

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOSEPH J. CHANG and JULIAN CANNON

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Appeal No. 99-0094  
Application 08/482,589<sup>1</sup>

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ON BRIEF

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Before MEISTER, McQUADE and NASE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Joseph J. Chang et al. appeal from the final rejection of claims 1 through 5 and 10. Claims 6 through 9 and 11, the only other claims pending in the application, stand withdrawn

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<sup>1</sup> Application for patent filed June 7, 1995.

from consideration pursuant to 37 CFR § 1.142(b).<sup>2</sup> We reverse.

The subject matter on appeal relates to a method for forming a rib on a cannula. The purpose of the rib is to prevent the removal of a contaminated cannula from a safety cover which deters accidental "needle sticks." Claim 1 is illustrative and reads as follows:

1. A method for forming a rib on a cannula comprising:

providing a cannula having a predetermined outside diameter said outside diameter being substantially constant along a predetermined position;

providing a sleeve having an inside diameter smaller than the predetermined outside diameter of the cannula;

heating the sleeve for a sufficient time and at a sufficient temperature to cause the inside diameter to expand to a diameter larger than the predetermined outside diameter of the cannula;

sliding the sleeve onto the cannula to said predetermined position while the inside diameter is expanded; and

cooling the sleeve to room temperature to cause the inside diameter of the sleeve to contract to a diameter

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<sup>2</sup> Although the appellants indicate on page 2 of their brief (Paper No. 13) that claims 6 through 9 and 11 have been canceled, the record does not contain any amendment formally effecting the cancellation.

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smaller than the predetermined outside diameter of the cannula to attach the sleeve to the cannula without mechanical compression thereby forming a rib on the cannula.

The references relied upon by the examiner as evidence of anticipation and obviousness are:

Zenick 1969	3,470,604	Oct. 7,
Scherer et al. (Scherer) 19, 1973	3,739,456	Jun.

Claims 1, 3, 5 and 10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Zenick, and claims 1 through 5 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Scherer in view of Zenick.

Reference is made to the appellants' brief (Paper No. 13) and to the examiner's answer (Paper No. 14) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

Turning first to the standing 35 U.S.C. § 102(b) rejection of claims 1, 3, 5 and 10, Zenick discloses a

method of producing a hypodermic needle assembly including the steps of rolling onto the butt-end of a sharpened cannula [1] a plurality of notched ribs [3, 86]; axially press-fitting the butt-end of the cannula into the undersized bore [11] of a

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thermoplastic hub [10] at a force of about 1½ to 2 pounds of force, in which the hub is produced from a moisture-absorbing thermoplastic such as nylon or the like and has been expanded by heating and/or saturated with moisture to about 10% residual moisture capacity so that the hub bore is softened; and permitting the hub to cool and dry at room temperature whereby residual moisture capacity is about 2% and a force approximately 10 times the installation force is required to pull the cannula axially from the hub [Abstract].

The bore in the hub initially has a diameter smaller than the outside diameter of the cannula such that when the hub is cooled after being expanded, softened and press-fitted onto the cannula the bore shrinks to tightly grip the cannula between the notched ribs (see Zenick at column 2, lines 6 through 39).

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert dismissed, 468 U.S. 1228 (1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on

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something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Claim 1 requires the steps of providing a cannula having a "predetermined outside diameter" which is "substantially constant along a predetermined position," sliding a sleeve onto the cannula to the predetermined position, and cooling the sleeve to cause its inside diameter to contract to a diameter smaller than the predetermined outside diameter. As implied by the examiner's

analysis (see pages 3 through 6 in the answer), the only way Zenick can meet these claim limitations is if the claim language requiring a "predetermined outside diameter" which is "substantially constant along a predetermined position" can be read on the predetermined outside diameter defined by Zenick's ribs or ridges 3, 86. The appellants' contention that the claim language in question cannot be so read (see pages 5 and

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6 in the brief) is persuasive. While Zenick's ribs or ridges 3, 86 do define a predetermined outside diameter of the cannula 1 at a predetermined position, the disclosure of these ribs or ridges is too ambiguous to reasonably support a finding that they also define a predetermined outside diameter which is substantially constant along a predetermined position. Thus, Zenick cannot be said to disclose each and every element of the invention set forth in claim 1.

Accordingly, we shall not sustain the standing 35 U.S.C. § 102(b) of claim 1, or of claims 3, 5 and 10 which depend therefrom, as being anticipated by Zenick.

As for the standing 35 U.S.C. § 103 rejection of claims 1 through 5 and 10, Scherer discloses a method of affixing a length

of sacrificial magnesium tubing 1 to a ferrous pipe 2 to protect the pipe from corrosion. The method includes the steps of

taking a tube of magnesium which has sacrificial properties, heating it to an elevated temperature at which it will flow when subjected to external

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pressure, slipping the tube over a length of ferrous pipe, compressing it until the metal of the tube is in intimate contact throughout the length of the tube with the ferrous pipe and allowing it to shrink fit in place by cooling [column 1, lines 32 through 39].

As conceded by the examiner (see page 3 in the answer), Scherer's method of affixing a sacrificial tube to a ferrous pipe fails to meet at least one of the limitations in claim 1. As explained above, the same is true of Zenick's method of producing a hypodermic needle assembly. Suffice it to say that the only suggestion for combining these clearly disparate methods so as to arrive at the method recited in claim 1 stems from hindsight knowledge impermissibly derived from the appellants' own teachings. The failings of the references in this regard are highlighted by the inconsistent positions taken by the examiner (see pages 4, 6 and 7 in the answer) as to how they might be so combined.

Therefore, we shall not sustain the standing 35 U.S.C. § 103 rejection of claim 1, or of claims 2 through 5 and 10 which depend therefrom, as being unpatentable over Scherer in view of Zenick.

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The decision of the examiner is reversed.

REVERSED

JAMES M. MEISTER	)	
Administrative Patent Judge	)	
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	)	
JOHN P. McQUADE	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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