

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte MARK H. FALAHEE

Appeal 2008-4978
Application 10/935,213
Technology Center 3700

Decided: September 16, 2008

Before TONI R. SCHEINER, LORA M. GREEN, and
FRANCISCO C. PRATS, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-3 and 5. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

The claims are directed to a surgical field smoke evacuator. Claim 1 is representative of the claims on appeal, and reads as follows:

1. A surgical field smoke evacuator, comprising:
a hollow, flexible tube having a proximal end with a fitting adapted
for connection to a vacuum source and a distal end that branches into a pair
of side tubes, each side tube having a plurality of smoke inlets;
the side tubes being composed of modular, interconnectable sections;
and
at least one element for holding the sides in position with the smoke
inlets proximate to a surgical wound.

The Examiner relies on the following reference:

John US 7,141,047 B2 Nov. 28, 2006

We reverse.

ISSUE

The Examiner contends that John anticipates claims 1-3 and 5 under 35 U.S.C. § 102(e).

Appellant contends that John does not teach side tubes being composed of modular, interconnectable sections.

Thus, the issue on appeal is: Whether John teaches side tubes being composed of modular, interconnectable sections as required by independent claim 1?

FINDINGS OF FACT

FF1 The invention is drawn to an adaptable evacuator for removing smoke from a surgical site, “regardless of surgical wound type or location.” (Spec. 1.)

FF2 Figure 2 of the disclosure is reproduced below.

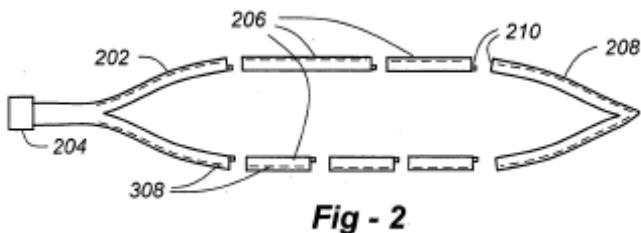


Fig - 2

Figure 2 shows a “modular smoke evacuation assembly according to the invention.” (Spec. 2.) According to the Specification:

This system comprises a suction end piece 202 having a connector 204 adapted for interconnection to a standard suction system, and varying length expander pieces 206 and an end connector 208. Between each piece, there is a coupling interconnect represented by 210, allowing the various components to be assembled to correspond to the incision.

(Spec. 3.)

FF3 The Examiner rejects claims 1-3 and 5 under 35 U.S.C. § 102(e) as being anticipated by John.

FF4 According to the Examiner,

John discloses a surgical field smoke evacuator comprising a hollow, flexible tube (12) having a proximal end with a fitting adapted for connection to a vacuum source (E) and a distal end that branches into a pair of side tubes and rejoins distally after branching (figure 1), each side tube having a plurality of smoke inlets (24a, 24b); the side tubes being composed of modular, interconnectable sections of varying lengths (col. 5, lines 22-

29); and a stapling tab element (16) extending from the hollow, flexible tube as, set forth in figures 1 and 3-4.

(Ans. 3.)

FF5 Figure 4 of John, relied upon by the Examiner, is reproduced below.

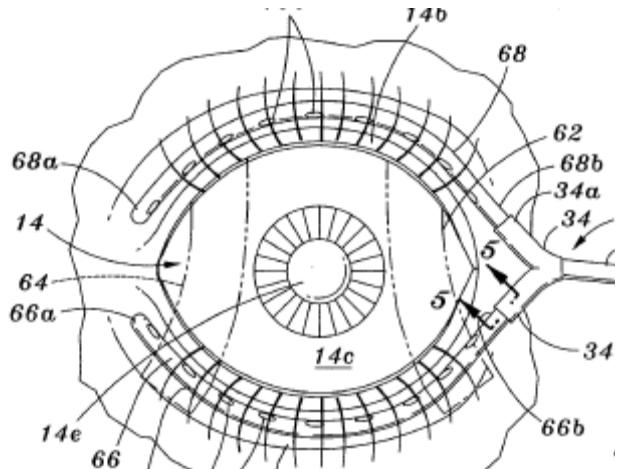


Figure 4 shows an embodiment of the eye aspirating device of John that has a pair of tubular branches inserted into the open eye of a patient (col. 3, ll. 43-46).

FF6 John teaches that the device 60 uses a pair of branch tubes 66 and 68, the open ends of which are inserted into the Y connector 34 (col. 5, ll. 10-18). According to John, the length of each branch tube is about 6 cm to about 7.5 cm, and are equal, but the length of the tubes may be changed, for example, for use in children, where the length of the tubes may be shorter (col. 5, ll. 22-29).

FF7 According to the Examiner, “John discloses that the side tubes are split into two branches (col. 4, lines 3-5) and that each side tube is connected to the Y connector as set forth in col. 5, lines 15-18, therefore providing side tubes that are composed of modular, interconnectable sections.” (Ans. 3.)

FF8 Thus, the Examiner finds that branch tubes 66 and 68, the open ends of which are inserted into the Y connector 34 meets the limitation of “the side tubes being composed of modular, interconnectable sections” as required by claim 1.

PRINCIPLES OF LAW

“A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference.” *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

ANALYSIS

Appellant argues that John does not teach ““side tubes being composed of modular, interconnectable sections.”” (App. Br. 3 (quoting claim 1).) According to Appellant, “the sidetubes themselves are *still not* composed of modular, interconnectable sections.” (*Id.*)

The Examiner responds that:

[A]ppellant’s arguments do not appear to be commensurate with the scope of the claim. The arguments appear to be directed toward a side tube that includes multiple sections that interconnect with each other. However, the claimed language is directed to “side tubes being composed of modular, interconnectable sections.” As such, 66b is one modular section interconnectable to 18A and then to 34, and 68b is another modular section interconnectable to 18A and then to 34 as shown in figures 4-5.

(Ans. 4.)

Claim 1 specifically requires that “the side tubes being composed of modular, interconnectable sections.” Although we recognize that during ex

parte prosecution, claims are to be “interpreted as broadly as their terms reasonably allow,” *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989), that interpretation is to be consistent with the Specification, *id.*; *see also, In re American Academy of Science Tech Center*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). We thus find that the Appellant has the better argument, and the claims require that the side tubes, *per se*, are each composed of modular, interconnectable sections. As the side tubes of John are composed of a single piece of tubing, the reference cannot anticipate claim 1.

CONCLUSION

Thus, as we find that John does not teach side tubes being composed of modular, interconnectable sections as required by independent claim 1 (the only independent claim on appeal), John does not anticipate the claims, and the rejection is reversed.

REVERSED

cdc

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