

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ANTHONY M. LOOPER and DAVID Q. FENG

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Appeal No. 2005-0916  
Application No. 09/785,374

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ON BRIEF

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Before KIMLIN, WALTZ and TIMM, Administrative Patent Judges.  
KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 3-13 and 15-21. Claims 22-24, 26-31, 33-37, 39-43 and 45-89 have been withdrawn from consideration. Claim 1 is illustrative:

1. A surgical device comprising:

a tissue engaging means and a handle assembly;

an actuating means connecting the handle assembly and the tissue engaging means for actuating the tissue engaging means;

a shaft member comprising a first tube made of a malleable material and having a proximal end, a distal end and a longitudinal axis, the proximal end of the first tube adapted to

Appeal No. 2005-0916  
Application No. 09/785,374

be coupled to the handle assembly, the distal end of the first tube adapted to be coupled to the tissue engaging means, the actuating means adapted to extend axially through the first tube, the first tube configured to be kink resistant and to bend about some bending radius in response to a bending moment applied to the first tube.

The examiner relies upon the following reference as evidence of obviousness:

Makower et al. (Makower)                      5,474,057                      Dec. 12, 1995

Appellants' claimed invention is directed to a surgical device comprising an actuating means which connects a tissue engaging means and a handle assembly. The actuating means is adapted to extend axially through a tube made of a malleable material. Also, the tube is configured to be kink resistant and to bend about some bending radius. According to appellants, "[t]he shaft member of the present invention allows the surgeon to bend and adjust the shape of the surgical device to minimize its intrusion and to allow for proper positioning in predetermined body locations" (page 2 of principal brief, third paragraph).

Appealed claims 1, 3-13 and 15-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Makower.

Appeal No. 2005-0916  
Application No. 09/785,374

Appellants group all the appealed claims together in one group (see page 2 of principal brief). Accordingly, all the appealed claims stand or fall together with claim 1.

We have thoroughly reviewed each of appellants' arguments for patentability. However, we are in complete agreement with the examiner that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning of § 103 in view of the applied prior art. Accordingly, we will sustain the examiner's rejection.

There is no dispute that Makower, like appellants, discloses a surgical device comprising an actuating means which connects a tissue engaging means and a handle assembly, wherein the actuating means extends through a tube. Makower does not expressly disclose that the material of the tube be malleable and the configuration of the tube be such that it is kink resistant and able to bend about some bending radius. However, as pointed out by the examiner, Makower provides the teaching that "[t]he tubular support 11 can be made out of any material appropriate for the nature of its use and in particular a medical grade plastics, metals or ceramics may be used, however, the choice of material will undoubtedly be determined by the function of the particular configuration" (column 7, lines 4-8). Also, the

Appeal No. 2005-0916  
Application No. 09/785,374

reference states that the tubular support should be made in a way that allows maximum passage therethrough while providing adequate strength (see column 7, lines 12-16). Consequently, we find that Makower provides a generic teaching that the tubular support may be made from malleable and non-malleable metals and plastics, contingent upon the intended use of the device. Since one of the challenges to surgeons and their support staff during invasive and minimally-invasive surgery is manipulating a myriad of surgical devices, we agree with the examiner that it would have been obvious for one of ordinary skill in the art to configure the tube of Makower such that it be flexible and kink resistant during use.

Appellants emphasize that there is no disclosure in Makower that the tube is kink resistant and is made from a malleable material. However, we agree with the examiner that the reference teaching that the tube should allow a maximum passage would have suggested the property of kink resistance. Also, although Makower does not explicitly state that the tube should be of a malleable material and be configured to be kink resistant and bendable, it has often been held by our reviewing Court that one of ordinary skill in the art is presumed to know more than that which is specifically disclosed in a reference. Even though

Appeal No. 2005-0916  
Application No. 09/785,374

appellants have not argued that they were the first to ascertain the problem of the tube not being kink resistant and bendable, we are persuaded that the recognition of the problem during surgery, as well as its solution, would have been readily apparent to one of ordinary skill in the art. In re Ludwig, 353 F.2d 241, 243-44, 147 USPQ 420, 421 (CCPA 1965).

Also, as alluded to by the examiner, claim 1 on appeal is of considerable breadth with respect to the tube properties of malleability, kink resistance and bendability. The claim fails to recite any degree of malleability, kink resistance or bendability. As such, it is impossible to determine to what degree, if any, the claimed tube differs from the metal and plastic tubes of Makower with respect to these properties.

As a final point, we note that appellants base no argument upon objective evidence of nonobviousness, such as unexpected results, which would serve to rebut the inference of obviousness established by the prior art.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is affirmed.

Appeal No. 2005-0916  
Application No. 09/785,374

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

AFFIRMED

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
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THOMAS A. WALTZ	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
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CATHERINE TIMM	)	
Administrative Patent Judge	)	

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Appeal No. 2005-0916  
Application No. 09/785,374

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