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EXAMINER

CLARK, JEANNE MARIE

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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT TRIAL AND APPEAL BOARD

BECTON, DICKINSON AND COMPANY
Requester & Respondent

v.

MICHAEL J. VAILLANCOURT
Patent Owner & Appellant

Appeal 2012-003151
Reexamination Control 95/000,565
Patent 6,699,221 B2
Technology Center 3900

Before RICHARD M. LEBOVITZ, JEFFREY B. ROBERTSON, and
RAE LYNN P. GUEST, *Administrative Patent Judges*.

GUEST, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

On July 27, 2012, Patent Owner and Real Party in Interest of U.S. Patent 6,699,221 B2 (hereinafter, “the ‘221 patent”), Michael J. Vaillancourt (hereinafter “Patent Owner”), requested rehearing under 37 C.F.R. § 41.79 of the Board’s Decision of June 29, 2012, affirming the Examiner’s rejections of claims 1-37 in an *inter partes* reexamination (hereinafter “Request”). Respondent and Third Party

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Requester also filed Comments in response to Patent Owner's Request on August 27, 2012 in accordance with 37 C.F.R. § 41.79(c).

Patent Owner contends that the Decision misinterpreted the facts and law in its interpretation of certain identified terms and, based on this misinterpretation, erred in finding the claims anticipated by, or concluding that the claims are obvious over, the prior art (Request 1-2; *see also* Request 17-30 (discussing the claim interpretation with respect to each of the affirmed rejections)).

Claim 1 is reproduced below for convenience. (App. Br., Claim App'x 1.)

1. A bloodless catheter comprising
a first hub having a bore at a proximal end;
a cannula fixed in and extending from an opposite distal end of
said hub for invasive positioning in a blood vessel; and
a septum seal mounted in said bore of said hub in
circumferentially sealed relation to prevent a flow of fluid from said
cannula to said proximal end of said hub, said seal having a weakened
central section.

CLAIM INTERPRETATION

During reexamination, "claims . . . are to be given their broadest reasonable interpretation consistent with the specification, and . . . claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (*quoting In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990)).

Patent Owner's Request argues that the Decision erred in its interpretation of the following terms:

- (a) "hub" as encompassing a structure having more than one piece (Request 9-11);
- (b) "bore" as encompassing a structure having a recess formed within a hollow chamber or barrel (Request 11-13); and

(c) “septum seal” as encompassing a structure of the valve member 55 of Vaillancourt ‘766 (Request 13-16).

We are not persuaded that our interpretation of these terms was in error.

For each of the terms noted above, Patent Owner argues that the Decision ignores the plain language of the claims (Request 9:18, 11:20-21, 13:20-22). However, Patent Owner fails to disclose what aspect of the plain language would alter the interpretation provided in the Decision. The claims use the terms “hub,” “bore” and “septum seal” with no qualifying language to further structurally define these features. That is, the claims do not expressly recite that a “hub” is limited only to structures having a one-piece body, that a “bore” may not have recesses therein, or that a “septum seal” be structurally limited to any particular shape.

Patent Owner argues that the inventor’s descriptions in the Specification and drawings of the ‘221 patent constitute the broadest reasonable interpretation consistent with the Specification and that “the Board Decision gives no credence to the inventor’s description” (Request 10:8-10 and 13-15, 12:3-12, 14:1-10).

The Decision acknowledged the use of the terms in the Specification in interpreting the claims (*see e.g.*, Decision 8, 19, and 32). The ‘221 patent provided no special meaning to the terms at issue, a point noted by Patent Owner in the Request (Request 10 and 11). *See In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (“During reexamination, as with original examination, the PTO must give claims their broadest reasonable construction consistent with the specification. Therefore, we look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation.”).

As aptly stated in *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997):

The appellants urge us to consult the specification and some of the cited prior art . . . and interpret the disputed language more narrowly

in view thereof. When read in light of this material, according to applicants, the “true” meaning of the phrase emerges. We decline to attempt to harmonize the applicants' interpretation with the application and prior art. Such an approach puts the burden in the wrong place. It is the applicants' burden to precisely define the invention, not the PTO's

The problem in this case is that the appellants failed to make their intended meaning explicitly clear. Even though the appellants implore us to interpret the claims in light of the specification, the specification fails to set forth the definition sought by the appellants.

While claims are sometimes construed more narrowly during patent infringement litigation to do justice and equity between the parties, adopting the broadest reasonable interpretation while the claims are undergoing reexamination is not unfair to the applicant as the claims can be amended and so interpreting the claims “serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified,” *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir.1984); *see also In re Prater*, 415 F.2d 1393, 1395-96 (CCPA 1969). We are, therefore, vigilant about not importing extraneous limitations into the claims. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (“[A]lthough the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments.”); *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (“[L]imitations are not to be read into the claims from the specification.”).

For example, with respect to the term “bore,” Patent Owner argues that a recess in a bore would preclude the movement of the septum seal as demonstrated in Figures 3 and 4 of the ‘221 patent, and thus the Decision’s broader interpretation of the term “bore” would be contrary to the disclosure (Request 12). We note that

the claims are silent as to the septum seal being capable of sliding in any particular manner, and we decline to read into the claims such a requirement.

Moreover, the Decision's broadest reasonable interpretations are not inconsistent with the Specification's embodiments. An interpretation is inconsistent with the Specification if the interpretation would exclude the specific embodiments described therein. Here, the panel's broader interpretation of the terms "hub," "bore," and "septum seal" encompasses not only the exemplified constructions described in the Specification but also other constructions that one of ordinary skill in the art would consider to be encompassed by the unqualified language of the claims. For example, with respect to the term "bore," we disagree with the Patent Owner's assertion that the Decision's interpretation "imposes a limitation that is not apparent in the language of the claim at issue, i.e., that the bore has a recess" (Request 12). To the contrary, the Decision's interpretation encompasses bores that have a recess and bores that do not have recesses because the unqualified term "bore" is not reasonably limited to any particularly shaped hollow structure. The written description of the '221 patent does not indicate that bores should be construed more narrowly to exclude recesses.

Patent Owner argues that the Decision failed to consider the citations to certain patents in the background section of the Specification, which Patent Owner alleges are examples of how one of ordinary skill in the art would have understood the terms at issue (10:3-5; 11:23-12:2, 14:11-15:7). With respect to the term "septum seal," Patent Owner further points to the use of terms in the inventor's other patents (Vaillancourt '891 and Vaillancourt '728), in which the term "septum" described only a part of a valve structure (Request 15 and 26-27), and statements made during prosecution of the '221 patent with regard to the Newgard reference

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(US 4,874,377) (Request 16-17) as evidence of misinterpretation of the term “septum seal” as claimed.

While the Specification and prosecution history of the ‘221 patent may include reference to patents in the art, Patent Owner did not argue in the Specification, during reexamination prosecution, or during the appeal that the terms used in these references constituted the full scope of the terms of the claims. The Request for Rehearing is not a time to rely upon arguments and evidence that could have been raised earlier. 37 C.F.R. § 41.79(b)(1) (2009) (“Arguments not raised in the briefs before the Board and evidence not previously relied upon in the briefs are not permitted in the request for rehearing except as permitted by paragraphs (b)(2) and (b)(3) of this section.”). Patent Owner provided no persuasive evidence on appeal that the noted claim terms deserve a more narrow meaning or that the references identified in the Specification or prosecution history limit how a skilled artisan would understand these terms. Moreover, it is not evident from reading the ‘221 patent that the patents cited in the specification, e.g., at col. 1, ll, 36-45, that the inventors intended to rely upon the cited patents to define and limit the structures recited in the claims at issue.

Moreover, we are not persuaded that the prior art patents teachings are evidence that one of ordinary skill in the art would have understood the term “septum seal” to have a more narrow meaning than the interpretation provided in the Decision. The prior art used the term “septum” and not “septum seal.” Accordingly, the prior art has only limited weight as to the scope and meaning of the distinct term “septum seal” of the ‘221 patent’s claims. For that reason, Patent Owner has not shown that the prior art’s use of the term “septum” is inconsistent with the Decision’s interpretation of the term “septum seal.”

Further, Patent Owner has not sufficiently explained why the statements made regarding the Newgard patent during prosecution of the '221 patent "precludes the septum seal from being read as the valve member 55 of Vaillancourt '766 (i.e. as supported circumferentially at one end and extended into space at another end[)]" (Request 17). According to Patent Owner's description, the arguments were directed to the fact that Newgard's seal was not in "circumferentially sealed relation" because "there is a circumferential gap between obturator member 48 [the alleged seal in the Newgard patent] and the wall of the bore 42 of the hub 38" (*id.* at 16-17). Yet, unlike the Newgard seal, the valve member 55 of Figure 3 of Vaillancourt '766 has one end in a friction fit with the bore of the hub and, thus, is in a "circumferentially sealed relation" as claimed (*see* Vaillancourt '766, Figure 3; Decision 33-34).

Patent Owner further contends that it is erroneous to resort to a dictionary definition, which Patent Owner deems "extrinsic evidence," when intrinsic evidence can resolve an ambiguity of a disputed claim (Request 11) (citing *Vitronics Corp. v. Conceptronics, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996)).

Our focus is properly directed to how one of ordinary skill in the art would have understood the unqualified terms "hub," "bore," and "septum seal." Accordingly, our resort to a dictionary definition as evidence of what a skilled artisan would have understood is proper. "Because dictionaries, and especially technical dictionaries, endeavor to collect the accepted meanings of terms used in various fields of science and technology, those resources have been properly recognized as among the many tools that can assist the court in determining the meaning of particular terminology to those of skill in the art of the invention." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1318 (Fed. Cir. 2005). Patent Owner

provided no persuasive evidence in its Appeal Brief as to how the skilled artisan would have understood the terms at issue and the Specification provides no express definition. Accordingly, the panel's reliance on dictionary definitions to determine the broadest reasonable interpretation to the skilled artisan is appropriate.

We cannot agree that the Decision's interpretation of the terms "hub," "bore," and "septum seal" was unreasonably broad, and we do not alter the Decision's interpretation. Accordingly, we need not address Patent Owner's arguments of patentability based on a more narrow interpretation. However, we address Patent Owner's additional arguments directed to specific claims and rejections below.

With respect to claim 10, Patent Owner contends that Figures 2 and 3 of Luther illustrate that "the front end of the plug [35b] slides relative to the surface of the septum [33]" which precludes the plug 35b from being "mounted on the septum [33]" (Request 20 and 23). According to Patent Owner, if mounted, "a relative movement between the plug and septum would be resisted and/or the movement of the plug would cause a tearing of the septum" (*id.*). With respect to claim 20, Patent Owner likewise contends that the Decision failed to apprehend that opener 120 of Van Heugten would not deform the membrane 110 if it were mounted thereon (Request 23-24).

The arguments made in the Appeal Brief with respect to claim 10 are not directed to any movement implied by Figures 2 and 3 of Luther (*see* App. Br. 17-18 and 20). As noted in the Decision, and thus not overlooked or misapprehended, Patent Owner's arguments regarding the rejection based on Luther were directed to a membrane opener 120 and a membrane 110, which do not appear in Luther

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(Decision 21; App. Br. 20). We decline to address arguments made for the first time upon rehearing. 37 C.F.R. § 41.79(b)(1).

Moreover, also as noted in the Decision:

Further, Patent Owner has directed us to no evidence in support of the contention that the plug 35b or opener 120 would not function if “mounted,” or supported, by the respective seals of Luther and Van Heugten. Attorney arguments do not take the place of evidence in the record. *Pearson*, 494 F.2d at 1405.

(Decision 26.) Accordingly, the Decision considered Patent Owner’s arguments and found them not persuasive for lack of evidence in support thereof.

Patent Owner further argues that Van Heugten fails to disclose valve member 110 in circumferentially sealed relation to the bore (Request 22-23).

As stated in the Decision:

Regarding the septum seal being in circumferentially sealed relation to the bore, Patent Owner merely asserts that these claim features are not taught by Van Heugten (*id.*). A general allegation that the art does not teach the claim limitations is no more than merely pointing out the claim limitations. *See* 37 C.F.R. § 41.67(c)(1)(vii). In any event, such statements do not address the Examiner’s specific findings and support therefore (*see* ACP 12, citing Van Heugten, col. 1, ll. 4-27, col. 2, ll. 45-50, col. 3, l. 59-col. 4, l. 49, and Figures 2, 3, and 4a-4c) articulated in the rejections or explain why the Examiner’s findings are not supported by the evidence.

(Decision 23.) The arguments made in the Request address the merits of the Examiner’s findings for the first time upon rehearing, which is not appropriate. 37 C.F.R. § 41.79(b)(1).

With respect to claim 4, Patent Owner further contends that “[t]he fact that the valve member 55 of Vaillancourt ‘766 collapses axially precludes an

interpretation that the valve member 55 is slidably mounted in the bore of the hub 10” (Request 28).

Upon Rehearing, Patent Owner must “must state with particularity the points believed to have been misapprehended or overlooked in rendering the Board's opinion reflecting its decision.” 37 C.F.R. § 41.79(b)(1).

The Decision states that:

Patent Owner’s arguments focus on the fact that the various portions of valve member 55, i.e., support end 56, valve end 31, and the thin-walled section 54, individually cannot meet the requirements of claim 4. However, Patent Owner fails to address the fact that the Examiner finds the mounting and axial movement of valve member 55, as a whole, meets the requirements of the claim 4. Accordingly, we are unconvinced that the Examiner’s position, which is based on sufficient rational underpinnings, is improper.

(Decision 35.) Patent Owner directs us to no points that the Decision misapprehended or overlooked. Patent Owner has not shown the reasoning provided in the Decision to be untenable.

Finally, with respect to claim 7, Patent Owner contends that “the Examiner cannot reasonably find that claim 7 reads on the valve member when the luer adaptor 40 is inserted into the hub 10, as illustrated in Fig. 2, when the valve member 55/30 is axially collapsed onto tube 20” (Request 29).

Again, Patent Owner has not identified the points believed to have been misapprehended or overlooked in the Decision. 37 C.F.R. § 41.79(b)(1). The Decision states that:

The Examiner reasonably finds that the claim 7 reads on the valve member when the luer adaptor 40 is inserted into hub 10, as illustrated in Figure 2, when valve member 55/30 is axially collapsed onto, and thus supported by, tube 20. We see no reason to read the requirements of claim 7 to exist only when no luer adaptor is present,

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and Patent Owner has provided no evidence or reasoning for us to do so.

(Decision 36). Patent Owner has not shown the reasoning provided in the Decision to be untenable.

Based on the foregoing, we have granted Patent Owner's request to the extent that we have reconsidered our decision, but we deny Patent Owner's request to alter our decision to affirm the Examiner's rejection.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. §1.136(a)(1)(iv).

DENIED

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