

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte WILLIAM LIPSKY

Appeal No. 2006-0180
Application No. 10/369,343

HEARD: FEBRUARY 22, 2006

Before FRANKFORT, CRAWFORD, 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 1-8, which are all of the claims pending in this application.

We REVERSE and REMAND.

BACKGROUND

The appellant's invention relates to a support carriage apparatus for suspending and mobilizing a plurality of overhead medical instruments in an operating room to increase footprint floor space efficiency and facilitate different surgical procedures in a single operating room (appellant's specification, page 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

Jako	4,503,854	Mar. 12, 1985
Morris	5,456,655	Oct. 10, 1995
Tachi et al. (Tachi)	6,027,247	Feb. 22, 2000

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Morris.

Claims 2 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Morris in view of Tachi.

Claims 3-5, 7 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Moriss in view of Tachi and Jako.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed November 5, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed August 23, 2004) and reply brief (filed January 7, 2005) for the appellant's arguments thereagainst.

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.

Claim Interpretation

A central issue in dispute in this appeal is whether the operating room having an operating table is positively recited in independent claims 1 and 2. The preamble of each of these claims recites apparatus "**for use in** an operating room with a structural ceiling and having an operating table located therein" (emphasis added). If we stopped reading the claim at this point, we might infer that the operating room is not positively recited as part of the invention but, rather, is the intended environment of use for the claimed apparatus. Claims 1 and 2 go on, however, to recite "a set of primary rails **connected to** the operating room [or to the ceiling of the operating room]."

The preamble of a claim does not limit the scope of the claim when it merely states a purpose or intended use of the invention; however, terms appearing in a preamble may be deemed limitations of a claim when they give meaning to the claim and properly define the invention. See In re Paulsen, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994). Although no litmus test exists as to what effect should be accorded to words contained in a preamble, review of a patent application in its entirety

should be made to determine whether the inventors intended such language to represent an additional structural limitation or mere introductory language. Id. Further, when limitations in the body of the claim rely upon and derive an antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention. Eaton Corp. v. Rockwell Int'l Corp., 323 F.3d 1332, 1339, 66 USPQ 1271, 1276 (Fed. Cir. 2003).

In this instance, the positive recitation in claim 1 of a set of primary rails connected to the operating room and in claim 2 of a set of primary rails connected to the ceiling of the operating room relies on the preamble for antecedent basis and for definition of the operating room and the ceiling. Moreover, appellant's specification repeatedly informs us that the invention is directed toward a support apparatus for mobilizing and storing a plurality of overhead instruments in an operating room to manage the useable space in a medical operating room to facilitate surgical procedures in an operating room.

In light of all of the above, we conclude, unlike the examiner, that claims 1 and 2 are directed to an apparatus in an operating room as set forth in the preamble, having a structural ceiling and an operating table located therein, with the set of primary rails required to be connected to the operating room. In other words, the claims are, in essence, directed to the combination of the apparatus and the operating room.¹ As

¹ Nevertheless, the inconsistency between the preambles of claims 1 and 2 and the recitation in

such, the recitation of an operating room having an operating table located therein cannot be overlooked or ignored in reading these claims on the prior art.²

The examiner's contention that "[a]ny room within a hospital could be considered an operating room since at any moment a patient may need surgery and may not be able to be transported thus rendering the room an operating room with the bed being the operating table" (answer, pages 7 and 8) is unreasonable. Even assuming that the examiner is correct that an emergency surgery may be performed in a patient's hospital room or a rehabilitation room (the types of rooms discussed by Morris) or in any other room of the hospital, one of ordinary skill in the medical field would not consider such

the body thereof of a set of primary rails connected to the operating room is deserving of correction in the event of further prosecution of this application.

² To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

rooms to be operating rooms as that terminology is used in the art. While it is true that the claims in a patent application are to be given their broadest reasonable interpretation consistent with the specification during prosecution of a patent application (see, for example, In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)), it is also well settled that terms in a claim should be construed as those skilled in the art would construe them (see Specialty Composites v. Cabot Corp., 845 F.2d 981, 986, 6 USPQ2d 1601, 1604 (Fed. Cir. 1988) and In re Johnson, 558 F.2d 1008, 1016, 194 USPQ 187, 194 (CCPA 1977)).

Inasmuch as Morris fails to disclose an operating room with an operating table therein, the subject matter of claim 1 is not anticipated by Morris. It follows that we cannot sustain the rejection of claim 1.

In rejecting claim 2, which recites that the set of primary rails is connected to the ceiling of the operating room, the examiner determines that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention "to have modified Morris to have located the primary set of rails on the ceiling as taught by Tachi for the purpose of allowing the operating room user the optimum amount of space below the rails for assisting patients" (answer, page 5). Be that as it may, such modification of Morris would not remedy the deficiency of Morris noted above, namely, the lack of any disclosure in Morris of an operating room having an operating table therein.

Accordingly, we also cannot sustain the rejection of claim 2, or claim 6 which depends from claim 2, as being unpatentable over Morris in view of Tachi.

The examiner's additional application of Jako in rejecting the remaining dependent claims also provides no cure for the deficiency in the examiner's combination of Morris in view of Tachi discussed above. It follows that we also cannot sustain the examiner's rejection of claims 3-5, 7 and 8 as being unpatentable over Morris in view of Tachi and Jako.

REMAND TO THE EXAMINER

Pursuant to 37 CFR § 41.50(a)(1), we remand this application to the examiner for further consideration of whether the subject matter of independent claims 1 and 2, and any of the claims depending therefrom, would have been unpatentable over the combined teachings of Tachi and Morris. Specifically, we note that Tachi discloses an overhead support apparatus for an X-ray apparatus for photographing during a medical treatment, such as surgical operation (column 7, line 11), for example, to confirm a condition inside the body of a person to be inspected and a state and position of a medical treatment tool while performing a surgical operation (column 9, line 8). Tachi teaches that, at least in part as a result of this overhead support arrangement, "the medical treatment by a doctor is less interfered with and the doctor can easily move and approach the person to be inspected" (column 3, lines 8-11). It follows that Tachi either teaches or suggests use of the overhead X-ray support apparatus in an operating room

with a ceiling and an operating table, with the rails of the support apparatus connected to the ceiling of the operating room. Morris, likewise, is concerned with clutter in hospital rooms and teaches supporting medical equipment such as IV systems and monitoring equipment from the ceiling or overhead to reduce such clutter. In response to this remand, the examiner should consider whether the combined teachings of Tachi and Morris would have suggested supporting additional medical equipment, such as IV systems as taught by Morris, which would typically be used in an operating room, on the overhead support system of Tachi to further assist in reducing clutter and providing better access to the patient in the operating room.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-8 is REVERSED.

The application is remanded to the examiner for the reason set forth above.

REVERSED AND REMANDED

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