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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* PAUL A. SCIRICA, HENRY E. HOLSTEN, BRIAN CRESTON,  
FRANK J. VIOLA, and KEITH L. MILLIMAN

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Appeal 2011-008296  
Application 11/374,573  
Technology Center 3700

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Before TONI R. SCHEINER, DONALD E. ADAMS, and  
LORA M. GREEN, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 16-23 and 26. We have jurisdiction under 35 U.S.C. § 6(b).

## STATEMENT OF THE CASE

The invention relates to an “adjustable gastric band configured to be positioned about a portion of the digestive tract of the patient, a driver assembly operatively associated with the gastric band and a transmission assembly configured to affect movement between the driver assembly and the adjustable gastric band” (Spec. 2). The Specification teaches:

The driver assembly includes an internal component or driver configured to be positioned within the patient and an external component or key operatively associated with the internal component. The external component is configured to transdermally move the internal component. The external and/or internal components include one or more magnetized members so as to affect movement of the internal component in response to movement of the external component. In one embodiment, both the internal and external components include one or more magnetized members of opposing polarities. The internal component is rotatably mounted within a housing. Manual rotation of the external component when positioned adjacent the internal component causes the internal component to rotate within the housing.

(*Id.*) The Specification teaches that the drive assembly may “contain a plurality of magnets that can be oriented in various ways both symmetrically and/or asymmetrically” (*id.* at 7).

Claim 16 is the only independent claim on appeal, and reads as follows:

16. A transdermally operated gastric banding assembly comprising:  
an adjustable gastric band comprising slots disposed along the circumference of the gastric band;  
a drive assembly having an internal component and an external component, the external component being spaced from the internal

component and being movable to effect corresponding movement of the internal component; and

a transmission assembly for transferring movement of the internal component to the adjustable gastric band,

wherein the external component effects movement of the internal component by a magnetic force,

wherein the internal component and the external component include at least two magnetized fingers which are oriented relative to each other such that the internal component and external component so configured will only function together,

wherein the external component acts as a key to effect movement of the internal component within the body,

wherein the gastric band is configured to retain a substantially circular configuration as the gastric band moves between an expanded position and a contracted position,

wherein the at least two magnetized fingers of the internal and external components includes at least three magnetized fingers having different polarities, and

wherein the at least three magnetized fingers are oriented asymmetrically about a circumference of the internal or external component.

The following ground of rejection is before us for review:

Claims 16-23 and 26<sup>1</sup> stand rejected under 35 U.S.C. § 103(a) as being rendered obvious by the combination of De Bennetot,<sup>2</sup> Dargent,<sup>3</sup> and Sohn.<sup>4</sup>

We affirm.

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<sup>1</sup> The statement of the rejection includes claim 15 (Ans. 4), but claim 15 has been cancelled (App. Br. 9).

<sup>2</sup> De Bennetot, US 3,749,098, issued July 31, 1973.

<sup>3</sup> Dargent et al., US 6,547,801 B1, issued Apr. 15, 2003.

<sup>4</sup> Sohn, US 5,762,599, issued Jun. 9, 1998.

## ANALYSIS

The Examiner relies on De Bennetot for teaching a “transdermally operated gastric banding assembly” (Ans. 3). Specifically, relying on Figure 2 of De Bennetot, the Examiner finds that the patent teaches internal and external components that comprise at least three magnetized fingers which are oriented asymmetrically about a circumference (*id.* at 4).

The Examiner relies on Dargent for teaching a gastric band that comprises slots disposed along the circumference of a gastric band (*id.*).

The Examiner relies on Sohn for teaching “magnetically-coupled implantable medical devices comprising multiple magnets with opposite poles positioned adjacent to each other” (*id.* at 5).

The Examiner concludes “it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the band of De Bennetot with the mechanism of Dargent in order to provide a reliable, safe means of constricting a hollow organ” (*id.* at 4 (emphasis removed)). The Examiner concludes further that positioning the magnets by alternating polarities as taught by Sohn would have yielded predictable results (*id.* at 5).

Appellants argue Figure 2 of De Bennetot shows “four pole pieces 12-15 which are symmetrically positioned around a circumference of a driving rotor/driven rotor 16 with teeth 16a-16d” (App. Br. 11). Appellants assert that De Bennetot does not teach or suggest orienting the poles asymmetrically, and the use of the transitional phrase does not cure that deficiency (*id.* at 11-12). Appellants also assert that Dargent also does not teach that requirement of claim 16 (*id.* at 12).

The Examiner responds that independent claim 16 uses the transitional term of “comprising,” and thus even though the embodiment shown in Figure 2 of De Bennetot has four fingers, it “comprises” “at least three magnetized fingers ... which are oriented asymmetrically around a circumference” (Ans. 5). That is, the claim language does not “exclude the fourth magnetized finger of De Bennetot reference” (*id.*).

We conclude that the Examiner has established a prima facie case of obviousness. Our mandate is to give claims their broadest reasonable interpretation in view of the Specification. *In re American Academy Of Science Tech Center*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). “An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.” *In re Zletz*, 893 F.2d 319, 322 (Fed. Cir. 1989). In addition, “[i]n the patent claim context, the term ‘comprising’ is well understood to mean ‘including but not limited to.’” *CIAS, Inc. v. Alliance Gaming Corp.*, 504 F.3d 1356, 1360 (Fed. Cir. 2007).

Figure 2 of De Bennetot is reproduced below:

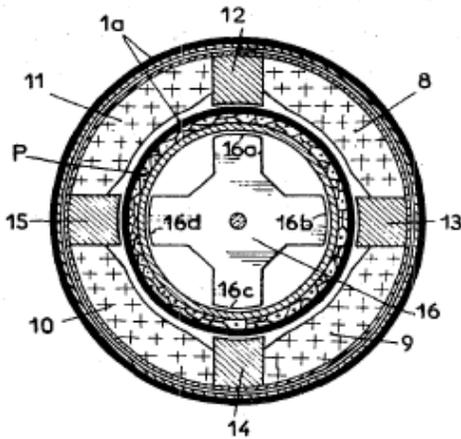


Fig-2

Figure 2 shows a driving rotor that has four permanent magnets 8-11 having pole pieces 12-15 that cooperate with teeth 16a to 16d of the driven rotor (De Bennetot, col. 2, ll. 22-25). While the four teeth 16a-16d are oriented symmetrically around the circumference, the driven rotor comprises “at least three magnetized fingers [that] are oriented asymmetrically about a circumference,” as required by claim 16. That is, any three of the teeth 16a-16d are oriented asymmetrically around the circumference. In addition, that interpretation is consistent with the present Specification, as the Specification teaches that the drive assembly may “contain a plurality of magnets that can be oriented in various ways both symmetrically and/or asymmetrically” (Spec. 7).

Appellants argue further that Sohn fails to teach or suggest “the limitations of ‘the internal component and the external component include at least two magnetized fingers which are oriented relative to each other such

that the internal component and external component so configured will only function together, wherein the external component acts as a **key** to effect movement of the internal component within the body ...” (App. Br. 16). Specifically, Appellants assert that Sohn discloses discs or cylinders having magnetic poles formed therein, and does not teach or suggest magnetized fingers that

are oriented relative to each other such that the internal component and external component so configured will only function together, wherein the external component acts as a **key** to effect movement of the internal component within the body, nor does Sohn disclose, teach or suggest at least three magnetized fingers that are oriented asymmetrically about a circumference of the internal or external component, as recited by claim 16.

(*id.* at 17-18).

The Examiner responds that “coupling the fingers of **De Bennetot** with sequential poles as shown by **Sohn** would facilitate the rotational engagement of the internal component and **Sohn** teaches that the ratio of the internal/external poles can vary depending on the desire torque and speed (Col 6, Lines 29-37)” (Ans. 6-7 (emphasis removed)).

We agree with the Examiner’s response. In addition, while Appellants emphasize the term “key,” they point to no definition in the Specification that limits the structure of either the internal component or the external component based on the use of that term. In fact, the Specification teaches that the driver assembly comprises an internal component positioned within the patient, and an external component or ‘key’ operatively associated with the internal component, which is “configured to transdermally move the

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internal component” (Spec. 2). Thus, all that is required is that the external component is operatively associated with the internal component, such that the internal component may be moved transdermally. That limitation is met by the combination as set forth by the Examiner.

#### SUMMARY

We affirm the rejection of claims 16-23 and under 35 U.S.C. § 103(a) as being rendered obvious by the combination of De Bennetot, Dargent, and Sohn.

#### TIME PERIOD FOR RESPONSE

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

cdc