

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAYMOND N. SJAARDA, M.D.

Appeal No. 2001-2073
Application No. 09/098,799

ON BRIEF

Before FRANKFORT, STAAB, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 19, all of the claims pending in this application.

Appellant's invention relates to a surgical tool for injecting fluid into a patient and, more particularly, to a surgical infusion tool having means at the distal end thereof for diffusing the fluid emanating from the tool. Figures 3, 4A, 4B and 4C show a first embodiment of appellant's invention; Figures

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5, 6A, 6B, 7A and 7B show a second embodiment and modifications thereof; while Figures 8, 9A, 9B and 10 show a third embodiment and modifications thereof. Independent claims 1, 9 and 13 are representative of the subject matter on appeal and a copy of those claims may be found in the Appendix to appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Graham	671,477	Apr. 9, 1901
Amoils	4,513,745	Apr. 30, 1985

Claim 6 stands rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1 through 10 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

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In addition to the foregoing rejections under § 112, the appealed claims also stand rejected under 35 U.S.C. § 102(b) and § 103 as follows:

a) Claims 1 through 6 and 9 through 19 under 35 U.S.C. § 102(b) as being anticipated by Graham;

b) Claims 1, 2, 9 through 11, 13, 18 and 19 under 35 U.S.C. § 102(b) as being anticipated by Amoils; and

c) Claims 7 and 8 under 35 U.S.C. § 103 as being unpatentable over Graham.

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the examiner's answer (Paper No. 16, mailed January 3, 2001) for the reasoning in support of the rejections, and to appellant's brief (Paper No. 15, filed March 7, 2000) for the arguments thereagainst.

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OPINION

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

Looking first to the examiner's rejection of claim 6 under 35 U.S.C. § 112, first paragraph, we understand this rejection to be based on lack of enablement. The first paragraph of 35 U.S.C. § 112 requires, inter alia, that the specification of a patent enable any person skilled in the art to which it pertains to make and use the claimed invention. Although the statute does not say so, enablement requires that the specification teach those in the relevant art to make and use the invention without "undue experimentation." In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). That some experimentation may be required is not fatal; the issue is whether the amount of experimentation required is "undue." Id. at 736-37, 8 USPQ2d at 1404.

Claims 1, 3 and 6 read as follows:

1. A surgical tool for injecting a fluid into a patient, the surgical tool comprising:

(a) a housing having a distal end and a sidewall defining a longitudinal bore having a central axis, said sidewall being provided with an aperture substantially at said distal end of said housing:

(b) means coupled to said housing for forcing the fluid through said central axis of said housing and out of said aperture; and

(c) a flow diffuser coupled to said housing and positioned over said aperture.

3. The surgical tool of Claim 1, wherein said flow diffuser is a permeable cap.

6. The surgical tool of Claim 3, wherein said permeable cap is provided with a plurality of holes.

The examiner has urged (answer, page 5) that it is unclear how the aperture can be on the sidewall and have a plurality of holes on the cap, and that it is further unclear whether this is only directed to Figures 8-10 since there is no support for a sidewall having an aperture and having a cap with a plurality of holes. On pages 8-11 of the brief appellant responds that the aperture defined in the above enumerated claims is not "in" or "on" the sidewall of the tool housing, but rather the sidewall of the tubular housing defines an aperture at its distal end through

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which the fluid flows. Appellant points to Figures 8, 9A, 9B, and 10 as an example of subject matter covered by claims 3 and 6, noting that those figures show a surgical tool wherein perforated caps (92) and (102) are secured over the open distal end (aperture) through which the fluid exits the tool (90).

After considering appellant's disclosure as a whole and reviewing claim 6 in light of the specification (In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983)), we find that the specification would permit one skilled in the art to make and use appellant's claimed subject matter without undue experimentation. The only embodiments actually described by appellant as including a permeable or perforated cap are seen in Figures 8, 9A, 9B, and 10 wherein the caps (94) or (102) clearly are secured over the open distal end of the hollow tool shaft (100). It is clear to us that claims 3 and 6 are readable on these embodiments of appellant's invention.

Since our review of appellant's specification reveals adequate guidance to enable the skilled artisan to make and use the claimed invention without undue experimentation, it follows that the examiner's rejection of claim 6 under 35 U.S.C. § 112,

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first paragraph, as being directed to a non-enabling disclosure will not be sustained.

Turning to the examiner's rejection of claims 1 through 10 under 35 U.S.C. § 112, second paragraph, we note that the examiner's first concern (answer, page 6) seems to be that the independent claims on appeal each recite "means coupled to said housing for forcing the fluid through said central axis of said housing and out said aperture." The examiner considers that such recitation is indefinite "because it is unclear how fluid can be forced through a central axis," since "[a]xis is defined as a line of symmetry." While the language of the claims on appeal is not the model of clarity, we nonetheless are of the opinion that one of ordinary skill in the art reading appellant's claims in light of the specification would know exactly what appellant intends by the above-noted language. Our review of the specification reveals that the recited "means" clause refers to the fluid supply (68) or (88) seen in Figures 3, 5 and 8 of the application drawings, which fluid supply is coupled to the proximal end of the tool housing and will force fluid through the hollow tool shaft (36) or (100) along the central axis of the shaft and out the aperture at the distal end of the hollow shaft.

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Thus, we consider that one skilled in the art would understand the language "through said central axis" as being more appropriately --along said central axis--. Although, since the central axis of the hollow housing or tool shaft (36) or (100) is an imaginary line, there is no reason why the fluid flowing through the hollow shaft of the tool could not also be broadly considered to flow "through" the central axis.

As for the examiner's concern regarding claim 6 on appeal, we are of the view that our discussions above in treating the rejection of claim 6 under 35 U.S.C. § 112, first paragraph, should put the examiner's concerns to rest. Clearly the plurality of holes in the permeable cap are in addition to the aperture at the distal end of the hollow shaft of the tool.

Looking to claim 13 and the examiner's rejection thereof under 35 U.S.C. § 112, second paragraph, we note that the examiner's position (answer, page 6) is that claim 13 is "vague and indefinite because it is unclear what the means for diffusing is with respect to all the different embodiments." The examiner opines that "[i]t appears that only figure 3-4 [sic] have a diffuser." After careful consideration, we agree with

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appellant's assessment (brief, page 12) that one of ordinary skill in the art considering the claimed subject matter in light of appellant's specification would have no problem understanding what structure in each of the disclosed embodiments corresponds to the recited "means . . . for diffusing the flow of the fluid exiting from said aperture" at the distal end of the tool housing. On page 12 of the brief, appellant sets forth exactly what structure in each embodiment corresponds to the "means" clause and that understanding is supported by the disclosure of the application. Accordingly, we conclude that the scope of the subject matter embraced by appellant's claims on appeal is reasonably clear and definite, and fulfills the requirements of 35 U.S.C. § 112, second paragraph.

Concerning the examiner's additional comments relating to dependent claim 14, we share appellant's view that "said diffusing means" of claim 14 has clear antecedent basis in the last clause of independent claim 13. As for the additionally recited "means secured to said housing for focusing . . .," it is our opinion that when the questioned language is read in light of appellant's specification as it would be interpreted by one of ordinary skill in the art, the skilled artisan would reasonably

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understand the scope and content of appellant's claim 14 on appeal. More particularly, we direct the examiner's attention to the explanation set forth by appellant on page 13 of the brief as one example of how the above-noted claim language is readable on the embodiment seen in Figure 6B. Accordingly, we will not sustain the examiner's rejection of claim 14 under 35 U.S.C. § 112, second paragraph.

We next look to the examiner's prior art rejections, beginning with the rejection of claims 1 through 6 and 9 through 19 under 35 U.S.C. § 102(b) as being anticipated by Graham. In the paragraph bridging pages 13 and 14 of the brief appellant sets forth a synopsis of the examiner's position and concludes that "[a]pplicant agrees with the Examiner's position" and that "[t]he rejection is, therefore, proper." In light of this concession on appellant's part, we summarily sustain the examiner's rejection of claims 1 through 6 and 9 through 19 under 35 U.S.C. § 102(b) as being anticipated by Graham.

We next look to the examiner's rejection of claims 1, 2, 9 through 11, 13, 18 and 19 under 35 U.S.C. § 102(b) as being anticipated by Amoils. On page 14 of the brief (**Issue 9**),

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appellant's sole argument regarding this rejection seems to be that the surgical instrument of Amoils fails to show a diffuser positioned over an aperture. While appellant has indicated on pages 7 and 8 of the brief that each of the claims subject to this rejection "stand or fall alone," we note that appellant has not presented any separate arguments with regard to the individual claims. Accordingly, we consider that we are free to select a claim or claims as being representative of the claims subject to this rejection and decide the appeal on the basis of those claims alone. We select claims 9 and 13 as being representative.

Independent claim 9 is clearly directed to the embodiments of appellant's invention seen in Figures 6A through 7B. However, this claim does not appear to positively recite a "diffuser" as an element of the claim. Looking at the surgical tool of Amoils (Fig. 1) and reading claim 9 thereon, we note that the tool of Amoils is a surgical tool for injecting fluid into a patient and includes a hollow tubular member or housing (12) having a sidewall defining a bore having a central axis, wherein said sidewall is provided with first and second apertures (26); and wherein the tool further includes a means coupled to the housing

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for forcing fluid along the central axis and out said first and second apertures (col. 2, lines 35-40). Thus, the tool of Amoils is fully responsive to that defined in appellant's claim 9 on appeal and anticipates that claimed subject matter.

As for independent claim 13 on appeal, we observe that the tool of Amoils (Fig. 1) includes a hollow tubular member or housing (12) having a sidewall defining a longitudinal bore provided with an aperture. Like appellant's disclosure regarding the embodiments of Figures 6A-7B, we read the "aperture" of claim 13 on appeal as corresponding to an open end portion of the tubular housing (12) of Amoils at a cross section taken just prior to (i.e., upstream of) the openings (26) therein. As noted above, the tool of Amoils further includes a means coupled to the housing for forcing fluid along the central axis and out said aperture and subsequently out the openings (26) downstream of the aperture (col. 2, lines 35-40). As for the "means secured to said housing for diffusing the flow of the fluid exiting from said aperture" set forth in the last clause of claim 13 on appeal, we view this means in light of appellant's embodiments seen in Figures 6A-7B as being readable on the portion of the tubular housing (12) immediately downstream of the openings (26)

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and on the backside of the cup (16) of Amoils, which structures collectively define a diffuser for diffusing the flow of the fluid exiting from said aperture (i.e., in appellant's words (brief, page 12), that portion of the tool provided over the open distal end of the tubular housing and which causes the fluid exiting from the aperture (as defined above) to slow and exit out the two openings (26) of Amoils).

Thus, we will sustain the examiner's rejection of both claims 9 and 13 under 35 U.S.C. § 102(b) based on Amoils, and also the rejection of claims 1, 2, 10, 11, 18 and 19 under 35 U.S.C. § 102(b) based on Amoils since those claims were not argued separately.

Regarding the rejection of claims 7 and 8 under 35 U.S.C. § 103 based on Graham, we observe that on page 14 of the brief appellant concedes that Graham discloses a bore in the tubular housing (A) of the vaginal syringe with a gauge larger than 32 gauge in diameter. Thus, appellant has conceded that the subject matter of claim 8 on appeal lacks novelty over Graham. Accordingly, we will sustain the examiner's rejection of claim 8 under 35 U.S.C. § 103, noting that anticipation or lack of

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novelty is the ultimate or epitome of obviousness. See, for example, In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

As for claim 7 and the requirement therein that the longitudinal bore of the housing be "smaller than fifteen (15) gauge in diameter," we agree with appellant's arguments on pages 15-18 of the brief that there is no reasonable basis to modify the housing (A) of the vaginal syringe of Graham to be smaller than fifteen gauge, and that if such a modification were made, the vaginal syringe of Graham would be unusable for its intended purpose. Thus, we will not sustain the examiner's rejection of claim 7 under 35 U.S.C. § 103 based on Graham.

In summary: we have

1) reversed the examiner's rejection of claim 6 under 35 U.S.C. § 112, first paragraph;

2) reversed the rejection of claims 1 through 10 under 35 U.S.C. § 112, second paragraph;

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3) affirmed the examiner's rejection of claims 1 through 6 and 9 through 19 under 35 U.S.C. § 102(b) as being anticipated by Graham;

4) affirmed the examiner's rejection of claims 1, 2, 9 through 11, 13, 18 and 19 under 35 U.S.C. § 102(b) as being anticipated by Amoils;

5) reversed the examiner's rejection of claim 7 under 35 U.S.C. § 103 as being unpatentable over Graham; and

6) affirmed the examiner's rejection of claim 8 under 35 U.S.C. § 103 as being unpatentable over Graham.

In addition to the foregoing, we REMAND this application to the examiner to consider if it would have been obvious within the meaning of 35 U.S.C. § 103 to one of ordinary skill in the art at the time of appellant's invention to provide a tubular housing (12) in the intra-ocular suction cutter of Amoils sized smaller than fifteen gauge. Amoils discloses a tool of the same nature as that disclosed and claimed by appellant, but is silent concerning the sizing of the housing therein. It would thus be

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appropriate for the examiner to ascertain the sizing of such tools in the prior art and consider making a rejection of claim 7.

In light of the foregoing, the decision of the examiner is affirmed-in-part.

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

AFFIRMED-IN-PART and REMANDED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

CEF/LBG

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BRETT J. TROUT
300 S.W. 5TH
SUITE 222
DES MOINES, IA 50309