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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RICHARD TERRY

Appeal 2018-002773
Application 13/516,660[1]
Technology Center 3700

Before BENJAMIN D. M. WOOD, NATHAN A. ENGELS, and LEE L. STEPINA, *Administrative Patent Judges*.

ENGELS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of claims 1–16 and 18–20. Claim 17 is canceled and no other claims are pending. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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

ILLUSTRATIVE CLAIM

Claim 1 is the sole independent claim on Appeal and is reproduced below as illustrative of the claimed subject matter:

> 1. A catheter assembly comprising:
> an elongate member having a proximal end and a distal end;
> the distal end having at least one drainage opening;
> a fluid containing member arranged on the elongate member; and
> a container containing the elongate member and the fluid containing member, wherein the container is a fluid impermeable package, and wherein a fluid contained in the container is disposed in the fluid containing member so as not to wet the container when contacting the same.

THE REJECTIONS

Claims 1–16 and 18–20 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 1–16 and 18–20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1, 2, 4–7, 9–13, 16, and 18–20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Murray et al. (US 7,380,658 B2; iss. June 3, 2008).

Claims 3, 14, and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Murray.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable in view of the combined teachings of Murray and Nishtala et al. (US 2010/0198195 A1; publ. Aug. 5, 2010).

ANALYSIS

In relevant part, independent claim 1 recites "wherein a fluid contained in the container is disposed in the fluid containing member so as not to wet the container when contacting the same." The Examiner determines that this language renders independent claim 1 and dependent claims 2–16 and 18–20 indefinite because it is unclear what elements are referenced by the language "when contacting the same." Final Act. 6.

Appellant's Appeal Brief does not address the Examiner's indefiniteness rejection. The Reply Brief, however, explains that Appellant submitted an amendment after the Final Office Action to replace the language "when contacting the same" with "when the fluid containing member contacts the container." Reply Br. 5. Appellant acknowledges, though, that the amendment was not entered.[2]

The Reply Brief also suggests that, even without the amendment, the correct interpretation of the disputed limitation "in view of the specification and common sense is that the *fluid containing member* does not wet the container upon contact," *Id.* at 4. Appellant cites the following language from the Specification as support for that interpretation: "In embodiments, the outside diameter 20a can alternatively be made fluid impermeable so as to not . . . wet the package 12 when contacting the same." *Id.* (quoting Spec. ¶ 63).

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[2] Appellant argues that the Examiner's decision to deny entry of the amendment was "flawed." Reply Br. 5. However, denial of entry of an amendment is a petitionable matter and not one properly addressed by the Board. *See* 37 C.F.R. § 1.181; 37 C.F.R. § 1.127; *see also In re Berger*, 279 F.3d 975, 984 (Fed. Cir. 2002), and *In re Hengehold*, 440 F.2d 1395, 1403 (CCPA 1971)).

We disagree with Appellant. First, by failing to address the Examiner's indefiniteness rejection in the Appeal Brief, Appellant's arguments were waived. *See Hyatt v. Dudas*, 551 F.3d 1307, 1313–14 (Fed. Cir. 2008); *Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (informative); 37 C.F.R. §§ 41.37(c)(1)(iv), 41.41(b)(2). Even if Appellant had not waived its arguments, we agree with the Examiner that claims 1–16 and 18–20 are indefinite.

Reading the plain language of claim 1 in light of Appellant's Specification, the scope and meaning of the disputed language is unclear and is not amenable to interpretation without considerable speculation. The plain language of claim 1 is unclear and nothing in the Specification defines or otherwise limits the scope of claim 1 to a particular interpretation. Notably, Appellant advances an implicit interpretation in arguments intended to overcome the prior art that is different than the interpretation quoted above from the Reply Brief. *Compare* Appeal Br. 10–11 (arguing Murray does not anticipate claim 1 because Murray discloses that fluid contacts and therefore wets the container), *with* Reply Br. 4 (interpreting the disputed limitation to mean "when the *fluid containing member* contacts the container"); *see* Ans. 3–4 (contending that water vapor cannot "wet" a container for the purposes of claim 1); Reply Br. 7–9 (arguing water vapor can "wet" a container for the purposes of claim 1). Accordingly, we affirm the Examiner's rejection of claims 1–16 and 18–20 as being indefinite, but, because the claims are indefinite and require considerable speculation as to scopes of the claims, we reverse *pro forma* the Examiner's prior art rejections. *See In re Steele*, 305 F.2d 859, 862 (CCPA 1962) (holding that the Examiner and the Board were wrong in relying on what, at best, were

speculative assumptions as to the meaning of the claims and in basing a prior-art rejection thereon).

Appellant also failed to address the Examiner's rejection of claims 1–16 and 18–20 as failing to comply with the written description requirement. As the rejection is unrebutted, we summarily affirm the Examiner's written description rejection.

DECISION

We affirm the Examiner's rejections of claims 1–16 and 18–20 under 35 U.S.C. § 112, first paragraph, and § 112, second paragraph.

We reverse *pro forma* the Examiner's rejections of claims 1–16 and 18–20 under 35 U.S.C. § 102(a) and § 103.

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