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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/230,149	09/19/2005	Peter Eisenkolb	02581-P0732A	3054
24126	7590	01/24/2013	EXAMINER	
ST. ONGE STEWARD JOHNSTON & REENS, I.L.C. 986 BEDFORD STREET STAMFORD, CT 06905-5619			BOSWORTH, KAMI A	
			ART UNIT	PAPER NUMBER
			3767	
			NOTIFICATION DATE	DELIVERY MODE
			01/24/2013	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PETER EISENKOLB and ANDREAS EFINGER

Appeal 2011-001245
Application 11/230,149
Technology Center 3700

Before CHARLES N. GREENHUT, MICHAEL L. HOELTER and
BARRY L. GROSSMAN, *Administrative Patent Judges*.

HOELTER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is a decision on appeal, under 35 U.S.C. § 134(a), from a final rejection of claims 1-19. App. Br. 2. We have jurisdiction under 35 U.S.C. § 6(b). Appellants' representative presented oral argument on January 15, 2013. We AFFIRM.

CLAIMED SUBJECT MATTER

The disclosed subject matter is directed to “a valve for a medical instrument, in particular an endoscopic instrument, for insulating against a distal-side fluid.” Spec. para. [0002]. Independent claim 1 is representative of the claims on appeal and is reproduced below:

1. A valve for medical instruments, in particular endoscopic instruments, with which a canal configured in the medical instrument and serving as input for at least one additional medical instrument is insulated from a distal-end fluid, with a valve housing that can be inserted at least partially into the canal, where in the valve housing at least one fluid opening is configured, and having at least one insulating body positioned in the valve housing and consisting of an elastic material, whereby the fluid opening is configured so that the distal-side fluid can be conducted out of the canal to the outside of the insulating body in such a way that the distal-side fluid reshapes the insulating body inward, insulating it, to be essentially perpendicular to the longitudinal direction of the insulating body characterized in that the insulating body has stiffening webs arranged on the outside in the area of the insulating lips serving to press the sealing lips towards one another in a sealing manner by means of the internal tension of the stiffening webs in such a way that the insulating lips are pressed against each other when no additional medical instrument is arranged in the valve housing and the insulating lips are pressed against the outer surface of the additional medical instrument when inserted in the valve housing and the insulating body and in that

the insulating body has a peripheral flange in each case at its proximal and at its distal end, and the insulating body can be secured free of tension and unspreaded in the longitudinal direction in a fixed position in the valve housing via one of the integrally formed flanges.

REFERENCES RELIED ON BY THE EXAMINER

Tower	US 5,161,773	Nov. 10, 1992
Stephens	US 5,350,364	Sep. 27, 1994
Blake	US 5,662,615	Sep. 2, 1997

THE REJECTIONS ON APPEAL

1. Claims 1-14 and 16-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Blake and Stephens. Ans. 4.
2. Claim 15 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Blake, Stephens and Tower. Ans. 9.

ANALYSIS

*The rejection of claims 1-14 and 16-19
as being unpatentable over Blake and Stephens*

Appellants argue claims 1-14 and 16-19 as a group. App. Br. 6. We select claim 1 for review with claims 2-14 and 16-19 standing or falling with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2011).

Claim 1 includes the limitation that stiffening webs provide “internal tension” that serve “to press the sealing lips towards one another in a sealing manner.” Claim 1 further includes the limitation that the “insulating body can be secured free of tension and unspreaded in the longitudinal direction” in the valve housing via one of the flanges. While the Examiner primarily relies on the teachings of Blake for disclosing the limitations of claim 1, the

Examiner specifically relies on the teachings of Stephens for disclosing the above two limitations and provides reasons for their combination. Ans. 4-6.

Appellants initially discuss Blake's manner of sealing which relies on external pressure (i.e., "*peritoneal pressure*") and not the internal tension of the claimed stiffening webs. App. Br. 7, *see also* Reply Br. 5. Appellants also discuss Blake's failure to teach an insulating body that "is secured free of tension, i.e. unspreaded in the valve housing." App. Br. 8. Appellants contend that the importance of the stiffening webs recited in claim 1 is that they "allow the insulating body to be secured free of tension, i.e. unspreaded in the valve housing" and that "Blake does not teach that the insulating body can be secured free of tension, i.e. unspreaded in the valve housing." App. Br. 8, *see also* Reply Br. 5. These discussions regarding Blake are not persuasive as they do not address the Examiner's reliance on Stephens, not Blake, for teaching these limitations. Ans. 5, 6.

Appellants further contend that because Blake's opposite "flanges 36a and 36b are pushed apart by skirt portion 32," this "teaches away from the required teachings of Claim 1, because the insulating body of Blake cannot be secured free of tension, i.e. unspreaded in the valve housing." App. Br. 8, *see also* Reply Br. 3-4. This contention is not persuasive for the reason stated above and because our reviewing court has provided instruction that a teaching away requires a reference to actually criticize, discredit, or otherwise discourage investigation into the claimed solution. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). We note that Blake discloses that elastomeric seal 36 "is positioned on" ledges of the skirt without expressly indicating whether the seal is under tension or not. Blake 4:48-52. However, even assuming Appellants contention that the seal's flanges 36a

and 36b are pushed apart by skirt portion 32 to be true, there is no indication that Blake criticizes, discredits or otherwise discourages the implementation of an untensioned seal. Accordingly, Appellants' contention is not persuasive.

In addressing the Examiner's reliance on Stephens, Appellants contend that this reference fails to disclose stiffening webs that seal via internal tension as claimed because Stephens fails to "disclose or teach that the insulating body can be *free of tension*, i.e. unspreaded in the valve housing." App. Br. 9, *see also* Reply Br. 4-5. For support, Appellants identify column 9, lines 5-20 of Stephens that discuss Stephens' top seal collar 248 being fixed which "thereby precludes axial movement of flange portions 242 and 274." App. Br. 10. This, accordingly to Appellants, teaches that Stephens' "insulating body will necessarily be tensioned, and cannot be *free of tension*, i.e. unspreaded in the valve housing, as required by Claim 1." App. Br. 10. The Examiner disagrees stating that this cited portion of Stephens discloses, at lines 14-20, that "the insulating body is arranged in a manner that permits the distal end (i.e., the end having flange 244) 'to move or float toward and away from top seal collar'" 248. Ans. 11. The Examiner further references column 9, lines 43-45 of Stephens that states that the insulating body "is received within the housing 'in a form wherein the seal member 234 is in its unstressed condition.'" Ans. 11.

We agree with Appellants that Stephens discloses that top seal collar 248 "is fixed to an upper portion" of the housing "and thereby precludes axial movement of flange portions **242** and **274**." Stephens 9:11-14. However, flange portions 242 and 274 are top flange portions retained in top seal collar 248 (Stephens 9:8-11) and there is no dispute that Stephens also

discloses that bottom seal collar 246, which retains bottom flange portions 244 and 276 (Stephens 9:8-11), is able to “move or float toward and away from top seal collar **248**” (Stephens 9:14-18). This, in addition to Stephens’ disclosure that the assembly “is typically received in a form wherein the seal member **234** is in its unstressed condition” (Stephens 9:43-45), does not persuade us that the Examiner’s analysis is in error or that the limitation “the insulating body can be secured free of tension and unspreaded in the longitudinal direction” is not taught by Stephens.

Appellants further contend that for obviousness, one skilled in the art needs to have a reasonable expectation of success in solving a problem when references are combined. App. Br. 10. More specifically, Appellants contend that if “the starting reference does not pose the problem to start with, then a person of ordinary skill would not expect success in solving that problem.” App. Br. 10. We agree with the need for a reasonable expectation of success when references are combined. *In re O’Farrell*, 853 F.2d 894, 903-904 (Fed. Cir. 1988) (“Obviousness does not require absolute predictability of successFor obviousness under § 103, all that is required is a reasonable expectation of success.”). *See also In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (“Only a reasonable expectation that the beneficial result will be achieved is necessary to show obviousness.”). However, we disagree with Appellants that for obviousness, the problem solved needs to be expressed in the starting reference. The Supreme Court, in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), has provided instruction that the “obviousness analysis cannot be confined by ...overemphasis on the importance of published articles and the explicit content of issued patents.” *KSR*, 550 U.S. at 419. Instead, the Supreme

Court has provided instruction that for obviousness “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at, 418. Appellants do not challenge the Examiner’s stated reasons for combining Blake and Stephens (Ans. 5, 6) but instead contends that the problem solved was not stated and as such the claimed solution of the insulating body being secured free of tension and unspreaded in the longitudinal direction “makes no sense to a person of ordinary skill when combining the Blake and Stephens” references. App. Br. 10. Appellants’ contention is not persuasive.

Appellants also contend that Stephens’ “ribs 272 are not arranged on the outside in the area of the sealing lips” but instead, “seal member 234 is molded over the cage member to form an integral assembly.” Reply Br. 2-3. We disagree with Appellants’ interpretation that Stephens’ teaching of the seal being “molded over the cage member” (Stephens 8:64) means that the seal is molded fully around and encloses the cage member. Stephens’ Figures 11 and 14-16 clearly disclose cage member 270 on the outside of seal member 234. We further note Appellants statement that “Stephens et al. disclose that the valve housing comprises axially extending ribs 272 arranged on the outside in the area of the sealing lips. *See* FIGS. 13-16 and Column 8, line 35-Column 9, line 42” (italics added). App. Br. 9. Accordingly, Appellants’ contention is not persuasive.

In view of the record presented, we sustain the Examiner’s rejection of claims 1-14 and 16-19.

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*The rejection of claim 15
as being unpatentable over Blake, Stephens and Tower*

Claim 15 depends from claim 11 which depends from claim 1. Claim 15 adds the limitation of an additional insulating element (*see* claim 11) that is secured by cementing to the insulating body. The Examiner relies on Tower for teaching the connection of insulating parts by cementing. Ans. 9. Appellants do not present arguments addressing Tower's teaching of cementing but instead, Appellants' contend that Tower fails to disclose stiffening webs and an insulating body secured free of tension. App. Br. 12. Appellants' arguments do not address the Examiner's reason for the rejection of claim 15. We sustain the Examiner's rejection of claim 15.

DECISION

The rejections of claims 1-19 are affirmed.

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

MP