

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 LARRY HOOD

Appeal No. 1999-2788
Application No. 08/910,469

ON BRIEF

Before COHEN, FRANKFORT, and BAHR, 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, 3 and 5 through 7, which are all of the claims remaining in this application. Claims 2, 4 and 8

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through 20 have been canceled.

Appellant's invention relates to an ultrasonically driven surgical cutting blade. Independent claim 1 is representative of the subject matter on appeal and a copy of that claim, as reproduced from the Appendix to appellant's brief, is appended to this decision.

The sole prior art reference of record relied upon by the examiner is:

Davison et al. (Davison)	5,324,299	Jun. 28,
1994		

Claims 1, 3 and 5 through 7 stand rejected under 35 U.S.C.

§ 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Davison. More particularly, the examiner has relied upon the embodiment of the ultrasonic surgical blade seen in Figures 6 through 8 of Davison, urging that the sharpened recess (62), disclosed in column 7, lines 34-36, includes a hook portion which terminates at a pointed

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tip. In the examiner's view, this pointed tip in Davison is at an outermost distal end of the blade body because,

"[t]he point (at the end of the edge of the hook portion 62 shown in figure 8 of Davison et al.) is at the radially outermost point of the device. In other words, no other portion of the device extends radially outward beyond this point. This point is therefore at an outermost point of the body. The point is also at a distal end of the body since it is located at the distal end portion of the body. The distal end portion of the Davison et al. body is considered to be the portion of the body which includes portions 60 and 64. Although the extreme end of the sharpened point is spaced proximally from the distalmost end point of the device, this is true for the blade of the invention as well. The extreme end of the pointed tip 24 of the blade of the invention is spaced proximally from the distalmost end point of the device as seen in figure 1 of the application. Even if the term "pointed tip" in the claims is considered to include the portion of the blade that has tapered sides that lead to the extreme end point (that is, the portion denoted by reference numeral 24 in figure 1), then even this pointed tip, including its base, is spaced proximally a small distance from the distalmost end point of the device as seen in figure 1 of the application."

In the alternative, the examiner urges that "it would have been obvious that the tip described in col. 7, lines 34-36 of Davison et al. is pointed for the reasons set forth above" (answer,

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page 4).

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejection, we refer to the examiner's answer (Paper No. 19, mailed November 4, 1998) and to appellant's brief (Paper No. 18, filed September 9, 1998) for a full exposition thereof.

OPINION

Having carefully reviewed the anticipation and obviousness issues raised in this appeal in light of the record before us, we have come to the conclusion that the examiner's rejections of the appealed claims under both 35 U.S.C. § 102(b) and 35 U.S.C. § 103 will not be sustained. Our reasoning in support of these determinations follows.

The only argument raised by appellant in this appeal (brief, pages 4-5) is that Davison does not anticipate or render obvious appellant's presently claimed ultrasonic cutting blade because the Davison patent does not teach or

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disclose a pointed tip at an outermost distal end of the blade body, as set forth in independent claim 1 on appeal. The language of independent claim 1 relating to the recessed cutting portion terminating in a pointed tip "at an outermost distal end of said body" was first added to claim 1 in an amendment filed May 12, 1997 in the parent of the present application. Appellant's specification does not use the same language as claim 1 in describing the recessed portion (22) and the pointed tip (24) of the cutting blade (12). More specifically, the specification does not mention or describe "an outermost distal end of said body," as is set forth in claim 1 on appeal. Therefore, our principal guidance for understanding this language must come from appellant's drawings.

Figure 1 of appellant's drawings shows the cutting blade body (20) as terminating in an outermost distal end that is contoured or curved from its upper or second side to its lower or first side and which terminates at the first side at a pointed tip (24). Thus, as is apparent from Figure 1, the entirety of the curved or contoured surface at the end of the

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blade body (20) adjacent to the recessed cutting portion (22) constitutes the "outermost distal end" of the blade body and includes the pointed tip (24). Stated another way, as can be clearly seen in Figure 1 of appellant's drawings, in a horizontal plane containing the pointed tip (24) there is no portion of the blade body to the left of the pointed tip and the pointed tip is thus located "at an outermost distal end" of the blade body.

Given our understanding of the language of claim 1 on appeal as set forth above, like appellant, we note that the pointed tip of the hook portion (64) of the sharpened recessed cutting portion (62) in Davison is located between the outermost distal end of the blade body and the proximal end of the blade body, i.e., the pointed tip in Davison is clearly spaced inwardly (proximally) of the outermost distal end (60) of the blade body. In this regard, as is apparent from Figures 6 through 9 of Davison, there is clearly a portion of the blade body which extends outwardly (distally) beyond the pointed tip of the sharpened recessed cutting portion to the outermost distal end (60) of the blade body. Accordingly, it

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is clear to us that the pointed tip of the hook portion (64) and cutting portion (62) of Davison is not part of a recessed cutting portion which "terminates at a pointed tip at an outermost distal end of said body" as required in appellant's claim 1 on appeal. For that reason, we will not sustain the examiner's rejection of claim 1, or of claims 3 and 5 through 7 which depend therefrom, under 35 U.S.C. § 102(b).

The examiner's attempt to read the entire upper segment of the hook portion (64) of Davison as the pointed tip (as shown in the marked-up Figure 8 attached to the examiner's answer) is unavailing. The pointed tip of Davison's ultrasonic cutting blade is only that portion of the blade that is part of the sharpened recess (62) at the top side edge of the blade and does not include the flat uppermost surface of the hook portion and the remainder of the blade body seen in Figures 6 through 9 adjacent to and underlying where the lead line for reference character (64) terminates. As for the examiner's position that the drawings of appellant's application show the pointed tip (24) spaced "proximally from

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the distalmost end point of the device as seen in Figure 1 of the application" (answer, page 4), we note that this is not the language of appellant's claim 1 on appeal and thus is of no moment, since the pointed tip (24) seen in Figure 1 of appellant's drawings is clearly part of the "outermost distal end" of the blade body as claim 1 on appeal requires. By contrast, the pointed tip relied upon by the examiner in the ultrasonic cutting blade of Davison (Fig. 8) clearly is not located at the outermost distal end of the blade body.

As for the examiner's rejection of the claims on appeal under 35 U.S.C. § 103 based on Davison, we note that even if it is conceded that the surgical blade therein includes a pointed tip at the sharpened recessed cutting portion (62), such does not in any way change the fact that Davison does not disclose, teach or suggest the cutting blade structure called for in appellant's claim 1 on appeal and in the claims which depend therefrom, since Davison clearly does not have a recessed cutting portion which "terminates at a pointed tip at an outermost distal end of said body" as required in appellant's independent claim 1 on appeal. Accordingly, we

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will not sustain the examiner's alternative rejection of
claims 1, 3 and 5 through 7 on appeal under
35 U.S.C. § 103.

In summary, the decision of the examiner to reject claims
1, 3 and 5 through 7 under 35 U.S.C. § 102(b) based on Davison
is reversed, as is the examiner's decision to reject claims 1,
3 and 5 through 7 under 35 U.S.C. § 103 based on Davison.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JENNIFER D. BAHR)	
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CLAIM 1

An ultrasonic cutting blade, comprising:

A-1

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a body which has a diameter, said body has a stepped flat portion which has a first side and a second side, said stepped flat portion has a recessed cutting portion located on only said first side of said body and which terminates at a pointed tip at an outermost distal end of said body, said stepped flat portion having a width that is no greater than said diameter of said body.