



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,649	03/21/2007	Eric Abel	CAF-34702/03	7673
25006	7590	11/28/2016	EXAMINER	
DINSMORE & SHOHL LLP 900 Wilshire Drive Suite 300 TROY, MI 48084			BACHMAN, LINDSEY MICHELE	
			ART UNIT	PAPER NUMBER
			3731	
			NOTIFICATION DATE	DELIVERY MODE
			11/28/2016	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

doCKET@patlaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ERIC ABEL, JAMES R. HEWIT, ALAN P. SLADE,
and ZHIGANG WANG

Appeal 2015-000617
Application 10/561,649
Technology Center 3700

Before CHARLES N. GREENHUT, MICHAEL L. HOELTER, and
JEFFREY A. STEPHENS, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 1–14, 18–20, 22–26, 28 and 31–42. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

CLAIMED SUBJECT MATTER

The claims are directed to a rectal expander and method of its use.

Claim 1, reproduced below, with emphasis added, is illustrative:

1. A medical apparatus for location at least partly within a body passage and for expanding the body passage, the apparatus comprising:

a tubular guide member extending between a leading end and a trailing end, wherein the trailing end having an inlet providing access into the tubular guide member, the tubular guide member further having an aperture in a side wall thereof for permitting access into the body passage from the inlet at the trailing end;

a handle secured to the trailing end of the guide member;
an actuating device mounted to the handle rearwardly of the trailing end of the guide member; and

an expansion device comprising a pair of expansion arms extending along respective edge regions of the aperture, wherein one end of each arm is secured to the leading end of the guide member and an opposite end of each arm extends rearwardly of the trailing end of the guide member to engage the actuating device, wherein the arms are configured to be moved by the actuating device between a collapse position and an expansion position by controllably elastically deforming said expansion arms *to expand the body passage in the region of the aperture by pushing a wall of the body passage away from the tubular guide member*, the expansion arms being uninterruptedly separated by the aperture.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Adams	US 5,325,848	July 5, 1994
Bonutti	US 5,454,365	Oct. 3, 1995
Clement	US 5,797,907	Aug. 25, 1998
Fleischman	US 7,048,734	May 23, 2006
Lee	US 7,198,626	Apr. 3, 2007

REJECTIONS

Claims 1–9, 12, 14, 18–20, 22–26, 28, 31–39, 41, and 42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee and Clement.

Claims 10 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee, Clement, and Bonutti.

Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee, Clement, and Adams.

Claim 40 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee, Clement, and Fleischman.

OPINION

The critical limitation at issue, and italicized above, describes the function of the recited “expansion arms” in claim 1. Claim 34 recites a similar limitation as part of a manipulative step. Where an apparatus is defined in functional terms, as in claim 1, the pertinent question is: what does the recited function communicate to one skilled in the art about the claimed structure? *See, e.g., K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1363 (Fed. Cir. 1999). For purposes of claim 1, the limitation in question implies that the expansion arms are able to exert sufficient force, while maintaining sufficient rigidity, to perform the recited functions of “expand[ing] the body passage . . . by pushing a wall of the body passage away from the tubular guide member.” *See, e.g., Rowe v. Dror*, 112 F.3d 473 (Fed. Cir. 1997) (analyzing the structure implied by reciting the procedure “angioplasty”).

The description of the structure and process of Lee relied upon by the Examiner (Final Act. 3–4 (citing Lee, col. 7); Ans. 2–3 (citing Lee, cols. 2, 3, 7)) does not contain sufficient express disclosure to inform us as to

Appeal 2015-000617
Application 10/561,649

whether the active elements 206, regarded by the Examiner as the recited “expansion arms,” are structurally capable of performing the function recited in claim 1, or actually performing the corresponding manipulative step of claim 34. Thus, Appellants correctly characterize the Examiner’s position as being based on inherency and provide an accurate summary of the legal standards associated therewith, namely that the allegedly inherent characteristic must be necessarily present in the prior art. Reply Br. 2–3 (citing *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999)); *see also, e.g., In re Schreiber*, 128 F.3d 1473, 1477–78 (Fed. Cir. 1997).

We are not apprised of any evidence or reasoning to support the Examiner’s position that any of the processes described in the cited portion of Lee (col. 3, ll. 23–25), all of which involve using temperature changes to perform their respective functions, necessarily involve “expan[sion]” by “pushing [tissue] away.” *See* Ans. 3. Thus, on the record before us, the Examiner has failed to provide sufficient evidence or scientific reasoning to establish that there is a sound basis for the Examiner’s belief that the functional, or manipulative, limitations in question are satisfied by some inherent characteristic of the prior art device of Lee. *See In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990). Accordingly, the Examiner’s rejections cannot be sustained on the basis set forth by the Examiner.

DECISION

The Examiner’s rejections are reversed.

REVERSED