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PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			OU, JING RUI	
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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* GENE W. KAMMERER and PETER KOMARNYCKY

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Appeal 2011-003998  
Application 11/258,436  
Technology Center 3700

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Before DONALD E. ADAMS, JEFFREY N. FREDMAN, and STEPHEN WALSH, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134 involves claims 1-4, 14, and 16-19 (App. Br. 2; Ans. 2).<sup>1</sup> We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

The claims are directed to a surgical assembly. Claim 1 is representative and is reproduced in the Claims Appendix of Appellants' Brief.

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<sup>1</sup> Pending claims 5, 6, and 15 stand withdrawn from consideration (App. Br. 2).

Claims 1 and 4 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Farnsworth.<sup>2</sup>

Claims 2, 3, 14, and 16-19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Farnsworth and Bennett.<sup>3</sup>

We reverse.

*Anticipation:*

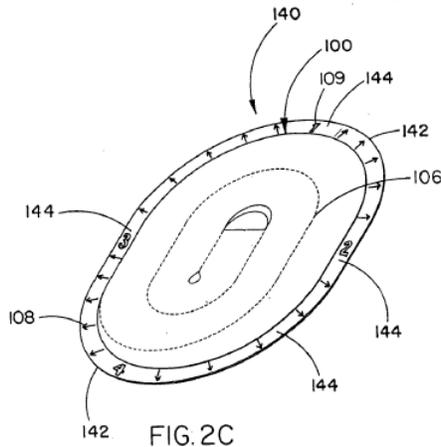
### ISSUE

Does the preponderance of evidence on this record support Examiner's finding that Farnsworth teaches Appellants' claimed invention?

### FACTUAL FINDINGS (FF)

FF 1. Farnsworth teaches a tissue repair device with a removable support member (Farnsworth, Title).

FF 2. Examiner directs attention to Farnsworth's FIG. 2C reproduced below:

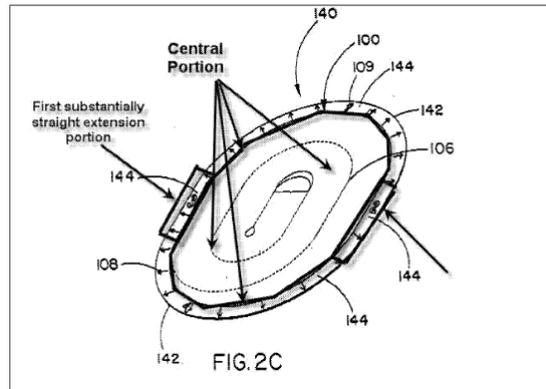


“**FIG. 2C** illustrates a perspective view of ... [Farnsworth's] invention with reference characters in the border area of the implantable device”  
(Farnsworth 3: ¶ [0028]; Ans. 3-5, 7, and 8).

<sup>2</sup> Farnsworth et al., US 2004/0019360 A1, published January 29, 2004.

<sup>3</sup> Bennett, US 2,026,158, issued December 31, 1935.

FF 3. Examiner's annotation of Farnsworth's FIG. 2C is reproduced below:



Examiner's annotation of Farnsworth's FIG. 2C adds features, not present in Farnsworth's original figure, specifically: (1) a central portion, (2) a first substantially straight extension portion, and (3) a second substantially straight extension portion (note arrow at the right of Examiner's annotated figure) (Ans. 3-5, 7, and 8).

FF 4. Examiner finds that Examiner's annotation of Farnsworth's FIG. 2C teaches a surgical assembly comprising, *inter alia*, a flexible, surgical implant removably secured to a substantially flat template, wherein the surgical implant comprises (1) a central body portion and (2) first and second substantially straight trimable portions that have a width less than a width of the central body portion and a length (*id.*)

#### ANALYSIS

Appellants contend that Examiner's annotation of Farnsworth's FIG. 2C "has no support whatsoever in the original text or figures of" Farnsworth (App. Br. 6; *see also id.* at 5). Accordingly, Appellants contend that Farnsworth fails to teach, *inter alia*, "a central body portion and at least first and second substantially straight trimable extension portions extending outwardly therefrom and each having a width less than a width of the central

body portion and a length” (*id.*; *Cf.* FF 4 and Ans. 7 (Examiner finds that the features at issue are taught by Farnsworth “as drawn out by the Examiner”)). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). On this record, Examiner failed to identify an evidentiary basis in Farnsworth that supports Examiner’s annotation of Farnsworth’s FIG. 2C.

#### CONCLUSION OF LAW

The preponderance of evidence on this record fails to support Examiner’s finding that Farnsworth teaches Appellants’ claimed invention. The rejection of claims 1 and 4 under 35 U.S.C. § 102(e) as being anticipated by Farnsworth is reversed.

*Obviousness:*

#### ISSUE

Does the preponderance of evidence on this record support a conclusion of obviousness?

#### FACTUAL FINDINGS (FF)

FF 5. Examiner relies on Farnsworth as discussed above (FF 1-4; Ans. 5-6).

FF 6. Examiner relies on Bennett to make up for Farnsworth’s failure to suggest a “template/mesh holder [that] comprises at least one tab element and at least one slit” (Ans. 5).

## ANALYSIS

Based on the combination of Farnsworth and Bennett, Examiner concludes that, at the time Appellants' invention was made, it would have been *prima facie* obvious to modify Farnsworth's invention to include "at least one tab and one slit ... to secure the mesh to the template or mesh holder and ease removal of the mesh from the template when needed" (Ans. 6).

Initially, we note that Examiner's statement of the rejection is ambiguous, wherein Examiner states that "[c]laims 2, 3, 14, and 16-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Farnsworth ... as applied to [independent] claims 1 and 14 above, and further in view of Bennett" (Ans. 5). Notwithstanding Examiner's contention to the contrary, claims 1 and 4 were rejected above *not* claims 1 and 14. While Appellants did not expressly address the obviousness rejection of record, Appellants contend that Farnsworth fails to address specific requirements common to both of Appellants' independent claims 1 and 14 (App. Br. 6).<sup>4</sup> For the reasons set forth above, with respect to the anticipation rejection, we agree with Appellants' contention. Examiner failed to establish that Bennett makes up for the foregoing deficiency in Farnsworth.

"[E]xaminer bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). "[R]jections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational

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<sup>4</sup> Claims 2-4 and 16-19 depend from claim 1 or 14.

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underpinning to support the legal conclusion of obviousness.” *In re Kahn*,  
441 F.3d 977, 988 (Fed. Cir. 2006).

#### CONCLUSION OF LAW

The preponderance of evidence on this record fails to support a conclusion of obviousness. The rejection of claims 2, 3, 14, and 16-19 under 35 U.S.C. § 103(a) as unpatentable over the combination of Farnsworth and Bennett is reversed.

REVERSED

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