

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ADMIR HADZIC, ALEN HADZIC, NIHAD HADZIC, GIGLIOLI SERGIO, FRANCA GELATTI, JERRY VLOKA, and HOWARD DONNELLY

Appeal 2006-1746
Application 10/375,678¹
Technology Center 3700

Decided: February 23, 2007

Before MURRIEL E. CRAWFORD, STUART S. LEVY,
and ANTON W. FETTING, *Administrative Patent Judges*.
STUART S. LEVY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Applicant appeals from a final rejection of claims 1-36 and 38-52 under 35 U.S.C. § 134 (2002). We have jurisdiction under 35 U.S.C. § 6(b) (2002).

¹ Application filed February 23, 2003. The real party in interest is MACOSTA MEDICAL U.S.A., L.L.C., Texas.

The examiner (final rejection, pages 2-11) rejected the claims as follows:

Claims 36-52 are rejected under 35 U.S.C. § 112 (first paragraph) as failing to comply with the written description requirement.

Claims 1-8, 10-12, 15-18, 20, 21, 23-25, 28-31, and 33 are rejected under 35 U.S.C. § 102(b) as being anticipated by Chester.

Claims 36, 40, 41, and 47-52 are rejected under 35 U.S.C. § 102(b) as being anticipated by Lee.

Claims 20 and 23-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cory in view of Chester.

Claims 9 and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chester.

Claims 13, 14, and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chester in view of Griffith.

Claim 35 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Chester in view of Gleason.

Claims 36, 38, 40, 41, and 45-50 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chester in view of Raymond.

Claim 39 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Chester in view of Raymond.

Claims 42-44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of Griffith.

In the Answer (pages 2 and 3) the Examiner lists the following rejections as being withdrawn:

The rejection of claims 9 and 34 under 35 U.S.C. § 103(a) as being unpatentable over Chester.

The rejection of claims 36, 40, 41, and 47-52 under 35 U.S.C. § 102(b) as being anticipated by Lee.

The rejection of claims 36, 38, 40, 41, and 45-50 under 35 U.S.C. § 103(a) as being unpatentable over Chester in view of Raymond.

The rejection of claim 39 under 35 U.S.C. § 103(a) as being unpatentable over Chester in view of Raymond.

The rejection of claims 42-44 under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of Griffith.

The Examiner asserts (Advisory action mailed February 9, 2006) that the amendment² submitted with the Reply Brief (filed November 23, 2005) has been entered. In addition, the Examiner asserts in the Advisory action that "[c]laim 32 was inadvertently not included in the [F]inal rejection, but that if it had been included, it [claim 32] would have been rejected on the same grounds as claim 13 as unpatentable over Chester in view of Griffith." Notwithstanding the Examiner's assertion, from our review of the Examiner's Answer, we find that no rejection is presented with respect to claim 32. Nor do we find a rejection of claims 9 or 22, or 34. Accordingly, we agree with Applicants (Reply Br. 2) that the examiner has presented no rejection of claims 9, 22, and 32, and add that claim 34 is also not rejected.

Moreover, the Examiner asserts (Answer 3) that the rejection of claim 35 under 35 U.S.C. § 103(a) as being unpatentable over Chester in view of Griffith has not been withdrawn, but is not subject to review on appeal because Applicants have not referred to this rejection in the Brief. We agree. From our review of the Brief and the Reply Brief, we find not mention of this rejection, even though Applicants could have responded to the Examiner's assertion in the Reply Brief. Accordingly, we sustain the rejection of claim 35 under 35 U.S.C. § 103(a) *pro forma*.

From all of the above, we find that the only rejections remaining for Decision on Appeal are as follows:

Claims 36-52 stand rejected under 35 U.S.C. § 112 (first paragraph) as failing to comply with the written description requirement.

Claims 1-8, 10-12, 15-18, 20, 21, 23-25, 28-31, and 33 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Chester.

Claims 20 and 23-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cory in view of Chester.

Claims 13, 14, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chester in view of Griffith.

Claim 1 is representative of the claims under appeal and reads as follows:

A nerve stimulation needle comprising:

- a hand graspable hub;
- a needle operably coupled to the hand graspable hub;

² The amendment rewrote claim 32 into independent form.

- a remote peripheral nerve stimulator;
- an electrical tether to operably electrically couple the needle to the remote peripheral nerve stimulator; and
- a needle functionality indicia disposed proximal the hand graspable hub.

The prior art relied upon by the examiner in rejecting the claims on appeal is:

Chester et al. (Chester)	4,515,168	May 7, 1985
Griffith	6,325,764	Dec. 4, 2001
Cory et al. (Cory)	6,706,016	Mar. 16, 2004 (filed Nov. 21, 2001)

With regard to the rejection of claims 36-52 under 35 U.S.C. § 112 (first paragraph) the Examiner contends (Answer 4) that the specification discloses embodiments in Figs. 1, 4, and 5 which have a remote stimulator and a needle and a hub having a display. The Examiner adds that the embodiment in Fig. 6 shows a remote stimulator, a remote nerve stimulator operational status display, but does not disclose a needle with a hub that has a display. Applicants contend (Br. 5 and 6) that the embodiment of figure 6 presents a display that is remote from the needle and its hub. Applicants argue that the details of the hub are defined in Fig. 2, which clearly presents the hub as having at least one and possibly a plurality of displays 24.

With regard to the rejection of claims 1-8, 10-12, 15-18, 20, 21, 23-25,

28-31 and 33 under 35 U.S.C. § 102(b) as being anticipated by Chester, Applicants contend (Br. 8 and 9) that Chester's all-in-one apparatus has no remotely located components and that the nerve stimulator in Chester is remote from the needle since the nerve stimulator is located on the syringe and not on the needle. Additionally, Applicants contend that the claim requires the needle functionality indicia be proximate to the hub, and that if the nerve stimulator is remote with respect to the needle, then the indicia, which is disposed on the nerve stimulator cannot be proximal to the hub. The Examiner contends (Answer 9 and 10) that the term "remote" in claim 1 does not have a reference point and that "remote" can be interpreted as being "remote" from the nerve stimulation needle as a whole or any portion of the needle. In the Reply Brief (page 9), Applicants respond that the term "remote" is not bereft of a reference point and that "remote" refers to being remote from the preceding claim elements; i.e., the hand graspable hub and the needle operatively coupled to the hand graspable hub.

With regard to the rejection of claims 20 and 23-28 under 35 U.S.C. § 103(a) as being unpatentable over Cory in view of Chester, the Examiner contends that Cory fails to disclose the visual indicator being rigidly coupled to the needle. To overcome this deficiency of Cory, the Examiner (Answer 7) turns to Chester for a suggestion of a visual indicator rigidly coupled to the needle, and maintains (*id.*) that it would have been obvious to provide Corey with a rigid coupling. Applicants contend (Br. 13) that Cory teaches keeping nerve stimulator/display remote from the needle and that Chester keeps the nerve stimulator/display in rigid combination with the needle. Specifically, Applicants contend (Br. 13 and 14) that both these references teach that the visual indicator comprises an integral part of the nerve stimulator itself. In the Reply Brief (page 12) Applicants add that

these references, in combination, only yield either a non-remote nerve stimulator that is rigidly coupled to the needle, or a remote nerve stimulator having a display that is not rigidly coupled to the needle.

With regard to the rejection of claims 13, 14, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Chester in view of Griffin, the Examiner contends (Answer 8) that although Chester fails to teach that the LED 28 is a multicolored LED or multicolor display, that Griffith teaches that it was known to utilize a multi-color LED or display with a nerve stimulator. Applicants contend (Br. 15 and 16) that Griffith's color display has nothing to do with the level of current provided, but rather correlates to differing amounts of electrical charge.

We affirm-in-part.

ISSUES

- I. With regard to the rejection of claims 36-52 under 35 U.S.C. § 112 (first paragraph) the issue is whether Applicants were in possession of the claimed invention as of the filing date of the application.
- II. With regard to the rejection of claims 1-8, 10-12, 15-18, 20, 21, 23-25, 28-31, and 33 the issue is whether Applicants have shown that the Examiner erred in rejecting these claims under 35 U.S.C. § 102(b). The issue turns on whether the visual indicator (display) of Chester can be considered to be both remote from the nerve stimulator and proximate to the needle.
- III. With regard to the rejection of claims 20 and 23-28 under 35 U.S.C. § 103(a) the issue is whether the Examiner erred in holding that the combined teachings and suggestions of Cory and Chester would have

suggested to an artisan the language of these claims. The issue turns on whether it would have been obvious to have rigidly coupled the visual indicator of Cory to the nerve block needle, in view of the teachings and suggestions of Chester.

- IV. With regard to claims 13, 14, and 19 under 35 U.S.C. § 103(a) the issue is whether the Examiner erred in holding that the combined teachings of Chester and Griffith would have suggested to an artisan the language of these claims. The issue turns on whether Griffith's description of using a multicolored display to indicate electric charge would have suggested to an artisan using a multicolored display indicative of a current level.

FINDINGS OF FACT (ISSUE I)

1. FIG. 1 comprises a system block diagram as configured in accordance with various embodiments of the invention (Specification 3).
2. FIG. 2 comprises a block diagram of a needle hub as configured in accordance with an embodiment of the invention (Specification 3).
3. FIG. 6 comprises a system block diagram as configured in accordance with yet another embodiment of the invention (Specification 4).
4. In some embodiments, the display is separate (or separable) from both the nerve stimulator and the nerve stimulator needle (Specification 4).
5. The logic unit ... causes the information to be displayed by the display 24 (or displays where more than one display is provided (Specification 6)).

6. In the various embodiments described above, the display comprises an integral part of the nerve stimulator needle. In other embodiments, however, the display may be separate from the nerve stimulator needle and also remote from the nerve stimulator 10 (Specification 7).

We additionally make the following Findings Of Fact from the drawings:

7. The embodiment of Fig. 1 shows the nerve stimulator apparatus to include hand-graspable hub 11, having display 14 and optional multi-position switch 15.

8. Fig. 2 shows hub 11 to include a display or displays 24.

9. Figure 6 shows an alternate embodiment that includes hub 11, but does not illustrate hub 11 to have an indicator or optional switch 15.

PRINCIPLES OF LAW

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).

ANALYSIS (ISSUE I)

From Fact 1 we find that the system including hub 11 is described as being in accordance with various embodiments of the invention, which we consider to be more than the embodiment of Fig. 1. From Fact 2 we find that the hub described in Fig. 2 is in accordance with an embodiment of the invention, not all embodiments. From Fact 3 we find that Fig. 6 is directed to another embodiment of the invention. From Fact 4 we find that in some embodiments the display is separate or separable from both the stimulator and the needle. From the disclosure of the display being separate or separable from "both" the stimulator and the needle, we find that in some embodiments the display is separate from both the stimulator and the needle. From Fact 6 we find that the "displays" refers to the plural displays on the hub 11, as shown in Fig. 4. From review of the record, we find that the originally filed disclosure describes embodiments where the display is on the hub or where the display is separate from the needle and the stimulator. However, we find no description of an embodiment where displays are both remote from the nerve stimulator and rigidly coupled to the nerve stimulator needle. Accordingly, from all of the above, we agree with the Examiner for the reasons advanced in then

Answer, as amplified by our comments, *supra*, that Applicant were not in possession of the invention of claim 36 at the time of filing of the application.

CONCLUSIONS OF LAW (ISSUE I)

The rejection of claims 36-52 under 35 U.S.C. § 112 (first paragraph) is sustained.

FINDINGS OF FACT (ISSUE II)

We make the following findings of fact with respect to Chester:

1. The broad object of the invention is to provide a nerve stimulator which can, in its entirety, be clamped onto a conventional syringe which is connected to an injection needle (Col. 1, lines 59-63).

2. The nerve stimulator of

unit **10** is clamped to, and supported by, a conventional syringe **12** which is connected to the metal hub **14** of an injection needle **16**. The stimulator **10** is clamped to the syringe **12** by means of a spring clip **18** which is fixed to the bottom of the stimulator housing. Electrical pulses from the stimulator are applied via an external lead **20** and a connector **22** to the metal hub **14** of the needle **16** (Col. 2, lines 52-59). (Emphasis in original).

It is further disclosed that the needle has a tip 17. (Col. 2, lines 53-59 and 63).

3. An indicator lamp 28, such as an LED, is also positioned on the top of the unit (Col. 3, lines 21 and 22).

PRINCIPLES OF LAW (ISSUE II)

It is well settled that if a prior art device inherently possesses the capability of functioning in the manner claimed; anticipation exists whether there was recognition that it could be used to perform the claimed function. *See, e.g., In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

ANALYSIS (ISSUE II)

Before addressing the Examiner's rejection, it is an essential prerequisite that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. Accordingly, we will initially direct our attention to Applicants' claim 1 to derive an understanding of the scope and content thereof.

From our review of the claim, we find that the language "a remote peripheral nerve stimulator" does not specifically recite what the stimulator is remote from. We are not persuaded by Applicants' assertion that the stimulator is remote from the previously recited elements in the claim because the claim uses the transitional phrase "comprising" which is open ended. As broadly drafted, the claim scope can be construed as the needle stimulator being remote from the needle or from the hub, or both. No convincing reason has been proffered by Applicants as to why the claim should be limited in scope to have the remote stimulator be remote from both the hub and the needle. While the claim may be reasonably interpreted as

advanced by Applicants, it can also be reasonably interpreted as advanced by the Examiner, as amplified by our comments, *infra*. Because claims are to be interpreted during patent prosecution as broadly as they can reasonably be interpreted consistent with the specification, we select the examiner's interpretation as the correct interpretation of the claim. In prosecution before the USPTO, there is no reason why Applicants cannot amend the claims to clarify that the stimulator is remote from both the hub and the needle assembly.

Turning to Fig. 1 of Chester, we find from fact 2 that the tip 17 of the needle 16 is remote from nerve stimulator 10 and that the indicator 28 is proximate to the hub 12, 14, as advanced by the Examiner (Answer 10). Accordingly, based upon our claim construction of claim 1, we find that the visual indicator 28 of Chester is proximate to hub 12, 14 but is remote from the tip 17 of needle 16. Thus, we are not convinced of any error on the part of the Examiner in rejecting claim 1, or claims 2-8, 10-12, and 15-18, which depend therefrom, under 35 U.S.C. § 102(b) as being anticipated by Chester.

We turn next to independent claim 20. We will sustain the rejection of claim 20 based on our interpretation, *supra*, of the term "remote" as found in claim 1. In addition, we note that claim 20 requires that the visual indicator is rigidly connected to the nerve block needle, which is met by indicator 28, 60 being rigidly coupled via 12 and 14 to the needle as advanced by the Examiner (Answer 5). Accordingly, we are not convinced of any error on the part of the Examiner in rejecting claim 20, or claims 21, 23-25, and 28 which depend therefrom, under 35 U.S.C. § 102(b) as being anticipated by Chester.

We turn next to independent claim 29. This rejection has not been separately argued by Applicants in either the Brief or the Reply Brief.

Accordingly, claim 29, and claims 30, 31, and 33 which depend therefrom, fall with the remainder of the claims of the group.

CONCLUSION OF LAW (ISSUE II)

The rejection of claims 1-8, 10-12, 15-18, 20, 21, 23-25, 28-31, and 33 under 35 U.S.C. § 102(b) is sustained.

FINDING OF FACTS (ISSUE III)

1. As found by the Examiner (Answer, page 7) Cory shows a nerve block needle 107 comprising a remote nerve stimulator 131, electrical coupling 122, 126, 142 to the nerve stimulator 131, and a visual indicator 141 (Fig. 2).
2. Cory additionally discloses (col. 2, lines 14-23) that
U.S. Patent No. 4,515,168 to Chester et al. discloses to clamp a nerve stimulator and locating device onto a syringe. As the entire nerve stimulator device is clamped onto the syringe, the unit is a long and clumsy assembly, which is difficult to maneuver. Moreover, the device disclosed by Chester does not allow for one-handed operation of needle advancement and current control. Particularly, the needle is advanced by one hand while the current must be controlled by turning the knob 27 with the other hand, which is an extremely awkward operation for the user.
3. We make reference to our findings, *supra*, with respect to the teachings of Chester.

PRINCIPLES OF LAW (ISSUE III)

On appeal, Applicant bears the burden of showing that the Examiner has not established a legally sufficient basis for combining the teachings of Cory and Chester. Applicants may sustain that burden by showing that where the Examiner relies on a combination of disclosures, the Examiner failed to provide sufficient evidence to show that one having ordinary skill in the art would have done what Applicants did. *United States v. Adams*, 383 U.S. 39 (1966); *In re Kahn*, 441 F.3d 977, 987-988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick, Co.*, 464 F.3d 1356, 1360-1361, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006). The mere fact that all the claimed elements of steps appear in the prior art is not *per se* sufficient to establish that it would have been obvious to combine those elements. *United States v. Adams, supra*; *Smith Industries Medical systems, Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1420 (Fed. Cir. 1999).

ANALYSIS (ISSUE III)

We find from Fact 2 that Cory specifically refers to the Chester patent by noting that in Chester, the stimulator is clamped onto the syringe and that two hands are required to operate the device of Chester. Cory asserts that as a result of this construction, the assembly is long and clumsy, and is extremely awkward to operate. From this disclosure of Cory, we find that Cory specifically teaches away from replacing the electrical cables 122, 126, and 1142 with a rigid connection as in Chester at 20, so as to have the visual indicator rigidly coupled to the nerve block needle. As to the specific question of "teaching away," our reviewing court in *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994) stated:

A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.

It follows that an artisan would not have been motivated to modify Cory in view of the teachings and suggestions of Chester as advanced by the Examiner.

Accordingly, we find that the Examiner has failed to establish a prima facie case of obviousness of claims 20 and 23-28.

CONCLUSIONS OF LAW (ISSUE III)

The rejection of claims 20 and 23-28 under 35 U.S.C. § 103(a) is not sustained.

FINDINGS OF FACT (ISSUE IV)

1. We make reference to our findings, *supra*, with respect to the teachings of Chester.
2. Griffith is directed to an apparatus for efficiently locating a nerve and for subsequently delivering an anesthetic to the nerve (Col. 1, lines 13-15).
3. As correctly noted by the Examiner (Answer, page 8) Griffith discloses that it is known to utilize a multi-color LED or display with a nerve stimulator (Col. 12, lines 12-19).
4. The multi-color LED of Griffith identifies the operating mode (Col. 12, lines 19 and 20 and col. 13, lines 4-34).

5. Chester discloses that visual indicator 28 may be an LED which provides a visual indication to the physician each time a current pulse is applied to the patient (Col. 3, lines 18-24).
6. Chester further discloses that “[s]till another object of the invention is to provide such an improved clamp-on nerve stimulator/locator which contain means for digitally reading out the amount of current or voltage being applied to the patient” (Col. 2, lines 7-10).

ANALYSIS (ISSUE IV)

We note at the outset that Applicants have only presented arguments with respect to claim 13. Accordingly, we select claim 13 as representative of the group. From the disclosure of Chester of having an LED indicator that provides a visual indication of a current pulse (Fact 4), and the disclosure of Griffith that a multi-color LED can be used as the visual indicator in a nerve stimulator to identify operating mode, we agree with the Examiner (Answer 8) that an artisan would have been motivated to replace the single color LED of Chester with a multi-color LED as taught by Griffith.

We are not persuaded by Applicants' contention that the modification would not have been obvious because Griffith uses different colors to correlate to different amounts of electrical charge because Griffith is not relied upon for a teaching of providing multi-color LEDs for indicating current pulses. Chester teaches using an LED to indicate current pulses. In addition, from Fact 6 we find a disclosure in Chester that the amount of current applied to a patient can vary. Accordingly, we additionally find from this description in Chester and

the teachings of Griffith that an artisan would additionally have been motivated to provide different colors to indicate different current levels being applied to the patient.

CONCLUSIONS OF LAW (ISSUE IV)

The rejection of claims 13, 14, and 19 under 35 U.S.C. § 103(a) is sustained.

DECISION

The decision of the Examiner to reject claims 36-52 under 35 U.S.C. § 112 (first paragraph) is affirmed. The decision of the Examiner to reject claims 1-8, 10-12, 15-18, 20, 21, 23-25, 28-31, and 33 under 35 U.S.C. § 102(b) is affirmed. The decision of the Examiner to reject claims 20 and 23-28 under 35 U.S.C. § 103(a) is reversed. The decision of the Examiner to reject claims 13, 14, and 19 under 35 U.S.C. § 103(a) is affirmed. The decision of the Examiner to reject claim 35 under 35 U.S.C. § 103(a) is affirmed.

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

AFFIRMED-IN-PART

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