

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HENRY A. REDMON

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Appeal No. 1999-1814  
Application No. 08/688,108

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ON BRIEF<sup>1</sup>

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Before ABRAMS, MCQUADE, and BAHR, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 13-19, which are all of the claims pending in this application. Claim 13 has been amended subsequent to the final rejection (see Paper Nos. 9 and 10).<sup>2</sup>

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<sup>1</sup> An oral hearing was set for May 17, 2000. However, pursuant to 37 CFR § 1.194(c), appellant's counsel was notified on May 15, 2000 that an oral hearing was not necessary. This appeal has been decided on brief.

<sup>2</sup> We note that the copy of the application filed on July 29, 1996 under 37 CFR § 1.60 contains markings which presumably reflect amendments made during the prosecution of parent Application No. 08/420,812, filed April  
(continued...)

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### BACKGROUND

The appellant's invention relates to a method of performing subcutaneous surgery, specifically to illuminate the carpal tunnel area of a patient to effect the severance of the transverse carpal ligament.

An understanding of the invention can be derived from a reading of exemplary claim 13, which reads as follows:

13. A method of performing illuminated subcutaneous surgery comprising the steps of making a relatively small incision of a determinate length in a patient's skin, providing a surgical instrument having a pair of blade portions which when closed have a determinate length, width and thickness; inserting the closed blade portions in the length direction with a nose thereof leading into the small incision and with a width-defining surface of one of the blade portions contiguous the epidermis adjacent the small incision, rotating the closed blade portions substantially 90 degrees which brings a thickness-defining surface of the blade portions adjacent the epidermis, subsequently spreading the blade portions to create a volume beneath the epidermis accessible through the incision for surgical purposes, and illuminating the volume incident to the performance of a surgical procedure.

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(...continued)

12, 1995, now U.S. Patent No. 5,569,300, and that, at the examiner's request (see Paper No. 3, page 2), appellant filed a "clean" copy of the original parent application (specification and claims) on February 17, 1998 (Paper No. 5). While there is no indication in the record that the "clean" copy has been entered, the amendment (Paper No. 9) filed subsequent to the final rejection has been entered in this "clean" copy of claim 13. Appellant filed preliminary amendments on July 29, 1996, including an amendment canceling claims 1-12. Although the preliminary amendments and an amendment filed February 17, 1998 have not been clerically entered, it is clear from the record that (1) appellant intends that all amendments be entered in the "clean" copy and (2) both the examiner and appellant agree that claims 1-12 have been canceled and that claims 13-19 as reproduced in the appendix to appellant's brief (Paper No. 8) are the currently pending claims. We leave it to the examiner to take appropriate action to address the above-noted informalities.

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

Agee et al. (Agee)	4,962,770	Oct. 16, 1990
Chow	5,353,812	Oct. 11, 1994

The following rejections are before us for review.

1. Claims 13-19 stand rejected under 35 U.S.C. § 112, first paragraph, because, according to the examiner, the specification, while enabling for a method to carpal tunnel surgery, does not reasonably provide enablement for surgery on other portions of the body and, thus, is not enabling for the full scope of the claims.
2. Claims 13 and 14<sup>3</sup> stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.
3. Claims 13, 14, 16 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Chow.

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<sup>3</sup> In view of the examiner's inclusion of claim 14 in this rejection in the final rejection (Paper No. 6, page 3), the examiner's omission of claim 14 in this rejection in the answer (Paper No. 11) is presumed to have been an inadvertent error. In any event, in light of our treatment of this rejection, infra, our interpretation does not prejudice appellant.

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4. Claims 15, 17 and 19<sup>4</sup> stand rejected under 35 U.S.C. § 103 as being unpatentable over Chow in view of Agee.

Reference is made to the brief (Paper No. 8) and the answer (Paper No. 11) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

#### 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 references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

#### *The enablement rejection*

Insofar as the enablement requirement is concerned, the dispositive issue is whether the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the appellant's application, would have enabled a person of such skill to make and use the appellant's invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA 1982). In calling into question the enablement of appellant's disclosure, the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement. Id.

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<sup>4</sup> It is clear from the record as a whole that the examiner's inclusion of claim 18, rather than claim 19, in this rejection in the final rejection was an inadvertent error which was corrected in the examiner's answer. As appellant has not petitioned the examiner's inclusion of claim 19 in this rejection in the answer as being a new ground of rejection and in light of our treatment of this rejection, infra, our interpretation does not prejudice appellant.

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In rejecting claims 13-19 under 35 U.S.C. § 112, first paragraph, the examiner contends that the specification, while being enabling for a method to carpal tunnel surgery, does not reasonably provide enablement for surgery on other portions of the body. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the method of the invention commensurate in scope with these claims. On page 3 and 4 of the specification it states that "in it's [sic: its] broadest aspects the surgical instrument of the present invention is utilized in conjunction with surgery to relieve carpal tunnel syndrome" also on page 4 the applicant specifically states that "Pursuant to the method of this invention" which inherently would limit the method of use to carpal tunnel surgery [answer, page 3].

We note, at the outset, that appellant's specification (page 1, lines 5-9) states that the invention relates to "a surgical instrument for and a method of performing subcutaneous surgery, specifically the utilization of the surgical instrument to illuminate the carpal tunnel area . . ." From our perspective, this would have conveyed to one of ordinary skill in the art that the disclosed method steps are applicable to subcutaneous surgery generally and more specifically, as an example, to carpal tunnel ligament surgery. While it is true that the specific embodiment of the invention described in detail in the specification is carpal tunnel surgery, the examiner has not advanced any explanation as to why one of ordinary skill in the art of subcutaneous surgery would not have been able to apply the teachings of appellant's disclosure to other forms of subcutaneous surgery.

Accordingly, we shall not sustain the examiner's rejection of claims 13-19 under 35 U.S.C. § 112, first paragraph.

The rejection under 35 U.S.C. § 112, second paragraph

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The examiner has rejected claims 13 and 14<sup>5</sup> on the basis that they fail to include "the critical limitation of 'carpal tunnel'" and that, absent this limitation, the specification and claims fail to provide the area of surgery at which the method is to be performed (answer, page 4).

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). As long as this requirement is met, the claims are not indefinite. Breadth is not to be equated with indefiniteness. In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971).

For the reasons discussed above with regard to the examiner's rejection of claims 13-19 under the first paragraph of 35 U.S.C. § 112, we do not consider "carpal tunnel" to be a critical limitation of the claims. While we appreciate that claims 13 and 14 are broad in that they are not limited to any particular area of the body or to any particular type of patient, the claims set out and circumscribe the invention with sufficient precision and particularity that its metes and bounds can be easily ascertained by one of ordinary skill in the art. We do not agree with the examiner that the scope of the claims must be limited to a particular area of the body to comply with the second paragraph of 35 U.S.C. § 112.

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<sup>5</sup> While the examiner has not included claims 16 and 18, we note, for the record, that these claims, like claims 13 and 14, are also not limited to carpal tunnel surgery.

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For the foregoing reasons, we shall not sustain the examiner's rejection of claims 13 and 14 under the second paragraph of 35 U.S.C. § 112.

The obviousness rejections

Turning first to the examiner's rejection of claims 13, 14, 16 and 18, we note that these claims require, inter alia, the steps of rotating the closed blade portions substantially 90 degrees which brings a thickness-defining surface of the blade portions adjacent the epidermis and subsequently spreading the blade portions to create a volume beneath the epidermis accessible through the incision for surgical purposes. The appellant argues that Chow neither discloses nor suggests these steps and, thus, does not render obvious the subject matter of the claims (brief, page 8).

Chow discloses a trigger finger release surgical method wherein the surgeon makes an incision I into the palm of a patient's hand and inserts a hollow cannula 1 into the incision through a sheath E surrounding a flexor tendon using a holder 6 to grasp the cannula. The cannula has a slot 2, as shown in Figure 7B, along its entire length. Once the cannula has been inserted such that both ends 1a, 1b extend out from the palm as shown in Figure 8, the surgeon inserts an arthroscope 9 into one end 1b of the cannula and pushes it forward until it is adjacent the site of a constriction. Next, the surgeon inserts a curved or flexible surgical knife 11 into the opposite end 1a of the cannula and pushes it forward until it is immediately beneath the portion of the sheath E to be cut to relieve the constriction and release the trigger finger. The surgeon may use a holder similar to holder 6 to grasp and manipulate the shank 11a

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of the blade. The knife 11 also has an enlarged head 11b which is narrower than the width of the slot 2 of the cannula. The height of the head is greater than the diameter of the shank but is less than the diameter of the cannula. The outer end of the knife has an inward or concave cutting edge 11c. Since the length of the cutting edge is shorter than the height of the knife at its outer end, the surgeon must rotate<sup>6</sup> the knife through the slot 2 in the cannula to bring the cutting edge to bear against the sheath as shown in Figure 13B and then proceeds to make the appropriate cuts in the sheath (column 5, lines 8-28). In column 3, lines 24-37, Chow also discloses a prior art "conventional surgical technique" for repairing trigger finger, comprising making an incision I in the palm of the hand, inserting a scissors X, scalpel or other cutting instrument through the incision, as illustrated in Figures 2 and 3, and cutting the sheath E to relieve the constriction. The examiner has not made it clear whether it is the "conventional" technique or the inventive surgical method of Chow which is relied upon in the rejection.

The examiner asserts that it would have been obvious to one of ordinary skill in the art to "make as small of an incision as possible and to insert the narrowest portion of the instrument into the small incision as leading edge thereby keeping the scaring [sic: scarring] area of the operation minimal" (answer, pages 4 and 5).

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts

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<sup>6</sup> It appears that the movement described by Chow is a turning or steering of the head radially away from the central axis of the cannula rather than a rotation of the blade about its own axis.

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that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

Initially, we note that the examiner has not supplied any evidence to support the assertion that it would have been obvious to one of ordinary skill in the art to insert the narrowest portion of the instrument into the incision as the leading edge. For this reason alone, the examiner's obviousness rejection appears to be based on speculation or impermissible hindsight, using appellant's disclosure as a template to reconstruct the claimed invention, and must therefore fall. Moreover, even accepting the examiner's position that it would have been obvious to one of ordinary skill in the art to insert the narrowest portion of the instrument into the incision as the leading edge in either the "conventional" technique or the inventive surgical method disclosed in the Chow patent, Chow still lacks any teaching or suggestion of the step of rotating the closed blade portions substantially 90 degrees as required by the claims. Turning first to the "conventional" technique discussed in column 3 and illustrated in Figures 2 and 3, to conclude that the cutting orientation of the scissors is any different than the insertion orientation (i.e., the orientation in which the narrowest portion of the instrument is the leading edge) and therefore is achieved only after a 90 degree rotation of the blades would require speculation. As for the inventive surgical method of Chow, the cannula 1 is generally circular in cross section and is of a diameter greater than either dimension of the blade 11 or its enlarged head (column 4, line 3, and

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column 5, lines 9-14) to permit insertion of the blade into the cannula. Consequently, the degree of stretching of the incision is determined solely by the cannula diameter and not by the particular insertion orientation of the cannula or the blade. In any event, we can find no teaching or suggestion in Chow's disclosure of the inventive method of a step of rotating the blade substantially 90 degrees from an orientation where a width-defining blade surface is contiguous with the epidermis to an orientation where a thickness-defining blade surface is adjacent the epidermis or a step of spreading blade portions as recited in the claims. With respect to the rotating step, the examiner's statement (final rejection, page 2) that "the term manipulating includes the motion of rotation" is of no assistance in this regard.

For the foregoing reasons, we shall not sustain the examiner's rejection of claims 13, 14, 16 and 18 under 35 U.S.C. § 103 as being unpatentable over Chow.

As for the examiner's rejection of claims 15, 17 and 19 under 35 U.S.C. § 103 as being unpatentable over Chow in view of Agee, we have reviewed the teachings of Agee but find nothing therein which overcomes the above-noted deficiencies of Chow. It follows then that we also shall not sustain this rejection.



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