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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte THOMAS M. FASSULIOTIS, GINGER E. LOWERY, and JOHN D. WITZIGREUTER

Appeal 2011-007545
Application 11/586,824
Technology Center 3700

Before ERIC GRIMES, FRANCISCO C. PRATS, and STEPHEN WALSH, *Administrative Patent Judges*.

WALSH, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the rejection of claims directed to a surgical suction instrument. The Patent Examiner rejected the claims for obviousness. We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part.

STATEMENT OF THE CASE

Claims 1, 7-10, 12, and 14 are on appeal. Claim 1 illustrates the subject matter on appeal and reads as follows:

1. A surgical suction instrument capable of being bent by hand during a surgical procedure to a desired shape and capable of remaining in the desired shape for a desired period during the course of the surgical procedure to create a custom-shaped suction device, comprising:

a first section including a suction tip;

a second section connected to the first section, the second section bendable to the desired shape; and

a third section connected to the second section allowing fluid suctioned from the suction tip, and through the second section, to be removed;

wherein the second section includes a metal rod insert-molded into a surgical cavity insertion tube; and

wherein the third section includes a handle and a suction tube attachment fitting positioned directly in front of, and at an acute angle with, the handle.

The Examiner rejected the claims as follows:

I. claims 1, 7, 10, 12, and 14 under 35 U.S.C. § 103(a) as unpatentable over Burney[1] and Fassuliotis;[2]

II. claims 8 and 9 under 35 U.S.C. § 103(a) as unpatentable over Burney and Mahlmann;[3]

III. claim 15 under 35 U.S.C. § 103(a) as unpatentable over Burney, Fassuliotis, and Malmin.[4]

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[1] Debra Burney, US 6,602,072 B2, issued Aug. 5, 2003.
[2] Thomas M. Fassuliotis, US 6,638,240 B2, issued Oct. 28, 2003.
[3] Lee A. Mahlmann, US 2006/0024641 A1, filed Aug. 2, 2004, published Feb. 2, 2006.
[4] Oscar Malmin, US 3,745,655, issued July 17, 1973.

I

The Examiner's position is that Burney's suction instrument differed from Appellants' by not having a handle with suction tube attachment positioned in front of, and at an acute angle with, the handle. (Ans. 4.) Although Burney was "silent as to the process used to insert a metal rod," the Examiner treated claim 1's "a metal rod insert-molded" as a product-by-process limitation, and found Burney's instrument the same in that respect. (*Id.*) The Examiner concluded it would have been obvious to modify Burney's device with the handle and suction tube of Fassuliotis "for the purpose of sufficiently maneuvering the device (via handle) without the suction tube impeding the user." (*Id.*)

Appellants allege that "inserting the metal rod before plastic is injected yields a structurally different result from one produced by another process." (App. Br. A8; Reply Br. 1-2.) Specifically, "a device having a metal rod produced by such a process will have a much tighter fit within the plastic than one made by a process (for example) involving drilling a hole into the plastic and then inserting the rod therein. Most importantly, the process of insert molding the metal rod will yield a device that is far more <u>sterile</u>." (App. Br. A8.) These arguments are unpersuasive. Appellants offer no evidence that an insert-molded rod would have a tighter fit than one inserted by another process. Sterility is not a limitation defining the claimed instrument, but Appellants also produce no evidence that there would be any difference in sterility. What is needed on these points is evidence distinguishing Burney's instrument, not argument.

According to Appellants, "it would not have been obvious to incorporate the suction tube attachment fitting structure disclosed in the

Fassuliotis reference into *Burney's* dental aspirator, as the Examiner asserts." (App. Br. A8; Reply Br. 3.) More specifically, "*Burney's* tubing arrangement does not apparently impede the user of the dental aspirator. It [is] respectfully submitted that the asserted motivation is at best merely a conclusory statement. Finally, there is no evidence on record that suggests that the proposed combination/modification would actually increase maneuverability during a dental procedure." (App. Br. at A9-A10.) These arguments are unpersuasive. We agree with the Examiner that the convenience of Fassuliotis' suction tube and handle configuration is sufficient motivation.

In any event, Fassuliotis provides evidence that the claimed configuration of the handle and suction tube fitting was an art-recognized alternative to the configuration described in Burney. Using either configuration therefore would have been obvious to a person of ordinary skill in the art. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) ("If a person of ordinary skill can implement a predictable variation [of a known work], § 103 likely bars its patentability.").

Claims 7, 10, 12, and 14 have not been argued separately and therefore fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii).

II

Dependent claim 8 limits the instrument of claim 1 to one having the metal rod constructed of stainless steel. The Examiner found that Mahlmann described a surgical aspirator analogous to Burney's dental aspirator, and having an embedded stainless steel rod where Burney described merely metal. (Ans. 5-6.) The Examiner concluded that it would have been

obvious to use stainless steel as Burney's metal "so that it remains in its bent configuration." (*Id.* at 6.) We conclude that the Examiner established a prima facie case for the obviousness of claim 8.

Appellants appeal the rejection of claim 8, but offer no explanation to show the Examiner erred. (App. Br. A10-A11.) The Reply Brief observes that "what is optimal for one application (surgery of the internal organs) would not necessarily be optimal for another (dental procedures)." (Reply Br. 4.) That may be so, but the possibility that stainless steel might not be optimal is not the criterion. As we agree the evidence is sufficient to support the obviousness of choosing Mahlmann's stainless steel as the metal for Burney's rod, we affirm the rejection of claim 8.

Claim 9 limits the instrument of claim 8 to one having a stainless steel metal rod about 0.093 inches in diameter. The Examiner concluded:

> It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify *Burney's* device to include a stainless steel metal rod with a 0.093 inch diameter being of sufficient diameter to be properly bent without breakage and maintain its desired shape, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

(Ans. 6, citing *In re Boesch*, 617 F.2d 272 (CCPA 1980).)

Appellants observe that "it has also been held that a particular parameter must first be recognized as a result-effective variable . . . before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation," but do not dispute that diameter was known to be a result-effective variable for adjusting bendability and shape maintenance. (App. Br. A11.) According to Appellants:

> More importantly, it is not clear why modifying *Burney* such that the dental aspirator's metal rod has a diameter of about 0.093 inch would have been optimal even if it were optimal for the Appellant's surgical suction instrument used for surgery of the internal organs of the body.

(*Id.*; *see also* Reply Br. 4.) We find this argument unpersuasive because, even assuming 0.093 would not have been optimal, there is no dispute that it would have been workable in Burney's instrument, and that it would have been arrived at by routine experimentation.

III

We reverse the rejection of claim 15 for the reasons Appellants provide. (*See* App. Br. A12; Reply Br. 4-5.)

SUMMARY

We affirm the rejection of claims 1, 7, 10, 12, and 14 under 35 U.S.C. § 103(a) as unpatentable over Burney and Fassuliotis.

We affirm the rejection of claims 8 and 9 under 35 U.S.C. § 103(a) as unpatentable over Burney and Mahlmann.

We reverse the rejection of claim 15 under 35 U.S.C. § 103(a) as unpatentable over Burney, Fassuliotis, and Malmin.

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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