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WELSH FLAXMAN & GITLER LLC 2000 DUKE STREET, SUITE 100 ALEXANDRIA, VA 22314			SCHAPER, MICHAEL T	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOHN P. MEASAMER

Appeal 2010-012234
Application 11/742,110
Technology Center 3700

Before JAMES P. CALVE, LYNNE H. BROWNE, and,
NEIL T. POWELL, *Administrative Patent Judges*.

CALVE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the rejections of claims 1, 5, 7, 8, 10, 11, 14, 16, 17, 19, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Ouchi (US 6,375,650 B1; iss. Apr. 23, 2002). App. Br. 3. Claims 6, 9, 15, and 18 are withdrawn and claims 2-4, 12, and 13 are cancelled. *Id.* We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

CLAIMED SUBJECT MATTER

Claims 1 and 11 are independent. Claim 1 is reproduced below:

1. An endoscopic instrument for performing surgical procedures, said instrument comprising:
 - an elongate member having a distal end for insertion into a patient's body and a proximal end opposite the distal end, the member having a distal portion adjacent the distal end and a central portion adjacent the distal portion;
 - wherein the distal portion has a first mechanical stiffness being a stiffness in tension of between about 5 lbf/in and about 20 lbf/in and a stiffness in bending of between about 0.02 lbf/in and about 0.40 lbf/in, and the central portion has a second mechanical stiffness being a stiffness in tension of between about 5 lbf/in and about 20 lbf/in and a stiffness in bending of between about 0.02lbf/in and about 0.40 lbf/in; and
 - wherein the first mechanical stiffness is greater than the second mechanical stiffness.

ANALYSIS

The Examiner found that Ouchi discloses a surgical endoscopic instrument with an elongate member 1a, 1b having a distal end 1a and a proximal end 1b wherein the distal portion has a first mechanical stiffness in tension and bending, the central portion has a second mechanical stiffness in tension and bending, and the first mechanical stiffness is inherently greater than the second mechanical stiffness because of the greater coil thickness of the distal end relative to the proximal end. Ans. 4. The Examiner found that although Ouchi does not disclose the claimed stiffness ranges, it would have been obvious for the first mechanical stiffness to have a stiffness in tension of between 5-20 lbf/in and a stiffness in bending of about between 0.02-0.4

lbf/in and for the second mechanical stiffness to have a stiffness in tension of between about 5-20 lbf/in and a stiffness in bending of about between 0.2-0.4 lbf/in as a matter of discovering optimum or workable ranges involving only routine skill in the art because the general conditions of the claim are disclosed in the prior art. Ans. 6. The Examiner determined that the relative stiffness of elements 1a and 1b are established through inherency so a skilled artisan would have configured the distal and central portions 1a, 1b with the claimed stiffness ranges without undue experimentation because Appellant has not disclosed that the claimed ranges are for any specific purpose other than being optimal values. Ans. 7.

Appellant argues that the Examiner relies on unsupported inherency arguments and just because coils of distal end 1a are thicker than the coils of proximal end 1b in Ouchi is not indicative of increased stiffness because a number of factors determine the stiffness of a coiled spring besides spring thickness. App. Br. 8-9. Appellant also argues that claims 1 and 11 recite specific stiffness ranges in tension and bending. App. Br. 10-11. Appellant argues that the claimed ranges are recited in combination with the first mechanical stiffness being greater than the second mechanical stiffness such that the claimed ranges require a specific relationship between the distal and central portions. App. Br. 10.

The Examiner has not established that the prior art recognizes that the relative mechanical stiffness in bending and tension of the distal and central portions of an endoscope are result effective variables such that a skilled artisan would have been motivated to experiment and optimize the tension and bending stiffness of the distal and central portions of the endoscope to achieve the claimed stiffness ranges as matter of routine experimentation.

Ouchi discloses an endoscope with a flexible sheath 1 with a firm portion 1a at the distal end and a non-firm portion 1b adjacent to the rear end of the firm portion 1a. Col. 2, l. 66 to col. 3, l. 6. The Examiner has not identified, nor do we discern where Ouchi describes how the mechanical stiffness in bending and tension of the distal and central portions are determined such that these values constitute result effective variables to be optimized through routine experimentation, nor has the Examiner shown that the prior art discloses any particular ranges or values for such stiffnesses such that it would have been obvious to arrive at the claimed stiffness ranges of claims 1 and 11 through routine experimentation. *See In re Antonie*, 559 F.2d 618, 620 (CCPA 1977) (discovery of an optimum value of a variable is normally obvious except when the parameter optimized is not recognized to be a result-effective variable or the results of optimizing the variable are unexpectedly good). As such, we cannot sustain the rejection of claims 1, 5, 7, 8, 10, 11, 14, 16, 17, 19, and 20.

DECISION

We REVERSE the rejections of claims 1, 5, 7, 8, 10, 11, 14, 16, 17, 19, and 20.

REVERSED

Klh