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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte FREDERIC H. MOLL

Appeal 2015-000806
Application 13/486,934
Technology Center 3700

Before LYNNE H. BROWNE, JILL D. HILL, and PAUL J. KORNICZKY,
Administrative Patent Judges.

BROWNE, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Frederic H. Moll (Appellant) appeals under 35 U.S.C. § 134 from the rejection of claims 30–33 under 35 U.S.C. § 103(a) as unpatentable over Humayun (US 6,800,076 B2, iss. Oct. 5, 2004), Hobart (US 6,743,221 B1, iss. June 1, 2004), and Wallace (US 2005/0222554 A1, pub. Oct. 6, 2005).¹ We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ We do not consider Appellant’s arguments pertaining to the drawing objections as these arguments pertain to petitionable, not appealable, matters and are not within the jurisdiction of the Board. *See* MPEP §§ 1002, 1201.

CLAIMED SUBJECT MATTER

Claim 30, reproduced below, is illustrative of the claimed subject matter:

30. A method for repairing a detached retina in a patient's eye, comprising:

 providing a robotic medical instrument system comprising a master input device, an instrument driver, a flexible sheath, and a guide instrument coaxially coupled within a working lumen of the flexible sheath;

 the instrument driver configured to independently control movement of the guide instrument relative to the flexible sheath;

 robotically extending the guide instrument out of a distal tip of the flexible sheath and into the vitreous body of the eye, the guide instrument comprising an elongate flexible body having a proximal end, a distal end, an image capture device, and an end effector coupled to the distal end;

 robotically maneuvering, steering and/or rotating the guide instrument relative to the flexible sheath while the distal end of the guide instrument is in the vitreous of the eye;

 pushing the detached retina toward the wall of the eye using the guide instrument under robotic control;

 robotically positioning the end effector at the area of the detached retina; and

 engaging the instrument driver to maneuver the end effector and repair the detached retina.

DISCUSSION

Appellant argues claims 30–33 together. *See* Appeal Br. 8–14. We select independent claim 30 as the representative claim, and claims 31–33 stand or fall with claim 30.

The Examiner finds that “Humayun teaches a method of treating retinal detachment including inserting a device; using the inserted device to push the retina back into place; and reattaching the retinal flap with a laser

fiber (see column 2, lines 5-10 and 19-21).” Final Act. 6. In addition, the Examiner finds that “Wallace et al teach a surgical method for internal surgery including a robotic manipulator, a steerable guide instrument and a catheter which are controlled by a master device (see Abstract), wherein the sheath and the guide instrument can be independently controlled” and “Hobart et al teach a surgical method which includes repairing a detached retina (see column8 [sic], lines 11–54) employing a flexible hosing including an optical fiber (see e.g. Figure 4, elements 433 and 419, respectively and column 10, lines 8–24).” *Id.* Based on these findings, the Examiner determines that it would have been obvious

to employ a method as taught by Hobart et al in the method of Humayun, since Humayun gives no details of the laser applicator that is suggested to be inserted his device, and since the flexible device of Hobart et al is more useful, due to its flexibility, or alternatively, to employ the method as taught by Humayun in the method of Hobart et al, since Hobart et al prefers that the eye be flushed with fluid (see column 7, lines 33-39), and employing the method of Humayun would require one less incision in the eye, which is desirable and in either case, to include the method of Wallace et al, since automating the method would reduce surgeon fatigue and increase patient safety, thus producing a method such as claimed.

Id. at 7.

Appellant argues that

[t]here is no teaching in Humayun that the body portion 2 is flexible, yet it is the body portion 2 that is inserted into the eye. Only the soft distal tip 8 is described in Humayun as being formed of a soft, flexible and resilient material (col. 5, 11. 18–26).

Appeal Br. 8. Appellant’s argument is not convincing because it is not responsive to the rejection as articulated by the Examiner, which relies upon Hobart to teach flexibility as discussed *supra*. See Final Act. 6–7.

Appellant further argues that “neither Hobart et al. nor Humayun teach or suggest a robotic medical instrument system comprising a master input device, an instrument driver, ‘an independently controllable robotic sheath instrument,’ and a guide instrument coaxially within a working lumen of the flexible sheath.” Appeal Br. 9. Again, Appellant’s argument is not responsive to the rejection as articulated by the Examiner which relies upon Wallace to teach these limitations. See Final Act. 6–7.

Next, Appellant argues that

there is no motivation for a person having ordinary skill in the art to employ the flexible housing 433 in Hobart et al. to the rigid body portion 2 of Humayun because a flexible tube or housing would give the physician less control of the distal tip 8 of Humayun.

Appeal Br. 9. However, this argument is foreclosed by *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), in which the Court rejected the rigid requirement of a teaching or suggestion or motivation to combine known elements in order to show obviousness. *KSR*, 550 U.S. at 415. The Court noted that an obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 418.

Furthermore, a given course of action often has simultaneous advantages and disadvantages, and this does not necessarily obviate any or all reasons to combine teachings. See *Winner Int’l Royalty Corp. v. Wang*,

202 F.3d 1340, 1349 n.8 (Fed. Cir. 2000) (“The fact that the motivating benefit comes at the expense of another benefit, however, should not nullify its use as a basis to modify the disclosure of one reference with the teachings of another. Instead, the benefits, both lost and gained, should be weighed against one another.”). Here the Examiner determines that the advantage of increased flexibility outweighs the loss in physical control. *See* Ans. 4–5. Appellant does not provide evidence or persuasive argument that one skilled in the art would be unable to determine the proper degree of flexibility while maintaining the needed physical control. Thus, Appellant’s argument is unconvincing.

In addition, Appellant argues that “Hobart et al. does not teach or suggest repairing a detached retina.” Appeal Br. 9. This argument is also not responsive to the rejection as articulated by the Examiner, which relies upon Humayun to teach this limitation. *See* Final Act. 6–7.

Then, Appellant argues that “[t]here is simply no motivation for a person having ordinary skill in the art to incorporate the robotic medical instrument system of Wallace et al. with the crude instruments disclosed in Hobart et al. and Humayun to repair a detached retina.” Appeal Br. 10. However, as discussed *supra*, this argument is foreclosed by *KSR*. To the extent that Appellant is arguing that the Examiner fails to articulate reasons for the proposed rejection, we note the reasoning quoted *supra*. Appellant does not explain why Examiner’s reasoning lacks rational underpinning. Thus, Appellant does not apprise us of error.

Finally, Appellant contends that “the prior art’s teachings undermine the reasons being proffered (by the Examiner) as to why a person of ordinary skill would combine the known elements” and discuss each of the references

separately. Appeal Br. 12–13. However, “[n]onobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures.” *See In re Merck & Co.* 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Appellant then describes the bodily incorporation of various components of Humayun, Hobart, and Wallace. *See* Appeal Br. 13–14. “[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review.” *In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983). The relevant inquiry is whether the claimed subject matter would have been obvious to those of ordinary skill in the art in light of the *combined teachings* of those references. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981). “Combining the *teachings* of references does not involve an ability to combine their specific structures.” *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973). Appellant does not explain why the teachings of Humayun, Hobart, and Wallace cannot be combined, and thus, do not apprise us of error.

For these reasons, we sustain the Examiner’s decision rejecting claim 30, and claims 31–33, which depend therefrom.

DECISION

The Examiner’s rejection of claims 30–33 is 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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED