

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte INBAE YOON

Appeal No. 96-2631
Application No. 08/177,616¹

ON BRIEF

Before FRANKFORT, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 27, which are all of the claims pending in this application.

We REVERSE.

¹ Application for patent filed January 4, 1994.

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BACKGROUND

The appellant's invention relates to a safety penetrating instrument. Claims 1, 6, 14 and 22 are representative of the subject matter on appeal and a copy of those claims is attached to this decision.

The prior art reference of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 is:

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| Allen et al. (Allen) | 5,312,354 | May 17, 1994 (filed Nov. 4, 1991) |
|-------------------------|-----------|--------------------------------------|

Claims 1 through 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Allen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the § 103 rejection, we make reference to the examiner's first office action (Paper No. 5, mailed November 1, 1994), the final rejection (Paper No. 7, mailed April 4, 1995) and the examiner's answer (Paper No. 12, mailed November 17, 1995) for the examiner's complete reasoning in support of the rejection, and to the appellant's brief (Paper No. 11, filed August 29, 1995) and reply brief (Paper No. 13,

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filed December 14, 1995) for the appellant's arguments thereagainst.

OPINION

Initially we note that on pages 7-8 of the brief the appellant seeks our review of the decision by the examiner (Paper No. 9) refusing entry of the amendment (Paper No. 8) after final filed May 25, 1995. However, the refusal by the examiner to enter appellant's amendment after final rejection relates to a petitionable matter and not to an appealable matter. See In re Schneider, 481 F.2d 1350, 1356-57, 179 USPQ 46, 51 (CCPA 1973) and In re Mindick, 371 F.2d 892, 894, 152 USPQ 566, 568 (CCPA 1967). See also Manual of Patent Examining Procedure (MPEP) § 1002(c), item 4(b) and § 1201. Thus, the relief sought by the appellant would have been properly presented by a petition to the Commissioner under 37 CFR §§ 1.127 and 1.181 instead of by appeal to this Board. Accordingly, we will not further consider this issue.

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

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positions articulated by the appellant and the examiner. It is our conclusion that Allen is insufficient to establish obviousness with respect to claims 1 through 27. Accordingly, we will not sustain the examiner's rejection of claims 1 through 27 under 35 U.S.C. § 103. Our reasoning for this determination follows.

Before addressing the examiner's rejection based upon prior art, it is an essential prerequisite that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art under 35 U.S.C. §§ 102 and 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988). Furthermore, it is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ

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385, 388 (Fed. Cir. 1983). Accordingly, we will initially direct our attention to claims 1, 6, 14 and 22 to derive an understanding of the scope and content thereof.

Claim 1 includes the limitation that the predetermined proximal distance "corresponds" to the thickness of the anatomical cavity wall. Claim 6 includes the limitation that the predetermined distance is "corresponding" to the thickness of the anatomical cavity wall. Claim 14 includes the limitation that the trigger member is movable proximally a proximal distance "corresponding" to the thickness of the anatomical cavity wall.

The American Heritage Dictionary, Second College Edition (1982), defines "corresponding" as "1. Agreeing or conforming, as in degree or kind, consistent. 2. Analogous or equivalent" and defines "correspond" as "1. To be in agreement, harmony, or conformity; . . . 2. To be similar, parallel, equivalent, or equal in character, quantity, origin, structure, or function."

Our review of the specification (e.g., pp. 5, 7, 16-17, 18), as originally filed, and the dictionary definitions lead us to conclude that one of ordinary skill in the art would understand

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the terminology "corresponds" or "corresponding" as recited in claim 1, 6 or 14 to mean "equal to or slightly greater than" such that the predetermined distance must be equal to or slightly greater than the thickness of the anatomical cavity wall.

Claim 1 includes the limitation that the protection means is triggered to place the safety penetrating instrument in the protected state "upon" the trigger means moving proximally a predetermined distance. Claim 6 includes the limitation that "upon" introduction of the cannula distal end in the anatomical cavity the trigger member triggers the release of the locking means permitting the retracting means to move the penetrating member from the extended position to the retracted position. Claim 14 includes the limitation that the safety penetrating instrument is triggered to move to the protective state "when" the trigger member has moved the proximal distance. Claim 22 includes the limitation that the safety penetrating instrument is triggered to move the safety penetrating instrument to a protective state "as soon as" a trigger member of the safety penetrating instrument has moved proximally a distance

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corresponding to a desired predetermined depth of penetration by the safety penetrating instrument into the tissue.

The American Hertigage Dictionary, Second College Edition (1982), defines "upon" as "On"² and defines "when" as "1. At the time that; 2. As soon as."

Our review of the specification (e.g., pp. 4, 5, 6, 17-18, 26-27, 32-33), as originally filed, and the dictionary definitions lead us to conclude that one of ordinary skill in the art would understand the terminology "upon," "when" and "as soon as" as recited in claim 1, 6, 14 or 22 to mean "at essentially the same time."

With regard to the question of obviousness, we find no teaching in Allen that would have suggested to one of ordinary skill in the art at the time of the appellant's invention that Allen's disclosed safety trocar instrument be modified in such a manner as to meet the limitations of independent claims 1, 6, 14 and 22. In that regard, we see no teaching in Allen that would

² The American Hertigage Dictionary, Second College Edition (1982), provides that one definition of "on" is "Used to indicate: Occurrence at a given time."

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have suggested any of the following limitations: (1) "trigger means proximally movable during penetration of the anatomical cavity wall for triggering said protection means to place said safety penetrating instrument in said protected state **upon** said trigger means moving proximally a predetermined distance whereby, when said predetermined proximal distance **corresponds** to the thickness of the anatomical cavity wall, said safety penetrating instrument will be placed in said protected state when said portal sleeve [sic, cannula] distal end enters the anatomical cavity" as recited in claim 1, (2) "a trigger member movable a predetermined proximal distance during penetration of the anatomical cavity wall for triggering release of said locking means to permit said retracting means to move said penetrating member from said extended position to said retracted position, said predetermined distance **corresponding** to the thickness of the anatomical cavity wall to allow said penetrating member to be moved to said retracted position **upon** introduction of said cannula distal end in the anatomical cavity" as recited in claim 6, (3) "a trigger member movable proximally a proximal distance **corresponding** to the thickness of the anatomical cavity wall; and triggering the safety penetrating instrument to move to the protective state **when** the trigger member has moved the proximal

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distance" as recited in claim 14, and (4) "triggering the safety penetrating instrument to move the safety penetrating instrument to a protective state where the penetrating member is protected **as soon as** a trigger member of the safety penetrating instrument has moved proximally a distance corresponding to a desired predetermined depth of penetration by the safety penetrating instrument into the tissue" as recited in claim 22. We agree with the appellant's argument that while the trigger sleeve 20 of Allen is movable a proximal distance from the position shown in Figure 3-C to the position shown in Figure 3-D, such proximal distance does not **correspond** to the thickness of the anatomical cavity wall as recited in claims 1, 6 and 14. We also agree with the appellant's argument that the retraction of Allen's penetrating member 24 does not occur **when/upon/as soon as** the trigger sleeve 20 of Allen is moved the proximal distance from the position shown in Figure 3-C to the position shown in Figure 3-D as recited in claims 1, 6, 14 and 22. We therefore conclude that claims 1, 6, 14 and 22 would not have been obvious over Allen.

Accordingly, we cannot sustain the examiner's rejection of appealed claims 1, 6, 14 and 22, or claims 2 through 5, 7 through

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13, 15 through 21 and 23 through 27 which depend therefrom, under
35 U.S.C. § 103 as being unpatentable over Allen.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 27 under 35 U.S.C. § 103 is reversed.

REVERSED

| | | |
|-----------------------------|---|-----------------|
| CHARLES E. FRANKFORT |) | |
| Administrative Patent Judge |) | |
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| |) | |
| |) | |
| |) | BOARD OF PATENT |
| LAWRENCE J. STAAB |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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| |) | |
| |) | |
| JEFFREY V. NASE |) | |
| Administrative Patent Judge |) | |

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APPENDIX

1. A safety penetrating instrument for penetrating an anatomical cavity wall to gain access to an anatomical cavity comprising

a cannula having a distal end for introduction in the anatomical cavity, a proximal end for being disposed externally of the anatomical cavity and a lumen between said distal and proximal ends of said cannula;

a penetrating member disposed in said lumen of said cannula and having a distal end for penetrating the anatomical cavity wall;

protection means for placing said safety penetrating instrument in a protected state where said distal end of said penetrating member is in a protected, non-exposed position; and

trigger means proximally movable during penetration of the anatomical cavity wall for triggering said protection means to place said safety penetrating instrument in said protected state upon said trigger means moving proximally a predetermined distance whereby, when said predetermined proximal distance corresponds to the thickness of the anatomical cavity wall, said safety penetrating instrument will be placed in said protected state when said portal sleeve [sic, cannula] distal end enters the anatomical cavity.

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6. A safety penetrating instrument for penetrating an anatomical cavity wall to gain access to an anatomical cavity comprising

a cannula having a distal end for introduction in the anatomical cavity, a proximal end and a lumen between said distal and proximal ends of said cannula;

a penetrating member disposed in said lumen of said cannula and having a distal end for penetrating the anatomical cavity wall;

retracting means for moving said penetrating member proximally from an extended position where said penetrating member distal end is disposed distally of said cannula distal end to a retracted position where said penetrating member distal end is disposed within said cannula distal end;

locking means for locking said penetrating member in said extended position; and

a trigger member movable a predetermined proximal distance during penetration of the anatomical cavity wall for triggering release of said locking means to permit said retracting means to move said penetrating member from said extended position to said retracted position, said predetermined distance corresponding to the thickness of the anatomical cavity wall to allow said penetrating member to be moved to said retracted position upon introduction of said cannula distal end in the anatomical cavity.

14. A method of forming a portal in the wall of an anatomical cavity comprising the steps of
penetrating the anatomical cavity wall with a penetrating member of a safety penetrating instrument having a protective state where the penetrating member is protected and a trigger member movable proximally a proximal distance corresponding to the thickness of the anatomical cavity wall; and
triggering the safety penetrating instrument to move to the protective state when the trigger member has moved the proximal distance.

22. A method of penetrating tissue comprising the steps of
penetrating the tissue with the distal end of a penetrating member of a safety penetrating instrument including a cannula receiving the penetrating member and adapted to remain in the tissue after the penetrating member is withdrawn from the cannula; and

triggering the safety penetrating instrument to move the safety penetrating instrument to a protective state where the penetrating member is protected as soon as a trigger member of the safety penetrating instrument has moved proximally a distance corresponding to a desired predetermined depth of penetration by the safety penetrating instrument into the tissue.

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APJ NASE

APJ FRANKFORT

APJ STAAB

DECISION: **REVERSED**

Prepared By: Delores A. Lowe

DRAFT TYPED: 19 Nov 97
1st Rev. 02 Dec 97

FINAL TYPED: