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13/083,719	04/11/2011	Maria Benson	14.049011	8760
122617	7590	01/29/2019	EXAMINER	
Merchant & Gould Hologic P.O.Box 2903 Minneapolis, MN 55402			PELLEGRINO, BRIAN E	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MARIA BENSON

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Appeal 2017-011771  
Application 13/083,719<sup>1</sup>  
Technology Center 3700

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Before MURRIEL E. CRAWFORD, MICHAEL W. KIM, and  
PHILIP J. HOFFMANN, *Administrative Patent Judges*.

HOFFMANN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant appeals from the Examiner's final rejection of claims 1, 6, 10, 11, and 19–22. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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<sup>1</sup> According to Appellant, the “real party in interest is Hologic, Inc.” Br. 3.

According to Appellant, the invention relates to an “apparatus for securing a marker wire.” Spec. ¶ 3. Claim 1 is the only independent claim on appeal. Below, we reproduce claim 1 as illustrative of the appealed claims.

1. A medical imaging marking apparatus comprising:
  - a marker wire configured to mark a subcutaneous site;
  - a hub comprising:
    - a base member defining an inner cylindrical opening adapted to receive the marker wire and comprising:
      - a split tube segment comprising a relaxed outer diameter; and
      - an unsplit tube segment adjacent the split tube segment and comprising an unsplit outer diameter greater than the relaxed outer diameter and comprising a circular protrusion on an outer surface of the unsplit tube segment; and
    - a cylindrical fastener member adapted to receive the base member, wherein the cylindrical fastener member comprises:
      - an end defining an opening for receiving the split tube segment, wherein the cylindrical fastener opening comprises a diameter less than the relaxed outer diameter of the split tube segment, such that receipt of the split tube segment into the cylindrical fastener opening compresses the split tube segment so as to secure the marker wire; and
      - a circular detent disposed on an inner surface of the cylindrical fastener member.

## REJECTIONS AND PRIOR ART

The Examiner rejects claims 1, 6, 11, and 19–22 under 35 U.S.C. § 102(e) as anticipated by Taylor et al. (US 2012/0253410 A1, pub. Oct. 4, 2012) (“Taylor”).

The Examiner rejects claim 10 under 35 U.S.C. § 103(a) as unpatentable over Taylor and Myers (US 5,511,895, iss. Apr. 30, 1996).

## ANALYSIS

### Rejection under 35 U.S.C. § 102(e)

With respect to the anticipation rejection of independent claim 1, the Examiner finds that Taylor’s “Fig[ure] 20 shows the apparatus with the unsplit tube comprising a circular protrusion 1327 (paragraph 255) on the outer surface.” Answer 2; *see also* Final Action 5. In particular, the Examiner finds “that a thread [that] goes around the circumference can be considered [the claimed] ‘circular protrusion[,]’ since this terminology is unlimited in what one of ordinary skill in the art interprets as the feature.” Answer 5.

Appellant argues that the Examiner errs because threads are not circular, but instead are spiral. Br. 19. Thus, according to Appellant, Taylor does not disclose claim 1’s recitation of a *circular protrusion* on an outer surface of the unsplit tube segment. Br. 18–19. We agree with Appellant. Thus, we determine that the Examiner does not support adequately that Taylor’s thread discloses the claimed circular protrusion.

Based on the foregoing, we do not sustain the Examiner’s anticipation rejection of claim 1. We also do not sustain the Examiner’s anticipation rejection of claims 6, 11, and 19–22 that depend from claim 1.

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Rejection under 35 U.S.C. § 103(a)

Claim 10 depends from claim 1. The Examiner does not establish, on the record, that Myers remedies the above-discussed deficiency in claim 1's rejection. Therefore, we do not sustain claim 10's obviousness rejection based on Taylor and Myers.

DECISION

We REVERSE the Examiner's obviousness rejections of claims 1, 6, 10, 11, and 19–22.

REVERSED