



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

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
13/743,527 01/17/2013 John Lipchitz SNI13-38(PT-2730-US-CNT)2 5132

100935 7590 02/23/2018

Dickinson Wright
Smith & Nephew, Inc.
7000 W. William Cannon Drive
Building 1
Austin, TX 78735

Table with 1 column: EXAMINER

HIGHLAND, RACHEL S

Table with 2 columns: ART UNIT, PAPER NUMBER

3731

Table with 2 columns: NOTIFICATION DATE, DELIVERY MODE

02/23/2018

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):

- dwpatents@dickinsonwright.com
Patents.Dept.US@smith-nephew.com
Brandi.Aiken@smith-nephew.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOHN LIPCHITZ, JUSTIN DYE,
ALFRED RODRIQUE BERUBE JR., and PAUL ALEXANDER TORRIE
(APPLICANTS: SMITH & NEPHEW, INC.)

Appeal 2017-002886
Application 13/743,527¹
Technology Center 3700

Before DONALD E. ADAMS, JOHN G. NEW, and
DEVON ZASTROW NEWMAN, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134(a) involves claims 1–7, 10, 11, and 13 (Final Act.² 1). Examiner entered rejections under 35 U.S.C. § 103(a).

We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ Appellants identify the real party in interest as “Smith & Nephew” (App. Br. 3).

² Office Action mailed January 29, 2016.

STATEMENT OF THE CASE

Appellants' disclosure "relates to a cannula used for arthroscopic, endoscopic, or laproscopic surgery" (Spec. ¶ 2). Claim 1 is representative and reproduced below:

1. A medical assembly, comprising:

a cannula, the cannula including *a proximal portion, a stopcock portion, a threaded distal portion, a tapered distal end with a longitudinal bore or lumen extending the length of cannula, the stopcock portion including a port for attachment to a source of fluid aspiration or suction and a manually actuatable valve for controlling an amount of fluid flow or suction;*

an annular shoulder between the proximal portion and the stopcock portion for forming a fluid-tight seal with a sealing cap removably coupled to cannula: and

a shaft received within the cannula and the sealing cap, the shaft including a tapered, threaded distal end that extends beyond the tapered distal end of the cannula, and a proximal handle that abuts against sealing cap.

(App. Br. 13 (emphasis added); *see id.* at 14–15 (the medical assembly of Appellants' only other independent claim, claim 13, requires, *inter alia*, "an *annular shoulder between the proximal portion and the stopcock portion for forming a fluid-tight seal with a sealing cap removably coupled to [a] cannula*" (emphasis added)).)³

³ We note that in response to a Notice of Non-Compliant Appeal Brief, mailed August 10, 2016, Appellants replaced pages 13–15 of their Appeal Brief (*see* Appellants' Response to Notice of Non-Compliant Appeal Brief).

The claims stand rejected as follows:

Claims 1–4, 10, and 13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Stouder '344⁴ and Blake.⁵

Claims 5 and 7 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Stouder '344, Blake, and Hunt.⁶

Claim 6 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Stouder '344, Blake, Hunt, and Clarke.⁷

Claim 11 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Stouder '344, Blake, and Flatland.⁸

ISSUE

Does the preponderance of evidence relied upon by Examiner support a conclusion of obviousness?

ANALYSIS

Stouder '344 “generally relates to cannulas and trocars used to puncture tissue for the performance of laparoscopic or anthroscopic surgery and, more particularly, to an adjustable length cannula and trocar” (Strouder

⁴ Stouder, Jr., US 5,882,344, issued Mar. 16, 1999.

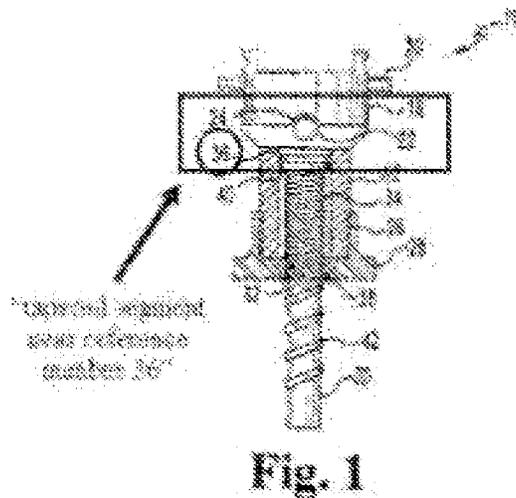
⁵ Blake, III, US 5,720,730, issued Feb. 24, 1998.

⁶ Hunt et al., US 5,273,545, issued Dec. 28, 1993.

⁷ Clarke, WO 99/21601, published May 6, 1999.

⁸ Flatland et al., US 5,752,938, issued May 19, 1998.

'344 1: 5–8). Stouder '344's figure 1, as annotated by Examiner, is reproduced below:



(Ans. 3). “Fig. 1 is a partial cross-sectional side view of a first embodiment [on an] adjustable cannula of [Stouder '344's] . . . invention,” annotated by Examiner to identify what Examiner considers to represent a “tapered segment near reference number 36” (*see* Ans. 3; Stouder '344 3: 2–4). Examiner finds “that the tapered portion near [element] 36,” of Stouder '344's Fig. 1, specifically “the top of the tapered section above reference number 36,” corresponds to Appellants' “claimed annular shoulder” (Ans. 2–3).

Examiner finds that Stouder '344 “does not explicitly teach a stopcock portion; however Stouder ['344] mentions . . . [Stouder '362⁹] and states the *side* is preferably constructed in accordance with the teachings of . . .

⁹ Stouder, Jr., US 5,350,362, issued Sept. 27, 1994.

[Stouder '362]" (Final Act. 3 (emphasis added)). For clarity, Stouder '362's Figure 1 is reproduced below:

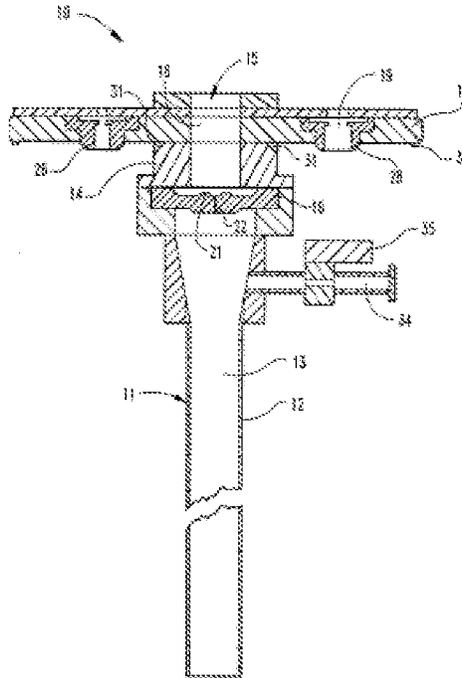


Fig. 1

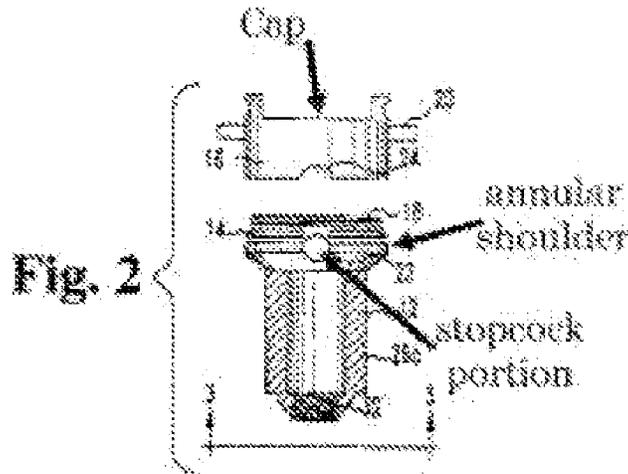
Stouder '362's "FIG. 1 is a side cross-sectional view of [a] cannula . . . according to one embodiment" of Stouder '362's disclosure (Stouder '362 2: 48–49 (emphasis removed)). In this regard, Examiner finds that Stouder '362 discloses a device comprising "a stopcock portion (34&35) including a port (34) for attachment to a source of fluid aspiration or suction and a manually actuatable valve (35) for controlling an amount of fluid flow or suction (Final Act. 3 (citing Stouder '362 5: 40–48)). "It is [] [E]xaminer's position that the teachings of [Stouder '362] . . . are included in [Stouder '344] . . . and that as such . . . [Stouder '344's] disclosure teaches a stopcock" (Final Act. 3). In the alternative, Examiner reasons that "it would have been obvious to one of ordinary skill in the art at the time of [Appellants'] invention to include a valve and stopcock as taught by . . .

[Stouder '344, because] such arrangements [were] known and widely used in the art” (*id.*).

Examiner further reasons that because Stouder '344 discloses “an annular shoulder (tapered segment near reference number 36) between the proximal portion and the stopcock portion[,] []it is [] [E]xaminer’s understanding that the stopcock and valve would be located below this feature” (*id.* at 3–4 (citing Stouder '362, Fig. 1)). We are not persuaded.

Notwithstanding Examiner’s assertion to the contrary, Stouder '344 makes reference to Stouder '362 in the context of a “slide 20” at the top of the device illustrated in Stouder '344’s Fig. 1, which “contain[s] a plurality of secondary seals of various sizes in order to accommodate instruments of varying diameter which may be passed through the adjustable length cannula 10” (Stouder '344 4: 24–31 (emphasis omitted)). Although, Stouder '344 discusses an optional “body member . . . that includes side port 22,” Stouder '344 does *not* make reference to, or otherwise incorporate, Stouder '362 to further support this feature of Stouder '344’s device (*see id.* at ll. 31–36). Nevertheless, Examiner finds, with reference to Stouder '344, that the annular shoulder of Stouder '344’s device “is located between the bottom most portion of the side port (22) (i.e. stopcock portion) and the proximal portion of the device” (Ans. 3; *see also id.* (Examiner’s annotation of Stouder '344’s Fig. 1)). In this regard, Examiner finds that Appellants’ claims “do[] not require the entirety of the stopcock to be below the shoulder for the [annular] shoulder to be ‘between’ the proximal end and the stopcock” (Ans. 3). Instead, Examiner reasons, Appellants’ claims require that the “annular shoulder [is located] between the proximal portion and the stopcock *portion*” and “[t]hus, only a *portion* of [Appellants’] stopcock

needs to be located below the annular shoulder to meet the [requirements of Appellants'] claim" (*id.*). Thus, with reference to Examiner's annotation of Stouder '344's figure 2 (reproduced below), Examiner finds that "at least a portion of side port (22) is located below uppermost portion of the annular shoulder and thus the annular shoulder is 'between' the stopcock portion and the proximal end of the device" (Ans. 4).



Examiner annotates Stouder '344's "FIG. 2," which illustrates "a partial cross-sectional side view of a cap and body member of . . . [an] adjustable length cannula" to identify what Examiner considers to represent the cap, annular shoulder, and stopcock portion of Stouder '344's device (*see* Stouder '344 3: 5–7 (emphasis omitted); Ans. 4).

We are not persuaded. As Appellants make clear, Stouder '344 fails "to teach or suggest 'an annular shoulder between the proximal portion and the stopcock portion'" (App. Br. 11 (emphasis omitted)). In this regard, Appellants correctly contend that Examiner's conclusion of obviousness is based on an incorrect reading of Appellants' claimed invention, wherein "the stopcock portion overlaps with the annular shoulder" and, contrary to Appellants' claims "reads [on] 'an annular shoulder between the proximal

portion and a portion of the stopcock portion” (Reply Br. 2 (emphasis omitted)).

Examiner relies on Blake to disclose “a medical cannula which features a tapered distal end (Final Act. 4);” Hunt to disclose “a medical device with a sealing cap where the sealing member is ‘formed of a single, molded piece’” (*id.* at 6 and 7); Clarke to “disclose[] an inhalation device with a sealing ring” (*id.* at 7); and Flatland to disclose “a sealing member comprising a first portion surrounding the opening and being thickened to limit tearing in the first portion and a second portion surrounding the first portion being tapered down in thickness to increase flexibility” (*id.* at 8). Examiner, however, fails to identify a disclosure in any of Blake, Hunt, Clarke, or Flatland to make up for the foregoing deficiency in Stouder ’344 (*see e.g.*, App. Br. 11 and 12).

CONCLUSION OF LAW

The preponderance of evidence relied upon by Examiner fails to support a conclusion of obviousness. The rejections of record are reversed.

REVERSED