

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 HUBERTUS FEUSSNER, RAINER GRAUMANN
and GERD WESSELS**

Appeal No. 2006-1509
Application No. 10/206,191
Technology Center 3700

ON BRIEF

Before CRAWFORD, BAHR and NAPPI **Administrative Patent Judges**.

NAPPI, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §134(a) of the final rejection of claims 1, 3 through 7 and 9 through 13. Claims 2 and 8 are canceled. For the reasons stated *infra* we reverse the examiner's rejection of these claims.

Invention

The invention relates to a system to provide image data of an organ within a patient undergoing a surgical intervention. See page 2 of appellants' specification. Claim 1 is representative of the invention and reproduced below:

1. Operating system for carrying out surgical interventions on a patient (1), comprising:

a storage device (4) for storing image data of an organ of a patient (1) that is invisible from outside; a surgical instrument (2) for carrying out the surgical intervention;

a position sensor (6), fitted on the surgical instrument (2), for detecting a spatial position of the surgical instrument (2); and

a processing device (5)

i) for calculating a spatial relationship between a position of the surgical instrument (2) located outside the body and the organ, which is represented by the image data, and ii) for repeatedly inserting a region of the image data that accurately correspond to the surroundings of the surgical instrument (2) into a display device (8), the image data being adjustedly inserted to always assure that a center of a displayed image corresponds to an accurate current position of the surgical instrument (2) with reference to the organ of the patient (1) as the surgical instrument is repeatedly repositioned outside the body, so that as the instrument is moved the image data is positioned so that the instrument remains at the center of the display device.

Rejection at Issue

Claims 1, 3 through 7, and 9 through 13 stand rejected under 35 U.S.C. § 112 first paragraph as failing to comply with the written description requirement. Throughout the opinion we make reference to the briefs, the answer and the final Office action for the respective details thereof.

Opinion

We have carefully considered the subject matter on appeal and the rejection advanced by the examiner. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejection and the arguments of appellant and the examiner, and for the reasons stated *infra* we will not sustain the examiner's rejection of claims 1, 3 through 7, and 9 through 13 under 35 U.S.C. § 112 first paragraph

The examiner states, on page 3 of the answer, that the specification does not disclose that the image of the body organ is displayed such that the middle/center of the displayed image always corresponds to a position of the medical instrument. Further, the examiner states:

The only portion of the specification that refers to this feature is seen on page 4, lines 21-23. While having the middle center of the displayed image correspond to an accurate position of the medical instrument with respect to the organ of the patient may appear to be a preferred embodiment of the invention, the specification fails to disclose this as an essential, required feature of the invention. The specification never discloses that the center of the displayed image always corresponds to the position of the instrument. It should be noted that there is a clear difference between an event occurring at some point in time and that same event always occurring. The Applicant originally disclosed the occurrence of the center of the image as showing the position of the instrument but failed to disclose that it occurred all of the time.

Appellants assert on page 8 of the brief:

[A]lthough the exact recitations are different, the invention provides for the image data being adjustably inserted to assure that a center of a displayed image corresponds to an accurate current position of the surgical instrument with reference to the organ of the patient. The examiner having acknowledged that this is a preferred embodiment, it is clear that the inventors had possession of the claimed invention and that the inventors/appellants are in compliance with 35 USC 112 first paragraph, written description requirement.

We concur with the appellants and are not convinced by the examiner's rationale. Initially we note that the examiner's statement "the specification fails to disclose this as an essential, required feature of the invention", applies the wrong standard to determine whether the disclosure complies with the written description requirement of 35 USC§ 112. Our reviewing court has said the written description requirement serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the

specific subject matter later claimed by him; how the specification accomplishes this is not material." *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In order to meet the written description requirement, the appellant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Put another way, "the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Finally, "[p]recisely how close the original description must come to comply with the description requirement of section 112 must be determined on a case-by-case basis." *Eiselstein v. Frank*, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (quoting *Vas-Cath*, 935 F.2d at 1561, 19 USPQ2d at 1116). In this case, the examiner has found that the specification, on page 4, identifies that it is advantageous for the middle or center of the displayed image to correspond to the position of the surgical instrument. Further, the specification makes no mention of the position of the surgical instrument being displayed at any location other than the center of the displayed image. Thus, we find that one of ordinary skill in the art would recognize from the appellants' disclosure that appellants, at the time of filing of the application, had possession of the claimed invention wherein the "image data being adjustedly inserted to always assure that a center of a displayed image corresponds to an accurate current position of the surgical instrument." Accordingly, we will not sustain the examiner's rejection of claims 1, 3 through 7, and 9 through 13 under 35 U.S.C. § 112 first paragraph as failing to comply with the written description requirement.

Conclusion

The decision of the examiner is reversed.

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

REVERSED

MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	
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JENNIFER D. BAHR)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
ROBERT E. NAPPI)	
Administrative Patent Judge)	

REN/lg

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Young & Thompson
745 South 23rd Street
2nd Floor
Arlington, VA 22202