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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KEVIN W. SMITH, THOMAS O. BALES,
MATTHEW A. PALMER, and DEREK DEE DEVILLE

Appeal 2014-006284¹
Application 12/266,226²
Technology Center 3700

Before KEVIN W. CHERRY, BRADLEY B. BAYAT, and
AMEE A. SHAH, *Administrative Patent Judges*.

SHAH, *Administrative Patent Judge*.

DECISION ON APPEAL³

The Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final decision rejecting claims 1–22. We have jurisdiction under 35 U.S.C. § 6(b).

¹ We note related appeals 2014-006185 (Application 12/266,252) and 2014-006350 (Application 13/539,694). *See* Appeal Br. 2.

² According to the Appellants, the real party in interest is “Medtronic, plc.,” the “ultimate parent” of assignee Covidien AG. Suppl. Info. filed Sept. 16, 2016; Tr. 4; Appeal Br. 2.

³ Throughout this opinion, we refer to the Appellants' Appeal Brief (“Appeal Br.,” filed Jan. 9, 2014), Reply Brief (“Reply Br.,” filed May 1, 2014), and Specification (“Spec.,” filed Nov. 6, 2008), and to the Examiner's Answer (“Ans.,” mailed Mar. 13, 2014) and Final Office Action (“Final Act.,” mailed Aug. 15, 2013).

The Appellants' representative appeared for oral hearing in this appeal on September 20, 2016 ("Hearing").⁴

We AFFIRM.

STATEMENT OF THE CASE

The Appellants' invention "relates generally to an ultrasonic cutting device and, more particularly, relates to a cordless, hand-held, fully electrically powered and controlled, surgical ultrasonic cutting device." Spec. ¶ 1.

Claims 1 and 14 are the independent claims on appeal. Claim 1 (Appeal Br. 27, Claims App.) is illustrative of the subject matter on appeal and is reproduced below (bracketing added for reference):

1. A disposable ultrasonic surgical handle, comprising:

[(a)] a disposable handle body defining a battery-holding compartment shaped to receive a battery therein and operable to couple a proximal end of an ultrasonic waveguide to a cordless ultrasonic transducer therethrough, the handle body having:

[(b)] a transducer dock exposed to the environment and shaped to interchangeably house at least a portion of the transducer thereat;

[(c)] a waveguide attachment dock shaped to align and attach the proximal end of the waveguide to the transducer and thereby hold the waveguide and the transducer at the handle body when the transducer is docked in the transducer dock and the waveguide is docked in the waveguide attachment dock;
and

[(d)] a disposable driving-wave generation circuit in the handle body and disposed to electrically contact the battery and the transducer when the battery and the transducer are disposed

⁴ Throughout this opinion, we refer to the transcript of the Hearing ("Tr.").

respectively in the battery-holding compartment and the transducer dock, the generation circuit operable to dynamically produce a resonant wave along the waveguide to thereby generate ultrasonic movement along the waveguide by exciting the transducer when the transducer is coupled to the waveguide.

REJECTIONS

Claims 1, 5–8, 10–13, 21, and 22 stand rejected under 35 U.S.C. § 101 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1–24 of U.S. Patent No. 8,419,757. Final Act. 3.

Claims 1–5, 7–9, 14–18, 21, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Houser (US 2006/0079878 A1, pub. Apr. 13, 2006), Sakurai (US 2004/0116952 A1, pub. June 17, 2004), and Kellogg (US 5,897,569, iss. Apr. 27, 1999). *Id.* at 5.

Claims 6 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Houser, Sakurai, Kellogg, and Bishop (US 5,954,736, iss. Sept. 21, 1999). *Id.* at 8.

Claims 13 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Houser, Sakurai, Kellogg, and Akagi (WO 2006/087885; with US 2008/0033248 A1, pub. Feb. 7, 2008, as the English language equivalent). *Id.* at 9.

Claims 10–12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Houser, Sakurai, Kellogg, and Denning (EP 1 594 209 A1, pub. Sept. 11, 2005). *Id.*

ANALYSIS

Double Patenting

The Appellants present no arguments against the Examiner's rejection of claims 1, 5–8, 10–13, 21, and 22 under 35 U.S.C. § 101 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1–24 of U.S. Patent No. 8,419,757. Thus, we summarily affirm the rejection.

Obviousness

The Appellants argue independent claims 1 and 14 as a group. *See* Appeal Br. 9. Claims 1 and 14 recite substantially similar limitations. We consider claim 1 as representative; claim 14 stands or falls with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner finds that Houser discloses the ultrasonic surgical assembly of claim 1 comprising a disposable handle body operable to couple an end of a waveguide to a transducer as partially recited by limitation (a), the handle body having a transducer dock, as recited by limitation (b), a waveguide attachment dock, as recited by limitation (c), and a driving-wave generation circuit operable to generate ultrasonic movement, as partially recited by limitation (d). *See* Final Act. 5. The Examiner finds Houser does not, however, disclose a handle body defining a battery-holding compartment, and the generation circuit being disposable, in the handle body, and electrically contacting the battery in the holding compartment and transducer in the dock, as partially recited by limitations (a) and (d). The Examiner cites to Sakurai to cure these deficiencies, finding that one of ordinary skill in the art would modify the device of Houser with the handle, compartment, battery, and circuit configuration of Sakurai “to enhance

portability of the ultrasonic instrument, and to efficiently merge the system into a light-weight, self-contained, hand-held, compact device.” *Id.* at 5–6 (citing Sakurai ¶¶ 7–13). The Examiner further finds that Houser and Sakurai do not disclose the generation circuit being operable to dynamically produce a resonant wave as partially recited by limitation (d). The Examiner cites to Kellogg to cure this deficiency, finding that one of ordinary skill in the art would modify the generation circuit of Houser and Sakurai with that of Kellogg “to increase the life and performance of the ultrasonic surgical device.” *Id.* at 6 (citing Kellogg, col. 1, l. 39–col. 2, l. 30).

The Appellants contend the Examiner’s rejection of claim 1 is in error because “the Examiner has failed to establish a prima facie case of obviousness as there is no teaching, no suggestion, and no motivation found” in Houser, Sakurai, and Kellogg “to arrive at each and every element.” Appeal Br. 9. Specifically, the Appellants argue that the Examiner’s rejection is in error because the Examiner relies on impermissible hindsight (*see id.* at 11, 15), and that one of ordinary skill in the art⁵ would not have been able to combine Houser, Sakurai, and Kellogg with predictable results (*see id.* at 15–20; *see also* Reply Br. 3–8 and Tr. 9, ll. 11–21). The Appellants argue

the combined teachings of Houser, Sakurai, and Kellogg do not render obvious the ultrasonic surgical handle of claim 1 and the ultrasonic surgical instrument assembly of claim 14, in which the handle body (1) defines a battery-holding compartment shaped to receive a battery, and (2) encloses a disposable driving-wave

⁵ We note the Appellants do not discuss the level of ordinary skill in the art. Thus, we do not consider the level of one of ordinary skill in the art at issue. But, regardless, the level of skill in the art is evidenced by the prior art of record. *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001).

generation circuit that is operable to dynamically produce a resonant wave along an ultrasonic waveguide.

Id. at 9–10 (emphases omitted).

After careful consideration and review of the arguments presented in the Appellants’ Appeal and Reply Briefs and Hearing, and of the Declarations,⁶ we disagree with the Appellants’ contention for at least the reasons discussed below.

To the extent the Appellants argue that the references are not analogous art because the references are “directed at solving very different problems” (Appeal Br. 15) and are not in the “applicable field of prior art” (*id.* at 21), we are not persuaded. *See In re Klein*, 647 F.3d 1343, 1348 (Fed. Cir. 2011) (discussing the two separate tests for determining whether the art is analogous: (1) whether the art is in the same field of endeavor and (2) if not in the same field, if the reference is “reasonably pertinent to the particular problem with which the inventor is involved”). The Appellants do not state what problems the references solve that are different than those solved by the Appellants’ invention. The Appellants also do not state what the “applicable” field of prior art should be, but simply state “the applicable field of prior art is defined by art that is far closer in similarity to the operational complexity – e.g., operating under resonance – and the power and voltage requirement of Appellants’ invention and the device of Kellogg.” Appeal Br. 21. The Appellants’ Specification does not specifically provide an “applicable field of prior art,” but, rather, that the

⁶ Declaration of Thomas O. Bales, Jr., dated Sept. 12, 2011 (hereinafter “Ex. A”); Dr. James F. Barter, dated Sept 13, 2011 (hereinafter “Ex. B”); and Thomas O. Bales, Jr., dated Oct. 4, 2012 (hereinafter “Ex. C”). Appeal Br. (Evid. App.).

invention “relates generally to an ultrasonic cutting device.” Spec. ¶ 1. The field of endeavor is determined “by reference to explanations of the invention’s subject matter in the patent application, including the embodiments, function, and structure of the claimed invention.” *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). Houser is similarly directed to “ultrasonic surgical instruments” that can be configured to permit cutting of tissue. Houser ¶ 10, Abstract. Sakurai is directed to a surgical instrument such as an ultrasonic knife, i.e., an ultrasonic cutting instrument. Sakurai ¶¶ 82, 83, Abstract. Kellogg is also directed to generating ultrasonic signals that are incorporated in surgical cutting instruments. Kellogg, col. 1, ll. 5–20. Thus, we find that the references are within the “applicable field of prior art” and are analogous art. *See Tyco Healthcare Group LP v. Ethicon Endo Surgery, Inc.*, 774 F.3d 968, 977 (Fed. Cir. 2014) (“The parties do not dispute that both the Davison patent and the Ethicon Prototype disclose ultrasonic surgical devices, a fact which situates them clearly within a common field of endeavor.”).

We also find unpersuasive the Appellants’ argument that

[d]ue to the fact that the motion induced in the devices and their control, or lack thereof, is vastly different between Sakurai and the Houser and Kellogg references, there is not the necessary teaching, suggestion, or motivation to a person of ordinary skill in the art that a combination of the references, in accordance with their predictable uses, could achieve the cordless handle of independent claims 1 and 14 of the present invention with any reasonable expectation of success.

Appeal Br. 20 (emphases omitted); *see also id.* at 15 (“because the motion induced in the devices and their control, or lack thereof, are very different, the teachings of the references are not properly combinable and the combination is achieved only through impermissible hindsight.”).

In support of this argument, the Appellants contend that prior to the invention, all known ultrasonic cutting devices like those of Houser and Kellogg used an electric cord plugged into an electric means due to the “relatively high voltage . . . required to drive a typical piezoelectric transducer” (Appeal Br. 16), and that the claimed invention “render[s] superfluous” the dependency on high voltage input power devices by using “low-voltage switching throughout the wave-forming process and amplification of the driving signal at a specific stage” (*id.* at 16–17 (emphasis omitted)). Additionally, the Appellants assert that the systems of Houser and Kellogg “focus on inducing efficient longitudinal movement of an ultrasonic surgical blade” (*id.* at 17), such that “[t]he feedback mechanisms and processing of the feedback occur solely in the bench-top generator” and “generation and control of the energy applied to the ultrasonic transducer as contemplated by Kellogg are highly complex.” *Id.* at 18. The Appellants argue, “[n]either Houser nor Kellogg describe or suggest operating these systems at battery voltages nor do they describe or suggest reducing all of the complex circuitry contained in the desktop generator down to a size that is solely resident within a handpiece of the surgical device,” (*id.*) and, thus, one of ordinary skill in the art would not combine Sakurai’s “simple” device with the “complex” device of Houser and Kellogg (*see id.* 18–20; *see also* Reply Br. 16–19).

To the extent the Appellants argue that Houser and Kellogg teach away from the invention, we are not persuaded. The Appellants’ statements that the prior art systems “focus on inducing efficient longitudinal movement of an ultrasonic surgical blade” (*id.* at 17) and “critical to the operation of Kellogg is the ability to establish, maintain and, if necessary,

reestablish operation of the ultrasonic scalpel at the system’s resonant frequency” (*id.* at 18) are not supported by sufficient evidence. Further, the Appellants do not provide sufficient evidence that either reference criticizes, discredits, or otherwise discourages the device being cordless. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

We note that the Appellants do not rebut the Examiner’s findings that Houser discloses a driving-wave generation circuit operable to generate ultrasonic movement (Final Act. 5) and that Kellogg discloses the generation circuit being operable to dynamically produce a resonant wave (*id.* at 6). The Appellants further do not rebut the Examiner’s reasoning for combining Houser and Kellogg. Rather, as noted above, the Appellants argue that Houser and Kellogg do not “describe or suggest operating these systems at battery voltages nor do they describe or suggest reducing all of the complex circuitry contained in the desktop generator down to a size that is solely resident within a handpiece of the surgical device,” (Appeal Br. 17–18), and thus, Sakurai’s “simple” device cannot be combined with the device of Houser and Kellogg. *See id.* at 18–20.

We find the Appellants’ argument unpersuasive at least because it is not commensurate with the scope of the claim. Claim 1 does not require a piezoelectric transducer, does not specify a particular voltage, nor does it recite limitations regarding low-voltage switching. Claims are to be given their broadest reasonable interpretation in light of the Specification, but limitations from the Specification are not read into the claims. *See In re Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1992); *see also In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998) (“The invention disclosed in [the]

written description may be outstanding in its field, but the name of the game is the claim.”).

Furthermore, the Appellants’ characterization of Kellogg’s operation that “[t]he feedback mechanisms and processing of the feedback occur **solely in the bench-top generator,**” and that “generation and control of the energy applied to the ultrasonic transducer as contemplated by Kellogg are highly complex,” (Appeal Br. 18) are statements not supported by factual evidence. Even *assuming arguendo* that Kellogg’s circuit is complex, the Appellants provide insufficient evidence regarding the required size of Kellogg’s or Houser’s circuit. We note that neither reference discusses the size or complexity of the generator circuit. Moreover, the claim does not recite any limitations regarding how complex or simple the circuit must be.

The Appellants also contend, in support of the argument,

in stark contrast to Houser and Kellogg, Sakurai actually teaches a relatively simple device that does not teach any methods or systems for controlling movement of a blade or shaft and does not even seek to establish resonance or to control any aspect of the movement of the ultrasonic blade or shaft at or near a resonant frequency. Sakurai is only concerned with the relatively simple ability to propagate energy to a distal treatment section of its instrument. In actuality, the operation the Sakurai device is no different from an ultrasonic toothbrush.

Id. at 18–19 (emphasis omitted). The Appellants assert that Sakurai does not mention a control system in the device’s handpiece, and that Sakurai has an open loop system with no means for altering the energy applied to the transducer as opposed to a “complex closed-loop feedback system operating internally by the battery and circuitry of the device.” *Id.* at 19–20.

We are not persuaded at least because, as noted above, the Examiner relies on Sakurai for having an ultrasonic cutter with a handle body

containing within it a battery, a battery compartment, and, in combination with Houser, teaches a disposable drive-wave generation circuit (*see* Final Act. 6; *see also* Ans. 12); Kellogg is relied on for modifying the circuit of Houser and Sakurai to produce a resonant wave, i.e., to modify the circuit of Houser and Sakurai to be “complex enough” to produce resonant waves. *See id.* The test for obviousness is not whether the features of Sakurai may be bodily incorporated into the structure of Houser, but what the combined teachings of Houser, Sakurai, and Kellogg suggest to one of ordinary skill in the art. *See Keller*, 642 F.2d at 425; *see also In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973) (“Combining the teachings of references does not involve an ability to combine their specific structures.”).

Furthermore, the argument is not commensurate with the claim. Claim 1 does not recite limitations regarding “a complex closed-loop system.” Claim 1 also does not require a “control system” nor that the device must be “complex” and cannot be “simple.” *Cf.* Appeal Br. 1819 (arguing that Sakurai’s device is simple and does not teach a control system in the handpiece). We disagree with the Appellants’ assertion that one of ordinary skill in the art would understand the limitation regarding dynamically producing a resonant wave to incorporate a piezoelectric transducer, maintain a particular voltage or resonance, low-voltage switching, or monitoring the motional current and being able to change input in response thereto. *See* Appeal Br. 16–19 *and* Tr. 12–15. The Specification discusses that frequency, current, and voltage must be controlled “dynamically” (Spec. 2), that the battery can dynamically change its power output (*id.* at 44), and that the “total power output needs to be adjusted dynamically” (*id.*). However, the Specification does not provide a specific

definition of “dynamically” or a description of the term such that one of ordinary skill in the art would understand the limitation of dynamically producing a resonant wave to incorporate a specific voltage, complexity, or switching.

We further find unpersuasive the Appellants’ assertion that “Sakurai simply does not contemplate the realm of complexity that is required for the **dynamic production of a resonant condition**” (Appeal Br. 20), because it is a statement without factual support. The Appellants do not point to, nor is it clear, where Sakurai contemplates or even discusses the complexity or simplicity of its device.

The Appellants further submit evidence in the form of two Declarations by inventor Thomas O. Bales, Jr., (Exs. A and C) as evidence that there is “no reasonable expectation of success as set forth in MPEP 716C.⁷” Tr. 11, ll. 12–14; *see also* Reply Br. 2. The Appellants rely on these Declarations to show “the state of the art at the time of Appellants’ invention and the monumental and non-obvious engineering task in developing an ultrasonic surgical handle having a driving-wave generation circuit that is both cordless and capable of dynamically producing a resonant wave along an ultrasonic waveguide” (Appeal Br. 18 n.1), i.e., in support of the argument that it would not have been obvious at the time of the filing of the application for one of ordinary skill in the art to combine the references (*see* Tr. 9, ll. 11–24; *see also* Reply Br. 4).

⁷ The current MPEP, revision of November 2015, does not contain a section 716C, thus it not clear to what the Appellants are referring. For purposes of this appeal, we consider the Appellants to be referring to MPEP § 2143.02, requiring a reasonable expectation of success. *See* Reply Br. 2.

We first note that we find unpersuasive the Appellants' arguments that the Examiner discounts the Declarations (*see* Reply Br. 3–5) and fails to give them “full consideration” (Tr. 16, ll. 16–23). The Examiner provides adequate reasoning as to why the Declarations are not persuasive. *See* Ans. 10–11. After further consideration of the Declarations, we agree that the Declarations are not persuasive to show nonobviousness.

Bales's Declarations are directed to references that are not the subject of the rejection on appeal. In the Declaration of September 12, 2011 (Ex. A), Bales states he “disagree[s] that it would have been obvious to a person of ordinary skill in the art to modify the corded ultrasonic device in *Bishop* with various features of the devices in *Vaitekunas* and *Rabin*” (Ex. A ¶ 8), and directs further statements to the differences between that prior art and the invention (*see id.* ¶¶ 9, 35). Similarly, Bales's Declaration of October 4, 2012 (Ex. C) is directed to the combination of Houser and prior art Jewett⁸. *See* Ex. C ¶¶ 5–9, 12–15. However, the Examiner relies on the combination of Houser, Sakurai, and Kellogg as rendering the claims obvious. Thus, to the extent the Declarations are relied upon as evidence that one of ordinary skill in the art would not combine Houser, Sakurai, and Kellogg because

there is not the necessary teaching, suggestion, or motivation to a person of ordinary skill in the art that a combination of the references, in accordance with their predictable uses, could achieve the cordless handle of independent claims 1 and 14 of the present invention with any reasonable expectation of success

⁸ US 2002/0138090 A1; pub. Sept. 26, 2002.

(Appeal Br. 20 (emphasis omitted)), these Declarations are not probative because they do not deal with the specific prior art that was the subject of the rejections. *See In re Beattie*, 974 F.2d 1309, 1313 (Fed. Cir. 1992).

The Appellants further rely on Bales's Declaration statements that having a self-contained, self-powered, cordless, battery-powered, ultrasonic surgical cutting and cauterizing device exceeded "the electrical and mechanical capabilities that were available in the art at the time the invention was made" (Ex. A ¶ 8; Reply Br. 5) as support that the Examiner relies on hindsight (*see* Reply Br. 3). The Appellants argue that the Declarations provide sufficient evidence that others at the time the application was filed did not believe the combination of an ultrasonic cutting device that produces a resonant wave and is cordless was possible. *See* Reply Br. 5–7 and Appeal Br. 18; *see also* Tr. 12, ll. 3–7. In support thereof, the Appellants emphasize the necessity of "the generator/control box [of corded devices due to] significant power at a high voltage, along with significant signal processing, [being] required to operate the ultrasonic handpiece" (Reply Br. 5–6 (citing Ex. A ¶ 18)), the cost of the generator/control box (*id.* (citing Ex. A ¶ 13)), and the evolution in the devices requiring "complex circuitry and high-voltage power generation" (*id.* (citing Ex. A ¶ 15)); *see also* Tr. 12–17). However, as noted above, the claim does not require a specific complexity or voltage such that it would be clear to one of ordinary skill in the art that the ultrasonic cutting device of Houser could not be modified by Sakurai to be cordless and self-contained and by Kellogg to dynamically produce a resonant wave. The Declarations are not commensurate with the scope of the claim. *See In re Lindner*, 457 F.2d 506, 508 (CCPA 1972) ("It is well established that the objective

evidence of nonobviousness must be commensurate in scope with the claims.”). Thus, the Appellants’ argument, as supported by Bales’s Declarations, that the Examiner improperly relies on hindsight is not persuasive.

The Appellants also submit a Declaration of Dr. James F. Barter, M.D. (Ex. B) as evidence of the current state of the art (*see* Appeal Br. 10). Dr. Barter states that he reviewed the Appellants’ application and the prior art Bishop⁹ (Ex. B ¶ 8) that is not relied upon by the Examiner in the rejection of record. Dr. Barter also states:

Similar to the device described in *Bishop*, all ultrasonic laparoscopic surgical devices currently in use, as well as those that I have used in the past, to surgically cut and cauterize tissue during a procedure, include a sterile ultrasonic laparoscopic hand-held surgical instrument connected to a separate and relatively expensive, large, and heavy non-sterile generator box by a long cord.

Id. ¶ 9. However, Dr. Barter provides no evidence as to why one of ordinary skill in the art would not combine Houser, Sakurai, and Kellogg for the reasons identified by the Examiner. Thus, to the extent Dr. Barter’s Declaration is relied on as support for the argument that the Examiner improperly relies on hindsight (*see* Reply Br. 3), it is not persuasive.

Thus, we find the Examiner has established a *prima facie* case of obviousness as the Examiner has provided articulated reasoning with rational underpinning to support a legal conclusion of obviousness. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

The Appellants submit Dr. Barter’s Declaration (Ex. B) for the secondary consideration of long-felt need. *See* Reply Br. 8–11; *see also*

⁹ US 5,954,736; issued Sept. 21, 1999.

Tr. 11, ll. 16–18, 18, l. 17–19, l. 16, 23, ll. 21–25, 19, ll. 17–20. We have fully considered Dr. Barter’s Declaration provided in support of secondary considerations and, weighing all evidence of obviousness against all evidence of non-obviousness, we find the secondary considerations unpersuasive to rebut the prima facie obviousness determination.

We consider anew the issue of obviousness under 35 U.S.C. § 103, carefully evaluating and weighing both the evidence relied upon in finding obviousness and the evidence provided by the Appellants. *See In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir. 1983).

Dr. Barter discusses: (1) a desire to use laparoscopic instruments (Ex. B ¶ 4); (2) all such devices currently in use require cords (*id.* ¶ 9) and a non-sterilized generator box (*id.* ¶¶ 9, 12, 13); (3) the cords and box present logistical challenges (*id.* ¶¶ 1017); and (4) examining and using the Appellants’ prototype that “is a lightweight, cordless ultrasonic surgical cutting/cautery instrument that contains a battery, a transducer, and all of the circuitry necessary to provide the functionality of the generator box in a single hand-held device” that would solve those challenges (*id.* ¶ 18). Even assuming that Dr. Barter is factually correct about the need for a cordless, battery-operated surgical cutting instrument, Dr. Barter’s Declaration does not consider that Sakurai provides a solution in the form of a cordless, battery-operated surgical knife. *See Sakurai* ¶¶ 7–13, 83. Furthermore, we agree with the Examiner (*see* Ans. 11) that Dr. Barter’s Declaration does not provide “objective evidence that an art-recognized problem existed in the art for a long period of time without solution.” *Ex Parte Jellá*, 90 USPQ2d 1009, 1019 (BPAI 2008) (precedential). Thus, we find the secondary

consideration advanced by Dr. Barter's Declaration of long-felt need inadequate to establish nonobviousness. Therefore, we do not find the Appellants' evidence of secondary considerations outweighs the prima facie showing of obviousness.

Thus, we are not persuaded the Examiner's rejection of claim 1 is in error, and, therefore, we sustain the Examiner's rejection of independent claims 1 and 14. The Appellants provide no separate arguments against the rejection of claims 2–5, 7–9, 15–18, 21, 22, but rely on their dependency from claims 1 and 14. *See* Appeal Br. 22. Similarly, the Appellants rely on the arguments presented for claims 1 and 14 for the rejections of dependent claims 6, 10–13, 19, and 20 (*see id.* at 22–25). Therefore, for the same reasons we sustain the rejection of independent claims 1 and 14, we also sustain the rejections of dependent claims 2–13 and 15–22.

DECISION

The Examiner's rejection of claims 1, 5–8, 10–13, 21, and 22 under 35 U.S.C. § 101 on the ground of nonstatutory obviousness-type double patenting is AFFIRMED.

The Examiner's rejections of claims 1–22 under 35 U.S.C. § 103(a) as obvious are AFFIRMED.

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