

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte STEPHEN B. CORN

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Appeal No. 96-4041  
Application 08/264,704<sup>1</sup>

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ON BRIEF

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Before McCANDLISH, Senior Administrative Patent Judge.

STAAB and McQUADE, Administrative Patent Judges.

STAAB, Administrative Patent Judges.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1 and 3-12, all the claims then pending in

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<sup>1</sup> Application for patent filed June 23, 1994. According to appellant, the application is a continuation of Application 07/938,366, August 31, 1992, now abandoned.

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the application. Subsequent to the final rejection, appellant submitted an amendment canceling claim 12. Accordingly, only claims 1 and 3-11 remain in the application.

Appellant's invention pertains to a scavenging device that prevents the release of anesthetic gas into the environment of an operating room. An understanding of the invention can be derived from reading independent claim 1, a copy of which is appended to appellant's brief.

The references of record relied upon by the examiner in support of the rejections are:

Trammell et al (Trammell) 1983	4,407,280	Oct. 4,
Poppendiek et al (Poppendiek) 23, 1989	4,832,042	May
Corn 6, 1994	5,370,110	Dec.

Claims 1 and 3-11 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of the Corn patent.<sup>2</sup>

Claims 1 and 3-11 stand further rejected under 35 U.S.C.

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<sup>2</sup> This is a new ground of rejection made for the first time in the answer.

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§ 103 as being unpatentable over Trammell in view of Poppendiek.

The rejections are explained in the examiner's answer (Paper No. 17, mailed April 11, 1996) and the supplemental examiner's answer (Paper No. 21, mailed September 3, 1996).

The opposing viewpoints of appellant are set forth in the brief (Paper No. 16, filed January 11, 1996) and the reply brief (Paper No. 19, filed June 17, 1996).

*The obviousness-type double patenting rejection*

Considering first the rejection of the appealed claims under the judicially created doctrine of obviousness-type double patenting, the reply brief states on page 2 that "Applicant hereby offers to submit a suitable Terminal Disclaimer in order to overcome the new ground of rejection. Such a Terminal Disclaimer will be filed at such time as the obviousness-type double patenting rejection stands as the only obstacle to allowance."

In light of the circumstance that appellant has failed to point out any error in the examiner's obviousness-type double

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patenting rejection, offering instead to submit a suitable terminal disclaimer "at such time as the obviousness-type double patenting rejection stands as the only obstacle to allowance," we are constrained to affirm this rejection.

*The 35 U.S.C. § 103 rejection*

Claim 1 calls for a vapor scavenging device comprising:  
(1) an enclosure means for placement over a patient's head,  
(2) closure means for closing an open bottom of the enclosure means to form a seal about the patient's neck, (3) a first opening means disposed in the enclosure means for accommodating an

anesthesia circuit fitting directly communicating with a patient's airway, (4) a second opening in the enclosure means, and (5) a conduit means sealingly engaging with the second opening for directly communicating a vacuum force to the interior of the enclosure means for removing waste gas therefrom.

Turning to Trammell, the examiner's primary reference, appellant does not dispute the examiner's finding that

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disposable hood 12 comprises an enclosure means as called for in claim 1. Further, we do not consider the claim 1 requirement for a closure means for closing an open bottom of the enclosure means to form a seal about the patient's neck to be an argued distinction over Trammell. In this regard, appellant does not specifically dispute the examiner's finding that Trammell's "means (24) close[s] said open bottom [of the enclosure] about the patient's neck" (answer, page 4). Further, the general 35 U.S.C. § 112, sixth paragraph, discussion found on page 10 of appellant's brief is not seen as a specific argument that Trammell does not have the claim 1 "closure means." In any event, Trammell's opening 23 constitutes "closure means" as called for in claim 1, as that term would be understood by one of ordinary skill in the art when read in light of the specification, in that appellant's specification indicates that the "seal" about the patient's neck

is "loose" (page 6, line 9), "not necessarily . . . airtight" (page 7, line 17), and merely creates "an effective degree of

sealing . . . . about the patient's neck" (sentence bridging pages 7 and 8) such that any leakage of gas in the enclosure from the area adjacent the patient's neck can be prevented by applying a suction force to the interior of the enclosure.

As to the claim 1 requirements for a first opening means in the enclosure for accommodating an anesthesia circuit fitting, and a second opening in the enclosure, we are aware that the examiner reads these claim limitations on Trammell's opening at fitting 27 and Trammell's opening 34<sup>3</sup>, respectively. However, we believe the better approach is to consider Trammell's opening 34 as corresponding to the claimed first opening means and Trammell's opening at fitting 27 as corresponding to the claimed second opening. First, Trammell's opening 34 satisfies the claimed "first opening means" limitation in that opening 34 of Trammell constitutes an opening in the enclosure that is fully capable of accommodating an anesthesia circuit fitting directly communicating with a patient's airway. Second, when the claimed "second opening" is read on Trammell's opening at

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<sup>3</sup> Trammell uses reference numeral 34 twice, once for a hose and once for an opening in the top of the enclosure.

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fitting member 27, Trammell's fitting 27 and conduit 34 collectively may then be read on the final claim limitation calling for a "conduit means"

sealingly engaged in the second opening since Trammell's fitting 27 and hose 34 are sealingly engaged in the opening via flange 26 and fitting member 29, and since fitting 27 and hose 34 are fully capable of directly communicating a vacuum force to the interior of the enclosure means for removing waste gases therefrom. Accordingly, when Trammell is viewed in this light, there is no need to resort to Poppendiek for a teaching of providing a conduit means in the second opening of Trammell.

To the extent appellant argues that the sixth paragraph of 35 U.S.C. § 112 requires interpreting the "first opening means" and "conduit means" limitations of claim 1 in a manner that distinguishes over Trammell's opening 34 and conduit means 27, 34, respectively, the argument is not well taken. It is debatable whether the "first opening means" and "conduit means" recitations are linked to the functional language that follow in a manner that triggers the 35 U.S.C. § 112, sixth

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paragraph, procedures

for construing means-plus-function claim terminology.<sup>4</sup>

However,

even if the "first opening means . . ." and "conduit means . . .  
." recitations of claim 1 are considered to be means-plus-  
function limitations within the meaning of 35 U.S.C. § 112,  
sixth paragraph, they do not distinguish over Trammell's  
opening 34 and conduit means 27, 34. This is so because  
Trammell's opening 34 and conduit means 27, 34 are fully  
capable of functioning in the ways set forth in the claim,  
and, in our view, are structurally the same as, or at least  
the equivalent of, the structures disclosed in appellant's  
specification that correspond to the claimed "opening means"  
and "conduit means" (i.e., opening 24 and tube 16,

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<sup>4</sup> See *York Products, Inc. v. Central Tractor Farm & Family Center*, 99 F.3d 1568, 1574, 40 USPQ2d, 1619, 1623 (Fed. Cir. 1996)(mere incantation of word "means" does not necessarily evoke § 112, sixth paragraph); *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 531, 41 USPQ2d 1001, 1006 (Fed. Cir. 1996)(merely because named element of claim is followed by word "means" does not automatically make element "means-plus-function" element under § 112, sixth paragraph).

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respectively).

Moreover, even when we read claim 1 on the Trammell device in the manner proposed by the examiner, Poppendiek's teaching that a suction force may be applied to a hood fitted over the head of a patient to promote the flow of exhalant gases therefrom would have provided ample suggestion to one of ordinary skill in the art to provide a tube in the opening 34 of Trammel to provide for positive evacuation of exhaled gases from the hood. In this regard, there is no requirement in the test for obviousness under 35 U.S.C. § 103 that the motivation for combining reference teachings be expressly articulated or suggested by the prior art. See *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983) and *In re McLaughlin*, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). Instead, the suggestion for combining the reference teachings may be an implied suggestion. See, for example, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025, 226 USPQ 881, 886-87 (Fed. Cir. 1985) and *In re Sernaker, supra*.

Appellant makes much of the fact that Trammell does not disclose or suggest accommodating an anesthesia circuit

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fitting in any of the hood openings. However, in that claim 1 does not positively recite the anesthesia circuit fitting as a positive element of the claimed subject matter, this line of argument is not persuasive.

With respect to appellant's argument on page 8 of the brief to the effect that Trammell's device would not work if modified in the manner proposed by the examiner, we are appraised of no persuasive evidence of record to support appellant's contention. It is well settled that an attorney's argument in the brief cannot take the place of evidence and that arguments of counsel, unsupported by competent factual evidence of record, are entitled to little weight. See *In re Payne*, 606 F.2d 303, 315, 203 USPQ 245, 256 (CCPA 1979) and *In re Pearson*, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

In light of the foregoing, we will sustain the standing rejection of claim 1 as being unpatentable over the teachings of Trammell and Poppendiek. In that appellant has not

separately argued the rejection of dependent claim 11 apart from claim 1, we will sustain the rejection of this claim as well.

We will also sustain the standing § 103 rejection of claim 4. When Trammell's opening 34 is viewed as corresponding to the claimed first opening means and Trammell's opening at fitting 27 is viewed as corresponding to the claimed second opening, Trammell's conduit means 27, 34 has a portion extending within the interior of the enclosure (see Figure 5) and a portion protruding from the enclosure. In addition, Trammell's conduit means is "affixed" to an inner surface of the enclosure in the broad sense in that flange 26 is held in tight surface to surface contact with an adjacent part of the enclosure's inner surface. In any event, it also would have been an obvious expedient to one of ordinary skill in the art to adhere flange 26 to the inner surface of the enclosure for the self evident purpose of providing a more secure engagement therebetween.

We will likewise sustain the rejection of claim 5 which depends from claim 4. Trammell's diffuser openings 33 define a construction that is perforated about the periphery of that

portion of the conduit means that extends within the enclosure.

In that appellant has not separately argued the rejection of claim 7 apart from claim 5 from which it depends, we will also sustain the rejection of this claim.

We will not sustain the rejection of claims 6, 8, 9 and 10. The examiner's position that it would have been obvious to one of ordinary skill in the art in light of the reference teachings to dispose the conduit means at a position adjacent to the patient's face (claim 6), provide a first opening in the form of a V-shaped split<sup>5</sup> (claim 8), provide closure means in the form of a strip or release tape (claim 9), and/or add a third port within the enclosure in communication with means for delivering heated, humidified air to the enclosure<sup>6</sup> (claim 10) is not well taken. In each instance, the examiner has failed to indicate any teaching in the applied references or

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<sup>5</sup> We note that the first opening of appellant's Figure 3 embodiment is not V-shaped as shown wherein the flaps 28 are flat, but rather only when said flaps are spread apart.

<sup>6</sup> In order to bring the drawings into compliance with 37 CFR § 1.83(a), this feature should be shown in the drawings.

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any prior knowledge generally available to one of ordinary skill in the art that would have led a person of ordinary skill in the art to modify Trammell in the manner proposed. For this reason, the rejections of these appealed claims must fail for lack of a sufficient

factual basis. *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968).

As to claim 3, for reasons stated *infra* in our new rejection entered under the provisions of 37 CFR 1.196(b), we have encountered substantial difficulty in understanding precisely what is meant by certain language in that claim. While we might speculate as to what is meant by the claim language in question, our uncertainty provides us with no proper basis for making the comparison between that which is claimed and the prior art as we are obligated to do. Rejections under 35 U.S.C. § 103 should not be based upon "considerable speculation as to the meaning of terms employed and assumptions as to the scope of the claims." *In re Steele*,

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305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). When no reasonably definite meaning can be ascribed to certain terms in a claim, the subject matter does not become obvious, but rather the claim becomes indefinite. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Accordingly, we are constrained to reverse the examiner's rejections of claim 3 as being unpatentable over the prior art. We hasten to add that this is a procedural reversal rather than one based upon the

merits of the rejection. We take no position as to the pertinence of the prior art as applied by the examiner in his rejection.

Pursuant to our authority under 37 CFR 1.196(b), we make the following new rejection.

Claim 3 is rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention. Claim 3 depends from claim 1 and further calls

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for a "fastening means" for selectively closing the first opening about the anesthesia circuit fitting<sup>7</sup> and the bottom portion of the enclosure means about the patient's neck. It is not clear if the fastening means of claim 3, which selectively closes the bottom portion of the enclosure about the patient's neck, is separate from the "closure means" of claim 1 that forms a seal about the patient's neck, or one and the same as the earlier recited "closure means."

*Summary*

The obviousness-type double patenting rejection of claims 1 and 3-11 is affirmed.

The § 103 rejection of claims 1, 4, 5, 7 and 11 is affirmed.

The § 103 rejection of claims 6 and 8-10 is reversed on the merits.

The § 103 rejection of claim 3 is reversed on procedural

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<sup>7</sup> The term "the breathing or anesthesia circuit fitting" appearing in claim 3 lacks a clear antecedent. For purposes of this appeal, we interpret same as "the anesthesia circuit fitting."

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grounds.

A new rejection of claim 3 under 35 U.S.C. § 112, second paragraph, has been made pursuant to our authority under 37 CFR § 1.196(b).

Since at least one of the examiner's rejections of each of the appealed claims has been sustained, the decision of the examiner is affirmed.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63,122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise

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one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request

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for reconsideration thereof.

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

*AFFIRMED; 37 CFR § 1.196(b)*

HARRISON E. McCANDLISH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JOHN P. McQUADE	)	
Administrative Patent Judge	)	

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LJS/pgg  
William C. Geary III  
Nutter, McClennen & Fish, LLP  
One International Place  
Boston, Massachusetts 02110-2699