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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRUCE JANKOWSKI and
JOSEPH RICHARD WITTMAN

Appeal 2014-008260¹
Application 13/571,290
Technology Center 3700

Before CHARLES N. GREENHUT, MICHAEL C. ASTORINO, and
MICHAEL L. HOELTER, *Administrative Patent Judges*.

HOELTER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is a decision on appeal, under 35 U.S.C. § 134(a), from a final rejection of claims 1–20. App. Br. 2. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Parent application number 10/540,197 was the subject of Appeal No. 2012-002364 in which the Examiner's rejections were affirmed. Thereafter, the application was amended and subsequently issued as U.S. 8,328,060 on December 11, 2012. App. Br. 1.

THE CLAIMED SUBJECT MATTER

The disclosed subject matter “relates to surgical instruments, e.g., surgical fastener or stapler apparatus and, more particularly to circular surgical staplers for performing surgical procedures.” Spec. ¶ 2. Claims 1 and 14 are independent claims. Claim 1 is illustrative of the claims on appeal and is reproduced below.

1. A surgical fastener applying apparatus comprising:
 - a body portion;
 - a shell assembly supported on a distal end of the body portion;
 - an anvil assembly movable in relation to the shell assembly between spaced and approximated positions, the anvil assembly comprising:
 - an anvil member; and
 - an anvil shaft extending proximally from the anvil member;
 - a vacuum channel extending into the anvil shaft; and
 - at least one opening in the anvil shaft at a location spaced proximally from the anvil member.

REFERENCES RELIED ON BY THE EXAMINER

Green	US 4,893,622	Jan 16, 1990
Sauer (“Sauer II”)	US 5,503,635	Apr. 2, 1996
Sauer (“Sauer I”)	US 5,839,639	Nov. 24, 1998

THE REJECTIONS ON APPEAL

Claims 1–5 and 12–20 are rejected under 35 U.S.C. § 103(a) as unpatentable over Sauer I and Sauer II.

Claims 6–11 are rejected under 35 U.S.C. § 103(a) as unpatentable over Sauer I, Sauer II, and Green.

ANALYSIS

*The rejection of claims 1–5 and 12–20
as unpatentable over Sauer I and Sauer II*

Appellants argue claims 1–5 and 12–20 together. App. Br. 3–11. We select claim 1 for review with claims 2–5 and 12–20 standing or falling with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Claim 1 includes the limitation of “at least one opening in the anvil shaft at a location spaced proximally from the anvil member.” The Examiner primarily relies on Sauer I for disclosing the limitations of claim 1 but relies on Sauer II for teaching openings that “are proximally spaced from an anvil along a longitudinal axis of the shaft.” Final Act. 2–3. The Examiner concludes that it would have been obvious to modify Sauer I with “openings axially along the anvil shaft in a proximal position relative to the anvil” as discussed in Sauer II. Final Act. 3. This is because Sauer II “states such a modification would allow tissue to be secured to the anvil shaft for the purpose of reducing operation time and ensuring effective fastening of the tissue with the surgical fastener and anvil assembly.”² Final Act. 3 (referencing Sauer II 16:56 – 17:5).

Appellants discuss the relative constructions of Sauer I and Sauer II, and the Examiner’s findings regarding these references, and also replicates several of the images from these references. App. Br. 3–7. After such discussion, Appellants contend that Sauer I “relates to a surgical stapler

² The Examiner further finds that Sauer II “clearly teaches the knowledge in the art of surgical instruments at the time of the invention to apply the technique of orienting vacuum openings on the shaft of an end member to yield the predictable result of securing tissue/organ(s) in place for subsequent compression by the surgical instrument.” Ans. 4.

apparatus” whereas Sauer II “relates to apparatus and method for performing circular end-to-end compression anastomoses.”³ App. Br. 7; *see also id.* at 10–11. In short, Appellants are arguing that the two devices are used for different medical procedures and that, as a consequence, “Sauer II actually teaches away from combination with Sauer I.”^{4,5} App. Br. 7.

We are instructed, “A reference does not teach away, however, if it merely expresses a general preference for an alternative invention but does not ‘criticize, discredit, or otherwise discourage’ investigation into the invention claimed.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1327 (Fed. Cir. 2009) (quoting *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004)). We are also instructed that simply because there are differences between two references, this is insufficient to establish that such references “teach away” from any combination thereof. *See In re Beattie*, 974 F.2d 1309, 1312-13 (Fed. Cir. 1992). In the matter before us, Appellants do not identify where Sauer II criticizes, discredits, or otherwise discourages investigation into the invention claimed. Thus, even should Sauer I and Sauer II address different vacuum techniques to close a body

³ Appellants do not allege that Sauer I and Sauer II are non-analogous art, instead, Appellants contend, “these devices function in substantially different ways.” Reply Br. 2.

⁴ Appellants contend (App. Br. 7) that Sauer II distinguishes over stapling-type devices by stating “One method of performing anastomoses involves the use of compression members,” and that “Another method of performing anastomoses” “involves the use of a circular stapling device.” Sauer II 1:18–19, 1:34–35.

⁵ Appellants also contend that the device of Sauer II does not “include any structure capable of receiving, storing, discharging, or applying surgical staples.” App. Br. 7. However, no such language is recited in claim 1 and further, the Examiner relies on Sauer I for disclosing “a surgical stapling apparatus.” Final Act. 2.

lumen, Appellants are not persuasive that such differences rise to the level of a teaching away such that Sauer I and Sauer II cannot be combined in the manner stated by the Examiner.

Appellants also assert that the Examiner's combination "would render Sauer I unsatisfactory for its intended purpose." App. Br. 3. This is because by relocating the vacuum holes as the Examiner suggests, "a substantial increase in the volume of tissue [would exist] that would have to be drawn into the snap cap pocket 104." App. Br. 9; *see also id.* at 8 and Reply Br. 2. In other words, the snap cap of Sauer I "would be unable to accommodate the increased volume of tissue" and that this "would interfere with, if not entirely prevent, proper operation of the Sauer I instrument." App. Br. 9.

Appellants provide no evidence to support this allegation or that any additional volume needed to accommodate an increase in tissue cannot be accomplished. Furthermore, Sauer I does not provide any indication as to the volume or quantity of tissue that can be engaged and captured between snap cap 106 and snap cap pocket 104, or that the presently disclosed volume is unable to handle additional tissue or that such volume is fixed and cannot be altered if needed. *See Sauer I* 7:40–41, 10:3–7. Accordingly, Appellants' argument regarding Sauer I being rendered unsatisfactory due to an increase in tissue volume is not supported by objective evidence nor is it otherwise self-evident from the record. We thus are not persuaded by Appellants' contention.

Appellants further argue that the instrument in Sauer I is "simply a positioning instrument utilized to orient the anvil assembly 20 within a tissue section to facilitate connection with a separate stapling instrument." App. Br. 10. However, claim 1 also appears to be directed to a positioning

instrument since claim 1 is devoid of any recitation to a connector or stapler, or its application, so as to render a connection.⁶ Thus, claim 1 is itself silent as to any stapling operation, and instead is directed to an anvil that may be moved, in addition to vacuum openings positioned with respect to the anvil. Accordingly, Appellants' contention that Sauer I is "simply a positioning instrument," is not persuasive the Examiner erred in combining Sauer I and Sauer II.

In view of the foregoing, we are not persuaded the Examiner erred in rejecting claims 1–5 and 12–20 as being obvious over Sauer I and Sauer II. We sustain the Examiner's rejection of these claims.

*The rejection of claims 6–11
as unpatentable over Sauer I, Sauer II, and Green*

Appellants do not present separate arguments challenging the Examiner's additional reliance on Green. App. Br. 11. Instead, Appellants contend that "the combination of Sauer I and Sauer II is improper" and consequently, "the combination of Sauer I, Sauer II, and Green is also improper." App. Br. 11.

Appellants' contention is not persuasive. We sustain the Examiner's rejection of claims 6–11 as being unpatentable over the combination of Sauer I, Sauer II, and Green.

⁶ Perhaps only claims 6–11 recite language directed to an actual stapling device and these claims are addressed below. However, the Examiner relies on Green for such teachings (Final Act. 4) and as indicated, Appellants do not dispute the teachings of Green.

Appeal 2014-008260
Application 13/571,290

DECISION

The Examiner's rejections of claims 1–20 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