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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MICHAEL A. MASINI

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Appeal 2011-003202  
Application 11/407,775  
Technology Center 1600

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Before DEMETRA J. MILLS, LORA M. GREEN, and  
SHERIDAN K. SNEDDEN, *Administrative Patent Judges*.

MILLS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134. The Examiner has rejected the claims for obviousness. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF CASE

Claims 1-25 are pending: however claims 8, 9, 11, 14-25 are withdrawn and 1-7, 10, 12, 13<sup>1</sup> are rejected and under appeal.

The following claims are representative.

1. Tissue repair apparatus, comprising:

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<sup>1</sup> Claims 8, 9, 11, and 14-25 are also pending, but stand withdrawn from consideration (Br. 1; *see also* Ans. 2).

a tissue fastener including a female portion and a male portion with a shaft configured to engage with the female portion a first elongated member for holding the female portion of the fastener behind tissue to be repaired;

a second elongated member for holding the male portion of the fastener in front of tissue to be repaired in alignment with the female portion; and

wherein the second elongated member is slideable relative to the first elongated member, allowing a user to pierce the tissue and compress the tissue as the male portion engages with the female portion; and

wherein the male portion includes a plurality of spaced-apart ribs or barbs along the shaft thereof, such that when the male portion engages with the female portion, the male portion locks into position once a desired degree of compression is achieved.

13. The instrument of claim 12, further including markings to indicate engagement of the male and female portions.

*Cited References*

Aranyi et al.	US 5,513,746	Apr. 30, 1985
Baldwin et al.	US 6,443,963 B1	Sep. 3, 2002
Duncan	US 4,548,202	Oct. 22, 1985

*Grounds of Rejection*

Claims 1-7, 12, and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Aranyi in view of Duncan.

Claims 1, 3, 4, and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Baldwin in view of Duncan.

## FINDINGS OF FACT

The Examiner's findings of fact are set forth in the Answer at pages 3-6.

### *Discussion both Obviousness Rejections*

#### ISSUE

The Examiner concludes that

Aranyi discloses a Tissue repair apparatus having a tissue fastener including a female (26a) and a male portion (30b) with a shaft to engage with the female portion, a first elongated member (28) holding the female portion behind the tissue, second elongated member (22) for holding the male portion in front of the tissue and being slidable to the first elongated member (figure 1, 24,27 col. 4 ll. 54-66, col. 5 ll. 1-14, col. 9 ll. 40-45) but lacks a plurality of spaced apart barbs on the male shaft to engage with the female portion in order to lock the device in a desired position. However Aranyi does disclose ribbed or barbed (figure 23, col. 9 ll. 45-48) and the female portion has something to engage with the barbs (col. 10, ll. 35-49) just not a plurality of them spaced apart.

Duncan teaches a tissue fastener with male and female portion with a plurality of barbs on the male shaft (80a, figure 1, 2, col. 5 ll. 14-43) to help lock the male portion into the female portion. It would have been obvious to one of ordinary skill of the art at the time of the invention to modify the male shaft of Aranyi with the male shaft of Duncan to include the ribs of Duncan, in order to be able to proficiently lock the male and female parts together in order to get a desired position of compressibility.

(Ans. 3-4.) The Examiner's obviousness rejection over Baldwin in view of Duncan is outlined in the Answer at pages 5-6, and is similar to that of Aranyi in view of Duncan.

Appellant argues that both Aranyi and Baldwin already include male and female parts that proficiently lock together. (Br. 3, 5.) Appellant argues that the apparatus of Aranyi and Baldwin *cannot accommodate* a male portion with a plurality of spaced-apart ribs or barbs along the shaft thereof. (Br. 3, 5.) Finally, with respect to claim 13<sup>2</sup>, Appellant argues that the claim is directed to *an instrument* with markings (plural) to indicate engagement of the male and female portions. Appellant does not understand how something that is "not seen" reads on the relevant limitation(s). (Br. 5-6.)

The issue is: Does the cited prior art support the Examiner's rejection of the claims for obviousness?

#### PRINCIPLES OF LAW

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant." *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citations omitted). In order to determine whether a *prima facie*

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<sup>2</sup> Note Appellant's Brief, page 4 indicates an amendment was filed with the Brief and that the limitations from claim 13 were moved into claim 12. We have no evidence of record indicating the Examiner entered this amendment, thus we consider it unentered.

case of obviousness has been established, we consider the factors set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966): (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the relevant art; and (4) objective evidence of nonobviousness, if present.

When a claim requires two separate elements, one element construed as having two separate functions does not meet the claim's terms. *See Lantech, Inc. v. Keip Mach. Co.*, 32 F.3d 542, 547 (Fed. Cir. 1994); *see also In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (claims requiring three separate means not anticipated by structure containing only two means using one element twice).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007).

“Attorney's argument in a brief cannot take the place of evidence.” *See In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974).

## ANALYSIS

We agree with the Examiner's fact finding, statement of the rejection and responses to Appellant's arguments as set forth in the Answer. We find that the Examiner has provided evidence to support a prima facie case of obviousness of all claims, except claim 13. We provide the following additional comment.

Since Appellant's arguments for both rejections are similar and based on the same secondary reference, we address them together. Appellant

provides separate argument for claim 13 in the Brief at page 24, last sentence to page 25. We address claim 13 separately. All other claims fall with claim 1 with respect to each rejection.

Appellant argues that both Aranyi and Baldwin already include male and female parts that proficiently lock together. Appellant argues that the apparatus of Aranyi and Baldwin *cannot accommodate* a male portion with a plurality of spaced-apart ribs or barbs along the shaft thereof. (Br. 3, 5.)

We are not persuaded by these arguments. Rather, we agree with the Examiner's conclusion that one of ordinary skill in the art reading Duncan would have found it obvious to use the plurality of barbs of Duncan to further enhance the lockability and the desired compression of the tissue based on the numerous barbs that lock the male member with the female member. (Ans. 6.) Duncan, col. 5, ll. 14-18, discloses "fastening members which are adapted to cooperate to compress or hold between them the resilient serration structure." Duncan further discloses in col. 5, ll. 34-43, that the plurality of barbs creates a unique means for effecting engagement to have a desired relationship of compressibility.

Nor are we persuaded that the apparatus of Aranyi and Baldwin *cannot accommodate* a male portion with a plurality of spaced-apart ribs or barbs along the shaft thereof. Figure 23 of Aranyi evidences both prongs 162 and barbs 164 on the male fastening member 30B. Aranyi, col. 10, ll. 36-49. Thus the device of Aranyi can accommodate barbs on the male fastening portion.

While Appellant presents attorney argument that neither Aranyi or Baldwin cannot accommodate a male portion with a plurality of spaced-

apart ribs or barbs along the shaft thereof, Appellant provides no evidence to support this position. “Attorney’s argument in a brief cannot take the place of evidence.” *See In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974).

We find, however, that claim 13 stands on a different footing than claim 1. The Examiner argues with respect to claim 13, that in Aranyi, “[w]hen the shaft enters the receptacle reference 168 of the male fastener will enter the receptacle and will not be seen. Therefore that marking will show that the two fasteners are together.” (Ans. 4-5.)

The Examiner further argues that

The Appellant additionally argues that the Aranyi and Duncan reference does not teach a plurality of markings that indicates engagement of the male and female parts. However, there are no further limitations of what the markings are and what specific engagement is being indicated and how its being indicated. *Therefore the gaps between the barbs or the area around the barbs that create the barbs can be considered a marking* and when this area is not seen, or spatially oriented or viewed at a proximal/distal degree from the female member, one can be indicated about the engagement. For example the space between the first and second barb can be viewed when the male and female members are separate. During the step when the male member is inserted into the female member, and one barb is distal to the female member, where the other barb is proximal to the female member, the gap between them can't be viewed and therefore you know the members are engaging. Additionally, if the gap is a certain distant distal to the female member while the proximal head of the male member is still proximal to the female member, one can be indicated that there is engagement. Therefore Aranyi and Duncan do have marking to indicate engagement.

[Emphasis added] (Ans. 6-7.)

Appellant argues claim 12 [sic 13] is directed to *an instrument* with markings (plural) to indicate engagement of the male and female portions. Appellant does not understand how something that is “not seen” reads on the relevant limitation(s). (Br. 4-5.)

We are not persuaded that the Examiner has set forth a prima facie case of the subject matter of claim 13 in the first instance. When a claim requires two separate elements, one element construed as having two separate functions does not meet the claim’s terms. *See Lantech, Inc. v. Keip Mach. Co.*, 32 F.3d 542, 547 (Fed. Cir. 1994); *see also In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (claims requiring three separate means not anticipated by structure containing only two means using one element twice). The Examiner cannot construe the barbs in the claims and their associated separation spaces to meet the elements of both the barbs and marking limitations.

Thus we conclude the Examiner has not set forth a prima facie case of obviousness of the subject matter of claim 13, which is reversed.

#### CONCLUSION OF LAW

The cited references support the Examiner’s obviousness rejection of claims 1-7, 10, and 12. The obviousness rejection of claim 13 is reversed.

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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-IN-PART

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