

**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(2) is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** SIEGFRIED RIEK,  
KARL-HEINZ BACHMANN  
and  
THOMAS GAISELMANN

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Appeal No. 97-2600  
Application 08/500,091<sup>1</sup>

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HEARD: September 15, 1997

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<sup>1</sup> Application for patent filed July 10, 1995. According to appellants, the application is a continuation of Application 08/168,213, filed December 17, 1993, now U.S. Patent No. 5,431,151, issued July 11, 1995; which is a continuation of Application 07/779,730, filed October 23, 1991, now U.S. Patent No. 5,271,380, issued December 21, 1993.

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

MEISTER, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is an appeal from the final rejection of claims 16-25, 27, 29-37, 39 and 41-44, the only claims remaining in the application. We reverse.

The appellants' invention pertains to an instrument for the penetration of body tissue. Independent claim 16 is further illustrative of the appealed subject matter and reads as follows:

16. An instrument for the penetration of body tissue comprising:

a rigid shaft having a distal end,

a tissue contacting element at the distal end of said shaft shaped to enlarge an opening in body tissue as the tissue contacting element and said shaft are advanced, said tissue contacting element having a distal end, and at least part of said tissue contacting element being transparent to permit viewing of body tissue therethrough, and

an advancing element at said tissue contacting element, said advancing element having a cutting edge to penetrate the body tissue and extending from adjacent the distal end of said tissue contacting element towards said shaft.

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The examiner has relied upon the following refer-  
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to support a rejection under 35 U.S.C. § 112, first paragraph:

Alvord 1878	207,932	Sept. 10,
Auburn 1980	4,191,191	Mar. 4,

Claims 16-25, 27, 29-37, 39 and 41-44 stand rejected under 35 U.S.C. § 112, first paragraph, as being based upon an original disclosure which fails to provide descriptive support for the subject matter now being claimed.

The examiner's rejection is explained on pages 4 and 5 of the Office action mailed December 19, 1995 (Paper No. 8).<sup>2</sup> The arguments of the appellants and examiner in support of their respective positions may be found on pages 7-21 of the brief, pages 1-4 of the reply brief, pages 4-11 of the answer and pages 2-4 of the supplemental answer. As evi-

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<sup>2</sup> Page 4 of the answer states that the "rejection is set forth in the prior Office actions paper numbers 8 and 12." Such a procedure by the examiner is totally improper and inappropriate. The **Manual of Patent Examining Procedure** (MPEP) § 1208 (6th ed., Rev. 2, Jul. 1996) expressly provides that incorporation by reference may be made only to a **single** other action.

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dence that descriptive support for the claimed subject may be found in the disclosure as originally filed, the appellants have relied upon an original declaration and a supplemental declaration by Mr. John M. Collins.

***OPINION***

We have carefully reviewed the appellants' invention as described in the specification, the appealed claims, the respective positions advanced by the appellants in the brief and reply brief and by the examiner in the answer and supplemental answer,

the prior art relied on by the examiner to support her position

and the declarations by Mr. Collins relied on by the appellants to support their position. This review leads us to

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conclude that the examiner's rejection of the appealed claims cannot be sustained.<sup>3</sup>

The examiner's position is summarized on pages 4 and 5 of the answer in the following manner:

[T]he independent claims filed with the instant application, claims 16, 27, 30 and 44 contained recitations of "an advancing element. . . having a cutting edge" or "at least one cutting element." The Examiner noted that the specification discussed an alter-nate embodiment of the trocar, as shown in Figure 7, where the window 34 was provided with a spiral 48 that is made from a wire that appears to have surfaces converging to an edge (see pages 15-16 of the instant specification). The Examiner also noted that the discussion at pages 15-16 did not impart, infer or otherwise describe a "cutting element" or an element that has the capability of being able to cut. In other words, the spiral 48 was no more than [sic, than] a wire which aided in the corkscrew motion which, in turn, aided in the **penetration** of the device rather than in the cutting of tissue. The

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<sup>3</sup> It therefore follows that we do not support the examiner's decision to require cancellation of the amendatory subject matter regarding the recitations of a "cutting edge or cutting element" and "advancing, cutting and penetrating" which were introduced into the specification by the amendment filed on April 19, 1996 (Paper No. 11).

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Examiner herein noted differences in the dictionary definitions of "penetrate" and "cutting". Thus, the claim language pertaining to the "advancing element" or the "cutting element" was not supported by the specification or the Figures and constituted new matter.

In support of this position the answer further states that:

Col. 3, lines 8-23 of Auburn make it clear that sharp or smooth edges can be used **interchangeably** as a means for imparting and/or aiding penetration. Thus, when the term "penetration" was used with respect to a trocar's screw-type threads, this did not necessarily lead to the conclusion that the threads are sharp. As Auburn demonstrates, they may be smooth. Alvord U.S. Patent 207,932 is another example of the use of smooth threads used to penetrate. Figure 3 of Alvord shows smooth screw-type threads (called a "spiral" by Alvord) applied to the external surface of a cannula and on page 1, recites "The dilator is applied by giving it a gentle rotary motion, the spiral causing it to advance slowly in position." [Pages 7 and 8.]

We will not support the examiner's position. Initially we observe that the description requirement found in the first paragraph of 35 U.S.C. § 112 is separate from the enablement requirement of that provision. **See Vas-Cath Inc. v. Mahurkar**, 935 F.2d 1555, 1560-64, 19 USPQ2d 1111, 1114-17

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(Fed. Cir. 1991) and *In re Barker*, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), **cert. denied**, 434 U.S. 1064 (1978). As the court stated in *Vas-Cath*, 935 F.2d at 1563-64, 19 USPQ2d at 1117:

35 U.S.C. § 112, first paragraph, requires a "written description of the invention" which is separate and distinct from the enablement requirement. The purpose of the "written description" requirement is broader than to merely explain how to "make and use"; the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession **of the invention**. The invention is, for purposes of the "written description" inquiry, **whatever is now claimed**.

. . . [D]rawings alone **may** be sufficient to provide the "written description" of the invention" required by § 112, first paragraph.

Here, it is true that the appellants' specification only broadly refers to the element identified in Fig. 7 by the numeral 48 as a "spiral" which, e.g., is "made from a wire" (see page 15) and makes no mention of this spiral or wire performing a cutting operation. It is also true that (1) Auburn teaches that a spiral in the form of screw threads on a

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trocar may be (a) sharp so that the screw threads cut tissue, (b) "smoothly contoured" (apparently for the purpose of simply distending tissue) or (c) a combination of sharp and smoothly contoured (see column 2, line 62 through column 3, line 23) and (2) Alvord teaches an analogous medical instrument wherein the spiral is formed from a wire which is clearly "rounded." The problem is,

however, that Fig. 7 of the appellants' drawings clearly depicts the spiral as having a generally sharpened edge which appears remarkably like the screw threads 32 of Auburn which are stated to cause "a gradual cutting through the abdominal wall" (column 2, line 64).

Moreover, the appellants have provided evidence that one skilled in the art would recognize that the spiral or wire 48 of the instant application has an edge which cuts tissue.

For example, the supplemental declaration by John M. Collins states that:

1. Auburn 4,191,191 clearly teaches that the trocar of Figs. 1, 2 and 3 has helical ridges forming a screw thread arrangement 32. The helical ridges 32 of Fig. 3 are "sharp pointed" (column 3, lines 10-11) and produce "a gradual cutting" of the abdominal wall (column 2, line 64). Accordingly, one skilled in the art would recognize that the sharp edge of Fig. 3 of Auburn is a cutting edge, and would recognize that the wire 48 of Riek et al [the instant application] has the same edge and shape as Fig. 3 of Auburn and therefore know that since both trocars are to be rotated to penetrate, the wire 48 of Riek et al provides an edge which cuts tissue when moved along tissue, and therefore is a cutting edge.<sup>[4]</sup> [Page 1.]

See also paragraphs 8 and 9 of the first declaration by Collins.

On the other hand, the evidence relied on by the examiner (i.e., Auburn and Alvord), while establishing that a spiral or

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<sup>4</sup> Using the same reasoning, the edges 24 depicted in the Fig. 7 of the appellants' drawing are apparently likewise cutting edges.

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wire does not necessarily cut, does so in the context of the spiral or wire being "smoothly contoured" (Auburn) or "rounded" (Alvord). Accordingly, based on the evidence before us, we are of the opinion that the appellants' original disclosure taken as a whole reasonably conveys to the artisan that the edges on the spiral or wire 48 depicted in Fig. 7 of the drawing are "cutting edges."

As to the examiner's contention that there is no descriptive support for an "advancing element," the appellants' specification clearly states that during the **penetration** of body tissue that "[v]ia the rotating spiral 48 and the attached thereto thread 24, the trocar **bores** into the tissue" (see page 16, lines 2-4; emphasis ours). This being the case, we do not believe it can seriously be contended that the appellants' original disclosure reasonably conveys to one of ordinary skill in this art that the appellants were in possession of "an advancing element" as of the filing date sought.

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In view of the foregoing the rejection of claims 16-25, 27, 29-37, 39 and 41-44 under 35 U.S.C. § 112, first paragraph, is reversed.

**REVERSED**

	JAMES M. MEISTER	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	BOARD OF
PATENT		)	
	NEAL E. ABRAMS	)	APPEALS AND
	Administrative Patent Judge	)	
INTERFERENCES		)	
		)	
		)	
	CHARLES E. FRANKFORT	)	
	Administrative Patent Judge	)	

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Nath Amberly & Associates  
1835 K Street, N.W.  
Suite 750  
Washington, D.C. 20006-1203