

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ENRICO NICOLO

Appeal No. 2002-0805
Application No. 09/168,649

ON BRIEF

Before COHEN, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 7, 10, 11, 13 to 15 and 21. Claims 1 to 6, 8, 9, 19 and 20 are allowed. Claims 12 and 16 to

BACKGROUND

The appellant's invention relates to non-traumatic laparoscopic bowel clamps which encircle the bowel (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

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| Moraweck | 943,263 | Dec. 14, 1909 |
| Slater | 5,241,968 | Sept. 7, 1993 |

Claim 21 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Moraweck.

Claims 10, 11, 13 and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Slater.

Claims 7 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the non-final Office action (Paper No. 17, mailed October 27, 2000) and the answer (Paper No. 19, mailed March 21, 2001) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 18, filed February 2, 2001) and reply brief (Paper No. 20, filed May 15, 2001) 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.

Claim 21

We sustain the rejection of claim 21 under 35 U.S.C. § 102(b).

A claim is anticipated only if each and every element as set forth in the claim is

anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

The manner or method in which a machine is to be utilized is generally not germane to the issue of patentability of the machine itself. See In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967). In addition, a statement of intended use in a claim does not generally serve to distinguish the claimed structural apparatus over the applied reference. See In re Sinex, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962). There is an extensive body of precedent on the question of whether a statement in a claim of purpose or intended use constitutes a limitation for purposes of patentability. See generally Kropa v. Robie, 187 F.2d 150, 155-59, 88 USPQ 478, 483-87 (CCPA 1951) and the authority cited therein, and cases compiled in 2 Chisum, Patents § 8.06[1][d] (1991).

a pair of cross-pivoted handles adapted to be gripped by the user for manipulation of said clamp and the engaged organ or hollow viscus; and
a pair of pivoted jaws, each jaw coupled to one said handle, wherein said pair of jaws are adapted to substantially encircle the engaged organ or hollow viscus.

Moraweck discloses surgical forceps particularly suited for operations in the nose and throat. As shown in Figures 1-2, the surgical forceps includes a pair of levers 1 and 2 pivoted connected at 3 and provided with gripping jaws 4 and 5 in the form of sharp curved prongs or claws. The levers 1 and 2 of the surgical forceps are converted into handles 6 and 7 after pivot 3 to permit the user to either open the jaws or to close the jaws of the surgical forceps upon an organ or growth.

The appellant argues (brief, pp. 11-12) that Moraweck does not anticipate the subject matter of claim 21 since the limitation of claim 21 that the jaws substantially encircle the engaged organ or hollow viscus is not met by Moraweck. We do not agree.

In our view, the intended use of the claimed surgical clamp "for engaging and mobilizing an organ or hollow viscus of a patient" and the intended use of the pair of

preamble and the body of the claim, the appellant has chosen to introduce the intended use in the body of the claim with the transition phrase "adapted to." The use of this transition phrase indicates to us that the intended use of the surgical clamp does not limit the scope of the claim as in Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 868, 228 USPQ 90, 94 (Fed. Cir. 1985).

Furthermore, it is our opinion that the surgical forceps as shown in Figure 2 of Moraweck would be capable of substantially encircling a suitably sized organ or hollow viscus. Thus, we conclude that the subject matter of claim 21 is readable on the forceps of Moraweck.

For the reasons set forth above, the decision of the examiner to reject claim 21 under 35 U.S.C. § 102(b) is affirmed.

Claims 10, 11, 13 and 14

We will not sustain the rejection of claims 10, 11, 13 and 14 under 35 U.S.C. § 102(b).

at least one handle adapted to be gripped by the user for manipulation of said clamp and the engaged bowel; and
at least one jaw coupled to said at least one handle, wherein said at least one jaw is adapted to substantially encircle the bowel, wherein said clamp is sized to fit through a conventional trocar.

Slater's invention relates to endoscopic surgical instruments having end effectors with a stationary element and an articulating element. Slater teaches (column 2, lines 52-56) that "[t]he end effectors of the invention may be scissors, graspers, clamps, dissectors, forceps, or any other types of end effectors known in the art, provided that they comprise two discrete components and one of them is rendered stationary."

Figure 1 of Slater shows a single acting laparoscopic hook scissors instrument prior to insertion into a trocar tube, and, in partial phantom format, after insertion into a trocar tube. Figures 2-4 of Slater show the details of blades 90, 92 of the end effector means 40 of the single acting laparoscopic hook scissors instrument. Each blade 90, 92 has a respective straight cutting edge 201, 203 which extends along blades 90, 92 to their distal portions 205, 207 remote from the pivotal engagement at 45. In use, blade 90 can be opened relative to blade 92 as shown in phantom in Figure 2, such that a

non-contacting, blunt edged, parallel, opposed hook elements 209, 211. With the object 300 so encompassed (or with hook element 209 grabbing the object as in the case of a vein or other small object), the object can be pulled to a location where positive identification by imaging or other equipment is achieved. When the identity of the encompassed object is identified, and cutting is desired, the cutting operation along cutting edges 201, 203 proceeds by pivotal movement of blade member 90.

The appellant argues (brief, pp. 8-9; reply brief, pp. 5-6) that claim 10 is not anticipated by Slater. We agree. In that regard, we agree with the appellant that Slater's laparoscopic hook scissors instrument would be understood by one skilled in the art not to be a surgical bowel clamp. In addition, while Slater does teach that the end effectors may be graspers or clamps instead of scissors, Slater does not teach that such end effectors (i.e., graspers or clamps) would be adapted to substantially encircle the bowel. In our view, contrary to the position of the examiner (answer, p. 3), it is not inherent that when the end effectors of Slater are either graspers or clamps that the end effectors would necessarily be provided with non-sharpened, non-contacting, blunt edged, parallel, opposed hook elements like Slater's hook elements 209, 211 provided

For the reasons set forth above, the decision of the examiner to reject claims 10, 11, 13 and 14 under 35 U.S.C. § 102(b) is reversed.

Claims 7 and 15

We will not sustain the rejection of claim 15 under 35 U.S.C. § 103 for the reasons set forth above with respect to parent claim 10. We will not sustain the rejection of claim 7 under 35 U.S.C. § 103 since as pointed out above with respect to claim 10 Slater does not disclose a surgical clamp having at least one jaw adapted to substantially encircle an engaged organ or hollow viscus.

CONCLUSION

To summarize, the decision of the examiner to reject claims 10, 11, 13 and 14 under 35 U.S.C. § 102(b) is reversed; the decision of the examiner to reject claim 21 under 35 U.S.C. § 102(b) is affirmed; and the decision of the examiner to reject claims 7 and 15 under 35 U.S.C. § 103 is reversed.

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

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| IRWIN CHARLES COHEN |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| JOHN P. McQUADE |) | APPEALS |
| Administrative Patent Judge |) | AND |
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| |) | |
| JEFFREY V. NASE |) | |
| Administrative Patent Judge |) | |

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BLYNN L. SHIDELER
WEBB ZIESENHEIM BRUENING LOGSDON
ORKIN & HANSON
700 KOPPERS BUILDING 436 SEVENTH AVENUE
PITTSBURGH, PA 15219