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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JUDE S. SAUER

Appeal 2015-000891
Application 12/039,503
Technology Center 3700

Before JOHN C. KERINS, WILLIAM A. CAPP, and LEE L. STEPINA,
Administrative Patent Judges.

CAPP, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the non-final rejection of claims 1–6 under 35 U.S.C. § 102(b) as anticipated by Weston (US 5,391,174, iss. Feb. 21, 1995). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

THE INVENTION

Appellant's invention is a ferrule receiving tip on surgical suturing instruments. Spec. ¶ 4. Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A ferrule receiving compartment for a surgical suturing instrument comprising:

a ferrule receiving opening for receiving a ferrule into the compartment, the opening having three radially spaced apart surfaces for contacting an outside surface of a ferrule and aligning a ferrule within the opening, the opening extending longitudinally to permit insertion and removal of a ferrule by frictional engagement with a needle;

a suture receiving slot radially disposed between first and second adjacent ones of the three radially spaced apart [sic apart] surfaces and extending longitudinally [sic longitudinally] the full length of the opening; and

at least one suture receiving chamber radially disposed between second and third adjacent ones of the three radially spaced apart surfaces.

OPINION

Appellant argues claims 1–6 as a group. Appeal Br. 3–7. We select claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2015).

The Examiner finds that Weston is capable of receiving a ferrule and permitting insertion and removal of the ferrule by frictional engagement with a needle.

Ferrules come in all shapes and sizes and Weston discloses a needle can fit within the opening longitudinally (Fig 5). Examiner sees nothing in Weston that precludes a ferrule from being able to frictionally fit within the opening, permitting inserting and removal of the ferrule by frictional engagement with a needle.

Final Action 5.

Appellant argues that Weston lacks a ferrule receiving opening having three radially spaced apart surfaces for contacting an outer surface of a ferrule. App. Br. 5. Appellant argues that the only objects in Weston that contact channel 40 are grasping members 12 and 14. *Id.* Appellant argues that grasping members 12 and 14 are distinguishable from a “ferrule.” *Id.* Appellant also argues that Weston fails to permit insertion and removal of a ferrule by frictional engagement with a needle. *Id.* at 7.

In response, the Examiner provides annotated versions of Figures 6 and 7 illustrating and identifying the location of three radially spaced apart surfaces in Weston. Ans. 3. The Examiner explains that the claim limitation “for contacting . . .” is treated as functional claim language. *Id.* at 4 (citing MPEP § 2114(II)). The Examiner points out that the claims do not positively recite either a ferrule or a needle. *Id.* The Examiner notes that Appellant has failed to explain how the claimed “surfaces” are structurally different than the surfaces of Weston. *Id.*

In reply, Appellant argues that MPEP § 2114(II) and interpretive case law should not apply to the instant claims. Reply Br. 3. Appellant argues that, to apply the rules for functional claiming, the Examiner: (1) must show identity of utility and purpose between the prior art and the claimed invention; and (2) make a factual determination that the cited reference is capable of performing the claimed function. *Id.* at 3–4. Appellant argues that Weston does not share the same utility and purpose as Appellant’s claimed surfaces. *Id.* at 4.

Appellant’s argument is not persuasive as it is based on a misreading of applicable law. In the case of *In re Schreiber*, 128 F.3d 1473 (Fed. Cir. 1997), the applicant claimed a popcorn dispenser. The Examiner, in

Schreiber, rejected claim 1 as anticipated by Harz, which disclosed a structurally similar conical spout for dispensing oil from an oil can. *Id.* at 1475. The Examiner’s position in *Schreiber* was ultimately upheld on appeal by the Federal Circuit. Appellant’s argument regarding identity of utility and purpose between the prior art and the claimed invention cannot be reconciled with the facts and ruling in *Schreiber*. *Id.* at 1479 (Board’s finding that Harz would be capable of performing the claimed functions not shown to be clearly erroneous).

In the instant case, Appellant’s Specification defines “ferrule” broadly.

As used herein ferrule is intended to include any structure that allows a needle to be selectively coupled to the end of a suture. Spec. ¶ 17. The limitations of claim 1: “*for contacting* an outside surface of a ferrule and aligning a ferrule with an opening;” and “*to permit* insertion and removal of a ferrule by frictional engagement with a needle;” are functional limitations. Claims App., claim 1 (emphasis added). A patent applicant is free to recite features of an apparatus either structurally or functionally. *See In re Swinehart*, 439 F.2d 210, 212 (CCPA 1971) (“[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims.”). Yet, choosing to define an element functionally, i.e., by what it does, carries with it a risk.

where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

Swinehart, 439 F.2d at 213. In the instant case, the Examiner finds that ferrules come in all shapes, sizes, and materials. Ans. 4. The Examiner finds that the surfaces of Weston's channel 40 are inherently sized to receive a ferrule that would receive a needle. *Id.* The Examiner's findings in this regard are sufficient, under *Swinehart*, to shift the burden of proof to Appellant to prove that Weston does not possess the claimed functional characteristics.¹

Appellant argues that Weston is not capable of aligning a ferrule within a ferrule receiving opening because the surfaces alleged by the Examiner change location. Reply Br. 14. In other words, channel 40 is crescent shaped along its length such that the cross-sectional location of the internal surfaces vary along the length of the channel. Weston, Figs. 5–10. We have reviewed Figures 5 through 10 of Weston and are not persuaded that the crescent shaped contours of channel 40 render it incapable of aligning a ferrule within the opening as claimed. Appellant's cursory argument regarding the crescent shape of Weston's channel, unaccompanied by any persuasive evidence, is insufficient to carry Appellant's burden of proof to show that Weston is not capable of meeting the functional limitations of claim 1.

It is well settled that “where all the structural elements of a claim exist in a prior art product, and the prior art product is capable of satisfying all functional or intended use limitations, the claimed invention is nothing more

¹ Appellant argues that the Examiner must make a “factual determination”: that Weston is capable of performing a functional limitation. Appeal Br. 4. To the extent that Appellant is attempting to alter the burden shifting framework set forth in *Swinehart*, we reject this argument as inconsistent with applicable law.

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than an unpatentable new use for an old product.” *Schreiber*, 128 F.3d at 1477. The Examiner’s finding that Weston discloses all the features of claim 1 is supported by a preponderance of the evidence.

We sustain the Examiner’s rejection of claims 1–6 as anticipated by Weston.

DECISION

The decision of the Examiner to reject claims 1–6 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED