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David W. Hight, VP & Chief IP Counsel Becton, Dickinson and Company (The Webb Firm) 1 Becton Drive, MC 110 Franklin Lakes, NJ 07414-1880			DESANTO, MATTHEW F	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* SIN FONG CHIN, CHEE LEONG ALVIN TAN,  
YAOHAN JON MOH, and KIAT JIN CHENG<sup>1</sup>

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Appeal 2010-010016  
Application 11/429,808  
Technology Center 3700

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*Before* SCOTT R. BOALICK, KEVIN F. TURNER, and  
DANIEL S. SONG, *Administrative Patent Judges*.

SONG, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> The real party in interest is Becton, Dickinson and Company (App. Br. 3).

The inventors (collectively “Appellant”) appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1-3, 5, 7, 11-13, 16, 17, 23 and 24 (Reply Br. 2).<sup>2</sup> We have jurisdiction over this appeal under 35 U.S.C. §§ 6(b) and 134(a).

The claimed invention is directed to a safety blood collection device that allows retraction of a needle into a holder housing based on the force of gravity (Abstract). Illustrative Figure 7A is reproduced below.

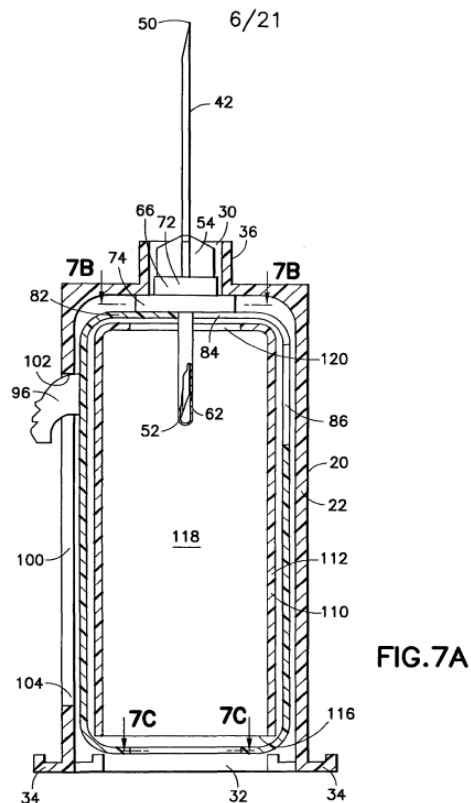


Figure 7A above is a partial cross-sectional view of a safety blood collection device including a needle cannula 42 of a needle assembly 40 (*see* FIG. 2) having a puncture tip 50 extending from a forward end of a holder

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<sup>2</sup> The Examiner's Answer indicates that previously-rejected dependent claims 4, 6, 8-10, 14, 15, 18-20, 25 and 26 are objected to as being dependent upon a rejected base claim (Ans. 2).

housing 20 (Spec. ¶¶ [0027], [0049] and [0064]). A flexible band member 82 that includes a slot 84 and slot opening 86 is disposed between the holder housing 20 and an inner housing insert 110 (Spec. ¶¶ [0058], [0064]; *see also* FIG. 5). The needle assembly is maintained in this position by flange 74 which has an outer diameter larger than the slot 84 (Spec. ¶¶ [0052], [0064]; *see also* FIGS. 5, 6 and 7B). The band member 82 is movable to a second position (Spec. ¶¶ [0065]-[0066]; *see also* FIGS. 9A and 9B), in which the flange 74 is aligned with the slot opening 86 which is sized to allow the flange 74, and thus the needle assembly, to drop under the force of gravity into the interior chamber 118 of the inner housing insert 110 (Spec. ¶ [0066]; *see also* FIGS. 9A and 10A).

Independent claim 1 is representative of the appealed claims and reads as follows (App. Br. 26, Claims App'x., emphasis added):

1. A safety blood collection device comprising:
  - a holder housing comprising a generally tubular wall extending between a forward end and an open rearward end to define an interior chamber therein, the rearward end of the holder housing adapted to receive a sample collection tube therethrough;
  - a needle including a puncture tip; and
  - a retainer co-acting with the holder housing and adapted to maintain the needle in a first position with the puncture tip extending from the forward end of the holder housing, *the retainer adapted for activation so as to release the needle, such that the force of gravity acts based on the weight of the needle to move the needle from the first position extending from the forward end of the holder housing to a second position in which the*

*puncture tip is contained within the interior chamber of the holder housing.*

#### THE REJECTIONS

1. The Examiner rejected claims 1-3, 5, 7, 11-13, 23 and 24 under 35 U.S.C. § 102(b) as anticipated by Crawford (US 6,306,118 B1 issued Oct. 23, 2001).

2. The Examiner rejected claims 1-3, 5, 7, 11-13, 23 and 24 under 35 U.S.C. § 102(b) as anticipated by Kinsey (US 5,755,673 issued May 26, 1998).

We REVERSE.

#### ISSUES

The following issues have been raised in the present appeal.

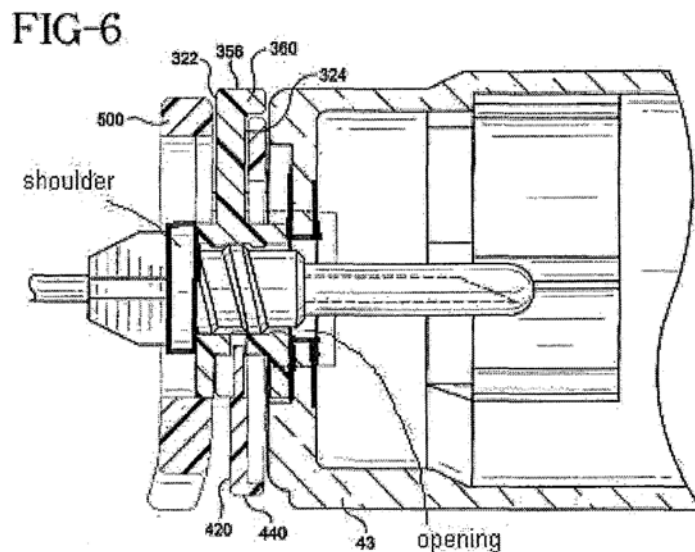
1. Whether the Examiner erred in finding that Crawford discloses a safety blood collection device comprising a retainer that can be activated to release a needle, such that the needle moves to a position in which the puncture tip is contained within the interior chamber of a holder housing as recited in claims 1 and 23.

2. Whether the Examiner erred in finding that Kinsey discloses a safety blood collection device comprising a retainer that can be activated to release a needle, such that the needle moves to a position in which the puncture tip is contained within the interior chamber of a holder housing as recited in claims 1 and 23.

## FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Crawford discloses a needle holder assembly (Abstract). Annotated Figure 6 of Crawford shown in the Appeal Brief is reproduced below (App. Br. 17).



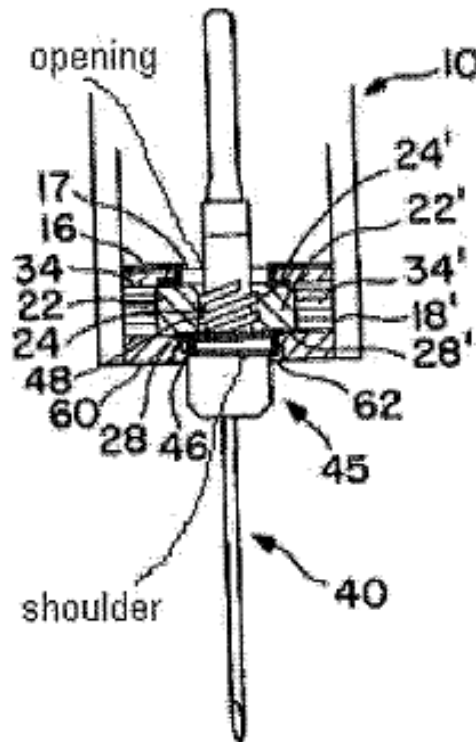
*Crawford*

Figure 6 above shows an exploded cross-sectional view of a portion of a needle holder assembly comprising a holder including a housing (20), an actuation mechanism (100) in a closed position, and a needle assembly (*see* col. 4, l. 26-27, 58-59; col. 6, ll. 30-37; FIGS. 2, 9 and 16). The Appellant's annotations to the figure show the "shoulder" of the needle assembly and the "opening" (i.e., aperture 62) at top end (22) of the housing (20) (col. 4, l. 60; *see also* FIGS. 2, 5, 12).

2. Crawford discloses that the actuation mechanism (100) includes a disengaging trigger 400 to move the actuation mechanism into

an open position to release the needle assembly (col. 6, ll. 37-41; FIGS. 8, 9, 18).

3. Crawford depicts the housing (20) as having an open bottom end 26 (col. 4, ll. 60-61; FIG. 5).
4. Kinsey discloses a needle holder (Abstract). Annotated Figure 4a of Kinsey shown in the Appeal Brief is reproduced below (App. Br. 22).



**FIG. 4a**

Figure 4a of Kinsey is a fragmentary medial sectional view of a holder 10 in combination with a cannula 40 showing an actuation mechanism 20 (see also FIG. 3a) in a cannula-mounting position (col. 4, ll. 45-48; col. 7, ll. 13-16). In this position, a hub disk 46 is received within an aperture 62 and

abuts the threaded halves 22, 22' (col. 7, ll. 17-22). The Appellant's annotations to the figure show the "shoulder" (i.e., hub disk 46) of the cannula 40 and the "opening" (i.e., aperture 17) of the end wall 16 (col. 6, l. 12).

5. Kinsey discloses that the hollow body 14 of the holder 10 has an open end at which a collection tube 50 is inserted into the hollow region of the hollow body (col. 5, ll. 7-14; *see* FIG. 1).

#### PRINCIPLES OF LAW

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

#### ANALYSIS

*Rejection of claims 1-3, 5, 7, 11-13, 23 and 24 as anticipated by Crawford*

As to claim 1, the Examiner determines that Crawford discloses a housing 20 (i.e., holder housing) defining an interior chamber therein; a needle including a puncture tip; and an actuation mechanism 100 (i.e., retainer) (Ans. 3; FIG. 2; FF 1). The Examiner contends that the retainer is adapted for activation to release the needle, such that the force of gravity acts on the needle to move it from a first position shown in Figure 5, to a second position in which the puncture tip is "contained within" the interior chamber of the housing (Ans. 3-4). The Examiner interprets the term

"contain" as "to have within" as defined in *The American Heritage Dictionary of the English Language* (Ans. 4-5).

The Appellant argues that the needle holder assembly of Crawford is physically incapable of releasing the needle into the housing (App. Br. 17; Reply Br. 4). In this regard, the Appellant contends that Figure 6 of Crawford shows that the needle assembly has a shoulder (annotated as "shoulder") that has a larger diameter than the opening (annotated as "opening") into the holder assembly (App. Br. 17; Reply Br. 4; FF 1), and consequently, the opening that is created when the threaded needle is released (FF 2) is insufficient in size for the needle to drop into the interior of the holder. The Appellant also argues that the term "contained within" means to "hold therein," "hold" also being a definition of "contain." (App. Br. 16-17; Reply Br. 2).

We disagree with the Appellant that the construction of the term "contained within" should be limited to mean "hold therein" as this construction, in our view, improperly imports limitations from the embodiments of the specification into the claim. Nonetheless, we agree with the Appellant that the rejection is not sustainable.

In Crawford, in order for the needle assembly to move into the interior of the housing (20) upon engagement of disengaging trigger (400), the "shoulder" must fit through the aperture 62 (*see* FIGS. 2, 9 and 18). As shown in Figure 6 of Crawford, however, the diameter of the "shoulder" appears to be larger than the diameter of the aperture 62 so that the "shoulder" would not be able to fit therethrough. While Crawford does not describe that the drawings are to scale, that does not mean "that things patent

drawings show clearly are to be disregarded." *In re Mraz*, 455 F.2d 1069, 1072 (CCPA 1972). Figure 6 shows the relative sizes of the shoulder and aperture, and as the Examiner has not directed us to any disclosure in Crawford that supports the position the aperture is sized larger than the shoulder, we find that inherency has not been established. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) ("Inherency ... may not be established by probabilities or possibilities.")

Therefore, in view of the above, we reverse the Examiner's anticipation rejection of claim 1, as well as claims 2, 3, 5, 7, 11-13, 16 and 17, which depend from claim 1. Independent claim 23 is similar to claim 1. Hence, we also reverse the anticipation rejection of claim 23 for substantially the same reasons, as well as claim 24, which depends therefrom.

*Rejection of claims 1-3, 5, 7, 11-13, 23 and 24 as anticipated by Kinsey*

As to independent claims 1 and 23, the scope of Kinsey's disclosure, the Examiner's basis for the rejection, and the Appellant's arguments for patentability, are all substantially the same as those for Crawford discussed *supra* (see FF 4, 5; App. Br. 21-23; Reply Br. 5-7). Thus, we reverse the Examiner's anticipation rejection of claims 1 and 23 based on Kinsey, as well as claims 2, 3, 5, 7 and 11-13, which depend from claim 1, and claim 24, which depends from claim 23.

### CONCLUSION

The Examiner erred in finding that Crawford or Kinsey each discloses a safety blood collection device comprising a retainer that can be activated to release a needle, such that the needle moves to a position in which the puncture tip is contained within the interior chamber of a holder housing as recited in claims 1 and 23.

### DECISION

The Examiner's rejections are reversed.

REVERSED

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