e)³;

(2) Claims 10, unpatentable over Fanselow under either 35 U.S.C. § 102(e) or § 103(a);

(3) Claims 1 to 5, unpatentable over Fairchild in view

²References herein to appellants' brief are to the corrected brief filed on Nov. 9, 1998 (Paper No. 19).

³ Although the examiner states that the anticipation rejections were under § 102(b), it is evident that § 102(e) was intended, since the Fanselow patent is based on an application which was filed before, but issued after appellants' filing date.

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of Fanselow, under 35 U.S.C. § 103(a).

Rejection (3)

We will first consider the rejection of claims 1 to 5 under § 103(a). Since appellants have grouped these claims together

(brief, page 9), we select claim 1 from the group and will decide this ground of rejection based thereon. 37 CFR § 1.192(c)(7).

The examiner, after summarizing the disclosures of Fairchild and Fanselow, concludes on page 4 of the answer that:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the tubing in Fanselow et al. to the infusion pump, container, and clamp in Fairchild et al. in order to provide fluid to a patient because the tubing in Fanselow et al. is specifically designed to be used with infusion pumps and because it can survive the long term abrasion forces of infusion pumps and has high flexibility so that it can be formed into tight loops and bends which are important for delivery tube service.

The only arguments found in appellants' brief and reply brief in opposition to this ground of rejection are on page 15 of the brief, first and second full paragraphs, and in the

first full paragraph on page 9 of the reply brief. In essence, appellants' argument is that it would not have been obvious to use the oriented tubing disclosed by Fanselow in the method of Fairchild, because no example of Fanselow teaches orienting the tubing, and "The teaching of Fanselow is not to use the orienting step" (brief, page 16; similarly, reply brief, page 9).

This argument is not persuasive. The fact that oriented tubing is not used in Fanselow's examples is not determinative, since "All the disclosure in a reference, not just the specific examples, must be evaluated for what it fairly teaches those of ordinary skill in the art." In re Snow, 471 F.2d 1400, 1403, 176 USPQ 328, 329 (CCPA 1973). See also In re Burckel, 592 F.2d 1175, 1179, 201 USPQ 67, 70 (CCPA 1979) (all disclosures of the prior art, including unpreferred embodiments, must be considered in determining obviousness). Moreover, we do not agree with appellants that Fanselow teaches not to use oriented tubing. The Fanselow patent specifically discloses that the tubing of its invention may be used as medical tubing, such as in "intravenous (IV)

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fluid administration sets" (col. 14, lines 22 and 23), and that "when appropriate, the multilayered tubing according to the present invention can be uniaxially, biaxially or multiaxially oriented to further enhance its physical characteristics" (col. 12, lines 33 to 36). The orientation process is disclosed at col. 12, line 66 to col. 13, line 16, it being stated that orientation "preferably but not necessarily provides additional tensile strength to the tubing" (col.12 , line 67, to col. 13, line 1). Also, orientation can be used to form very small diameter tubes (col. 13, lines 13 to 16), and smaller size tubing is used in IV sets (col. 10, lines 44 and 45).

In view of these teachings of Fanselow, we consider that it would have been obvious to one of ordinary skill in the art to use the oriented tubing of Fanselow in the IV set of Fairchild. As noted above, Fanselow teaches the use of the tubing disclosed therein in IV sets, and contains no suggestion that this teaching does not include oriented

tubing.

Rejection (3) will therefore be sustained.

Rejection (1)

As the examiner notes at page 4 of the answer, appellants present no argument in the brief against the rejection of claims 1 and 6 to 9 under § 102(e) as anticipated by Fanselow. Appellants do not disagree, but assert on page 2 of their reply brief that their argument against the § 103 rejection of claim 1 is a "broader argument," such that "if claim 1 is not obvious in view of Fanselow et al. (alone or in combination with other references), as argued, than it cannot, by definition, be anticipated by Fanselow et al."

The converse of this assertion, namely, that if claim 1 is obvious in view of Fanselow under § 103 then it is anticipated by Fanselow under § 102, does not necessarily follow. However, since we have held above that claim 1 is obvious over Fairchild in view of Fanselow, and appellants have presented no other arguments as to why claim 1 is not anticipated by Fanselow, rejection (1) will be affirmed, both with respect to claim 1 and with respect to claims 6 to 9,

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which are grouped therewith (brief, page 9).

Rejection (2)

Claim 10 reads:

10. The method of claim 1 wherein the tubing has been heat set to maintain the oriented diameter during the use of the tubing.

The examiner does not point to a specific disclosure in Fanselow of heat setting the oriented tubing, but takes the position at pages 2 and 3 of the answer that:

It is inherent that after the tube is oriented, it will be heat set in order to maintain its new diameter during the use of the tubing. Claim 10 is a method of using a medical tube. Fanselow disclose a method of using a medical tube that is a polymeric blend, has been extruded, has been oriented, and then quenched or heat set, which would lock in the oriented diameter, see col. 12, line [?]. In the alternative, it would have been obvious to an ordinary person skilled in the art at the time the invention was made to heat set the oriented tube in Fanselow so that the oriented tube would not change diameter or shape.

We note initially that although the examiner seems to use "quenched" and "heat set" interchangeably, Fanselow's disclosure that the tubing is quenched (col. 13, lines 6 and 7) is not a disclosure that it is heat set. According to dictionary definitions supplied by appellants with the reply brief, "quenching" means "cooling suddenly, as in tempering

steel,"⁴ whereas, "heat set" means "to fix (as a plastic or pleats in fabric) in a permanent form through the action of heat."⁵

In making a rejection on the ground that claimed subject matter would inherently be present in the apparatus or process described by a reference, the examiner bears the initial burden of making out a prima facie case, as by providing a basis in fact and/or technical reasoning which reasonably supports the position that what is allegedly inherent would necessarily flow from the teachings of the prior art. Behr v. Talbott, 27 USPQ2d 1401, 1407-08 (BPAI 1992). In the present case, we do not consider that the examiner has met that burden. On page 4, the examiner states that in Fanselow, "the tubing is quenched or heat set after orientation 'to congeal them into a [sic] solid multilayer tubing' in order to maintain the oriented diameter during use of the tubing." However, the quoted "to congeal" passage from Fanselow, which appears at col. 12, line 58, is taken from a sentence which

⁴ Hackh's Chemical Dictionary, 4th Ed., p. 562.

⁵ Webster's Third New International Dictionary, p. 1046.

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reads in its entirety (col. 12, lines 55 to 58, emphasis added):

Upon transport through the coextrusion die, the united layers of plasticized or melted polymer or polymer mixture are cooled such as by a water bath or air to congeal them into solid multilayered tubing.

Thus, Fanselow discloses only cooling (quenching) to congeal the polymer; there is no disclosure of heat setting.

The examiner further refers to the fact that both the appellants and Fanselow disclose the use of a cold bath to solidify the oriented tubing. It is not apparent, however, how this indicates that the tubing of Fanselow is inherently heat set.

The examiner likewise does not make out a prima facie case to sustain the alternative contention that it would have been obvious to heat set Fanselow's oriented tubing. No factual basis is provided to support the conclusion of obviousness. In re GPAC, Inc., 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995) (a factual basis is required to validate a claim rejection under § 103).

Accordingly, we will not sustain rejection (2).

Conclusion

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The examiner's decision to reject claims 1 to 10 is affirmed as to claims 1 to 9, and reversed as to claim 10.

No time 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)
)
) BOARD OF PATENT
LAWRENCE J. STAAB)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
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