

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JONATHAN A. COOK

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Appeal No. 97-4372  
Control No. 90/003,683<sup>1</sup>

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ON BRIEF

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

STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> Reexamination proceeding for U.S. Patent No. 5,275,174, issued January 4, 1994, based on Application 07/913,972, filed July 16, 1992, which is a continuation of Application 07/731,990, filed July 18, 1991, now abandoned, which is a continuation of Application 07/610,308, filed November 8, 1990, now abandoned, which is a continuation of Application 07/091,070, filed August 12, 1987, now abandoned.

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This is a decision on an appeal from the examiner's final rejection of claims 1-9, 11 and 14-16, all the claims in this reexamination of U.S. Patent No. 5,275,174. The original patent included claims 1-16. Appellant has canceled claims 10, 12 and 13, and amended the remaining claims during prosecution.

The subject matter involved is a method of (claims 1-9) and a system for (claims 11 and 14-16) assessment of a physiological state of a body joint of an animal. Independent claim 16 is exemplary of the claimed subject matter and reads as follows:<sup>2</sup>

16. A system for assessment of a physiological state of a body joint of an animal, wherein a first body portion is connected to a second body portion and is movable relative to the second body portion through muscular contraction, which comprises:

- a stationary support to fix the first body portion;
- a [sleeve] movable restraining member to receive the second body portion, said [sleeve] movable restraining member capable of motion within a plane defined by motion of the second body portion about a pivot point of the joint and

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<sup>2</sup> Claim 16 has been reproduced in the manner required by 37 CFR § 1.530(d) and 37 CFR § 1.121(f), that is, with matter deleted being placed between brackets and matter added being underlined.

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capable of providing a constant resistance to relative movement within the plane;

means for measuring a level of electrical activity generated by the muscular contraction producing motion of the second body portion about a pivot of the joint;

means for recording a background level of electrical activity produced by a muscle contraction that is unrelated to movement of the second body portion about a pivot point of the joint; and

means for measuring a rate of change of position of the [sleeve] movable restraining member within the plane, whereby the physiological status of the body joint may be assessed.

No references are relied upon by the examiner in support of the rejections.

The appealed claims stand rejected as follows:

(a) claims 1-9, 11 and 14-16 under 35 U.S.C. § 112, first paragraph, "for the reasons set forth in the objection to the specification" (answer, page 3)<sup>3</sup>; and

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<sup>3</sup> With respect to appellant's specification, the examiner states on page 3 of the answer:

The specification has been objected to under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, fails to provide support for the invention as is now claimed. All embodiments as originally disclosed fail to disclose the use of a "moveable [sic, movable] restraining member" **if** one

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(b) claims 1-9, 11 and 14-16 under 35 U.S.C. § 305 "as being broadened" (answer, page 3).

In addition to seeking review of the foregoing rejections, appellant has raised as an issue in this appeal the propriety of the examiner's objection to the specification under 35 U.S.C.

§ 112, first paragraph, because certain amendments to the specification allegedly introduce "new matter" into the disclosure. While we appreciate that there may be some overlap between the examiner's rejection of the appealed claims under 35 U.S.C. § 112, first paragraph, and the examiner's objection to the specification under that same section of the statute based on "new matter" allegedly introduced into the specification by amendment, our authority does not extend to

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were to interpret this terminology to be equivalent to the term 'sleeve' previously used. [emphasis added]

Thus, the examiner's objection to the specification as failing to provide "support" for the invention as now claimed appears to be based on an interpretation of the term "movable restraining member" added to the specification and claims by amendment.

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objections. *See Ex parte C*, 1492, 1494, n.3 (BPAI 1993). Accordingly, we shall not review or further discuss the examiner's action in this regard.

*The 35 U.S.C. § 112, first paragraph, rejection*

New or amended claims in a reexamination proceeding are to be examined for compliance with 35 U.S.C. § 112. 37 CFR § 1.552. However, consideration of 35 U.S.C. § 112 issues in a reexamination proceeding should be limited to the amendatory (i.e., new language) matter. M.P.E.P. § 2258. In the present case, it appears that the examiner has rejected the claims under 35 U.S.C. § 112, first paragraph, based on a specification that allegedly fails to provide "support" for the terminology "movable restraining member" added to the independent claims by amendment.

As correctly noted by appellant on page 15 of the brief, the first paragraph of 35 U.S.C. § 112 includes three separate requirements, namely, that subject matter defined in the claims be described in the specification, that the specification disclosure as a whole is such as to enable one

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skilled in the art to make and use the claimed invention, and that the best mode contemplated by the inventor of carrying out the invention be set forth. *In re Moore*, 439 F.2d 1232, 1236, 169 USPQ 236, 238-39 (CCPA 1971). Like appellant, in the present instance we believe that the examiner's rejection under 35 U.S.C. § 112, first paragraph, is founded on the description requirement of that section of the statute.

With respect to the description requirement found in the first paragraph of 35 U.S.C. § 112,

[t]he test for determining compliance . . . is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. The content of the drawings may also be considered in determining compliance with the written description requirement.

*In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)(citations omitted). In the present case, we conclude that one of ordinary skill would have understood that appellant was in possession of a method and system for assessment of a physiological state of a body joint, which method and system includes a "movable restraining member" for

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receiving one of the body portions adjacent the joint being assessed, as now claimed. Support for the added claim language is found at, for example, column 1, lines 62-67 (" . . . the method being characterized in that a first body portion is retained with respect to a first member, and a second body portion is retained in respect to a second member, relative movement between the said two members being constrained with selected levels of resistance . . . ."). The rejection under § 112 will accordingly not be sustained.

*The 35 U.S.C. § 305 rejection*

In considering this issue, we are guided by the following principles. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding. 35 U.S.C. § 305. A claim is enlarged if it includes within its scope any subject matter that would not have infringed the original patent. *In re Freeman*, 30 F.3d 1459, 1464, 31 USPQ2d 1444, 1447 (Fed. Cir. 1994), citing with approval *Ex parte Neuwirth*, 229 USPQ 71 (BPAI 1985)(addition of "substantially" to the word "rounded" in a claim constitutes a broadening of the claim in

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contravention of 35 U.S.C. § 305). During reexamination of an unexpired patent, claims are to be given their broadest reasonable interpretation consistent with the specification, and limitations in the specification are not to be read into the claims. *In re Yamamoto*, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984). Furthermore, words in a claim will be given their ordinary and accustomed meaning, unless it appears that the inventor used them differently. *Envirotech Corp. v. Al George, Inc.*, 730 F.2d 753, 759, 221 USPQ 473, 477 (Fed. Cir. 1984).

In rejecting the appealed claims under 35 U.S.C. § 305, the examiner has taken the following position:

Applicant elected during prosecution of the application [which matured into the patent] to limit the claimed structure to a sleeve and the replacement of such a term with the term "moveable [sic, movable] restraining member", which reads on structure other than a sleeve, is considered to be broadening of the claims. [answer, pages 3-4]

The examiner's position is well taken. Appellant has not established that the word "sleeve" was ever intended to be used other than in its ordinary and accustomed manner.<sup>4</sup>

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<sup>4</sup> We note appellant's contention on page 13 of the brief to the effect that during prosecution of the application that

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Further, appellant does not appear to assign any special meaning to the words "movable restraining member" now appearing in the claims in place of the word "sleeve." Accordingly, giving the words "sleeve" and "member" their ordinary and accustomed meaning to the extent that meaning is consistent with the specification, without reading limitations in the specification into the claims, we hold that the claims under reexamination are broader than the original patent claims because the presently claimed movable restraining "member" terminology encompasses within its metes and bounds subject matter that is not encompassed by the "sleeve" terminology of the original claims. In support of this position we observe that the word "member" may mean "a distinct part to a whole," whereas the word "sleeve" may mean "an encasement into which an object fits."<sup>5</sup> Given these

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matured into the patent under reexamination, appellant intended the term "sleeve" to be generic to the movable members of all the disclosed embodiments. Appellant has pointed to no evidence in the record before us, and we are aware of no such evidence, that supports this contention.

<sup>5</sup> Webster's II New Riverside University Dictionary, Riverside Publishing Company, copyright 1984 © by Houghton Mifflin Company.

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definitions, it is our view that a "sleeve" to receive the second body portion, as per the original patent claims, necessarily encases or encloses the body portion to at least some degree, whereas a "movable restraining member" to receive the second body member, as now claimed, does not necessarily encase or enclose the body portion. The rejection under § 305 will therefore be sustained.

*Summary*

The rejection of the appealed claims under 35 U.S.C. § 112, first paragraph, is reversed and the rejection of the appealed claims under 35 U.S.C. § 305 is affirmed.

Since at least one rejection of each of the appealed claims has been affirmed, the decision of the examiner finally rejecting the appealed claims is affirmed.

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

*AFFIRMED*

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|-----------------------------|---|-----------------|
| NEAL E. ABRAMS              | ) |                 |
| Administrative Patent Judge | ) |                 |
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| CHARLES E. FRANKFORT        | ) | BOARD OF PATENT |
| Administrative Patent Judge | ) | APPEALS AND     |
|                             | ) | INTERFERENCES   |
|                             | ) |                 |
|                             | ) |                 |
| LAWRENCE J. STAAB           | ) |                 |
| Administrative Patent Judge | ) |                 |

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