

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte INBAE YOON, SUZANNE J. YOON and SAMUEL C. YOON

Appeal No. 97-4119
Application No. 08/369,545¹

ON BRIEF

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

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application for patent filed January 6, 1995. According to appellants, this application is a continuation-in-part of Application 07/596,937, filed October 15, 1990, now abandoned; which is a continuation-in-part of Application 07/222,776, filed July 22, 1988, now abandoned; which is a continuation-in-part of Application 08/249,116, filed May 25, 1994, now U.S. Patent No. 5,514,091 issued May 7, 1996.

This is an appeal from the decision of the examiner finally rejecting claims 1, 7, 14, 15, 17, 40, 52 and 53. Claims 19-24 have been allowed, claims 3, 8-12, 16, 18, 41, 43, 44, 46, 47, 54 and 55 have been indicated as containing allowable subject matter, claims 4-6, 13, 42, 45, 48-51, 56 and 57 have been withdrawn from consideration as being directed to a non-elected invention, and claims 2 and 25-39 have been canceled.

The appellants' invention is directed to a method of creating a space endoscopically at an obstructed site in anatomical tissue. The claims on appeal have been reproduced in an appendix to the Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Sinnreich 13, 1975	3,882,852	May
Tovey 1995	5,405,360	Apr. 11,

(filed Jul. 22, 1993)

THE REJECTIONS

Claims 1, 7, 14, 15, 17 and 40 stand rejected under 35
U.S.C. § 102(b) as being anticipated by Sinnreich.

Claims 52 and 53 stand rejected under 35 U.S.C. § 102(e)
as being anticipated by Tovey.

OPINION

Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See *In re Paulsen*, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). Anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference. See *Verdegaal Brothers Inc. V. Union Oil Co. Of California*, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987). Nor is it required that the reference teach what the applicant is claiming, but only that the claim on appeal "read on" something disclosed in the reference, *i.e.*, all limitations of the claim are found in the reference. See *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984).

Claim 1 is directed to a method of creating a space endoscopically "at an obstructed site in anatomical tissue,"

and the steps recited in the body of the claims call for penetrating the tissue, introducing an expandable member "in the anatomical tissue . . . at the obstructed site" and expanding the expandable member to displace the tissue to create a space "at the obstructed site." The examiner is of the view that the language of this claim is broad enough to read on Sinnreich, which discloses a device for penetrating the abdomen and expanding a membrane therein, while the appellants argue that it is not. We find ourselves in agreement with the examiner, and we therefore will sustain the rejection of claim 1. Our reasons for arriving at this conclusion follow.

From our perspective, the essence of the appellants' arguments appears to be that the claimed method is limited to creating a space in solid tissue or the like where no space, or a very small space, previously existed. However, that is not what is recited in claim 1, considered literally or when read in the light of the specification. The method recited in the claim operates upon "anatomical tissue" which, according to the specification, "include[s] portions or the entireties of all anatomical parts" (page 3). The Sinnreich device shown in Figure 5 does just that, in that it penetrates the tissue of

the abdomen, which certainly is anatomical tissue. Once inside the abdomen, Sinnreich inflates an expandable member which creates a space that did not previously exist, in that it insuflates the cavity to open it so that procedures can be conducted and visualized by means of an endoscope (column 3).

The question then becomes whether the abdomen is an "obstructed site." The definition of "obstructed site" set forth on page 3 of the appellants' specification is

anatomical spaces or cavities of such a small size that procedures cannot be visualized and/or performed as well as anatomical locations where no space or cavity exists.

In our opinion, the fact that Sinnreich teaches that the abdomen needs to be insuflated by his device prior to inserting an endoscope to perform and visualize procedures, in and of itself, establishes that this anatomical tissue falls within the appellants' definition of "obstructed site." Moreover, considering that a cavity of such small size that procedures cannot be visualized and/or performed is an "obstructed site," according to the appellants' specification, the abdomen of a small adult, a child or an infant, with which the Sinnreich device can be utilized, would qualify.

Another facet of the appellants' arguments essentially urges that "in" in the context of the anatomical tissue should be interpreted as meaning "within," that is, in the sense that it is within the confines of a solid piece of tissue. On this basis, the appellants conclude that the language of claim 1 does not read on the Sinnreich system. However, the claim recites merely that the obstructed site is "in" anatomical material, and therefore in our view is broad enough to include being simply inside or within the abdominal cavity, in accordance with the common definition of "in."² The disclosure of the invention does not establish a more limited definition of "in." Thus, the insertion of the Sinnreich device through the abdominal wall so that it is positioned inside the abdomen meets the terms of the claim.

Since the appellants have chosen to group dependent claims 7, 14, 15, 17 and 40 with claim 1, the rejection of these claims also is sustained.

We reach the opposite conclusion, however, with regard to claims 52 and 53, which have been rejected as being anticipated

² See, for example, *Merriam Webster's Collegiate Dictionary, Tenth Edition*, 1996, page 585.

by Tovey. This reference discloses a device for deploying a mesh implant adjacent to body tissue to which it is to be fastened, in procedures such as the repair of a hernia. The mechanism that deploys the net includes members that are mechanically biased to the open position. However, even if it is conceded that the device is inserted into an "obstructed site," it is our view that the reference does not support the conclusion that the net and its positioning arms "displaces the anatomical tissue to create a space" at the obstructed site when moved into its expanded position, as is required by claim 52. In this regard, the expanding members are wires and the net is a planar sheet, and the reference does not explicitly state that these elements move tissue aside to create a space nor, in our opinion, can it be assumed that such is the inherent result.

The rejection of claims 52 and 53 is not sustained.

While we have carefully considered all of the arguments presented by the appellants, they have not convinced us that the rejection of claims 1, 7, 14, 15, 17 and 40 should not be sustained. Our position with regard to these arguments should be apparent from the foregoing recitations.

SUMMARY

The rejection of claims 1, 7, 14, 15, 17 and 40 is sustained.

The rejection of claims 52 and 53 is not sustained.

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

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