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BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HECTOR CHOW,
EARL J. MILLS, FEDERICO BILOTTI,
RONALD J. BRINKERHOFF,
MARTIN MADDEN and RICHARD L. GRANT

Appeal No. 94-1882
Application 07/860,479

ON BRIEF

Before PARSONS, LYDDANE and MEISTER, *Administrative Patent Judges.*

MEISTER, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-20, the only claims present in the application.

The appellants' invention pertains to a cartridge of surgical staples and to a method of tissue closure which includes the placing of at least two rows of surgical staples in tissue in

Application for patent filed March 30, 1992. According to applicants, the application is a continuation-in-part of Application 07/641,380, filed February 19, 1991, now abandoned.

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such a manner that at least one of the legs of each staple in each row interlocks with the legs of one of the staples in another row when the staples are crimped. Independent claims 1, 12 and 20 are further illustrative of the appealed subject matter and copies thereof, as they appear in the appendix to the appellants' brief, are appended to this opinion.

The references of record relied on by the examiner are:

Froehlich	4,526,174	Jul. 2, 1985
Pruitt (Pruitt '637)	4,848,637	Jul. 18, 1989
Pruitt (Pruitt '503)	4,930,503	Jun. 5, 1990
Pruitt (Pruitt '623)	4,941,623	Jul. 17, 1990

Claims 1-11 stand rejected under 35 U.S.C. 103 as being unpatentable over Froelich in view of Pruitt ('637), Pruitt ('503) and Pruitt ('623). According to the examiner it would have been obvious to provide the cartridge of Froelich with multiple rows of staples in view of Pruitt ('637), Pruitt ('503) and Pruitt ('623).

Claims 1-11 stand rejected under 35 U.S.C. 103 as being unpatentable over any one of Pruitt ('637), Pruitt ('503) and Pruitt ('623) in view of Froelich.² The examiner is of the opinion that it would have been obvious to modify any one of the Pruitt devices to have staples which have their leg ends in an overlapped position when the staples are in a closed tissue

² This rejection was set forth as a new ground of rejection in the answer.

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gripping position in view of the teachings of Froelich.

Claims 12-20 stand rejected under 35 U.S.C. 112, first paragraph. It is the examiner's position that

[t]hese claims call for rows of staples which are angled in such a way that when the staples exit the cartridge, they interlock. It is not clear from the disclosure what kind of structure could permit such an arrangement. Appellant's staple gun is apparently a conventional type of staple gun with conventional cartridges, such as shown in the Pruitt patents. It is not understood how rows of cartridges, facing each other and angled at each other could operate in this conventional gun. It is also not clear how the cartridge accommodates such an arrangement, including embodiments where you have both straight rows and angled rows. (see answer, pages 3 and 4)

In support of this position the answer also states

[a]ppellants' arguments begin by addressing Examiner's objection to the specification, which is not actually at issue. At issue are the claims themselves and whether or not they can be understood in light of the disclosure. (see answer, page 5)

Rather than reiterate the conflicting viewpoints advanced by the appellants and the examiner in support of their respective positions, reference is made to the brief, reply brief and answer for the full exposition thereof.

OPINION

As a preliminary matter, we base our understanding of the appealed subject matter upon the following interpretation of the terminology appearing in the claims. In claims 9, 10, 16 and 17 we interpret "staples closed in a different shape" to be -- staples which are to be closed in a different shape -- since

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it is readily apparent that the staples contained in the rows of the cartridge are not closed while in the cartridge as these claims set forth but, instead, are closed only after they have exited the cartridge.

We have given careful consideration to the appellants' invention as described in the specification, to the appealed claims, to the prior art applied by the examiner and to the respective positions advanced by the appellants in the brief and by the examiner in the answer. These considerations lead us to conclude that the examiner's rejections of claims 1-11 under 35 U.S.C. 103 are sustainable. Accordingly, we will sustain these rejections. We will not, however, sustain the examiner's rejection of claims 12-20 under 35 U.S.C. 112, first paragraph. Our reasons for these determinations follow.

Considering first the rejection of claims 12-20 under 35 U.S.C. 112, first paragraph, we initially we note the description requirement found therein is separate from the enablement requirement of that paragraph. See *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984) and *In re Barker*, 559 F.2d 588, 194 USPQ 470 (CCPA 1977). Here, it is apparent to us from the examiner's statement of the rejection on pages 3 and 4 of the answer that this rejection in fact is based upon a non-enabling disclosure. Cf. *In re Bowen*, 492 F.2d 859, 181 USPQ 48 (CCPA 1974).

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With regard to the question of enablement, it is well settled that the examiner has the initial burden of producing reasons that substantiate a rejection based on lack of enablement. See *In re Marzocchi*, 439 F.2d 220, 169 USPQ 367 (CCPA 1971) and *In re Strahilevitz*, 668 F.2d 1229, 212 USPQ 561 (CCPA 1982). Once this is done, the burden shifts to the appellants to rebut this conclusion by presenting evidence to prove that the disclosure is enabling. See *In re Eynde*, 480 F.2d 1364, 178 USPQ 470 (CCPA 1973) and *In re Doyle*, 482 F.2d 1385, 179 USPQ 227 (CCPA 1973). Additionally, as the court in *In re Gaubert*, 524 F.2d 1222, 187 USPQ 664 (CCPA 1975) stated:

To satisfy §112, the specification disclosure must be sufficiently complete to enable one of ordinary skill in the art to make the invention without undue experimentation, although the need for a minimum amount of experimentation is not fatal * * *. Enablement is the criterion, and every detail need not be set forth in the written specification if the skill in the art is such that the disclosure enables one to make the invention.

The determination of what constitutes undue experimentation in a given case requires the application of a standard of reasonableness, having regard for the nature of the invention and the state of the art. See *Ex parte Forman*, 230 USPQ 546 (BPAI 1986).

Moreover, as the court in *In re Angstadt*, 537 F.2d 498, 190 USPQ 214 (CCPA 1976) noted, a relevant inquiry is whether the scope of enablement is commensurate with the scope of the claimed subject matter.

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Here, we do not find that the examiner has satisfied his initial burden of producing any reasonable line of reasoning which would substantiate a rejection based on lack of enablement. From our perspective, the artisan would readily understand from Figs. 17 and 18 of the appellants' drawings that the inclined drivers 50 serve to push staples which have been positioned in inclined pockets (unnumbered in Fig. 17) in such a manner that there is an interlocking of the legs of the staples as illustrated in Fig. 18. We do not believe it could seriously be contended that the artisan would not know how to make and use a cartridge having all such inclined pockets and drivers, or a combination of straight and inclined pockets and drivers, without undue experimentation.

As to the examiner's statement that "[a]t issue are the claims themselves and whether or not they can be understood in light of the disclosure," we note that such a contention is normally applicable to a rejection based upon the second paragraph of Section 112. In any event, the examiner has not reasonably established why or how one of ordinary skill in the art armed with the appellants' disclosure would not have been able to make and use the claimed invention without undue experimentation. This being the case, we will not sustain the examiner's rejection of claims 12-20 under 35 U.S.C. 112, first paragraph.

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Turning now to the rejections of claims 1-11 under 35 U.S.C. 103, we treat first the rejections wherein any one of the Pruitt references are utilized as the primary reference. Each of the Pruitt references discloses a cartridge of surgical staples containing a plurality of rows of staples which have not been closed that are formed to grip tissue with at least one of said rows of staples containing staples wherein each said staple in the rows comprise a crown connected to two legs. Noting that claims 1-3 and 5-10 are directed to a cartridge *per se*, we find response in each of the Pruitt references for all the structure of the cartridge set forth in these claims and conclude they lack novelty vis-à-vis any one of the Pruitt references. While we appreciate the fact that the examiner described the rejection of claims 1-3 and 5-10 in terms of obviousness rather than lack of novelty, we note that lack of novelty is the epitome of obviousness. See *In re Fracalossi*, 681 F.2d 792, 215 USPQ 569 (CCPA 1982).

As to the rejection of claims 1-11 under 35 U.S.C. 103 wherein Froelich is utilized as a primary reference, the examiner has correctly noted Froelich discloses a cartridge 10 having a single row of surgical staples 14. On the other hand Pruitt ('637) in column 1, line 17, Pruitt ('503) in column 1, line 18, and Pruitt ('623) in column 1, line 23, all teach the provision of a cartridge having two, three or four rows of surgical

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staples. We share the examiner's view that it would have been obvious to one of ordinary skill in this art to provide the cartridge of Froelich with multiple rows of surgical staples in view of the teachings of any one of the Pruitt references. Indeed, the appellants have not argued otherwise.

With respect to independent claim 1 the appellants argue that there is no teaching in the references of the staples "in a closed tissue-gripping position comprises said legs folded toward ..." and, with respect to claims 9 and 10, that there is no teaching in the references of staples "closed in a different shape." We reiterate, however, these claims are directed to a cartridge *per se* having rows of staples which have not been closed. The recitations to which the appellants refer are merely statements as to the particular manner in which the staples are to be closed by the stapler once they have exited from the cartridge. Such recitations, in our view, are merely statements of intended use which may not be relied on to distinguish the structure of the cartridge from the prior art. See *In re Pearson*, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974), *In re Yanush*, 477 F.2d 958, 177 USPQ 705 (CCPA 1973) and *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967).

The appellants have not separately argued the patentability of dependent claims 5 and 11. Accordingly, these claims fall with the claims from which they depend. See *In re Nielson*, 816

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F.2d 1567, 2 USPQ2d 1525 (Fed. Cir. 1987).

In view of the foregoing, we will sustain the examiner's rejections of claims 1-11 under 35 U.S.C. 103.

We also note that the appellants' brief contains arguments concerning the propriety of the examiner making the Office action dated October 8, 1992 (Paper No. 6) a final rejection. Under 35 U.S.C. 134 and 37 CFR 1.191, appeals to the Board of Patent Appeals and Interferences are taken from the decision of the primary examiner to reject claims. We exercise no general supervisory power over the examining corps and the decision of the examiner to issue a final rejection is not subject to our review. See M.P.E.P. 706.07(c) and 1201; compare *In re Mindick*, 371 F.2d 892, 152 USPQ 566 (CCPA 1967) and *In re Deters*, 515 F.2d 1152, 185 USPQ 644 (CCPA 1975). Thus the relief sought by the appellants would have properly been presented by a petition to the Commissioner under 37 CFR 1.181.

In summary:

The examiner's rejection of claims 12-20 under 35 U.S.C. 112, first paragraph, is reversed.

The examiner's rejection of claims 1-11 as being unpatentable over any one of Pruitt ('637), Pruitt ('503) or Pruitt ('623) in view of Froelich is affirmed.

The examiner's rejection of claims 1-11 under 35 U.S.C. 103 as being unpatentable over Froelich in view of Pruitt ('637),

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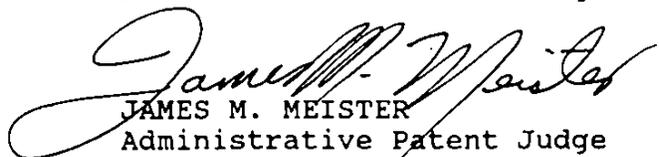
Pruitt ('503) and Pruitt ('623) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR 1.136(a). See the final rule notice, 54 F.R. 29548 (July 13, 1989), 1105 O.G. 5 (August 1, 1989).

AFFIRMED-IN-PART


MARION PARSONS, JR.)
Administrative Patent Judge)


WILLIAM E. LYDDANE)
Administrative Patent Judge)


JAMES M. MEISTER)
Administrative Patent Judge)

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CLAIM 1

In a cartridge of surgical staples containing a plurality of rows of staples, each said row of staples formed to grip tissue, at least one of said rows of staples containing staples wherein each said staple in said at least one row comprises a crown connected to two legs wherein said staple in a closed tissue-gripping position comprises said legs folded toward said crown so that said leg ends approximate said crown, and said leg ends overlap each other along said crown length.

CLAIM 12

A cartridge of surgical staple rows, said staple rows tilted within said cartridge and facing an adjacent row, such that when said staples exit said cartridge to grip tissue, each of the legs in each of said staples forming said tilted rows interlock with one of the legs of a staple in said adjacent row.

CLAIM 20

A method of tissue closure comprising first placing at least two rows of surgical staples in tissue, each of said staples having staples legs connected by a crown, and then crimping said staples in said tissue such that at least one of the legs in each said staples in one of said rows interlocks with one of the legs of a said staple in said adjacent row.