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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAMES SPITLER

Appeal 2017-010232
Application 13/813,102¹
Technology Center 3700

Before HUBERT C. LORIN, PHILIP J. HOFFMANN, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

SILVERMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1–6, and 21–27. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART and enter a NEW GROUND OF REJECTION under 37 C.F.R. § 41.50(b).

¹ The Appellant identifies C.R. Bard, Inc. as the real party in interest. Appeal Br. 4.

ILLUSTRATIVE CLAIM

1. A securement device for securing a medical article, the securement device comprising:

first and second anchor pads, each comprising an upper foam layer and a lower adhesive surface, the lower adhesive surface being configured to attach to an epidermal layer of a patient, wherein the anchor pads are laterally offset in opposite directions from a midline; and

a retainer disposed above the anchor pads comprising:

a body member having an inverted channel formed therethrough, the inverted channel being configured to retain a portion of the medical article and having a longitudinal access opening disposed on an underside of the body member to allow ingress and egress of the portion of the medical article;

first and second proximal members extending generally transversely downward from the body member and defining a proximal retention surface therebetween, wherein the first proximal member terminates in a first proximal footing which is secured to the first anchor pad and the second proximal member terminates in a second proximal footing secured to the second anchor pad;

first and second distal members extending generally transversely downward from the body member and defining a distal retention surface therebetween, wherein the first distal member terminates in a first distal footing which is secured to the first anchor pad, and wherein the second distal member terminates in a free end unsecured to an anchor pad; and

an offset member extending laterally outward and longitudinally proximal from a point on the body member, the offset member having a

downwardly extending portion at its outer end, the downwardly extending portion terminating in a distal footing which is secured to one of the anchor pads.

CITED REFERENCES

The Examiner relies upon the following references:

Bierman (hereinafter "Bierman '516")	US 6,428,516 B1	Aug. 6, 2002
Wright et al. (hereinafter "Wright")	US 2008/0132848 A1	June 5, 2008
Bierman et al. (hereinafter "Bierman '740")	US 2009/0143740 A1	June 4, 2009
Bierman et al. (hereinafter "Bierman '491")	US 2010/0324491 A1	Dec. 23 2010

REJECTIONS

- I. Claims 1–3, 5, and 21–24 are rejected under 35 U.S.C. § 102(b) (pre-AIA) as anticipated by Bierman '740.
- II. Claims 4 and 25 are rejected under 35 U.S.C. § 103(a) (pre-AIA) as unpatentable over Bierman '740.
- III. Claim 6 is rejected under 35 U.S.C. § 103(a) (pre-AIA) as unpatentable over Bierman '740 and Bierman '516.
- IV. Claims 26 and 27 are rejected under 35 U.S.C. § 103(a) (pre-AIA) as unpatentable over Wright and Bierman '491

FINDINGS OF FACT

The findings of fact relied upon, which are supported by a preponderance of the evidence, appear in the following Analysis.

ANALYSIS

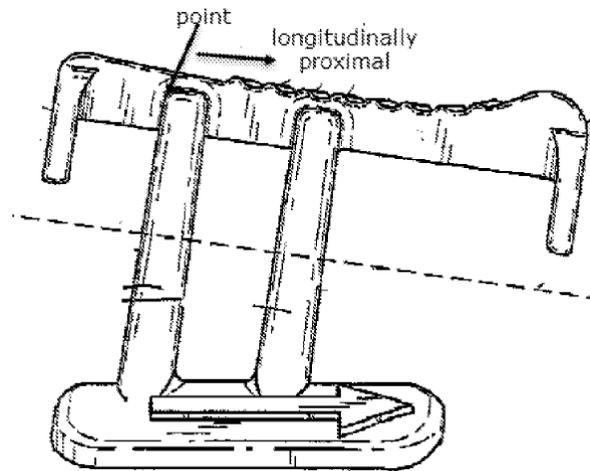
Independent Claim 1 and Dependent Claims 2–6

1. Independent Claim 1 and Dependent Claims 4–6

The Appellant presents two arguments, in regard to the rejection of independent claim 1 as anticipated by the Bierman '740 reference.

First, the Appellant argues that Bierman '740 does not teach claim 1's recitation of "an offset member extending laterally outward and longitudinally proximal from a point on the body member." Appeal Br. 11–14.

In the Examiner's view, the reference teaches the identified limitation — as illustrated by the Examiner's annotated version of Figure 29 of the reference (and provided on page 4 of the Final Office Action), indicating that there is a "point," on the body member of the device, from which an "offset member" "extend[s]" in both "laterally outward" and "longitudinally proximal" directions. Final Action 3–4. The Examiner's annotated Figure 29 of Bierman '740 is reproduced, below (*id.* at 4):



Reproduced above is the Examiner's annotated Figure 29 of Bierman '740 (a perspective side view). *Id.* The Examiner's annotated Figure 29 of

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Bierman '740 shows that there is a “point” (so indicated by the Examiner) from which the “offset member” (the elongate member on to the left, which is identified in the reference as a “rib[] 280”) “extend[s]” in both “laterally outward” and “longitudinally proximal” (the “proximal” direction being indicated by the Examiner), as claim 1 requires. *See* Bierman '740 ¶¶ 138–39, Fig. 29. *See also* Final Action 4, Answer 2.

Disputing the Examiner’s finding, the Appellant contends that the identified disclosure of Bierman '740 does not teach “the offset member as a **whole**, extending laterally outward and longitudinally proximal from a point on the body member.” Appeal Br. 12. Yet, claim 1 does not employ the “as a whole” qualification. Nevertheless, the Appellant fails to demonstrate the asserted shortcoming of Bierman '740, even in regard to the “offset member” as a whole.

The Examiner’s Answer offers suggestions for a potential amendment to claim 1, albeit without “commenting on the patentability of such language but rather providing further explanation as to how the member could be explained.” Answer 2. Disputing the helpfulness of the Examiner’s suggestion, the Appellant argues that “the Examiner *also* appears to be struggling to describe the claimed offset member”; “[t]herefore, paradoxically, the Examiner’s arguments appear to support Appellant’s arguments.” Reply Br. 6–7. Contrary to the Appellant’s assessment, the Examiner is not “struggling” at all, in regard to mapping the present claim to the prior art. Rather, the Examiner is simply providing a suggestion for an amendment, in order to advance the prosecution of the case.

In view of the foregoing, the Appellant’s first argument, concerning the anticipation rejection of claim 1, is not persuasive of error.

The Appellant's second argument, regarding independent claim 1, contends that the rejection is erroneous, because "it is improper for the Examiner to rely on two separate embodiments to anticipate the claims." Appeal Br. 15. The Appellant states that the Final Office Action (page 3) relies upon an embodiment shown in Figures 1–5 of Bierman '740, as well as a different embodiment shown in Figures 25–34 of Bierman '740. *Id.* Further the Appellant points to the Examiner's statement that ¶ 74 of Bierman '740 shows a number of mechanisms for a retainer to support a medical article that may interact with the abutment surfaces of various medical articles (shown in Figures 13, 22, and 31 of the reference). Reply Br. 7 (citing Answer 3–4). The Appellant emphasizes that "Figs. 13, 22 and Fig. 31 refer to different embodiments." *Id.*

In regard to the rejection of independent claim 1, the Examiner states that "throughout the rejection of the specific features of the retainer the Examiner relies on a single embodiment" and that Figures 1 and 5 are "indicated at the outset because these Figures include the directional indicators and show how the device attaches to the adhesive pad." Answer 2–3.

Additionally, although Bierman '740 does disclose multiple embodiments of a retainer (*see* Bierman '740 ¶¶ 13–47), there are common features among the various embodiments in the figures cited by the Examiner. Notably, Bierman '740 points out the fundamental similarity of certain disclosed embodiments, stating:

As shown in FIGS. 25 through 34, the general structure of the retainer 2500 is similar to that of the retainer 120 described with reference to FIGS. 1 through 5 except that the body member 130 of the retainer 2500 includes a second spine 2800 extending in a proximal direction.

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Bierman '740 ¶ 138. The Appellant does not attach any particular significance to these distinguishing features.

The Appellant's remark that "Figs. 13, 22 and Fig. 31 [of Bierman '740] refer to different embodiments" (Reply Br. 7) is not persuasive, because Figures 13, 22, and 31 depict medical articles that interact with a retainer or, in the terminology of claim 1, a "securement device for securing a medical article." Indeed, the recited "medical article" of claim 1 is a workpiece that is not part of the claimed "securement device." The features of the "medical article," in claim 1, merely describe an intended use for the "securement device" and, therefore, do not limit the scope of the claim. *See In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) ("Although Schreiber is correct that [the prior art reference] does not address the use of the disclosed structure to dispense popcorn, the absence of a disclosure relating to function does not defeat the Board's finding of anticipation. It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable.") (citations omitted). *See also In re Sinex*, 309 F.2d 488, 492 (CCPA 1962) ("The expression 'for reconcentrating liquid dehydrating agents' is merely a statement of intended use and does not qualify or distinguish the structural apparatus claimed over the reference.")

Therefore, the Appellant has not shown adequately that the rejection relies upon teachings found only in different embodiments. *See In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) ("[I]t has long been the Board's practice to require an applicant to identify the alleged error in the examiner's rejections.") (citing *Ex parte Frye*, Appeal No. 2009-006013, at 9–10, 2010 WL 889747 (BPAI Feb. 26, 2010) (precedential)).

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Furthermore, the Federal Circuit has explained that there is no absolute rule that multiple embodiments of a reference can never form the basis for anticipation:

To the extent the district court suggested a blanket rule that two embodiments disclosed in a reference can never be considered in combination to make a finding of anticipation, this was incorrect. In *Kennametal, Inc. v. Ingersoll Cutting Tool Co.*, 780 F.3d 1376 (Fed. Cir. 2015), we explained that “a reference can anticipate a claim even if it ‘d[oes] not expressly spell out’ all the limitations arranged or combined as in the claim, if a person of skill in the art, reading the reference, would ‘at once envisage’ the claimed arrangement or combination.” *Id.* at 1381. Thus, even when a reference discloses elements in different locations in the disclosure, the relevant question is whether the reference is sufficiently clear in disclosing the combinability of those elements such that a skilled artisan would “at once envisage” the claimed combination.

Chamberlain Grp., Inc. v. Techtronic Indus. Co., ___ F.3d ___, 2019 WL 3938278, *5 (Fed. Cir. Aug. 21, 2019).

In view of the foregoing analysis, the Appellant’s second argument does not persuade us of error in the rejection of independent claim 1 as being anticipated by Bierman ’740.

Because the Appellant does not advance any separate argument regarding dependent claims 4–6, we are not persuaded of any error in the rejection of those claims.

Accordingly we sustain the rejection of independent claim 1 and dependent claim 5 under 35 U.S.C. § 102(b). Further, we sustain the rejections of dependent claims 4 and 6 under 35 U.S.C. § 103(a).

2. *Dependent Claims 2 and 3*

Claims 2 and 3 depend from claim 1 and further recite “edges” on the “first and second distal members” (claim 2), or the “first and second proximal members” (claim 3), that comprise “abutment surfaces” for restricting the “longitudinal” movement of a “medical article”:

2. The securement device of claim 1, wherein *proximal edges* of said *first and second distal members* comprise *abutment surfaces* configured to inhibit longitudinal translation of a medical article secured within the channel.

3. The securement device of claim 1, wherein *distal edges* of said *first and second proximal members* comprise *abutment surfaces* configured to inhibit longitudinal translation of a medical article secured within the channel.

(Emphasis added).

The Appellant contends that Bierman '740 does not anticipate claims 2 and 3, because the reference purportedly lacks the recited features of the “proximal edges” of claim 2 and the “distal edges” of claim 3, as well as because the rejections purportedly rely upon two separate embodiments disclosed in the reference. *See* Appeal Br. 15–21, Reply Br. 8–10.

The Examiner takes the position that Bierman '740 discloses various structures that satisfy the identified limitations of claims 2 and 3. *See* Final Action 5 (citing Bierman '740 ¶¶ 9, 74), Answer 3–4 (additionally citing Bierman '740 ¶¶ 86–87, 130, 132).

Notwithstanding the Appellant’s views regarding the Examiner’s identified disclosures of Bierman '740 discussed in the Appeal Brief (pages 15–21) and Reply Brief (pages 8–10), the Appellant does not analyze Bierman '740 ¶ 86, which refers to “multiple abutment surfaces” on the “ribs” of the disclosed medical device retainer:

The retainer 120 thus preferably includes one or more abutment surfaces. In the illustrated embodiment, the retainer further includes multiple abutment surfaces that are formed by one or more ribs 280 in the body member 130. In the form of a rib 280, one abutment surface forms one side of the rib and another abutment surface forms the other side of the rib. . . . Multiple abutment surfaces allow the medical device to be retained in multiple positions relative to the retainer. Located between the one or more ribs 280 are slots 220.

Bierman '740 ¶ 86. The ribs of Bierman '740 are arranged in pairs and project laterally, in opposing directions, from both sides a “spine” (*see, e.g., id.* ¶¶ 85, 87 (reference numeral 145)), as seen in Figure 2 of the reference, reproduced below.

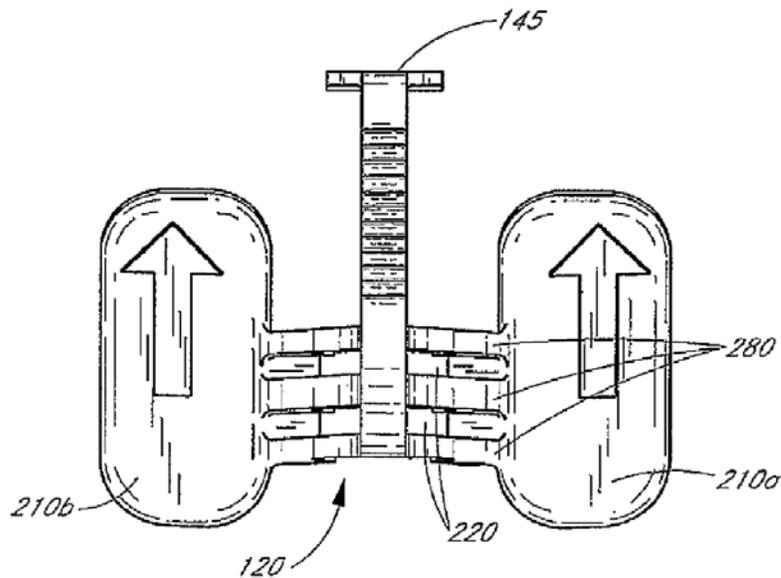


FIG. 2

Figure 2 of Bierman '740, for example, shows the claimed “proximal edges . . . compris[ing] abutment surfaces” (per claim 2) on the proximal side of one pair of ribs 280, as well as the claimed “distal edges . . . compris[ing] abutment surfaces” (per claim 3) on the distal side of another pair of

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ribs 280. Accordingly, we are not persuaded by the Appellant's argument that Bierman '740 lacks the identified limitations of claims 2 and 3.

Nor are we persuaded by the Appellant's argument that the rejection of claims 2 and 3 might improperly rely upon features from multiple embodiments of Bierman '740. *See* Appeal Br. 16–17, 19. The analysis of the similar issue (raised by the Appellant, in regard to claim 1), discussed above, applies to claims 2 and 3. Additionally, the Appellant has not shown adequately that the rejection of claims 2 and 3 relies upon teachings found only in different embodiments of the reference.

Accordingly we sustain the rejection of claims 2 and 3 under 35 U.S.C. § 102(b).

*Independent Claim 21 and Dependent Claims 22–25
(New Ground of Rejection)*

Independent claim 21 and dependent claims 22–24 stand rejected as anticipated by Bierman '740. *See* Final Action 5–6. Dependent claim 25 stands rejected as obvious over Bierman '740. *See id.* at 7.

Independent claim 21 recites, in relevant part:

a first proximal member and a second proximal member, each extending downward from a central portion and defining a proximal retention surface therebetween;

a first distal member and a second distal member, each extending downward from the central portion . . . ; and

a third distal member extending downward from the central portion between the first and second distal members.

(Emphasis added).

Among the reasons submitted for disputing the rejection of independent claim 21, the Appellant argues that the reference lacks the recited “third distal member extending downward from the central portion

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between the first and second distal members.” *See* Appeal Br. 21–23.

Throughout the briefing, the Appellant regards claim 21 as requiring the “third distal member” to be “between the first and second distal members.” *See id.* at 22–23.

By contrast, according to the Examiner, the claim requires only the recited “central portion” to be “between the first and second distal members”:

The Examiner has previously explained she has interpreted this as the third distal member extends from the central portion which is between the first and second distal members. The claim would need to be further clarified in order to distinguish over this interpretation. For example to clarify that the third distal member is between the first and second distal members and extends downward from the central portion to make it clear what Appellant is actually trying to claim because the Examiner maintains that claim is currently written in such a way as to be interpreted broadly different ways.

Answer 4.

Although, the Appellant contends that Figures 8–11 of the Specification confirm the soundness of the Appellant’s interpretation (*see* Appeal Br. 23), the Appellant does not adequately explain why the claim should be so construed. Claim 21, as drafted, is ambiguous and, therefore, fails to meet the definiteness requirement of 35 U.S.C. § 112(b). *See In re Packard*, 751 F.3d 1307, 1310–13 (Fed. Cir. 2014) (“[A] claim is indefinite when it contains words or phrases whose meaning is unclear,” i.e., “ambiguous, vague, incoherent, opaque, or otherwise unclear in describing and defining the claimed invention.”) *See also In re McAward*, No. 2015-006416, 2017 WL 3669566, at *3 (PTAB Aug. 25, 2017) (precedential).

Accordingly, we do not assess the merits of the rejection under § 102(b) (claims 21–24) and § 103(a) (claim 25). Rather, for the reasons

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given above, and pursuant to our authority under 37 C.F.R. § 41.50(b) to enter a new ground of rejection, we determine that the claims are indefinite under 35 U.S.C. § 112(b). Accordingly, the prior-art rejections must fall, *pro forma*, because they are necessarily based upon speculative assumptions as to the meaning of the claim language. *See In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962) (addressing an obviousness rejection). This determination does not reflect on the merits of the underlying rejections based upon § 102(b) and § 103(a).

*Independent Claim 26 and Dependent Claim 27
(New Ground of Rejection)*

Independent claim 26 and dependent claim 27 stand rejected as obvious over the Wright and Bierman '491 references. *See* Final Action 8–9; Answer 5–6.

Independent claim 26 recites, in relevant part:

a retainer having *a first pair of members, a second pair of members, and an arm member extending transversely downward*, each of the first and second pairs of members defining a retention surface for receiving a portion of the medical article therebetween.

(Emphasis added).

According to the Final Office Action (page 8), Figures 10 and 13 of Wright disclose the “first pair of members” (at reference numerals 101, referring to the base of the disclosed device), the “second pair of members” (at reference numerals 103, also referring to structures on the base of the device), and the “arm member extending transversely downward” (at reference numeral 112, referring to a portion of the device cover).

Among the arguments presented, the Appellant contends that the Examiner errs in mapping of the “first pair of members” and the “second

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pair of members” to Wright, because “as best seen in Fig. 10 of Wright, the alleged first and second pairs of members, pegs 101, 103 extend transversely upward, not downward, as required.” Appeal Br. 30. *See also* Reply Br. 15.

The Examiner’s Answer responds, by stating that the directionality of the claimed “members” depends upon whatever frame of reference is employed: “Regarding the limitations to the members extending downward, the claim does not recite a reference point from where they extend downward and the Examiner finds the members would extend upwards and downwards depending on a starting point of reference.” Answer 6.

Yet, the Examiner’s mapping of the identified features to Wright (and the Appellant’s criticism thereof) cannot be evaluated sufficiently, because it is unclear whether the disputed language of claim 26 — “a first pair of members, a second pair of members, and an arm member *extending transversely downward*” — requires only the “arm member” to “extend[] transversely downward” — or whether the “first pair of members” and the “second pair of members” must also “extend[] transversely downward.” (Emphasis added). This ambiguity in the claim language is particularly confounding, because the Appellant contends that the Examiner’s mapping of the “first pair of members” and the “second pair of members” (to the identified structures of Wright’s base) conflicts with the Examiner’s mapping of the claimed “arm member” (to a feature of Wright’s cover): “Since the rim of the cover 28 [identified by the Examiner as element 112] and the pegs 101, 103 extend in opposite directions from the retainer when in a configuration for retaining a medical article, i.e. in the closed position, they cannot both extend downward.” Reply Br. 15.

Therefore, claim 26, as drafted, fails to meet the definiteness requirement of 35 U.S.C. § 112(b). *See Packard*, 751 F.3d at 1310–13. *See*

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also McAward, 2017 WL 3669566, at *3.

Accordingly, we do not assess the merits of the rejection of claims 26 and 27 under § 103(a). Rather, for the reasons given above, and pursuant to our authority under 37 C.F.R. § 41.50(b) to enter a new ground of rejection, we determine that these claims are indefinite under 35 U.S.C. § 112(b). Accordingly, the prior-art rejection must fall, *pro forma*, because it is necessarily based upon speculative assumptions as to the meaning of the claim language. *See Steele*, 305 F.2d at 862–63. This determination does not reflect on the merits of the underlying rejections based upon § 103(a).

DECISION

We AFFIRM the Examiner’s decision rejecting claims 1–3 and 5 under 35 U.S.C. § 102(b).

We AFFIRM the Examiner’s decision rejecting claims 4 and 6 under 35 U.S.C. § 103(a).

We REVERSE the Examiner’s decision rejecting claims 21–24 under 35 U.S.C. § 102(b), *pro forma*.

We REVERSE the Examiner’s decision rejecting claim 25–27 under 35 U.S.C. § 103(a), *pro forma*.

We ENTER A NEW GROUND OF REJECTION for claims 21–27, under 35 U.S.C. § 112(b).

This Decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options

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with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in MPEP § 1214.01.

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

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b).