The opinion in support of the decision being entered today was **not** written
for publication and is **not** binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROYICE B. EVERETT

Appeal No. 2000-0087
Application No. 08/592,006

ON BRIEF

Before ABRAMS, McQUADE, and STAAB, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 6 and 26-40, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a method of sterilizing a female patient by closing the fallopian tubes. An understanding of the invention can be derived from a reading of exemplary claim 32, which appears in the appendix to the appellant's Brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Sagie et al. (Sagie)	5,107,513	Apr. 21, 1992

Claims 6 and 26-40 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sagie.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the Answer (Paper No. 13) and the final rejection (Paper No. 7) for the examiner's complete reasoning in support of the rejection, and to the Supplemental Brief (Paper No. 12) and Reply Brief (Paper No. 14) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The appellant's invention is directed to a gynecological procedure for sterilizing a female patient by placing a heating device in fixed contact with tissue adjacent to the tubal ostia in order to coagulate the interstitial portion of the patient's fallopian tube and thereby close the fallopian tube. As disclosed, the method utilizes a light-transmitting optical fiber conduit that transmits laser light energy, which is converted at least in part to heat energy. The optical fiber is inserted through the patient's uterus. As manifested in independent claim 32, the appellant's inventive method comprises the steps of

> (a) inserting into the patient's uterus an elongated light energy transmitting conduit having a distal end;
>
> (b) transmitting light energy through said conduit such that at least a portion of the transmitted energy generates heat; and
>
> (c) coagulating tissue adjacent to the patient's fallopian tubes and thereby closing the patient's fallopian tubes by applying said heat to said tissue.

Independent claim 6 is more limited, in that it specifies that the tissue to which the heat is applied is a portion of the uterus, and includes the additional step of repeating the step of applying heat for the other of the patient's fallopian tubes, so that both are closed. Independent claim 35 also is more limited than claim 32, for it requires that the distal end of the light transmitting conduit be positioned adjacent to the patient's tubal ostia.

It is the examiner's position that the claimed method would have been obvious to one of ordinary skill in the art in view of the teachings of Sagie. The appellant argues that this would not have been the case, and points out a number of deficiencies in Sagie's

teachings with regard to the claimed invention which, in his view, are overcome only by the use of hindsight on the part of the examiner. We find ourselves to be generally in agreement with the positions advanced by the appellant in the Briefs.

Sagie is concerned with finding a laser that may be "efficiently employed in a variety of uses" (column 6, lines 54 and 55), including gastro-enterology, general surgery, urology, vascular surgery, gall stones, bronchoscopy, neurosurgery, cardiac surgery, and gynecology (column 7, lines 3-5). While Sagie considers the Neodymium-YAG laser proposed for use by the appellant, and other lasers, as effective in some respects, the reference teaches that the holmium laser is best for all-around use in medical-surgical applications (column 7, line 14 et seq.). In the discussion that follows of the various procedures for which this selected laser is usable, Sagie provides the following information at column 11, lines 42-53, which is the sole portion of the reference upon which the examiner relies in the rejection (Paper No. 7, page 2):

> 8. Holmium Laser Application in Gynecology
>
> In order to verify the holmium laser application in the field the following studies were conducted: fallopian tube sterilization by tube shrinkage; reversal of this sterilization procedure using a welding technique; and intrauterine surgery of polyps, benign tumors and septum. On the basis of these experiments, safe and effective ablation of endometrium for memorhaghia can also be expected. Some of the work in this field is disclosed in Lachman, E. et al. 7th Congress of the International Society for Laser Surgery and Medicine, Munich, FRG, (1987), incorporated herein by reference.

Even if one were to accept, arguendo, the examiner's position that one of ordinary skill in the art would have found it obvious, from the above paragraph of Sagie when taken with the mention of coagulation elsewhere in the reference, to close the fallopian tubes by means of laser coagulation, and that the laser be introduced through the patient's uterus, a fatal defect still exists in the rejection. This resides in the requirement in all three of the independent claims that the coagulation should be performed in tissue "adjacent to" the fallopian tubes, which clearly is not explicitly taught by the reference and, in our view, would not have been suggested by the reference.

This being so, the teachings of Sagie fail to establish a prima facie case of obviousness with regard to the subject matter of the three independent claims and, it follows, the rejection of all of the claims cannot be sustained.[1]

CONCLUSION

The rejection is not sustained.

The decision of the examiner is REVERSED.

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[1]The initial burden of establishing a basis for denying patentability to a claimed invention rests upon the examiner. See In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993).

NEAL E. ABRAMS Administrative Patent Judge	)	
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APPEAL NO. 2000-0087 - JUDGE ABRAMS
APPLICATION NO. 08/592,006

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DECISION: **REVERSED**

Prepared By:

DRAFT TYPED: 26 Apr 02

FINAL TYPED: