

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte LOUIS A. CAMPBELL and ROBERT M. CASANOVA

Appeal 2007-2558
Application 10/205,948
Technology Center 3700

Decided: August 7, 2007

Before DONALD E. ADAMS, ERIC GRIMES, and RICHARD M.
LEBOVITZ, *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-12.
We have jurisdiction of this appeal under 35 U.S.C. 6(b). We affirm.

STATEMENT OF CASE

Claims 1-12, which are all the pending claims, are rejected over prior art. The Examiner relies on the following evidence of unpatentability:

Knoepfler	US 5,217,460	Jun. 8, 1993
Hoogeboom	US 5,752,972	May 19, 1998

There are two rejections at issue in this appeal:

- 1) Claims 1 and 7-12 stand rejected under 35 U.S.C. § 102(b) as anticipated by Knoepfler (Answer 3).
- 2) Claims 1-12 stand rejected under 35 U.S.C. § 102(b) as anticipated by Hoogeboom (Answer 5).

Claims 1, 5, 7, and 8 are separately argued. We reproduce claims 1, 5 (and claim 3 on which claim 5 depends), 7, and 8 as follows:

1. An apparatus for holding an annuloplasty ring, comprising:
 - a fixed jaw member having a base and either a peripheral edge spaced radially outward from the base or a plurality of fingers extending radially outward from the base;
 - a movable jaw member having a clamping end and being movable relative to said peripheral edge or said plurality of fingers of said fixed jaw member for clamping an annuloplasty ring in compression for implantation in a heart valve annulus; and
 - a coupling means for operably connecting the fixed and movable jaw members to provide releasable compression clamping for holding the annuloplasty ring.
3. The apparatus of claim 1, further comprising a handle selectively coupled with the fixed jaw member.
5. The apparatus of claim 3, wherein the handle is radially aligned with said fixed jaw member.
7. The apparatus of claim 1, wherein the fixed jaw member includes the base and the peripheral edge spaced radially outward from the base.
8. The apparatus of claim 1, wherein the fixed jaw member includes the base and the plurality of fingers extending radially outward from the base.

CLAIM INTERPRETATION

Claim 1 is directed to an apparatus for holding an annuloplasty ring. The apparatus comprises a fixed jaw member, a movable jaw member, and “a coupling means for operably connecting the fixed and movable jaw members to provide releasable compression clamping.”

The preamble of claim 1 recites that the apparatus is “for holding an annuloplasty ring.” Preamble language that merely states the purpose or intended use of an invention is generally not treated as limiting the scope of the claim. *Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 952, 78 USPQ2d 1267, 1273 (Fed. Cir. 2006); *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345, 65 USPQ2d 1961, 1964 (Fed. Cir. 2003). “However, the preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim.” *Bicon*, 441 F.3d at 952, 78 USPQ2d at 1273.

Here, the claim body recites that “the fixed and movable jaw members” are connected by a “coupling means” which provides for “releasable compression clamping for holding the annuloplasty ring.” Thus, the “coupling means” is the structure which enables the apparatus to achieve “compression clamping” and to hold the annuloplasty ring. The preamble language that the apparatus is for “holding an annuloplasty ring” does not itself confer a definite or further structural limitation to the apparatus; it is an intended use of the claimed apparatus. For this reason, we do not interpret the phrase “holding an annuloplasty ring” to limit the scope of the claim.

The fixed jaw member in claim 1 has “either a peripheral edge spaced radially outward from the base or a plurality of fingers extending radially outward from the base.” During patent prosecution, the words in a claim are

given their broadest reasonable interpretation as they would be understood by persons of skill in the art in the context of the specification. *See In re American Academy of Science Tech Center*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004). The term “radially” is defined as “arranged like radii or rays. . . . [;] made or moving in the direction of a radius; going from the center outward or from the circumference inward along a radius.”¹ Thus, we interpret “spaced radially” to indicate that the “peripheral edge” or “plurality of fingers” are arranged on a radius which extends from the base. In other words, they are positioned “around” the base like rays.

The phrase “peripheral edge” is defined as “external boundary.”² The peripheral edge is part of the fixed jaw member (“a fixed jaw member having . . . a peripheral edge”). Thus, the peripheral edge is the outer boundary of the fixed jaw member.

The peripheral edge and the plurality fingers are “spaced” or “extending” from the “base” of the jaw. A “base” is the “bottom support”³ Thus, we interpret the base to be any structure which supports the peripheral edge or plurality of fingers.

FINDINGS OF FACT

Knoepfler

1. Knoepfler describes a multi-purpose medical forceps (Knoepfler, Abstract).

¹ *The Random House College Dictionary* 1088 (1982).

² *Id.* at 988.

³ *Id.* at 111.

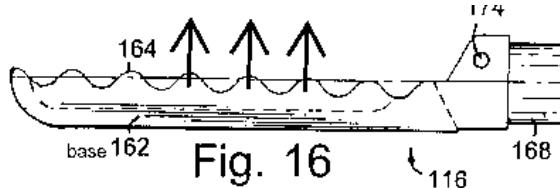
2. As shown in Fig. 1, the forceps comprise an elongate housing 6 having a jaw pair 7 (Knoepfler, col. 2, ll. 59-61) and a handle 5 in the form of a pistol grip (Knoepfler, col. 2, ll. 64-65).
3. The jaw pair 7 is comprised of a fixed jaw element 40 and a movable or pivotable jaw element 41 (Knoepfler, col. 3, ll. 54-58; Fig. 2).
4. “Jaw 41 is connected to a forward end 35 of the housing 6 by a pin 42. Jaw 41 is thereby operable to pivot or move relative to Jaw 40” (Knoepfler, col. 3, ll. 61-62, Figs. 2-3).
5. “The fixed jaw 40 further includes three teeth 50, 51 and 52 which are cooperable with two teeth 53 and 54 in the rotating jaw 41 for grasping tissue and the like” (Knoepfler, col. 4, ll. 18-20, Fig. 3).
6. The fixed jaw 40 and movable jaw 41 described by Knoepfler meet the limitation of a “fixed jaw member” and a “movable jaw member having a clamping end” as recited in claim 1 (Knoepfler, col. 2, ll. 60-61, col. 3, ll. 54-58, Fig. 2; Answer 3-4).
7. The fix jaw 40 is attached to a pistol grip which serves as a base for the jaw pair, satisfying the claimed limitation of “a fixed jaw member having a base” (Knoepfler, col. 2, ll. 64-65, Fig. 1).
8. The fixed jaw member has three teeth (50, 51, and 52) on the outer edge of the jaw member (Knoepfler, col. 4, ll. 18-20, Fig. 3), each of which can be described as being on a radial arm extending from the base (*see* Answer 8). This arrangement satisfies the limitation in claim 1 of “either a peripheral edge spaced radially outward from the base or a plurality of fingers extending radially outward from the base” (Answer 4).
9. Jaw 41 pivots with respect to jaw 40, enabling the pair to grasp tissue (Knoepfler, col. 3, ll. 61-62, col. 4, ll. 18-20, and Fig. 2). Thus, Knoepfler’s

forceps has “a coupling means for operably connecting the fixed and movable jaw members . . . to provide releasable compression clamping” as in claim 1 (Answer 3-4).

Hoogeboom

10. Hoogeboom describes a surgical instrument having a handle, an end effector, and tubular sleeve extending between the handle and an end effector (Hoogeboom, Abstract, col. 5, ll. 4-7, and Fig. 11).
11. As shown in Figs. 16 and 18, the end effector comprises a “stationary end effector 116” and a “pivotally movable end effector 114” (Hoogeboom, col. 5, ll. 59-67; Answer 5).
12. The stationary end effector 116 includes undulating or toothed edges 164 (Hoogeboom, col. 5, ll. 64-65 and Fig. 16) on base 162.
13. The movable effector 114 also has undulating or toothed edges (Hoogeboom, col. 5, ll. 65-67).
14. The stationary end and movable end are pivotally connected which enable the ends to come together and grip tissue (Hoogeboom, col. 6, ll. 16-34, 6-7).
15. The stationary end effector 116 and the pivotally movable end effector 114 satisfy the limitation of claim 1 of a “fixed jaw member” and a “movable jaw member having a clamping end” as recited in claim 1 (Hoogeboom, col. 5, ll. 59-67; Answer 5).
16. The stationary end effector comprises undulating or toothed edges 164 which are supported by a base 162 (Hoogeboom, col. 5, ll. 64-65 and Fig. 16; Answer 5) and thus meets the limitation in claim 1 of a “a fixed jaw member having a base” (Answer 5, 9).

17. Each of the undulating or toothed edges is on the outer boundary of the jaw member and extends radially outward from the base 162 (Hoogeboom, Fig. 16; Answer 5) as required by claim 1. Fig. 16 of Hoogeboom, showing the radial outward extension of the jaw member, is reproduced below:



Arrows have been added to reproduced Fig. 16 of Hoogeboom, as depicted above, to show the peripheral edge or fingers which extend “radially outward from the base.”

18. The stationary and movable effector ends are connected by a pivot (Hoogeboom, col. 6, ll. 16-34) which is “a coupling means for operably connecting” the effector ends as recited in claim 1.

DISCUSSION

Anticipation over Knoepfler

Claims 1 and 7-12 stand rejected under 35 U.S.C. § 102(b) as anticipated by Knoepfler (Answer 3).

Anticipation under 35 U.S.C. § 102 requires that “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). We agree with the Examiner (FF (“Findings of Fact”) 6-9) that Knoepfler teaches every element recited in claims 1, 7, and 8, anticipating the claimed invention.

Appellants contend that “Figs. 2-3 show the ‘peripheral edge spaced radially outward’ is circumferential or perimetric, which is clearly not true for the edge of the fixed member of Knoepfler” (Br. 4). They argue that the term “peripheral” means “‘constituting an outer boundary or periphery’” (Br. 5). “[T]his meaning is the only one compatible with the invention as shown in Figs. 2-3. Therefore, Applicants submit the skilled [worker] would find the use of ‘peripheral’ in the present claims to be clear and distinct over Knoepfler” (Br. 5).

We do not find this argument persuasive. As pointed out by the Examiner, the terms “circumferential” and “perimetric” are not recited in the claims (Answer 6-7). Relying on the same definition of “peripheral” adopted by Appellants, the Examiner found, and we agree, that the teeth 50-52 described by Knoepfler are located on the *outer* edge of the jaw (Knoepfler, col. 4, ll. 18-20, Fig. 3; FF 8; Answer 8), thus satisfying the limitation in claims 1 and 7 of a “peripheral edge.” To the extent that Figs. 2 and 3 of the Specification show an arrangement that is different from

Knoepfler,⁴ we are in complete agreement with the Examiner that limitations from the Specification are not read into the claims (Answer 6-7). (*See Sjolund v. Musland*, 847 F.2d 1573, 1581, 6 USPQ2d 2020, 2027 (Fed. Cir. 1988) (“[W]hile it is true that claims are to be interpreted in light of the specification and with a view to ascertaining the invention, it does not follow that limitations from the specification may be read into the claims.”); *see also In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (“[L]imitations are not to be read into the claims from the specification.”).) Appellants have not identified any disclosure in the Specification inconsistent with our interpretation of the claim.

Appellants also contend that the “teeth of the clamping edges of Knoepfler extend orthogonally from the edge, rather than radially from the base” as recited in claims 1 and 8. We have interpreted the phrase “radially outward from the base” to mean that the teeth are arranged around the base

⁴ Although Appellants argue that Figs. 2 and 3 show a peripheral edge that is “clear and distinct” over Knoepfler (Br. 5), they do not explain or describe how the peripheral edges illustrated in Figs. 2 and 3 of the Specification differ from the teeth described by Knoepfler. In fact, they look the same because in profile, as depicted in Figs. 2 of the Specification and Knoepfler reproduced below, each is L-shaped.

Fig. 2 of Specification:



Fig. 2 of Knoepfler:

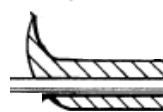


Fig. 2 of the Specification shows the edge pointed upward; Fig. 2 of Knoepfler shows the edge (“tooth”) pointed upward.

on a radius or ray. Fig. 2 of Knoepfler shows the housing 6 which extends like a radius from the base; the plurality of fingers are located at the end of the radius and thus extend radially outward from it as recited in claim 1 (Knoepfler, col. 2, ll. 59-61, 64-65, col. 4, ll. 18-20, and Fig. 3; FF 2, 5, and 8). Appellants have not specifically articulated what differs between the claimed “plurality of fingers” and the teeth shown in Knoepfler’s medical forceps. *See also supra* fn. 4.

For the foregoing reasons, we affirm the rejections of claims 1, 7, and 8. Claims 9-12 fall with claims 1, 7, and 8 because they were not separately argued.

Anticipation over Hoogeboom

Claims 1-12 stand rejected under 35 U.S.C. § 102(b) as anticipated by Hoogeboom (Answer 5).

Anticipation under 35 U.S.C. § 102 requires that “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). We agree with the Examiner (*see FF 15-18*) that Hoogeboom teaches every element recited in claim 1, anticipating the claimed invention.

Appellants contend “[s]imilarly to Knoepfler, if the handle of Hoogeboom is considered to be a base, the end effector is a single edge point and the tubular sleeve/mobile member pair is a single finger” (Br. 6).

We do not find this argument persuasive for several reasons. As argued by the Examiner, Hoogeboom’s base 162 supporting the toothed edges is treated as the part corresponding to the base of claim 1 (Answer 9;

FF 16, 17). Thus, Appellants' argument does not address the rejection as set forth by the Examiner. Moreover, even if we were to interpret the handle as a base, the toothed edge is positioned at the end of the tubular handle which extends outwardly and radially from the handle base; thus, the toothed edge is in fact extending radially outward from either the base 162 (where each toothed edge occupies a different radial position) or the handle shown in Fig. 11 (where the edges are located at the end of the radial arm).

With respect to claim 5, Appellants contend that "it further recites a handle radially aligned with the fixed member of the ring holder. Although this embodiment may have a somewhat greater resemblance to the instrument of Hoogeboom, it still recites the "peripheral edge" limitation or the "plurality of fingers" limitation of claim 1" (Br. 6). We agree with Examiner's finding that Hoogeboom describes a handle that is axially and radially aligned with the fixed jaw member as shown in Fig. 12 (Answer 5). Appellants have not identified a defect in this reasoning and we find none.

With respect to claims 7 and 8 reciting "peripheral edge" and "plurality of fingers," Appellants have not identified any defect in the Examiner's findings (Answer 5; FF 17) that Hoogeboom describes these elements, and we also find none.

For the foregoing reasons, we affirm the rejection of claims 1, 5, 7, and 8. Claims 2-4, 6, and 9-12 fall with them because separate reasons for their patentability were not provided.

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TIME PERIOD

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)(2006).

AFFIRMED

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