

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte INBAE YOON

Appeal No. 96-2081
Application 08/125,892¹

ON BRIEF

Before COHEN, CRAWFORD, and GONZALES, Administrative Patent Judges.

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 24 through 30. These claims constitute

¹Application for patent filed September 24, 1993. According to appellant, this application is a continuation of application serial no. 07/789,599, filed November 8, 1991, now abandoned, which is a divisional of application serial no. 07/556,081, filed July 24, 1990, now U.S. Patent No. 5,074,840, issued December 24, 1991.

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all of the claims pending in this application.

We REVERSE and REMAND.

BACKGROUND

The claims on appeal are drawn to methods of manipulating tissue and packing during an endoscopically performed operative procedure and to a method of performing an endoscopic operative procedure. An understanding of the invention can be derived from a reading of exemplary claim 24 which appears on pages 18 and 19 of appellant's main brief.

The reference applied in the final rejection is:

Lee 682,090 Sep. 3, 1901

The following rejection is before us for review:

Claims 24 through 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lee.²

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted

² Claims 24 through 30 were also rejected in the final rejection on the ground of obviousness-type double patenting. However, subsequent to the final rejection, a terminal disclaimer was filed (Paper No. 9). Since the obviousness-type double patenting rejection has not been repeated in the examiner's answer, we understand that the rejection has been overcome by the terminal disclaimer.

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rejection, we make reference to the final rejection (Paper No. 6) and the examiner's answer (Paper No. 16) for the complete reasoning in support of the rejection, and to the corrected main

brief (Paper No. 15) and reply brief (Paper No. 17) 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 reference, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Initially we note that on pages 2-5 of the main brief, the appellant requests that we consider the claims as amended by an amendment (Paper No. 8) filed after the final rejection and which was refused entry by the examiner (Paper No. 10). We must point out, however, that under 35 U.S.C. § 134 and 37

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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 decisions of primary examiners to deny entry of amendments are not subject to our review. See Manual of Patent Examining Procedure (MPEP) §§ 1002.02(c) and 1201 (7th ed., Jul. 1998); In

re Mindick, 371 F.2d 892, 894, 152 USPQ 566, 568 (CCPA 1967)
and

In re Deters, 515 F.2d 1152, 1156, 185 USPQ 644, 648 (CCPA 1975). Inasmuch as consideration of the claims as amended subsequent to the final rejection would, in effect, overrule the examiner's decision to refuse entry of the amendments, we decline to take such action.

Claims 24 through 26 recite a method of manipulating tissue during an endoscopically performed operative procedure. Claims 27 through 29 set forth a method of packing during an endoscopically performed operative procedure. Claim 30 calls

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for a method of performing an endoscopic operative procedure. Thus, we agree with appellant that each and every claim is limited specifically and unequivocally to a particular combination of steps to be performed during or in the course of an endoscopic-ally performed operative procedure.

The patent to Lee discloses a "surgical dressing packer" useful "for packing antiseptic gauze or other surgical dressing into the uterus or deep-seated abscesses or wounds" (lines 9-13). There is no mention in Lee of any endoscopically performed operative procedure much less any teaching or suggestion that the disclosed apparatus would be useful in performing endoscopic surgery.

In applying the test for obviousness,³ we reach the conclusion that the claimed method would not have been suggested by the applied prior art. Specifically, we see no suggestion in the applied prior art of using the apparatus disclosed therein in an endoscopically performed operative

³ The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

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procedure. Thus, we must conclude that the examiner used impermissible hindsight.⁴

For the above reasons, the examiner's rejection of appellant's claims 24 through 30 under 35 U.S.C. § 103 as being unpatentable over Lee will not be sustained.

REMAND TO THE EXAMINER

The specification indicates that prior to appellant's invention, methods of packing an internal operative site during open surgery were well known. The appellant also admits that prior to his invention methods for exposing and manipulating tissue during endoscopically performed operative procedures

⁴ The conclusion that the claimed subject matter is obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

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were known, albeit inadequate. The specification also discloses that it was known prior to appellant's invention to remove body fluids from the operative site for external collection using suction equipment during endoscopically performed operative procedures. See, specification, pages 1 and 2.

Accordingly, we remand this application to the examiner to consider the claimed subject matter relative to the endoscopi-cally performed operative procedures known prior to appellant's invention and to determine if the claimed subject matter is patentable under 35 U.S.C. § 102 and § 103 over the known endoscopically performed operative procedures alone or in combination with other prior art, such as, the patent to Lee.

CONCLUSION

To summarize, the decision of the examiner to reject claims 24 through 30 under 35 U.S.C. § 103 is reversed.

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Additionally, we have remanded the application to the
examiner for consideration of issues relating to prior art.

REVERSED AND REMANDED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MURRIEL E. CRAWFORD)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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JOHN F. GONZALES)	
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