

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte GREGORY T. FOSSUM

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Appeal No. 98-2779  
Application 08/496,604<sup>1</sup>

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ON BRIEF

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Before MEISTER, ABRAMS and FRANKFORT, 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 through 13, all the claims pending in the application.

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<sup>1</sup> Application for patent filed June 29, 1995.

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Appellant's invention relates to a surgical clamp useful for removing foreign bodies during surgical procedures. 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 attached to this decision.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

English	2,618,268	Nov. 18, 1952
Schlein	3,981,308	Sep. 21, 1976
Kurwa	4,574,804	Mar. 11, 1986

Claims 1 through 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kurwa in view of Schlein and English.

Rather than reiterate the examiner's full statement of the above-noted rejection and the conflicting viewpoints advanced by the examiner and appellant regarding the rejection, we make reference to the final rejection (Paper No. 5, mailed

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November 7, 1996) and the examiner's answer (Paper No. 12, mailed November 12, 1997) for the examiner's reasoning in support of the rejection, and to appellant's brief (Paper No. 11, filed

August 7, 1997) and reply brief (Paper No. 13, filed January 16, 1998) for appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

Preliminary to treating the examiner's rejection of the appealed claims, we note that on page 3 of the brief appellant has indicated that for purposes of this appeal, "claims 1-13 may be grouped together." In such an instance, we would normally select a claim as being representative of the claimed

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subject matter (e.g., independent claim 1) and proceed to decide the appeal on the basis of that claim alone (See 37 CFR § 1.192(c)(7)). However, in this case, in both the brief and reply brief, appellant has made separate arguments that go to the propriety of the examiner's combination of Schlein with Kurwa (applicable, for example, to claims 1 and 2) and English with Kurwa (needed to additionally address the limitations of claims 3 through 13). The examiner, in her answer, has separately responded to each of appellant's lines of argument. Accordingly, since the examiner and appellant have both provided their positions on the propriety of the respective combinations of prior art noted above, we deem it appropriate to review each of those combinations in deciding this appeal. We hasten to add that inconsistencies between appellant's grouping of the claims and separate arguments presented in the brief, like those noted above, should normally be resolved prior to the application being forwarded to the Board for our treatment of the appeal.

In reviewing the examiner's prior art rejection of the appealed claims, the only difference we perceive between the

surgical clamp of Kurwa and that defined in claim 1 on appeal is the requirement in appellant's claim 1 of a jaw portion on each of the intersecting arms which includes a "diamond grid gripping surface." As set forth in Kurwa, at column 2, lines 45-46, the jaw portions (18a, 18b) of the surgical clamp are described as having "serrated facing surfaces 24." As seen in Figure 6a, the serrated facing surfaces of the jaws of the clamp in Kurwa are used to grip an object, i.e., the optic nerve (D), during enucleation (a surgical procedure involving the removal of a diseased eyeball). Recognizing that the surgical clamp of Kurwa lacks the specific type of gripping surface set forth in appellant's claim 1, the examiner has turned to the surgical clamp of Schlein for such a teaching. On pages 3-4 of the final rejection, the examiner has indicated that

"Schlein discloses a surgical clamp having jaw portions, 10, 12 comprising diamond grid gripping surfaces 22.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the diamond surfaces as taught by Schlein, since Schlein states at column 2, lines 51-58 that such a modification would insure [sic] a firm grip on the tissue being selected."

Like the examiner, we are of the opinion that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to use the diamond grid gripping surfaces as taught by Schlein as the serrated facing surfaces (24) in Kurwa so as to "insure [sic] a firm and positive grip on the work-piece" as suggested in Schlein (col. 2, line 51-52). Both Kurwa and Schlein describe the jaws of their surgical clamps as being "serrated," with Schlein expressly disclosing that such serrations are preferably in the form of diamond-shaped teeth which, as seen in Figure 7, provide a diamond grid gripping surface on each jaw. Thus, we view the collective teachings of the applied references as evidencing knowledge in the art regarding known alternative forms of serrated jaws used for surgical clamps, and as being suggestive to one of ordinary skill in the art of using the type of serrations disclosed and taught in Schlein on other surgical clamps with serrated jaws, i.e., such as the surgical clamp seen in Kurwa, as a means for ensuring a firm and positive grip on a work-piece during surgery.

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Appellant's arguments against the use of the diamond grid gripping surfaces of Schlein in the clamp of Kurwa, in our opinion, are misplaced. The arguments in the brief (page 6) and reply brief seem to seek some express teaching in either Kurwa or Schlein that the gripping surfaces of the jaws in Kurwa are inadequate before a substitution of the specific form of gripping surfaces in Schlein can be made for the serrations of Kurwa. We know of no such requirement. In this regard, we note that where two known alternatives are interchangeable for their desired function, an express suggestion of the desirability of the substitution of one for the other is not needed to render such substitution obvious. See In re Fout, 675 F.2d 297, 301, 213 USPQ 532, 536 (CCPA 1982); In re Siebentritt, 372 F.2d 566, 567, 152 USPQ 618, 619 (CCPA 1967).

While we have fully considered the arguments advanced by appellant, we are not convinced thereby that the examiner's conclusion of obviousness as it applies to claim 1 on appeal is in error. Although appellant points to alleged distinctions between the prior art and the invention of claim

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1 based upon use of the surgical clamp set forth in claim 1 for gripping a foreign object and the problem which the invention solves, we note that it is clear that the purpose proposed as the reason why the artisan would have found the claimed subject matter to have been obvious based on the prior art need not be identical to the purpose or problem which appellant indicates to be the basis for having made the invention in order to establish a prima facie case of obviousness. As long as some reasonable motivation or suggestion to combine the references is provided by the prior art taken as a whole, as we believe there is in this case, the law does not require that the references be combined for the reasons contemplated by appellant. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); In re Dillon, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990)(en banc), *cert. denied*, 500 U.S. 904 (1991) and In re Kronig, 539 F.2d 1300, 1304, 190 USPQ 425, 427-28 (CCPA 1976). In addition, the fact that appellant may have recognized an advantage which would flow naturally from following the suggestions of the prior art cannot be the basis for patentability when the difference would otherwise have been

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obvious. See Ex parte Obiaya, 227 USPQ 58 (BPAI 1985), aff'd. mem., 795 F.2d 1017 (Fed. Cir 1986).

Thus, for the above reasons, we will sustain the examiner's rejection of claim 1 under 35 U.S.C. § 103. Since no separate argument has been made by appellant regarding dependent claim 2, we consider that claim 2 will fall with claim 1.

Appellant's arguments in the brief and reply brief directed to the feature of the invention relating to the use of a rat tooth (10) at the distal end of the jaw portion of the clamp are not relevant to independent claim 1, since no such recitation appears in claim 1. Likewise, those arguments are not relevant to dependent claim 2 which also has no such feature recited therein. However, given that appellant has argued this feature in both the brief and reply brief, we will treat it. We first note that the examiner has addressed this aspect of the claimed subject matter (e.g., claims 3 through 13) by relying on the teachings of English, which shows a surgical clamp that includes a rat tooth structure (17, 19) at

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the distal end of the jaw portion of the clamp in combination with a series of longitudinal corrugations (at 23) located on the gripping portion of the clamp therein. English also shows or discloses latching means (14) on the clamp members (10, 11) for holding the members (10, 11) closed together when desired. According to the examiner (final rejection, page 4),

"It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a latching means and rat tooth jaws as taught by English, since English states at column 3, lines 19-28 that such a modification would enable the jaw members to be held in the position desired by the surgeon and since English states at column 4, lines 18-33 that the rat tooth jaw arrangements prevent side slip of the tissue being grasped by the surgeon."

While we certainly share the examiner's view with regard to the latching means of English, especially given that Kurwa already includes a latch mechanism or catch at (22) for allowing the handle portions (16) to be "releasably locked together" (col. 2, lines 42-44), we must agree with appellant that it would not have been obvious to one of ordinary skill in the art to provide the distal ends of the jaws of the clamp in Kurwa with a rat tooth structure like that of English. We reach this conclusion because the offset portions of the ends

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(26) of the clamp of Kurwa would not lend themselves to a rat tooth structure of the type seen in English. Note particularly, the arguments found in appellant's reply brief (pages 2-4). The need in Kurwa for the smooth extension (28) on the tip end of the jaw portion (18a) would preclude a rat tooth arrangement like that of English from being used therein, since at least the distal end of jaw portion (18a) must remain free of obstructions to define the smooth flat surface (29) that is critical to the disclosed use of the clamp of Kurwa. Note specifically, Figures 3, 4a and 5a of Kurwa and the disclosure at column 3, line 6, *et seq.*, highlighting the significance of the smooth, rounded extension (28) and smooth flat surface (29). Thus, the examiner's rejection of claims 3 and 4, the claims which depend therefrom, and claims 11 through 13 relying on the combined teachings of Kurwa, Schlein and English will not be sustained.

To summarize our decision, we note that 1) the examiner's rejection of claims 1 and 2 under 35 U.S.C. § 103 has been sustained and 2) the examiner's rejection of claims 3 through

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13 under 35 U.S.C. § 103 has not been sustained. The decision of the examiner is, accordingly, affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

JAMES M. MEISTER	)	
Administrative Patent Judge	)	
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NEAL E. ABRAMS	)	
Administrative Patent Judge	)	APPEALS AND

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) CHARLES E. FRANKFORT  
) Administrative Patent Judge  
)

CEF/kis  
Paul K. Legaard  
WOODCOCK, WASHBURN, KURTZ  
MACKIEWICZ & NORRIS  
One Liberty Place  
46th Floor  
Philadelphia, PA 19103

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APPENDIX

1. A surgical clamp comprising:  
a pair of intersecting arms and pivot means  
interconnecting said arms for providing rotating motion about  
a common axis;  
said arms each comprising handle portion, jaw portion,  
and shaft portion between said handle and jaw portions;  
each handle portion further comprising finger loop and  
latching means opposite said finger loop and in substantially  
the same plane therewith;  
each jaw portion further comprising diamond grid gripping  
surface; and  
said gripping surface on each jaw being operably opposed  
and said latching means being operably engageable when said  
handle portions are rotated toward each other for holding said

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handle portions in a fixed position, and operably engaging  
said gripping surfaces.