

BHS

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 81

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

MAILED

YULUN WANG and KEITH PHILLIP LABY

MAY 28 2002

Junior Party,  
(Patent 5,907,664),

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

v.

PHILIP S. GREEN

Senior Party  
(Application 08/709,930).

Patent Interference No. 104,643

Before SCHAFFER, LEE, and MEDLEY, Administrative Patent Judges.

MEDLEY, Administrative Patent Judge.

**DECISION ON GREEN REQUEST FOR RECONSIDERATION  
AND FINAL JUDGMENT**

**A. Introduction**

A decision on preliminary motions was entered on 30 March 2002 (Paper 76). Wang's preliminary motion 1 for judgment against Green was granted on the basis that Green's sole involved

claim 144 is unpatentable under 35 U.S.C. § 112, ¶ 1, for lack of written description support. Green's preliminary motion 4 to add claims to its application was denied. Since Green lacked standing to remain in the interference, the remaining preliminary motions were dismissed. Green was ordered to show cause why judgment should not be entered against Green, and that the response be in the form of a request for reconsideration (Paper 76 at 28).

On 30 April 2002 Green filed a request for reconsideration of the decision on preliminary motions (Paper 79). Although Wang was authorized to file an opposition to Green's request for reconsideration and Green was authorized to file a reply to any opposition filed by Green (Paper 76 at 29), parties Wang and Green were informed on 6 May 2002 that the parties need not file an opposition or reply.

For the reasons that follow, Green's request for reconsideration of our decision on preliminary motions is denied.

#### **B. Decision**

At the heart of Green's request for reconsideration is Green's assertion that (1) Wang only raised the issue of enablement and did not raise the issue of written description support with respect to Green's claimed "end effector" and (2) the board *sua sponte* decided, under 37 CFR § 1.641 (a), whether

Green had written description support for Green's claimed "end effector."

Green begins its brief by asserting that we did not consider our own binding precedent of LeVeen v. Edwards, 57 USPQ2d 1406 (BPAI 2000), which Green correctly notes it argued in its opposition to Wang's preliminary motion 1. Specifically, Green argues that Wang's preliminary motion 1 should have been dismissed for failing to set forth facts to support an argument that Green's claim 144 lacks written description support (Paper 79 at 5).

There were several procedural deficiencies noted in LeVeen. That the facts were not presented in numbered paragraphs in the beginning of the brief was only one of several noted deficiencies. For example, in LeVeen, the movant attempted to incorporate by reference "arguments" made by its declarants. Id. at 1414. The issues in LeVeen were ones of anticipation and obviousness, not of written description support. With respect to obviousness, Edwards had failed to provide a reason, motivation, suggestion, or teaching in the prior art as to why the subject matter of LeVeen's claims would have been obvious, and thus failed to make out a *prima facie* case of obviousness. Id. at 1414. Thus, Green is incorrect that Edwards' motion for judgment was dismissed because Edwards had failed to set forth sufficient facts on which relief could be granted (Paper 79 at 5). Not

setting forth sufficient facts was only one of the noted deficiencies.

While Wang, in its preliminary motion 1, did not set forth facts in its facts section to support an argument that the term "end effector" for holding a surgical instrument was not described in Green's specification, Wang did set forth facts in its argument section to support the relief requested. In its argument section of its preliminary motion, Wang clearly alleges that Green does not have written description support for an end effector for holding a surgical instrument. In the context of an argument that a term lacks written description support, the movant has the burden of demonstrating that it is entitled to the relief sought. In essence, the movant has the burden to prove a negative, that the substance of a term or phrase that is being claimed is not described in the specification. The facts necessary to support such an argument would be that the specification is lacking a description of what is being claimed. It may be enough then for the moving party to set forth facts in support of its argument that a claimed term or phrase is not supported by the written description, without necessarily culling through the entire specification to demonstrate that something is simply not there. Here, that is what Wang did. The mere fact that Wang put the facts in the wrong location of its preliminary motion is not sufficient grounds, in this case, for dismissal of

Wang's preliminary motion.

Green argues that we *sua sponte* considered whether Green had written description support for an end effector for holding a surgical instrument under 37 CFR § 1.641(a) (Paper 79 at 12-13). Green argues that Wang's argument, in Wang's preliminary motion 1, was clearly based on enablement and that Wang did not fairly raise the issue of written description support, such that Green was improperly denied a chance to respond.

As stated in our decision on preliminary motions, the issue of written description support was clearly before us (Paper 76 at 11, "We understand Wang's argument to be based on a lack of written description support ... Wang makes it clear, through the context of its argument, that written description is at issue with respect to the "end effector" limitation.").

We disagree with Green that the issue of written description support for an end effector for holding a surgical instrument was not fairly raised and presented by party Wang. We further disagree that Green did not have a chance to properly respond. Wang's argument is presented below:

**A. The '930 Specification Does Not Provide An Enabling Disclosure For An End Effector That Holds A Surgical Instrument Limitation Of The Claim.**

2. Green has not identified an end effector that holds a surgical instrument. In the Fourth Supplemental Preliminary Amendment, Green stated that articulate arms 100, 142 hold surgical instruments 114, 170. There is no statement in the Amendment that the specification of the '930 has an end effector which holds the surgical instrument

as required by the count. The count recites an articulate arm having an end effector. The end effector holds a surgical instrument. Green has not identified an element that qualifies as an end effector of an articulate arm. (Wang Exh. 2002, p. 5, 1<sup>st</sup> para, right side).

3. The '930 application refers to item 170 as an end effector. (Green Exh. 1103, p. 17, ll. 15-17).

4. Green now states that item 170 is an instrument. Which one is it? The count requires that the instrument and end effector be two distinct elements. For how could the end effector hold itself. If item 170 is an instrument then where does the '930 application disclose an end effector? If item 170 is an end effector then the specification of the '930 application clearly does not show 170 holding a surgical instrument.

5. Given either interpretation of item 170 the '930 specification does not disclose an end effector for holding a surgical instrument as required by the count. (Paper 32 at 4-5).

While Wang does use the term "enablement" in the title of the subsection, it is clear that Wang is arguing that Green's specification lacks written description support for an end effector for holding a surgical instrument. Throughout its argument, Wang repeats that Green has not identified an end effector for holding a surgical instrument and that there is an inconsistency between explanations of the term provided by Green during prosecution of its involved application, with Green's annotation of claim terms in this proceeding, and with Green's specification.

Wang, in its preliminary motion 1, points out that Green has on occasion referred to the same item in Green's specification as

both the end effector and the surgical instrument. Wang argues that the claim recites two distinct items and that the one, e.g. the end effector, is for holding the surgical instrument. Wang concludes its argument by asserting that Green's specification does not disclose an end effector for holding a surgical instrument as required. While Green argues that no where in this section does Wang mention the phrase "written description" (Paper 79 at 19-20), also absent from Wang's arguments, with the exception of the subtitle, is the phrase "lacking enablement."

As correctly pointed out by Green, the issue of written description support and enablement are two distinct requirements under 35 U.S.C. § 112, ¶ 1. Wang's substantive argument regarding the end effector is based on written description support and not on enablement. While we recognize that Wang's subtitle may be misleading, to dismiss Wang's preliminary motion because Wang failed to use the proper heading would put form over substance. We do not think that such an outcome would lead to a just determination in this interference. See 37 CFR § 1.601. See also Pfluger v. Wertheim, 203 USPQ 874, 877 (Comm'r 1978) ("[P]apers will be treated on the basis of their content, rather than their title.")

Furthermore, party Green itself addresses Wang's arguments regarding lack of written description support. Specifically, Green argues in its opposition:

[A]s explained by Dr. Salisbury, the specification of Green's '665 patent (and thus the '930 application) often uses the term "end effector" to refer to the operative end of the surgical instrument used to manipulate tissues. (Green EXHIBIT 1014, page 4, paragraph 8; additional fact paragraph 3, *supra*.) As can be understood with reference to Fig. 9 of Green's '665 patent, robotic arms generally define a kinematic chain of joints and links between a base 110 of the robot and a working end of a robotic tool 114R. In robotics, the working end of the tool is often referred to as the "end effector" (as in Green's '665 patent). Alternatively, it is also known in robotics to define some other convenient location (often a joint) along the kinematic chain as the "end effector." (Green EXHIBIT 1014, page 4, paragraph 8; additional fact paragraph 3, *supra*.) This is merely a difference in nomenclature. Any convenient interface or joint along the kinematic chain may be designated the "end effector," so that the '665 patent, and thus the '930 application, effectively discloses an articulate arm having an end effector for holding a surgical instrument, (Green EXHIBIT 1014, page 4, paragraph 8; additional fact paragraph 3, *supra*.) (Emphasis added) (Paper 50 at 8).

The above-noted argument is responsive to Wang's argument regarding written description support for the end effector. We specifically addressed Green's argument presented above in our decision as follows:

Dr. Salisbury's testimony is of little value because the meaning defined by Green in '930 is contrary to the alleged "common meaning." The term "end effector" is used in '930 to describe a surgical instrument and not the end of an instrument or tool, or an intermediate joint or link along a kinematic chain of joints and links.

Green has not used the term "end effector" according to its common meaning as pointed out by Dr. Salisbury. Nothing stemming from Green's specification indicates that Green was aware of the asserted broad meaning of "end effector" urged by Dr. Salisbury. Green used the term in a very narrow sense that is even outside of the broad scope of the meaning urged by Dr. Salisbury. The surgical instrument necessarily embodies its own end and thus cannot be a joint or link located between the robot base and an end of itself.

Note, that expert testimony which contradicts the meaning of a term as is defined in the specification is entitled to little weight. Vitronics Corp. v. Conceptronic Inc., 90 F.3d 1576, 1585, 39 USPQ2d 1573, 1579 (Fed. Cir. 1996). An inventor's definition and explanation of a claim term, as evidenced by the specification, controls the interpretation of that claim term. Serrano v. Telular Corp., 111 F.3d 1578, 1582, 42 USPQ2d 1538, 1541 (Fed. Cir. 1997). Here, the '930 specification defines the term "end effector" to mean a surgical instrument, and as used, the end effector does not hold a surgical instrument. [FN omitted]. The '930 specification does not describe the "end effector" as a part located along a kinematic chain of joints and links between the robot base and the end of a tool.

Furthermore, Salisbury fails to sufficiently set forth facts to support a conclusion that one of ordinary skill in the art at the time of the Green '930 invention, would know that the term "end effector" means any convenient location along a kinematic chain, or alternatively that "end effector" means the end of a working tool. Salisbury makes his assertions in the present tense as follows:

In robotics, the working end of the tool is often referred to as the "end effector" ... it is also known in robotics to define some other convenient location (often a joint) along the kinematic chain as the "end effector". (Green Ex. 1014, ¶ 8).

Green fails to direct us to where in Salisbury's testimony, Salisbury indicates what was known at the time the '930 application was filed regarding the term "end effector". What is important is that which was known when the application was filed, not what was known when Salisbury testified. (Paper 76 at 13-15).

For the above reasons, we are not persuaded that (1) the issue of written description support for the end effector for holding a surgical instrument was not fairly raised and presented to Green, or that (2) we *sua sponte* considered the issue on our own. Wang raised the issue of written description support and Green responded.

Green next argues that we construed "end effector" too narrowly in light of Green's full disclosure (Paper 79 at 23). At the outset, Green argues that we improperly shifted roles by looking into Green's specification on our own without being directed to certain passages by Wang. As stated above, Wang has a negative burden of demonstrating that something isn't so. That Wang did. That we "on our own" verified the truth of the assertions does not mean that Wang failed to meet its burden.

Green argues that we failed to look at Green's entire specification in making our decision, since we ignored non-surgical embodiments when interpreting the term "end effector" (Paper 79 at 25). Green's entire disclosure was considered in rendering our decision. Green claim 144 recites "A system for allowing a surgeon to control a surgical instrument ... an articulate arm having an end effector for holding the surgical instrument..." The challenge mounted by Wang was that Green failed to provide written description support for an end effector for holding the surgical instrument. In this respect, Green's specification was reviewed for a description (including all drawings) that described an end effector for holding the surgical instrument. As we stated in our decision, in the context of surgery, e.g. using a surgical instrument, Green's specification describes the end effector as the surgical instrument. The end effector is not for holding the surgical instrument, but rather

is described as the surgical instrument itself. Thus, we did not ignore the other embodiments, but rather looked for where Green possibly has support for the claimed term of an end effector for holding the surgical instrument. The logical place to look is with respect to the embodiments that describe surgery and use of a surgical instrument. Even so, the entire specification (including the drawings) was reviewed for support for the claimed term.

Green argues that it is confused as to what the panel considers is the "common meaning" of the term end effector as discussed in our decision. The "common meaning" was provided by Green, through the Green's expert Dr. Salisbury, as clearly provided in our decision (Paper 76 at 13-15, "Green has not used the term "end effector" according to its common meaning as pointed out by Dr. Salisbury.").

Lastly, Green argues that it should have an opportunity to address the facts and legal issues presented to it for the first time in our decision (Paper 79 at 28-29). Green argues that it should have an opportunity to file new supporting evidence, and new preliminary motions. As stated above, Wang's preliminary motion 1 raised the issue of written description support with respect to the term of an end effector for holding a surgical instrument. Green responded, by providing evidence and arguments addressing why Green did have written description support for an

end effector for holding a surgical instrument. Accordingly, our decision did not raise a new issue. Green had the opportunity to respond when opposing Wang's preliminary motion. We simply resolved the issue raised in Wang's motion while giving full consideration to the points made and evidence submitted by both parties.

We note, that Green has already filed a responsive preliminary motion 4 in which Green proposed to change the term "end effector" for holding a surgical instrument to an "outer operating end" for holding a surgical instrument. That preliminary motion was denied (Paper 76 at 20).

Having considered Green's arguments in its request for reconsideration, we conclude that Green has failed to demonstrate that we misapprehended or overlooked any fact or argument first presented prior to the filing of the request for reconsideration.

The decision on preliminary motions (Paper 76) has been reconsidered to the extent necessary to provide the discussion here. No change in the decision will be made. Green's request for reconsideration is denied.

Since Green lacks standing to continue in this interference (Paper 76 at 21-28), judgment is entered against Green.

Upon consideration of the record, it is

**ORDERED** that Green's request for reconsideration is denied.



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