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EXAMINER

OU, JING RUI

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRISTIAN KISSEL and HARALD FISCHER

Appeal 2011-006292
Application 10/837,281
Technology Center 3700

Before ERICA A. FRANKLIN, JACQUELINE WRIGHT BONILLA, and
SHERIDAN K. SNEDDEN, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a medical clip. The Examiner has rejected the claims as anticipated. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

STATEMENT OF THE CASE

Appellants' invention relates to a "a medical clip comprising a single platelet (1) of an elastic bio-compatible material which is provided with a central H-shaped cut so as to form in the platelet a frame structure (5) having side frame members (5'') and end frame members (5') with flat plate-like tongues (3) surrounded by the frame structure (5) and extending from the opposite end frame members (5') toward each other" (App. Br. 2). Figure 1 of the Specification is reproduced below.

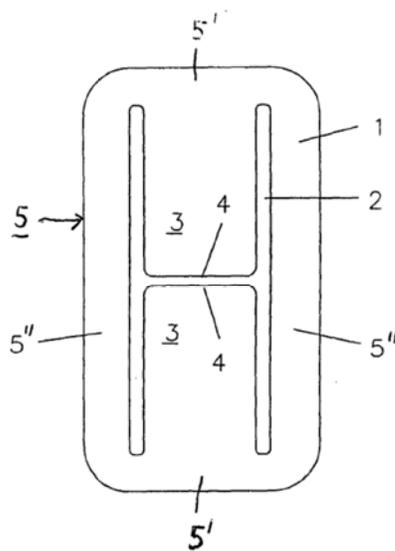


Figure 1 "shows a platelet with an H-shaped cut-out" according to the present invention (*Id.* at 3, l. 12).

Claims 1-8 are on appeal. Claim 1, the only independent claim on appeal, is representative and reads as follows (emphasis added):

1. A medical clip comprising a single platelet (1) of an elastic bio-compatible material, said platelet being provided with a *central H-shaped cut* so as to form in the platelet a frame structure (5) having side frame members 5'' and end frame members (5') with flat plate-like tongues (3) surrounded by the frame structure (5) and extending from the opposite end frame

members (5') toward each other and having adjacent front edges (4) said side frame members (5") being curved in oriented generally along straight parallel lines thereby forming grasping elements, and the area between the opposite end frame members (5') about an axis extending parallel to the front edges (4) of the tongues (3) and elastically biasing said front edges (4) of said plate-like tongues toward each other.

The rejections before us for review are the Examiner's rejection of claims 1-4 under 35 U.S.C. 102(b) as being anticipated by Durgin,¹ as well as the rejection of claims 5-8 under 35 U.S.C. 103(a) as being obvious over Durgin in view of Durgin, Nash,² and Hogendijk³ or Hart.⁴

I.

Issue

The Examiner finds that Durgin discloses a clip having each element of claim 1, including an H-shaped cutout (Ans. 3-4; citing Fig. 18 of Durgin).

Appellants contend that the "introduction of the H in Fig. 18 of Durgin et al. by the Examiner is clearly a feature introduced by hindsight" (App. Br. 5).

The issue presented is: Does the evidence of record support the Examiner's findings that Durgin anticipates claim 1?

¹ Durgin et al., US 6,428,548, issued Aug. 6, 2002.

² Nash et al., US 5,242,456, issued Sept. 7, 1993.

³ Hogendijk et al., US 6,051,007, issued Apr. 18, 2000.

⁴ Hart et al., US 6,579,304, issued June 17, 2003.

Findings of Fact

The following findings of fact (“FF”) are supported by a preponderance of the evidence of record.

FF1. Figure 18 of Durgin is reproduced below.

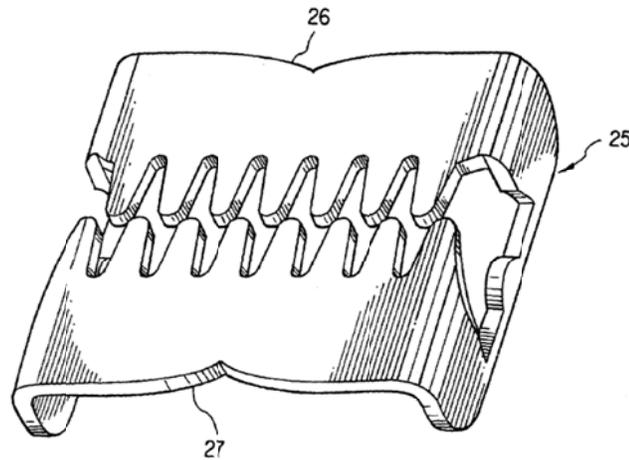


FIG. 18

Figure 18 of Durgin shows a “surgical clip with the tissue grasping surfaces formed as straight members” (Durgin col. 4, ll. 20-22).

Principles of Law

“[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.” *Net MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008).

The words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. See *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989). We determine the scope of the claims not

solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004); *In re Prater*, 415 F.2d 1393, 1395-96 (CCPA 1969). In this regard, “claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their ‘broadest *reasonable* interpretation.’” *In re Marosi*, 710 F.2d 799, 802 (Fed. Cir. 1983) (quoting *In re Okuzawa*, 537 F.2d 545, 548 (CCPA 1976) (emphasis by Marosi). This is the standard for claim interpretation in both original examination and re-examination. *In re Yamamoto*, 740 F.2d 1569, 1571-73 (Fed. Cir. 1984).

Analysis

We agree with Appellants. As explained by Appellants, Figure 18 of Durgin shows a surgical clip where the cuts located in the middle of the clip “represent tooth structures of an engagement clip” and that “[i]t may rather be said that the teeth of the clip engagement area of Durgin et al. are formed by a wave-shaped cut which produces the teeth” (App. Br. 5). The Examiner’s finding that a person of ordinary skill in the art would have interpreted the teeth formation of the Durgin clip to represent an “H” is not supported by a preponderance of the evidence. We therefore do not sustain the Examiner’s anticipation rejection of independent claim 1, nor claims 2-4, which depend on claim 1 and likewise require the “central H-shaped cut” element.

Conclusion of Law

Because Durgin fails to teach all elements of the claim, we reverse the rejection of claims 1-4 under 35 U.S.C. § 102(b) as anticipated by Durgin.

II.

The Examiner also rejects dependent claims 5-8 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Durgin, Nash, and Hogendijk or Hart (Office action mailed May 24, 2010, at 4).⁵

The obviousness rejection relies upon the underlying reasoning in the anticipation rejection based on Durgin. Having reversed the anticipation rejection above, we reverse the obviousness rejection that relies on Durgin for the same teaching of the “central H-shaped cut” element. None of the additional references cited for the obviousness rejection cure the deficiency of Durgin in this regard.

SUMMARY

We reverse the rejection of claims 1-4 under 35 U.S.C. 102(b) as being anticipated by Durgin. We also reverse the rejection of claims 5-8 under 35 U.S.C. § 103(a) as obvious over the combination of Durgin, Nash, and Hogendijk or Hart.

⁵ The Examiner stated in the Answer that “[e]very ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading ‘WITHDRAWN REJECTIONS’” (Ans. 3). The Answer does not include a section with the subheading “WITHDRAWN REJECTIONS.”

Appeal 2011-006292
Application 10/837,281

REVERSED

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