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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte AJAY RANE

Appeal 2017-011832[1]
Application 14/041,774
Technology Center 3700

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

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 14, 15, 18, 20–24, and 26–28. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6.

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[1] The Appellant identifies Endo Pharmaceuticals, Inc. as the real party in interest. Appeal Br. 3.

The invention relates generally to surgical implants, insertion tools, kits, and assemblies for treating pelvic floor disorders related to levator avulsion. Spec. 4 lines 26–28.

Claim 14, the only independent claim on appeal, is illustrative:

> 14. A kit for treating a levator avulsion in a patient, the kit comprising:
>
> a first elongate implant comprising
>
> a support portion comprising an anterior end, a posterior end, a length extending between the anterior end and the posterior end, and a width, the length being greater than the width,
>
> a first end portion extending from the support portion, the first end portion having a proximal end connected to the anterior end of the support portion, and a distal end, a connector being attached to the distal end,
>
> a second end portion extending from the support portion, the second end portion having a proximal end connected to the posterior end of the support portion, and a distal end, a connector being attached to the distal end,
>
> a second elongate implant comprising
>
> a support portion comprising an anterior end, a posterior end, a length extending between the anterior end and the posterior end, and a width, the length being greater than the width,
>
> a first end portion extending from the support portion, the first end portion having a proximal end connected to the anterior end of the support portion, and a distal end, a connector being attached to the distal end,
>
> a second end portion extending from the support portion, the second end portion having a proximal end connected to the posterior end of the support portion, and a distal end, a connector being attached to the distal end,
>
> wherein each elongate implant includes the support portion and the first and second end portions, and no other elongate end portions extending from the support portion; and
>
> two insertion tools, each one comprising a needle comprising a helical curve, wherein the two needles comprise

different helical curves, one needle comprising a curve capable of creating a tissue path between a patient's left obturator foramen and a region of a levator avulsion on a patient's left side, the other needle comprising a curve capable of creating a tissue path between a patient's right obturator foramen and a region of a levator avulsion on a patient's right side, and

one insertion tool comprising a needle comprising a two-dimensional curve, the needle being capable of creating a tissue path between a perirectal incision and a region of a levator avulsion,

wherein each connector is capable of engaging an end of one of the needles, and the first implant is configured to extend between an anterior skin incision at the obturator foramen on one side of the patient and a perirectal skin incision on the same side, with the support portion of the first implant positioned to support tissue of the levator avulsion on the side of the patient, the first end portion of the first implant extending in an anterior direction through the anterior skin incision with the connector of the first end portion of the first implant being external to the patient, and the second end portion of the first implant extending in a posterior direction through the perirectal skin incision with the connector of the second end portion of the first implant being external to the patient; and the second implant is configured to extend between an anterior skin incision at the obturator foramen on an opposing side of the patient and a perirectal skin incision on the same opposing side, with the support portion of the second implant positioned to support tissue of the levator avulsion on the opposing side of the patient, the first end portion of the second implant extending in an anterior direction through the anterior skin incision with the connector of the first end portion of the second implant being external to the patient, and the second end portion of the second implant extending in a posterior direction through the perirectal skin incision with the connector of the second end portion of the second implant being external to the patient.

The Examiner rejected claims 14, 15, 18, 20–24, and 26–28 under 35 U.S.C. § 103(a) as unpatentable over Anderson et al. (US2006/0195007 A1, pub. Aug. 31, 2006) ("Anderson") and Cox et al. (US 2005/0245787 A1, pub. Nov. 3, 2005) ("Cox").

We AFFIRM.

ANALYSIS

Claims 14, 15, 20–24, and 26–28

We are unpersuaded by the Appellant's argument that neither reference discloses the multiple implants recited in independent claim 14, nor is any disclosed implant configured for placement on a single side of a patient, because Anderson discloses only a single sling designed to be used across both sides of a patient. Appeal Br. 10; *see also* Reply Br. 2.

Independent claim 14 recites two implants, but the recited limitations for each of the first and second implants are identical, and neither recites any specific physical characteristics, other than a length greater than a width, or characteristics that limit them to use on a single side of a patient. In this respect, the Appellant's arguments are not commensurate with the scope of the claim, which is broader than what is argued.

In addition, the Examiner finds Anderson discloses a sling that meets the claim language. *See* Final Act. 3–4. The Examiner further finds that the second implant, being identical to the first, is merely a duplication of parts that is patentably insignificant. *Id.* at 5. The Appellant does not challenge

this finding directly[2]. As such, the Appellant has not demonstrated any error with respect to the implants in the rejection.

We also are not persuaded by the Appellant's argument that Anderson's implant is not sized and/or shaped for placement to treat levator avulsion on one side of a patient. Appeal Br. 11. Although the Specification describes how the implant is used to support tissue, the Specification and claim language do not limit the size, shape, dimensions, material, or properties of the claimed implants. *See* Spec. 7 lines 2–5 and 19–26, 9 lines 1–4, and 11 lines 28–29 (cited at Appeal Br. 6). The argument is thus not commensurate with the scope of the claim, which is silent on the size and shape of the implants claimed.

Further, the Appellant argues the three-dimensional tools of Anderson are not sized and shaped to extend from a left (or right) obturator foramen and a region of a levator avulsion on either side of the patient, because they are for use on a "different tissue path." *Id.* at 11. We are not persuaded by the Appellant's argument.

Claim 14 recites:

> one needle comprising a curve capable of creating a tissue path between a patient's left obturator foramen and a region of a levator avulsion on a patient's left side, the other needle comprising a curve capable of creating a tissue path between a patient's right obturator foramen and a region of a levator avulsion on a patient's right side.

Neither the claim language nor the Specification describe the physical size or shape of the tools, other than their generally helical shape, nor what is necessary to be capable of creating the claimed tissue path. The Examiner

[2] An argument about duplication of parts is advanced only for dependent claim 18.

finds Anderson discloses multiple helical tools that meet the claim language. Final Act. 4. Although Anderson does not describe the same tissue path as claimed, the Appellant does not indicate, and we do not discern, the physical differences that would render Anderson's needles incapable of being used in the same tissue path as the broadly-claimed, helical needles.

We finally are unpersuaded by the Appellant's arguments that there is no reason given in Anderson and Cox to combine Cox's two-dimensional needles into the Anderson kit, and the Examiner's reason to avoid cross-contamination is not a valid reason because cross-contamination issues are not described in either reference. Appeal Br. 12.

To the extent Appellant seeks an explicit suggestion or motivation for a combination of parts in a reference itself, this is no longer the law in view of the Supreme Court's recent holding in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 419 (2007). Nonetheless, Anderson describes a reason for multiple copies of tools, to avoid contamination of tools through re-use. Anderson ¶ 205. In addition, the mere combination of familiar elements, such as the tools in each of Anderson and Cox, according to known methods, by including all in a single kit, is likely to be obvious when it does no more than yield predictable results. *KSR*, 550 U.S. at 416.

The Appellant has thus failed to demonstrate error in the Examiner's rejection of claim 14. For this reason, we sustain the rejection of claim 14, as well as of dependent claims 15, 20–24, and 26–28 that were not argued separately.

Claim 18

The Appellant argues that the four identical implants recited in dependent claim 18, which are also identical to the two recited in

independent claim 14, are not obvious based on the holding in *In re Harza*, 274 F.2d 669 (CCPA 1960), that, according to the Appellant, is "[a]ny modifications or benefits provided by duplicating parts overcomes such an obviousness rejection." Appeal Br. 12–13. The Appellant further argues that multiple implants may be needed at a single site for a patient with a levator avulsion that is larger than the width of a single elongate implant, and this benefit overcomes a mere duplication of parts. *Id.* at 13.

We are unpersuaded by the Appellant's arguments. The Appellant provides no specific cite in *Harza* to support the assertion that the mere duplication of parts is not obvious if there are modifications or benefits from the duplication. We disagree with this interpretation, because *Harza* instead states that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced. *Harza*, 276 F.2d at 671. Here, merely adding more implants so that a large avulsion can be treated is not a new or unexpected result, since any ordinary artisan would know that more implants would cover more area, or provide more strength, than a single implant. We discern nothing different from the duplication of implants in claim 18 from the duplication of implants in claim 14. For this reason, we sustain the rejection of claim 18.

DECISION

We affirm the rejection of claims 14, 15, 18, 20–24, and 26–28 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED