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Row 1: 12/567.884, 09/28/2009, David Kirsch, H-US-01490 (203-6228), 5267
Row 2: 50855, 7590, 11/09/2016, EXAMINER POON, ROBERT
Row 3: Covidien LP, 555 Long Wharf Drive, Mail Stop 8N-1, Legal Department, New Haven, CT 06511, ART UNIT 3788, PAPER NUMBER
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID KIRSCH and GUIDO PEDROS

Appeal 2015-001284^{1,2}
Application 12/567,884
Technology Center 3700

Before ANTON W. FETTING, PHILIP J. HOFFMANN, and
KENNETH G. SCHOPFER, *Administrative Patent Judges*.

HOFFMANN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the rejection of claims 1–7 and 9–18. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

According to Appellants, the invention “relates to suture packages for receiving barbed sutures.” Spec. ¶ 2. Claim 1 is the only independent claim.

¹ Our decision references Appellants’ Specification (“Spec.,” filed Sept. 28, 2009), Appeal Brief (“Appeal Br.,” filed Apr. 28, 2014), and Reply Brief (“Reply Brief,” filed Oct. 29, 2014), as well as the Final Office Action (“Final Action,” mailed Nov. 29, 2013) and the Examiner’s Answer (“Answer,” mailed Aug. 29, 2014).

² According to Appellants, Covidien LP is the real party in interest. Appeal Br. 1.

See Appeal Br., Claims App. We reproduce claim 1, below, as representative of the appealed claims.

1. A suture package comprising:

a suture retaining member including an outer wall and an inner wall, the inner wall being radially spaced from the outer wall and defining a suture retaining area therebetween,

wherein the inner wall defines a needle retaining area and includes at least one opening therein to permit reception of at least one suture therethrough, wherein the outer wall includes a plurality of inwardly extending tabs configured to engage a cover; and

a cover configured to be received within the outer wall of the suture retaining member and to selectively engage the inwardly extending tabs formed thereon, wherein the cover includes a tab to facilitate separation of the cover from the inwardly extending tabs of the suture retaining member, the tab extending beyond the outer wall when the cover is selectively engaged by the inwardly extending tabs.

Id.

REJECTIONS AND PRIOR ART

The Examiner rejects the claims as follows:

claims 1–6, 10–13, and 16–18 under 35 U.S.C. § 103(a) as unpatentable over Sobel (US 4,967,902, iss. Nov. 6, 1990) (“Sobel ’902”) and Gordon (US 4,433,808, iss. Feb. 28, 1984);

claim 7 under 35 U.S.C. § 103(a) as unpatentable over Sobel ’902, Gordon, and Sobel (US 5,655,652, iss. Aug. 12, 1997) (“Sobel ’652”);

claim 9 under 35 U.S.C. § 103(a) as unpatentable over Sobel ’902, Gordon, and Bowen (US 5,657,894, iss. Aug. 19, 1997); and

claims 14 and 15 under 35 U.S.C. § 103(a) as unpatentable over Sobel '902, Gordon, and Daniele (US 5,628,395, iss. May 13, 1997).

See Answer 2–6.

ANALYSIS

Based on our review of the record, for the reasons discussed in detail below, we do not sustain the Examiner's obviousness rejections of the claims.

With respect to the rejection of claim 1, the Examiner determines the following:

Gordon discloses a cover (30) and container (12) combination and in particular discloses a closure arrangement wherein the cover and container are attached by the cover (30) being received within the cover and held down by inwardly extending tabs (45) extending inward from the vertical wall (108), the cover further comprising a pull tab (36) that lifts the cover from the container. One of ordinary skill in the art would have found it obvious to substitute one closure arrangement for the other. In the instant case, rather than using apertures and posts to engage the cover (190) and container (210) of Sobel, based upon the teaching of Gordon, one of ordinary skill in the art would have found it obvious to engage the cover and container of Sobel by incorporating inwardly extending tabs on the outer wall of Sobel and a pull tab on the cover of Sobel such that the cover and container are engaged through the tabs holding the cover down and disengaged through the use of the pull tab as the use of a pull tab facilitates access to the contents (Gordon, col. 2, ll. 40[–]50).

Answer 7. Thus, in accordance with the Examiner's proposed combination, Gordon's "inwardly extending tabs (45)" are placed on Sobel '902's "outer wall." *See id.* The Examiner does not identify, specifically, what structure in Sobel '902 corresponds to the outer wall. Regardless, even if we agree with the Examiner that Sobel discloses a cover and an outer wall, the

Examiner does not rely on Sobel '902 to teach the cover received within the outer wall, as required by claim 1. *See id.* at 2–3, Claims App. Thus, it is not clear how adding Gordon's tabs to any outer wall in Sobel '902, as proposed by the Examiner (*see id.* at 7), would result in the claimed "cover configured to be received within the outer wall of the suture retaining member" (Appeal Br., Claims App.). Therefore, we agree with Appellants that "Sobel '902 in view of Gordon fails to disclose a cover for a suture package [which] is received within the outer wall of a suture retaining member." *Id.* at 3; *see also id.* at 4.

Notwithstanding the above discussion, we determine that the Examiner's reason for combining the references lacks the required rational underpinning. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). More specifically, as discussed above, the Examiner determines that

[i]n the instant case, *rather than using apertures and posts to engage the cover (190) and container (210) of Sobel*, based upon the teaching of Gordon, one of ordinary skill in the art would have found it obvious to *engage the cover and container of Sobel by incorporating inwardly extending tabs on the outer wall of Sobel* and a pull tab on the cover of Sobel such that the cover and container are engaged through the tabs holding the cover down and disengaged through the use of the pull tab *as the use of a pull tab facilitates access to the contents*.

Answer 7 (emphases added). Thus, while the Examiner's reasons for combining the references address why it would have been obvious to use Gordon's pull tab in Sobel '902's arrangement, the Examiner's reasons do not address why it would have been obvious to use Gordon's inwardly extending tabs in Sobel '902's arrangement.

Thus, based on the foregoing, we do not sustain the obviousness rejection of claim 1. Inasmuch as the Examiner does not rely on any other

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reference to remedy the above-discussed deficiencies in the rejection of claim 1, we do not sustain any of the obviousness rejections of claims 2–7 and 9–18 that depend from claim 1.

DECISION

We REVERSE the Examiner’s obviousness rejections of claims 1–7 and 9–18.

REVERSED