

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY WELLS and DAVID RACENET

Appeal No. 2005-2607
Application No. 09/865,774

ON BRIEF

Before GARRIS, WARREN, and JEFFREY T. SMITH, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1-10.

The subject matter on appeal relates to a trocar assembly comprising an obturator having first and second ends with a sharpened tip positioned on the first end and a hand grip positioned on the second end and wherein a cushioned member is positioned on at least one pressure contact surface of the hand

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grip. This appealed subject matter is adequately represented by independent claim 1 which reads as follows:

1. A trocar assembly comprising:

an obturator defining a longitudinal axis and having first and second ends,

a sharpened tip positioned on the first end of the obturator and a hand grip positioned on a second end of the obturator opposite the first end, and a cushioned member positioned on at least one pressure contact surface of the hand grip.

The references relied upon by the examiner as evidence of obviousness are:

Ott	5,674,237	Oct. 7, 1997
Silber et al. (Silber)	5,928,154	Jul. 27, 1999

All of the appealed claims are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ott in view of Silber.¹

We refer to the various briefs and answers for a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning the above noted rejection.²

¹ As reflected on page 3 of the brief, the appellants have grouped and argued the appealed claims together. Accordingly, in our disposition of this appeal, we need focus on claim 1 only which is the sole independent claim before us. See 37 CFR § 1.192(c)(7)(2003).

² On pages 1 and 2 of the surreply brief filed June 4, 2004, the appellants correctly point out that the supplemental examiner's answer mailed April 15, 2004 was not permitted under the regulation then in existence (i.e., prior regulation 37 CFR § 1.193(b)(1); compare current regulation 37 CFR § 41.43 (Sept.

(continued...)

OPINION

For the reasons expressed in the answer and below, we will sustain this rejection.

The independent claim on appeal distinguishes from the Ott patent by requiring "a cushioned member positioned on at least one pressure contact surface of the hand grip." The trocar handle 110 of Ott's trocar assembly 20 is not disclosed as having any such cushioned member. We agree with the examiner, however, that it would have been obvious for an artisan with ordinary skill to provide patentee's trocar handle with a grip layer of the type and for the reasons taught by Silber.

According to the appellants, no reason exists for combining these reference teachings in the above proposed manner. We cannot agree. As more fully explained in the answer, an artisan would have been motivated to so combined these reference teachings in order to provide the trocar handle of Ott with the several advantages taught by Silber to attend use of his grip layer such as reduced fatigue and occupational injuries due to minimalization of gripping force (e.g., see lines 1-10 in column

²(...continued)
2004) which expressly permits a supplemental examiner's answer). However, this error on the examiner's part is harmless since, from our perspective, the supplemental answer merely reiterates positions previously advanced by the examiner in the answer.

3 and lines 37-51 in column 5 of Silber). We have no doubt but that the artisan would have appreciated the applicability of such advantages to the trocar assembly of Ott.

The appellants further argue that Silber's grip layer is not tantamount to the here claimed cushioned member since the former is disclosed as being non-compressible and rigid. This is incorrect. The examiner has rightly explained that Silber actually teaches that his grip layer is "substantially" non-compressible (see line 18 in column 3) and "substantially" rigid (see line 60 in column 3), thus indicating that the layer is compressible and non-rigid to at least some extent. More importantly, the examiner has correctly pointed out that patentee's grip layer and the appellants' cushioned member are both made of the same types of materials such as Santoprene™ (e.g., see lines 28-60 in column 8 of Silber in comparison with the first full paragraph on specification page 4) and possess overlapping durometer values (e.g., see line 58 in column 7 through line 27 in column 8 of Silber in comparison with lines 1-9 on specification page 5).

Contrary to the appellants' apparent belief, these circumstances provide adequate, reasonable support for the examiner's determination that Silber's grip layer inherently

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possesses the "cushioned" characteristic of the appealed claim 1 "cushioned member." See Ex parte Levy, 17 USPQ2d 1461, 1463-64 (Bd. Pat. App. & Int. 1990). Moreover, it is here appropriate to reiterate the examiner's well taken point that neither appealed claim 1 nor the specification disclosure contains any requirements as to the degree of this "cushioned" characteristic or the thickness of this "cushioned member."

In light of the foregoing and for the reasons well stated by the examiner in her answer, it is our ultimate determination that the examiner has established a prima facie case of obviousness which the appellants have failed to successfully rebut with argument or evidence of nonobviousness. We hereby sustain, therefore, the section 103 rejection of claims 1-10 as being unpatentable over Ott in view of Silber. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)

The decision of the examiner is affirmed.

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

AFFIRMED

Bradley R. Garris)	
Administrative Patent Judge)	
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Charles F. Warren)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
Jeffrey T. Smith)	
Administrative Patent Judge)	

BRG:tdl

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