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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/878,305	05/20/2013	Janko Bubenik	1131-058.101	6527
22145	7590	10/23/2019	EXAMINER	
KLEIN, O'NEILL & SINGH, LLP 16755 VON KARMAN AVENUE SUITE 275 IRVINE, CA 92606			ZAMORY, JUSTIN L	
			ART UNIT	PAPER NUMBER
			3783	
			NOTIFICATION DATE	DELIVERY MODE
			10/23/2019	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JANKO BUBENIK, HECKMANN HARALD, and HARMS
VOLKER

Appeal 2018-002305
Application 13/878,305
Technology Center 3700

Before CHARLES N. GREENHUT, MICHAEL J. FITZPATRICK, and
ANNETTE R. REIMERS, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–27. *See* Non-Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing was scheduled for October 1, 2019. Appellant waived attendance at the hearing.

We AFFIRM-IN-PART.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as B. BRAUN MELSUNGEN AG. Appeal Br. 1.

CLAIMED SUBJECT MATTER

The claims are directed to hinged shield assemblies and related methods. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A hinged shield assembly configured to shield a needle to prevent needlesticks, the assembly comprising:

a needle hub including a first hinge part defining a first socket and a second socket, the needle extending from the needle hub; and

a shield including a second hinge part defining a first ball and a second ball, the first ball and the second ball engaging the first socket and the second socket to pivotably secure the shield to the needle hub, the shield further including a plurality of side walls configured to partially surround the needle when the shield assembly is in a protected position, the plurality of side walls including a center wall located between a first side wall having the first ball located thereon and a second side wall having the second ball located thereon;

wherein each of the first socket and the second socket comprises an opening with a diameter that increases inward of the opening to a maximum diameter then tapers down to a narrower diameter that is smaller than the maximum diameter and wherein each ball has a diameter that is greater than the diameter of the opening so that the first ball and the second ball seat within the first socket and the second socket and resist withdrawal from the first socket and the second socket.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Nakanishi	US 4,658,471	Apr. 21, 1987
Sweeny	US 5,599,318	Feb. 4, 1997
Carnevali	US 6,561,476 B2	May 13, 2003
Newby	US 2002/0072715 A1	June 13, 2002
Sagisaka	US 2007/0274770 A1	Nov. 29, 2007
Woehr	US 2008/0306451 A1	Dec. 11, 2008
Akins	US 2009/0173330 A1	July 9, 2009

REJECTIONS

Claims 3 and 25 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1–8, 11, 14–17, 22, 23, and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sweeny, Akins, and Sagisaka.

Claims 9, 12, 20, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sweeny, Akins, Sagisaka, and Newby.

Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Sweeny, Akins, Sagisaka, and Carnevali.

Claim 18 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Sweeny, Akins, Sagisaka, Newby, and Carnevali.

Claims 13 and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sweeny, Akins, Sagisaka, and Woehr.

Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Sweeny, Akins, Sagisaka, Woehr, and Carnevali.

Claim 19 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Sweeny, Akins, Sagisaka, Newby, and Woehr.

Claim 27 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Sweeny, Akins, Sagisaka, and Nakanishi.

OPINION

The rejection under 35 U.S.C. § 112, second paragraph

Appellant filed an amendment purporting to overcome the rejection under 35 U.S.C. § 112, second paragraph, on April 18, 2017. We do not find any indication in the record as to whether this amendment was entered or whether it overcame the rejection under 35 U.S.C. § 112, second paragraph. The Examiner repeats the rejection under 35 U.S.C. § 112, second paragraph, in the Examiner's Answer of November 2, 2017 but does not comment on the April 18, 2017 amendment. Ans. 2–3. As Appellant does not seek review of the rejection under 35 U.S.C. § 112, second paragraph (App. Br. 8–9), we consider any arguments that could have been raised as waived and summarily sustain this rejection. *See, e.g., In re Berger*, 279 F.3d 975 (Fed. Cir. 2002) (in which the Board affirmed an uncontested rejection of claims under 35 U.S.C. § 112, second paragraph, and on appeal the Federal Circuit affirmed the Board's decision and found that the appellant had waived his right to contest the indefiniteness rejection by not presenting arguments as to error in the rejection on appeal to the Board). *See also, Hyatt v. Dudas*, 551 F.3d 1307, 1314 (Fed. Cir. 2008) (“applicant can waive appeal of a ground of rejection”). We leave it to the Examiner to clarify the status of the April 18, 2017 amendment.

Obviousness

All of the prior-art rejections presented rely entirely or in part on the combination of Sweeny, Akins, and Sagisaka. The Supreme Court in *KSR*

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Int'l. v. Teleflex, 550 U.S. 398 (2007) reaffirmed the framework for determining obviousness as set forth in *Graham v. John Deere Co.* (383 U.S. 1 (1966)). The first of the factual inquiries set forth in *Graham* that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103(a) is determining the scope and content of the prior art. The determination of the scope and content of the prior art includes determining whether prior art references are “analogous.” Whether a reference in the prior art is “analogous” is a fact question. *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992) (citing *Panduit Corp. v. Dennison Mfg.*, 810 F.2d 1561, 1568 n.9 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987)). Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *Id.* (citing *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986); *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979)). “A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. Thus, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the invention attempts to solve. If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection.” *In re Clay*, 966 F.2d at 659.

Concerning analogousness, Appellant argues:

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Akins and Sagisaka are not from the same fi[el]d of invention, i.e., from the field of hinged cap needle devices. . . Thus, under the first In re Bigio [(381 F.3d 1320 (Fed. Cir. 2004))] prong, Akins and Sagisaka are non-analogous art.

...

[T]he Office fails to consider whether Akins and Sagisaka are reasonably pertinent under the factors outlined in MPEP Section 2141.01(a). For example, the Office did not discuss the problems to be solved by the instant application, by Akins, or by Sagisaka. Instead, the Office merely asserts that Sweeney, Akins, and Sagisaka are combinable as the combination “represents a well-known method of connecting two parts together and would be obvious to one of ordinary skill during the design of such a device.” (OA, p. 5) This conclusory statement is defective and fails to address the non-analogous nature of Akins and Sagisaka

App. Br. 22–23.

In response, “[t]he Examiner maintains that the scope of the prior art encompasses all known hinge designs wherein the hinge is pivoted about a single axis.” Ans. 16. Even if this statement were correct, it would not explain why Sagisaka, which relates to “ball joints used in automobile suspension devices or steering devices” (Sagisaka para. 2) as opposed to “hinge designs,” would pass muster as analogous art. The only further comment by the Examiner in the record before us that relates to this issue appears to be, “[t]he fact that Sagisaka is drawn to an automobile ball joint is immaterial as it is only relied upon to teach said engagement means explicitly.” Ans. 14. The Examiner provides neither authority nor explanation as to why the subject matter to which Sagisaka is drawn is “immaterial” to the obviousness inquiry under 35 U.S.C. § 103(a). Obviousness of the claimed subject matter under § 103(a) is judged from the perspective of a hypothetical person “having ordinary skill in the art *to*

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which said subject matter pertains.” 35 U.S.C. § 103(a) (Emphasis added).

Our reviewing court’s predecessor has stated:

Section 103 requires us to presume full knowledge by the inventor of the prior art in the field of his endeavor. . .but it does not require us to presume full knowledge by the inventor of prior art outside the field of his endeavor. . .In that respect, it only requires us to presume that the inventor would have that ability to select and utilize knowledge from other arts reasonably pertinent to his particular problem which would be expected of a man of ordinary skill in the art to which the subject matter pertains.

In re Antle, 444 F. 2d 1168, 1171–72 (CCPA 1971).

Appellant also challenges the Examiner’s stated reasoning for incorporating the teachings of Akins and Sagisaka, which is: “the ball and socket represents a well-known method of connecting two parts together and would be obvious.” App. Br. 24–25 (citing Non-Final Act. 5). We agree with Appellant that this reasoning lacks any fact-specific context. The Examiner does not appear to expound on this reasoning anywhere else in the record before us. MPEP §§ 2141–43 each state that “[t]he key to supporting any prima facie conclusion of obviousness under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), cited with approval in *KSR Int’l. v. Teleflex*, 550 U.S. 398, 418 (2007). The equivalency of two connection methods for a particular application, the reasons or motivating factors for substituting them, the expectation of success, and the predictability of the results associated with doing so, are all

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factual questions relevant to determining obviousness. *See, e.g.*, MPEP § 2143(I). Where, as here, the record is incomplete with respect to the factual findings and reasoning relied on to reach a conclusion of unpatentability, it becomes difficult to provide any meaningful appellate review. *In re Zurko*, 258 F. 3d 1379, 1386 (Fed. Cir. 2001).

Our reviewing court has frequently cautioned that it is not proper to base a conclusion of obviousness upon facts gleaned only through hindsight. To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction—an illogical and inappropriate process by which to determine patentability. *Sensonics Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570 (Fed. Cir. 1996) (citing *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)). The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made. *Id.* (citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138 (Fed. Cir. 1985)). The analogous-art inquiry, and the requirement for articulating fact-specific reasons for combining reference teachings, as discussed above, provide important guards against the use of hindsight in determining obviousness. In light of the fact that the Examiner has not provided a persuasive explanation as to why Sagisaka should be considered within the scope of the prior art that should be considered in judging obviousness, and the fact that the Examiner has not articulated a persuasive reason supported by rational underpinnings for combining the reference teachings in the manner proposed, we conclude that it is more likely than not that the Examiner improperly resorted to hindsight in reaching a conclusion

of obviousness. Accordingly, the prior-art rejections before us cannot be sustained on the grounds set forth by the Examiner.

CONCLUSION

The Examiner’s indefiniteness rejection is summarily sustained.

The Examiner’s prior-art rejections are reversed.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
3 and 25	112, second paragraph	Indefiniteness	3 and 25	
1–8, 11, 14–17, 22, 23, and 26	103(a)	Sweeny, Akins, and Sagisaka		1–8, 11, 14–17, 22, 23, and 26
9, 12, 20, and 21	103(a)	Sweeny, Akins, Sagisaka, and Newby		9, 12, 20, and 21
10	103(a)	Sweeny, Akins, Sagisaka, and Carnevali		10
18	103(a)	Sweeny, Akins, Sagisaka, Newby, and Carnevali		18
13 and 24	103(a)	Sweeny, Akins, Sagisaka, and Woehr		13 and 24
25	103(a)	Sweeny, Akins, Sagisaka, Woehr, and Carnevali		25
19	103(a)	Sweeny, Akins, Sagisaka, Newby, and Woehr		19
27	103(a)	Sweeny, Akins, Sagisaka, and Nakanishi		27
Overall Outcome			3 and 25	1, 2, 4–24, 26, and 27

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TIME PERIOD FOR RESPONSE

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

AFFIRMED-IN-PART