



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
**United States Patent and Trademark Office**  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/495,934	09/25/2014	Kristin Finberg	0109/0048	1007
135866	7590	03/13/2020	EXAMINER	
LAW OFFICE OF LOUIS WOO 717 NORTH FAYETTE STREET ALEXANDRIA, VA 22314			AHMED, TASNIM M	
			ART UNIT	PAPER NUMBER
			3783	
			MAIL DATE	DELIVERY MODE
			03/13/2020	PAPER

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

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* KRISTIN FINBERG, CAL AARON HOOPLE,  
AMY KUBAS, RONALD GENE TRAVIS, and LOUIS WOO

---

Appeal 2019-004885  
Application 14/495,934  
Technology Center 3700

---

Before JENNIFER D. BAHR, MICHAEL L. HOELTER, and  
MICHAEL J. FITZPATRICK, *Administrative Patent Judges*.

FITZPATRICK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a) from the Examiner's final decision rejecting claims 8–11 and 21–24. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

---

<sup>1</sup> We use “Appellant” in reference to the “applicant” as the latter term is defined in 37 C.F.R. § 1.42. Appellant identifies Smiths Medical ASD, Inc. as assignee and sole real party in interest. Appeal Br. 3.

## STATEMENT OF THE CASE

### *The Specification*

The Specification's disclosure "relates to implantable medical devices and more particularly to portals having an indicia bearing septum that can readily be identified after being implanted into a patient, and methods of manufacturing the indicia bearing septum." Spec. ¶1.

### *The Claims*

Claims 8–11 and 21–24 are rejected. Final Act. 1. The only other pending claims, namely claims 1–7 and 12–20, have been withdrawn from consideration. *Id.* Claims 8 and 9 are the independent claims on appeal. Appeal Br. 19–20. Claim 8 is illustrative and reproduced below.

8. A port implantable into a patient, comprising:
  - a housing having a chamber with an opening and an outlet, the opening having fitted therein a one piece unitary septum made of an elastomeric material having
    - at least one continuous cavity of a given configuration formed by a depression on the top surface of the septum,
    - a one piece solid radiopaque insert injection molded from a liquid radiopaque material having the given configuration fittingly mounted to the cavity to present a visual indicia,
    - the septum sealing the opening of the chamber to form a reservoir in the housing adapted to store a fluid,
    - a catheter adapted to be connected to the outlet to be in fluid communication with the reservoir so that the fluid is conveyable between the reservoir and the patient when the port is implanted into the patient;
  - wherein, after the port is implanted in the patient, the radiopaque insert at the septum provides at least one

identification indicia of the port under x-ray or computer tomography imaging.

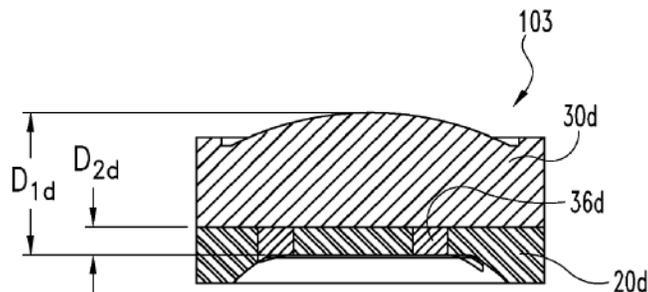
*Id.* at 19 (paragraphing added).

*The Examiner's Rejection*

The following rejection before us is claims 8–11 and 21–24, under 35 U.S.C. § 102(a)(1), as anticipated by US 2011/0288503 A1, published Nov. 24, 2011 (“Magalich”).

DISCUSSION

Magalich discloses a medical imaging septum and access port device. Magalich, Title. The Examiner found that Magalich discloses all of the limitations of claim 8. Final Act. 3–4 (citing Magalich ¶¶2, 4, 5, 8, 54, 74, 85, 89 and Figs. 2, 5D, 6, 7, 9). To meet the “one piece unitary septum” limitation, the Examiner relies *exclusively* on the embodiment of Figure 5D. *See* Ans. 8 (“For clarification, the embodiment of the device being relied on is that of Fig. 5D only, where the device as a whole comprises distinct elements of a first elastomer region 30d, a second elastomer region 20d, and an insert 36d; other figures are only referred to for labels or other perspectives of the exemplary device.”). Figure 5D of Magalich is reproduced below.



**Fig. 5D**

Figure 5D of Magalich shows a cross-sectional view of septum 103. Magalich ¶¶18, 86. The Magalich septum comprises two elastomeric regions 20d and 30d. ¶¶72, 89. Region 20d includes former voids that have been “filled” in by indicia 36d. *See id.* ¶89 (“As illustrated in FIG. 5D, region 36d, which may comprise the indicia, is shown as a solid material, often an elastomeric region.”). The indicia 36d “may include radiopacity additive. Alternatively region 36d may lack, or have less, radiopacity additive or other attributes as compared to other regions, such as for example region 20d.” *Id.*

The Examiner finds that region 20d is “one piece unitary septum made of an elastomeric material” within the meaning of claim 8. Final Act. 3. Appellant argues that the Magalich septum 103 is not a one piece unitary septum because it is explicitly described as consisting of multiple elastomeric regions, i.e., 20d and 30d in the asserted embodiment of Figure 5D. Appeal Br. 10–11. The Examiner responds that region 20d alone is asserted as a one piece unitary septum. *See* Ans. 8 (“[O]nly the second elastomer region 20d is being considered as the claimed septum.”). The Examiner is free to do this as the claim is open-ended and does not exclude additional structure. *See* Appeal Br. 19 (Claim 8 reciting: “A port implantable into a patient, *comprising*: . . .” (emphasis added)). However, region 20d, although “one piece” and “unitary,” is not a septum, given the voids that extend fully therethrough. In other words, region 20d is incapable of “sealing the opening of the chamber to form a reservoir in the housing adapted to store a fluid,” as further recited in claim 8. And, even if indicia 36d effectively plugs those voids, indicia 36d cannot be considered as part of the septum, because the septum must be “one piece unitary.”

Accordingly, based on the record established by the Examiner focusing exclusively on Figure 5D of Magalich, we reverse the rejection of independent claim 8. We likewise reverse the rejection of claim 9, which similarly recites “a one piece unitary resealable elastomer septum having a top surface sealingly fitted to the top opening to establish a reservoir in the housing.” Appeal Br. 19. We also reverse the rejection of claims 10, 11, and 21–24, all of which depend from either claim 8 or claim 9. *See In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988) (“Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.”).

SUMMARY

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>References/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
8–11, 21–24	102(a)(1)	Magalich		8–11, 21–24

REVERSED