

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HOWARD L. SHACKELFORD, SR.

Appeal 2008-4770
Application 10/920,084
Technology Center 3700

Decided: December 18, 2008

Before TONI R. SCHEINER, LORA M. GREEN, 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, 2, 11, 12, 14-16, and 18-21. Jurisdiction is under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

The claims are directed to a jacket for a scalpel. According to the Specification, the “use of disposable scalpels is increasing in many hospitals. The disposable scalpel is, typically, made from plastic, which forms a body having a channel portion and often having a handle portion” (Spec. 1: 9-11). “A blade is disposed on a slider in the channel portion” (*id.* at 1: 11-12).

The disadvantage to such scalpels is that disposable scalpels lack heft. That is, traditional metal scalpels, which were typically made from stainless steel, had a certain weight and balance. Physicians who have been trained with traditional metal scalpels tend to dislike the lighter disposable scalpels. Additionally, even users who have been trained using disposable scalpels prefer a scalpel with more heft as such scalpels provide, in a subjective sense, more control and feedback.

(*Id.* at 1: 17-22.) “There is, therefore, a need for a jacket structured to be coupled to a disposable scalpel and structured to add heft” (*id.* at 1: 30-31). The Specification describes a jacket for a disposable scalpel (*id.* at 2: 7-8).

The Examiner finally rejects claims 1, 2, 11, 12, 14-16, and 18-21, which are all the pending claims, under 35 U.S.C. § 102(b) as anticipated by Cohn (US 5,941,892, Aug. 24, 1999) (Ans. 3). We select claims 1 and 20 as representative of the appeal subject matter. Claims 1 and 20 read as follows:

1. A jacket for a scalpel, said scalpel having an elongated body with a base wall and two sidewalls forming a scalpel channel, and a blade assembly having a blade coupled to a slider, said slider structured to move said blade between a first, retracted position and second, extended position, said jacket comprising:
 - a body having an elongated base wall and two sidewalls;
 - each sidewall extending generally perpendicular to said jacket base wall, thereby defining a jacket channel;

said jacket sidewalls spaced apart a sufficient distance so that said scalpel may be disposed between said jacket sidewalls; and

a trap structured to hold said scalpel in said jacket channel.

20. A scalpel assembly comprising:

a scalpel having an elongated body with a base wall and two sidewalls forming a scalpel channel, a blade assembly having a blade coupled to a slider, said slider structured to move said blade between a first, retracted position and second, extended position, and a handle portion;

said scalpel handle portion having a scalpel trap portion;

a jacket having a body with an elongated base wall and two sidewalls, each sidewall extending generally perpendicular to said jacket base wall, thereby defining a jacket channel, said jacket sidewalls spaced apart a sufficient distance so that said scalpel may be disposed between said jacket sidewalls, and a handle portion;

said jacket handle portion having a jacket trap portion;

and

said scalpel trap portion structured to engage said jacket trap portion to secure said scalpel in said jacket.

ISSUE ON APPEAL

Does Cohn describe a jacket for a scalpel and a scalpel that meets the limitations of claims 1 and 20?

PRINCIPLES OF LAW

During examination, “claims ... are to be given their broadest reasonable interpretation consistent with the specification, and ... claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Bond*, 910 F.2d 831, 833 (Fed.Cir.1990); *accord Bass*, 314 F.3d at 577 (“[T]he PTO must apply the broadest reasonable meaning to the claim language, taking into

account any definitions presented in the specification.”); *In re Cortright*, 165 F.3d 1353, 1358 (Fed.Cir.1999) (“Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach.”); *Hyatt*, 211 F.3d at 1372. . . . Giving claims their broadest reasonable construction “serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified.” *Yamamoto*, 740 F.2d at 1571; *accord Hyatt*, 211 F.3d at 1372; *In re Zletz*, 893 F.2d 319, 322 (Fed.Cir.1989) (“An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.”).

In re American Academy Of Science Tech Center, 367 F.3d 1359, 1365 (Fed. Cir. 2004).

Terms appearing in a preamble may be deemed limitations of a claim when they “give meaning to the claim and properly define the invention.” *Gerber Garment Technology, Inc. v. Lectra Sys., Inc.*, 916 F.2d 683, 688 (Fed. Cir. 1990) (quoting *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 896 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 857 (1984)).

It is well settled that “[i]f the body of the claim sets out the complete invention, and the preamble is not necessary to give ‘life, meaning and vitality’ to the claim, ‘then the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation.’” *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1373-74, . . . (Fed.Cir.2001) (quoting *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 . . . (Fed. Cir. 1999)).

Schumer v. Lab. Computer Sys., Inc., 308 F.3d 1304, 1310 (Fed. Cir. 2002).

Preamble language that merely states the purpose or intended use of an invention is generally not treated as limiting the scope of the claim. *See Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d

1339, 1345 (Fed. Cir. 2003); *Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997).

Anticipation requires that 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 (Fed. Cir. 2001).

CLAIM INTERPRETATION

The dispute in this rejection involves the proper interpretation of the term “scalpel” as recited in claims 1 and 20. Appellant contends that a “scalpel” would be understood by persons of skill in the art “to be a very precise tool having a handle and a blade coupled together in an exact relationship. That is, a scalpel blade cannot be loosely attached to the handle” (Shackelford, Jr. Aff. ¶ 4). The Examiner rejects this interpretation as too narrow (Ans. 5), construing it more broadly to read on a scalpel blade with a handle portion, irrespective of how they are coupled (Ans. 4: 12-13).

During patent examination, claims must be given their broadest reasonable interpretation in light of the specification as they would be understood by persons of ordinary skill in the art. *In re American Academy of Science Tech Center*, 367 F.3d at 1365. As explained in *Zletz*: “An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.” *In re Zletz*, 893 F.2d at 322.

The term “scalpel” is not explicitly defined in the Specification. However, the Specification states a “disposable scalpel is, typically, made from plastic, which forms a body having a channel portion and often having

a handle portion” (Spec. 1: 9-11). The disposable scalpels are for use in hospitals by physicians for surgical procedures (*id.* at 1: 9, 19-20, 26-27; at 8: 20-21). A disposable scalpel is described in the Specification as having a “slider” in the channel for moving the blade into different positions (*id.* at 1: 11-14). In the description of its own embodiments, the Specification states that the “scalpel . . . generally includes an elongated body . . . and a blade assembly” (*id.* at 3: 24). In sum, the Specification characterizes a scalpel as having an elongated body and handle, and typically a slider for moving the blade.

Appellant’s interpretation of the term “scalpel” is not its broadest reasonable interpretation for the purposes of patent examination. The Specification does not define it, as does Appellant, to require an “exact relationship” between the blade and handle that would exclude these parts from “loosely” fitting together. There are also no terms in the claim that would require persons of ordinary skill in the art to read the term “scalpel” so narrowly.

While we acknowledge the affidavit of Dr. Shackelford, Jr. stating that persons of skill in the art would understand the term “scalpel” to have a precise meaning, we do not agree that this is the only reasonable interpretation possible. The Specification does not describe the claimed scalpel in such a way that would exclude a loose fitting between the blade and handle. Nor does the Specification restrict the claimed scalpel to a particular use or procedure that would require such arrangement. For these reasons, we decline to read the term “scalpel” as recited in the claims to have the narrow meaning proffered by Appellant’s in this appeal.

FINDINGS OF FACT

The Cohn patent

Figure 34

1. Cohn describes a scalpel having a handle **512** and a shield **526** (Cohn, Figs. 34-38).
2. The shield **526** releasably retains blade cartridge **524** comprising a slidable blade (Cohn, at col. 9, ll. 8-9, 12; Figs. 34-38).
3. The shield **526** has protuberances **540** (Cohn, at col. 9, l. 33).
4. The handle **512** has sidewalls **518** and an upper wall (see handle portion between **512** and distal end **516**) that forms a channel or open cavity **520** (Cohn, at col. 9, ll. 1-6).
5. The handle **512** has openings **522** (Cohn, col. 9, l. 26; Fig. 34).
6. The shield **526** and blade cartridge fit into cavity **520** of handle **512** (Cohn, at col. 9, ll. 6-9, 12-16).
7. The protuberances **540** on shield engage in each of the openings **522** of the handle **512** to engage the shield **526** in the handle cavity **520** (Cohn, at col. 9, ll. 23-35).

Figure 16

8. Cohn describes another embodiment of a scalpel having an elongate handle **412** and a shield **430** (Cohn, at col. 6, ll. 7-23; Fig. 16).
9. The shield **430** is shown in Figure 16 as elongated and terminating in proximal protuberance **432** (Cohn, at col. 6, ll. 15-16), having sidewalls (see walls between **462** and **461**), and a base wall that forms a channel (extending from element **432**).

10. A blade holder **438** has a blade **446** that fits within shield **430** (Cohn, at col. 6, ll. 33-39). The blade holder **438** and shield **430** are also referred to as cartridge **428** (*id.* at col. 6, ll. 12-22).

11. The blade holder can be slid into different positions within the shield (Cohn, at col. 7, ll. 41-42).

12. The handle **412** has “a proximal end **414**, a[n] open distal end **416** and sidewalls **418** that define an upwardly open cavity **420** with a bottom **422** having an open void **424** therein” (Cohn, at col. 6, ll. 7-11: Fig. 16).

13. “Sidewalls **418** each hav[e] an elongate channel **426** therein” (Cohn, at col. 6, ll. 11-12).

14. “Cartridge **428** is releasably retained in cavity **420** by a proximal protuberance **432** on shield **430** that is sized and shaped to engage an inward dimple **434** in at least one, preferably both sidewalls **418** of handle **412**” (Cohn, at col. 6, ll. 15-18).

Claim 1

15. Claim 1 is directed to a *jacket* for a scalpel.

16. The jacket comprises:

17. (1) a body having a base wall, sidewalls, and a jacket channel defined by the base and sidewalls; and

18. (2) “a trap structured to hold said scalpel in said jacket channel.”

19. The claim preamble recites the structure of the scalpel which is intended to fit into the claimed jacket, but the body of the claim does not require the presence of a scalpel.

20. It is not disputed by Appellant that the handle **512** described by Cohn having sidewalls **518** and an upper wall that forms a channel or open cavity

520 (FF4) meets the limitations of claim 1 of a jacket body having sidewalls, a base wall, and jacket channel (FF15-17).

21. It is not disputed by Appellant that the openings **522** of the handle **512**, which engage the protuberances **540** located on the shield **526** (FF4-7), meet the limitation of a claim 1 of a “trap” (FF18).

Claim 20

22. Claim 20 is directed to a scalpel assembly comprising:

23. (1) a scalpel and (2) a jacket which holds the scalpel.

24. The scalpel is recited in the claim to have the following characteristics:

25. • an elongated body with a base wall and two sidewalls forming a scalpel channel;

26. • a blade assembly having a blade and a slide that is structured to move the blade into different positions;

27. • a handle portion; and

28. • a scalpel trap portion.

29. The jacket is recited to have the following characteristics:

30. • an elongated body with a base wall and two sidewalls forming a jacket channel;

31. • a jacket handle:

32. • a jacket trap portion.

33. The scalpel trap portion is “structured to engage said jacket trap portion to secure said scalpel in said jacket.”

34. Cohn describes a cartridge **428** that comprises a shield **430**, blade holder **438**, and a blade **446** that (FF10) that corresponds to the scalpel recited in claim 20 (FF23, 24, 26).

35. The shield **430** has an elongated body and a channel formed by walls (FF8-9) which meet the corresponding limitations of the claimed scalpel (FF25).

36. The shield **430** further comprises a blade holder **438** having blade **446** which can be slid into different positions within the shield, satisfying the requirement of claim 20 of “a blade assembly having a blade coupled to a slider” in which the slider moves the blade into different positions (FF10-11).

37. The shield **430** also has the claimed handle portion (FF27) – an elongated end which terminates in proximal protuberance **432** (FF9).

38. Cohn also teaches a handle **412** which engages the shield **430** – and thus is the same structure as the jacket of claim 20 (FF23, 33).

39. The handle **412** is elongated and has a channel and walls (FF12-13) as does the jacket of claim 20 (FF30).

40. The handle **412** has an inward dimple that engages the protuberance **432** on shield **430** which corresponds to the jacket trap portion and scalpel trap portion, respectively, of the claimed scalpel assembly (FF28, 32, 33).

ANALYSIS

Claim 1

Anticipation requires that 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 at 1383. The Examiner finds (Ans. 3), and we agree, that Cohn describes and depicts a handle **512** with an open cavity **520** and openings **522** (FF1, 4, and 5) which meets all the limitations of the claimed “jacket for a scalpel,” including the “jacket channel” (cavity **520**) and “trap structured to hold” a scalpel

(openings **522**) (FF20-21). We thus conclude that there is sufficient evidence to establish that every element of the claimed “jacket for a scalpel” is found in Cohn, anticipating it.

Appellant contends that Cohn “splits the handle into two components, a reusable handle portion and a disposable shield. Neither of these elements, however, may be coupled to the blade/slider in a manner to form a complete ‘scalpel’” (App. Br. 6).

This argument is not persuasive. As established by the Examiner, the handle **512** described by Cohn and depicted in Figure 34 meets all the structural limitations of the claimed “jacket for a scalpel” (FF20-21; Ans. 3). Appellant has not identified a structure recited in claim 1 which is absent from Cohn’s handle **512**. Appellant’s statement that Cohn’s handle **512** is “split” into a handle and shield (**526**) does not structurally distinguish the claimed jacket from the disclosed handle **512**. The claim language does not exclude additional elements from being present within the jacket, such as the shield **526** described in Cohn (FF1-3). Nor does the claim language require the scalpel to be formed of a single piece.

Appellant also argues that the claim sets forth “a jacket that is structured to be disposed about a disposable scalpel” (Reply Br. 6). The teachings of the prior art “against which patentability is to be measured is not a scalpel handle having a cartridge, but a scalpel handle suitable for use as a jacket in combination with disposable scalpels” (*id.*)

This argument is not convincing. A claim is anticipated when each of its elements is described in the prior art. In this case, claim 1 is directed to a “jacket for a scalpel” having several specific structural limitations which are met by Cohn’s handle **512**. Appellant has not identified a deficiency in

these findings, but rather appears distinguish the claimed scalpel jacket based on its intended use. Preamble language that merely states the purpose or intended use of an invention is generally not treated as limiting the scope of the claim. *See Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d at 1345; *Rowe v. Dror*, 112 F.3d at 478.

The claim further characterizes the scalpel in its preamble as having an elongated body and blade assembly. We agree with Appellant that the terms appearing in a preamble may be deemed limitations of a claim when they “give meaning to the claim and properly define the invention.” *Gerber Garment Technology, Inc. v. Lectra Sys., Inc.*, 916 F.2d at 688. However, in this case, the complete structure of the jacket is set forth in the claim body and satisfied by Cohn’s handle **512**. *See Schumer v. Lab. Computer Sys., Inc.*, 308 F.3d at 1310. Moreover, Cohn’s handle is structured to accommodate a blade assembly as required by the preamble of claim 1 and further comprises a “trap” structure (cavity **520**; FF4, 6, 7), as in claim 1, to engage the blade assembly. In sum, Cohn’s device serves the same function as the claimed “jacket for a scalpel.”

Appellant asserts that the Cohn’s shield **526** and blade cartridge **524** do not form a “scalpel” as required by claim 1. This argument is not persuasive. Claim 1 does not require a scalpel. It is drawn to a scalpel jacket whose intended use is to hold a scalpel.

For the foregoing reasons, we affirm the rejection of claim 1. Claims 2, 11, 12, 14-16, 18, and 19 were not argued separately (App. Br. 10) and thus fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii).

Claim 20

Claim 20 is directed to a scalpel assembly comprising a scalpel and a jacket which holds the scalpel (FF22-23). The Examiner finds that all limitations of the assembly are met by the scalpel described by Cohn and illustrated in Cohn's Figure 16 (Ans. 4). As summarized above (FF22-40), we agree with these findings and conclude that Cohn anticipates the subject matter of claim 20. Thus, we turn to Appellant's rebuttal arguments and evidence.

Appellant contends that cartridge **428** as disclosed by Cohn (*see* FF10) does not meet the limitations of a scalpel as required by claim 20 (App. Br. 8). "The reason the 'cartridge 428' is never identified [by Cohn] as a 'scalpel' is because those skilled in the art would not consider the 'cartridge 428' to be a 'scalpel.'" (*Id.*) According to Appellant, the term "scalpel" would be understood by persons of skill in the art "to be a very precise tool having a handle and a blade coupled together in an exact relationship. That is, a scalpel blade cannot be loosely attached to the handle" (Shackelford, Jr. Aff. ¶ 4). Appellant asserts that the blade/slider described by Cohn would be disposed loosely in the shield and thus would not be considered a scalpel by persons of ordinary skill in the art (App. Br. 7-8). Rather, Appellant contends that all three elements described in Cohn – the shield, blade holder, and handle form a scalpel (*id.*).

As explained above, we decline to read the term "scalpel" as recited in claim 20 to have the narrow meaning proffered by Appellant's in this appeal. The scalpel of claim 20 has

an elongated body with a base wall and two sidewalls forming a scalpel channel, a blade assembly having a blade coupled to a slider, said slider structured to move said blade between a first,

retracted position and second, extended position, and a handle portion; said scalpel handle portion having a scalpel trap portion.

All these elements are met by the cartridge **428** comprising a shield **430** (the “elongated body” with a “scalpel channel”) and a blade holder **438** (FF34-36). Appellant has not distinguished the structure of the claimed “scalpel” other than to assert that the blade is loosely mounted in the shield and therefore would not be understood to be a scalpel. “[I]t is Appellant’s position that those skilled in the art, as well as those about to have surgery performed upon them, would refuse to use the ‘scalpel’ identified by the Examiner, as that assembly would easily allow the blade/slider to become disengaged from the ‘handle’” (Reply Br. 4).

The claim does not require the scalpel to be rigidly connected. The claim also does not limit the scalpel to be used for a particular procedure.

We affirm the rejection of claim 20. Claim 21 falls with claim 20 because separate reasons for its patentability were not provided. 37 C.F.R. § 41.37(c)(1)(vii).

CONCLUSION OF LAW

Cohn describes a jacket for a scalpel and a scalpel that meets the limitations of claims 1 and 20. We therefore affirm the rejection of claims 1 and 20, and dependent claims 2, 11, 12, 14-16, 18, 19, and 21 as anticipated by Cohn.

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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).

AFFIRMED

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