

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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN J. OROSZ, JR.

Appeal No. 2002-1220
Application No. 08/940,601

ON BRIEF

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

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 5 and 9 through 14. Claims 6 through 8 stand allowed. These claims constitute all of the claims in the application.

Appellant's invention pertains to a medical needle combined with a syringe for withdrawal of blood from a patient, a medical needle for insertion into a patient, and a process of withdrawing

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blood from a patient with a syringe and needle assembly. A basic understanding of the invention can be derived from a reading of exemplary claims 1, 9, and 13, respective copies of which appear in an appendix to the main brief, a copy of which is appended to the examiner's answer (Paper No. 18).

As evidence of anticipation and obviousness, the examiner has applied the documents listed below:

Guerra	3,906,930	Sep. 23, 1975
Brinon	5,611,778	Mar. 18, 1997

Becton Dickinson (B-D) Division Product Catalog, Spinal Needles, F2, (March 30, 1993)

The following rejections are before us for review.

1. Claims 1 through 5 and 9 through 12 stand rejected under 35 U.S.C. § 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Brinon.

2. Claims 13 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Guerra in view of Brinon.

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3. Claims 1 through 5 and 9 through 12 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Becton Dickinson.

The full text of the examiner's rejections and response to the argument presented by appellant appears in the final rejection and answer (Paper Nos. 13 and 18), while the complete statement of appellant's argument can be found in the main and reply briefs (Paper Nos. 17 and 19).

Appellant groups the claims as follows: claims 1 through 5, claims 9 through 12, and claims 13 and 14 (main brief, page 5). In light of this claim grouping and the argument presented, we select independent claims 1, 9, and 13 for review, with the dependent claims standing or falling with their respective independent claim.

OPINION

In reaching our conclusion on the issues, anticipation and obviousness raised in this appeal, this panel of the Board has

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carefully considered appellant's specification and claims, the applied teachings,¹ and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The first rejection

We sustain the rejection of claims 1 and 9 under 35 U.S.C. § 102(e) as being anticipated by and, in the alternative, under 35 U.S.C. § 103(a) as obvious over Brinon. It follows that we likewise sustain the rejection of claims 2 through 5 and 10 through 12 since these dependent claims stand or fall with claims 1 and 9, respectively, as earlier indicated.

¹ In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the Board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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Anticipation under 35 U.S.C. § 102 is established only when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); and RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). However, the law of anticipation does not require that the reference teach specifically what an appellant has disclosed and is claiming but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Independent claim 1 requires a distinctly visible mark surrounding the tip of a sharp insertion end of a medical needle that is combined with a syringe. Independent claim 9 specifies a

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mark of distinctly visible color surrounding the sharp insertion end of a medical needle body.

A review of the overall teaching of Brinson, taking into account the appearance of the (Tuohy) needle as revealed in PRIOR ART Figs. 1 through 3 of the reference, makes it quite apparent to this panel of the Board that one versed in the art would appreciate the needle as evidencing a distinctly visible mark or a mark of distinctly visible color surrounding the tip of the sharp insertion end thereof. In other words, the mark 15 of Brinson, closest to the needle tip end (Fig. 2), produces a needle tip end with a contrasting color appearance that clearly visibly marks the tip end. It is noted that Figs. 7 and 8 of Brinson reveal the combination of a needle and a syringe (column 3, lines 57 through 65). Based upon the above analysis, we conclude that the content of claims 1 and 9 is anticipated by Brinson. The rejection of these claims under 35 U.S.C. § 103 is also sustained, since lack of novelty is the epitome of obviousness. See In re Fracalossi, 681 F.2d 792, 215 USPQ 569, 571 (CCPA 1982).

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The argument of appellant in the main (pages 6 through 9) and reply briefs fails to convince us that the content of each of independent claims 1 and 9 is not anticipated by or obvious over the Brinon teaching. Contrary to the assertion in the main brief (page 7) that Brinon does not disclose appellant's medical needle which has a distinctly visible mark at its tip, we determined above that the claimed needle is anticipated and rendered obvious by the prior art needle found in the Brinon patent. Thus, the further argument in the reply brief (page 2) that focuses upon the marking in Brinon that is spaced from the tip end is misplaced since the contrasting color of the tip end is responsive to the visible mark recitation now claimed.

The second rejection

We do not sustain the rejection of claims 13 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Guerra in view of Brinon.

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Independent claim 13 sets forth the process of withdrawing blood from a patient with a syringe and needle assembly including the step of providing a color mark surrounding the tip of a needle to facilitate accurate directioning of a needle toward an artery.

Simply stated, it is our opinion that it would not have been obvious to one having ordinary skill in the art, based upon the collective teachings of Guerra and Brinon by themselves, to substitute a needle expressly disclosed for use in an epidural anesthesia process (Brinon) for a needle used in a blood taking process (Guerra). We recognize, as did appellant, that the applied references do not address the problems faced in the process of withdrawing blood from a patient and the solution therefor that is the focus of the present application and its claims 13 and 14 (main brief, page 9, and reply brief, page 2). In light of the above, we readily perceive that one having ordinary skill in the art would have lacked motivation to make the examiner's proposed modification in a process of withdrawing blood from a patient.

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The third rejection

We sustain the rejection of claims 1 through 5 and 9 through 12 under 35 U.S.C. § 102(a) as being anticipated by Becton Dickinson.

It is quite apparent to us, as it was to appellant (main brief, pages 9 and 10), that the needle of Becton Dickinson is akin to the needle taught by Brinon. Thus, in light of our analysis and conclusion of anticipation above regarding the Brinon teaching, we likewise sustain the rejection of appellant's claims based upon the Becton Dickinson document, with our earlier reasoning being incorporated herein by reference.

In summary, this panel of the Board has sustained the first and third rejections on appeal, but not the second rejection.

The decision of the examiner is affirmed-in-part.

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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

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
LAWRENCE J. STAAB)	
Administrative Patent Judge)	

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