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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GREGORY R. WHITTAKER,
GARY MCALISTER, and JASON HAMILTON

Appeal 2011-008497
Application 12/030,590
Technology Center 3700

Before LORA M. GREEN, MELANIE L. McCOLLUM, and
JEFFREY N. FREDMAN, *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 1-5, 10, 11, 16-18, and 20.¹ We have jurisdiction under 35 U.S.C. § 6(b).

¹ Claims 6-9, 12-15, 19, and 21-23 are also pending, but stand withdrawn from consideration (App. Br. 2).

STATEMENT OF THE CASE

Claims 1 and 11 are representative of the claims on appeal, and read as follows:

1. A surgical access device, comprising:
 - an elongate surgical access member having a lumen extending therethrough that is configured to receive a surgical tool;
 - a flexible sleeve member having a lumen extending therethrough that is configured to receive the elongate surgical access member; and
 - a substantially rigid collar member disposed adjacent to a proximal end of the flexible sleeve member and having a lumen extending therethrough that is configured to receive the elongate surgical access member, the collar member being movable relative to the elongate surgical access member to selectively configure the flexible sleeve member in a relaxed condition in which the flexible sleeve member has a relatively smooth outer surface and a compressed condition in which the flexible sleeve member has a plurality of protrusions formed on the outer surface that are configured to create a seal between the outer surface and tissue, each protrusion extending circumferentially around the flexible sleeve member, wherein the flexible sleeve member is normally in the relaxed condition and is configured to receive a compressive force to be configured in the compressed condition.

11. The device of claim 10, wherein the outer tissue-contacting surface contains threads configured to form a seal with tissue when a compressive force is applied to the deformable surgical access member.

The following grounds of rejection are before us for review:

- I. Claims 1-5, 10, 16-18, and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bonutti² (Ans. 3). Appellants only argue independent claims 1, 10, and 16 separately, and thus

² Bonutti, US 5,197,971, issued Mar. 30, 1993.

the dependent claims stand or fall with the claim on which they depend. 37 C.F.R. § 41.37(c)(1)(vii).

- II. Claim 11 stands rejected under 35 U.S.C. § 103(a) as being rendered obvious by the combination of Bonutti and Smith.³ (Ans. 6.)

We affirm.

ANALYSIS

Anticipation

The Examiner finds that Bonutti teaches all of the limitations of claim 1. Specifically, relying on Figures 7 and 8 of Bonutti, the Examiner finds that the surgical access member as taught by Bonutti has a flexible sleeve member, in which in the relaxed condition has a relatively smooth outer surface as shown in Figure 7 (Ans. 4). The Examiner finds further that the flexible sleeve member has a compressed condition as shown in Figure 8, wherein “the flexible sleeve member has a plurality of protrusions (shown at 62 in Figure 8) formed on the outer surface that are configured to create a seal between the outer surface and tissue, each protrusion (62) extending circumferentially around the flexible sleeve member” (*id.*)

As to claim 1, Appellants argue that Bonutti is drawn to a surgical retractor that is expandable within a body to allow for improved visualization of a surgical site (App. Br. 5). Appellants assert that while it comprises a plurality of hinged arms that expand outwardly to engage tissue,

³ Smith, US 2005/0119685 A1, published Jun. 2, 2005.

the arms provide multiple fluid pathways between the arms, thus preventing a seal against the tissue (*id.*). That is, according to Appellants, “[t]he arms do not create a seal against the tissue because of the large gaps in between each arm, nor is such required for their intended function” (*id.*).

Similarly, as to claims 10 and 16, Appellants argue that Bonutti fails to anticipate those claims as the disclosed device does not form a seal with the tissue.

Our mandate is to give claims their broadest reasonable interpretation consistent with the Specification as it would be interpreted by one of ordinary skill in the art. *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).

Claim 1 requires a “flexible sleeve member has a plurality of protrusions formed on the outer surface that are configured to create a seal between the outer surface and tissue, each protrusion extending circumferentially around the flexible sleeve member.” Claim 10 requires that the “the deformable surgical access member is configured to receive a compressive force to effect an increase in an outer diameter thereof to configure the outer tissue-contacting surface in a condition effective to form a seal with tissue at a plurality of axial locations along a length of the deformable surgical access member.” Finally, claim 16 is drawn to a method that requires a “flexible sleeve [that] includes surface features which

extend radially outward from the elongate surgical access member at a plurality of axial locations along a length of the flexible sleeve to form a seal with tissue at the plurality of axial locations along the length of the flexible sleeve.”

Appellants do not point to any definition of seal in the Specification. Seal may be defined as “to fasten or close tightly by or as if by a seal.”⁴ While claims 1, 10 and 16 require that the protrusions formed on the outer surface of the flexible sleeve create a seal between the outer surface and the tissue, the claims do not set forth any limitation as to how much of the circumference of the surgical access device need be sealed in such a manner. Stated differently, the claims only require that the protrusions form a seal, but the claims do not specify how much tissue is involved in or the extent of that seal.

⁴ seal. Dictionary.com. *Dictionary.com Unabridged*. Random House, Inc. <http://dictionary.reference.com/browse/seal> (accessed: February 28, 2013).

Figures 7 and 8 of Bonutti are reproduced below:

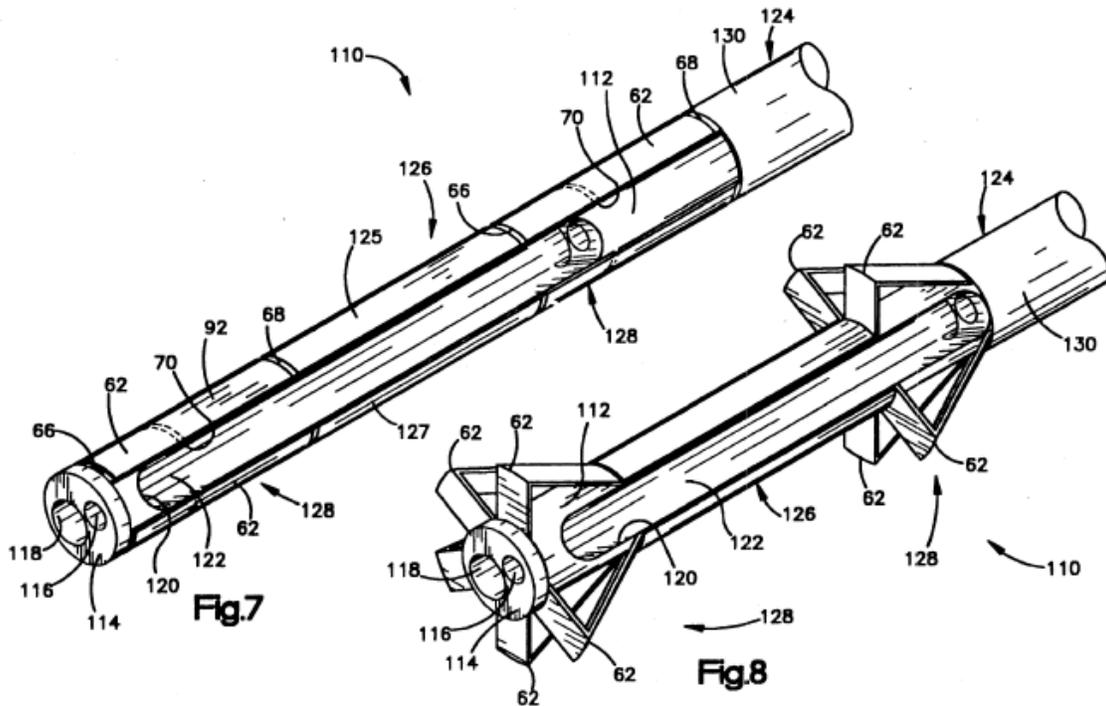


Figure 7 shows “a retractor having two axially expanding portions, shown in the unexpanded condition,” and Figure 8 show the same retractor in the expanded condition (Bonutti, col. 3, ll. 7-11). We agree with the Examiner (Ans. 7-8) that the arms 62 will form a seal with the tissue.

We thus conclude that the Examiner has established that independent claims 1, 10, and 16 are anticipated by Bonutti. Dependent claims 2-5, 17, 18, and 20 fall with those claims.

Obviousness

The Examiner relies on Bonutti as in the anticipation rejection, but finds that “Bonutti is silent on the specifics of the outer tissue-contacting surface containing threads configured to form a seal with tissue when a

compressive force is applied to the deformable surgical access member”
(Ans. 6).

The Examiner finds that “Smith discloses a surgical access device having a deformable surgical access member (24) having an outer tissue-contacting surface which contains threads (38) to retain the device in tissue such that the threads form a seal with the tissue (paragraph [0060])” (*id.*). The Examiner thus concludes that it would have been obvious to provide the outer tissue-contacting surface of the deformable surgical access member of Bonutti with threads as taught by Smith so that the deformable surgical access member may be retained better by tissue (*id.*).

Appellants argue that there is no reason to combine the references as suggested by the Examiner (App. Br. 6). Specifically, Appellants argue that even if it one did employ the threads of Smith on the retractor of Bonutti, they would not be located where the arms 62 expand, as that is designed to be inside the body cavity to expand the tissue for visualization, whereas the threads are positioned at the skin (*id.*). Appellants argue further that the threads have gaps between them, as the arms of Bonutti do, and thus would not form a seal, but would leave flow paths in between (*id.*).

We do not find Appellants’ arguments convincing. As to Appellants’ argument as to the lack of a seal, that argument has been addressed above with respect to the anticipation rejection. As to Appellants’ argument that one would not add the threads of Smith to the arms of the device of Bonutti, Smith teaches that not only may the threads be used to advance the apparatus, but, in the alternative, they may also be used to retain the apparatus in tissue (Smith, p. 3, ¶ 60). Thus, the ordinary artisan would have

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added the threads of Smith to the arms 62 of the surgical access device of Bonutti to allow for better retention of the device in tissue when in the expanded condition.

SUMMARY

We affirm the rejection of claims 1-5, 10, 16-18, and 20 under 35 U.S.C. § 102(b) as being anticipated by Bonutti; as well as the rejection of claim 11 under 35 U.S.C. § 103(a) as being rendered obvious by the combination of Bonutti and Smith.

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)(1)(iv).

AFFIRMED

cdc