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Philip H. Burrus, IV Burrus Intellectual Property Law Group LLC 222 12th Street NE Suite 1803 Atlanta, GA 30309			NGUYEN, CAMTU TRAN	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARK SPENCER G. CHUA

Appeal 2018-000737
Application 13/489,811¹
Technology Center 3700

Before JENNIFER D. BAHR, STEFAN STAICOVICI, and
LEE L. STEPINA, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Mark Spencer G. Chua (“Appellant”) appeals under 35 U.S.C. § 134(a) from the Examiner’s decision in the Non-Final Office Action (dated Feb. 16, 2017, hereinafter “Non-Final Act.”) rejecting claims 1–15, 18, and 19.² We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We REVERSE.

¹ Medline Industries, Inc. is identified as the real party in interest in Appellant’s Appeal Brief (filed July 17, 2017, hereinafter “Appeal Br.”). Appeal Br. 2.

² Claims 16, 17, and 20 are cancelled. *See* Appeal Br. 28.

INVENTION

Appellant's invention is related "to a patient positioner suitable for use during surgery." Spec. para. 2.

Claims 1 and 18 are independent, are illustrative of the claimed invention, and read as follows:

1. A patient positioner, comprising:
a central portion;
a pair of shoulder restraints extending distally from a first side of the central portion, each shoulder restraint terminating at an attachment area comprising a fastener;
a pair of fasteners, each being complementary to the fastener, each disposed along the first side, and further disposed along a second and third side of the central portion, respectively; and
a plurality of securement straps configured to attach the patient positioner to a procedure table and extending distally from the second side and the third side of the central portion, respectively;
wherein the central portion defines a patient warming sensor insertion aperture.

18. A method of positioning a patient, comprising:
passing a patient warming sensor through an aperture in a patient positioner and attaching the patient warming sensor to a patient's backside;
placing the patient positioner along the patient's backside;
folding a first shoulder restraint about a patient's first shoulder;
wrapping a first attachment area extending from the first shoulder restraint about a first edge of the patient positioner to attach it to a side of the patient positioner facing away from the patient's backside;
folding a second shoulder restraint about a patient's second shoulder; and
wrapping a second attachment area extending from the second shoulder restraint about a second edge of the patient positioner to attach it to the side of the patient positioner facing away from the patient's backside.

REJECTIONS

- I. The Examiner rejects claims 1, 2, 7, 11, 12, and 14 under 35 U.S.C. § 103(a) as being unpatentable over White, Sr. (US 6,053,580, iss. Apr. 25, 2000, hereinafter “White) and Wootan (US 4,742,821, iss. May 10, 1988).
- II. The Examiner rejects claims 3–6 under 35 U.S.C. § 103(a) as being unpatentable over White, Wootan, and Van Pelt (US 3,297,026, iss. Jan. 10, 1967).
- III. The Examiner rejects claims 8–10 under 35 U.S.C. § 103(a) as being unpatentable over White, Wootan, and Cooley (US 2005/0236002 A1, pub. Oct. 27, 2005).
- IV. The Examiner rejects claim 13 under 35 U.S.C. § 103(a) as being unpatentable over White, Wootan, and Long (US 2,845,314, iss. July 29, 1958).
- V. The Examiner rejects claim 15 under 35 U.S.C. § 103(a) as being unpatentable over White, Wootan, and Yellen et al. (US 4,068,314, iss. Jan. 17, 1978, hereinafter “Yellen”).
- VI. The Examiner rejects claims 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over White, Wootan, and Patel (US 4,331,161, iss. May 25, 1982).

ANALYSIS

Rejection I

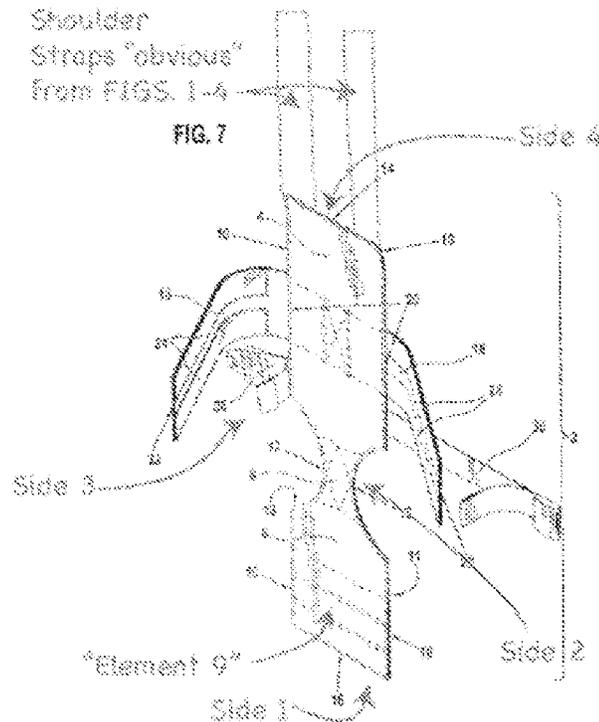
The Examiner finds that White discloses, in the embodiment of Figures 7 and 8, a patient positioner including, *inter alia*, a central portion 4, 6, a pair of fasteners 9, and a plurality of securement straps 36. Non-Final Act. 2–3.

However, the Examiner finds that White's embodiment of Figures 7 and 8 "lacks a pair of shoulder restraints," as called for by independent claim 1. Nonetheless, the Examiner notes that White discloses in the embodiment of Figures 1-4 "a pair of shoulder restraints (15) extending distally from *a first side (16)* of the central portion (4, 6), each shoulder restraint (15) terminating at an attachment area (3) comprising a fastener (5)." *Id.* at 3 (emphasis added); *see also* White, Fig. 1. The Examiner further finds that White's "Figure 2 further illustrates the pair fasteners (9), each being complementary to the fasteners (5), each disposed along the side (16)." *Id.* at 3. Thus, the Examiner concludes that

[I]t would have been obvious to modify the patient positioner in Figures 7-8 such that it includes a pair of shoulder restraints (15), taught by the embodiment of Figures 1-4, as . . . pair of fasteners (9), each being complimentary to the fasteners (5) as shown in Figure 2, as such features restrain patient's shoulders relative to the central portion (4, 6) during a supine position, which renders the combination a Trendelenburg positioner.

Id. at 4.

As shown below, Appellant provides an annotated Figure 7 of White, which, according to Appellant, illustrates the Examiner's modified positioner of White:



Appellant’s annotated Figure 7 of White illustrates fasteners 9 disposed adjacent first, second, and third side of the restraint and “obvious” shoulder straps (straps 15 from White’s Figures 1–4) disposed adjacent a fourth side of the restraint. *See* Appeal Br. 20.

Thus, Appellant argues that in the Examiner’s modified positioner of White “straps extend[] from, and complimentary fasteners [are] disposed adjacent to, **opposite sides** of a restraint.” *Id.* at 21. In contrast, according to Appellant, claim 1 requires that “straps extend[] from, and complimentary fasteners [are] disposed adjacent to, a **common side** of a positioner.” *Id.*

In response, the Examiner takes the position that although “[A]ppellant’s originally-filed [S]pecification has not defined [the term] **along**,” “Appellant’s Figure 5 illustrates [the] claimed limitations [of a] pair of fasteners (214, 215) **along** the first edge.” Examiner Answer (dated Oct. 3, 2017, hereinafter “Ans.”) at

13–14. Illustrated below is the Examiner’s annotated Figure 5 of Appellant’s Drawings showing a “first edge:”

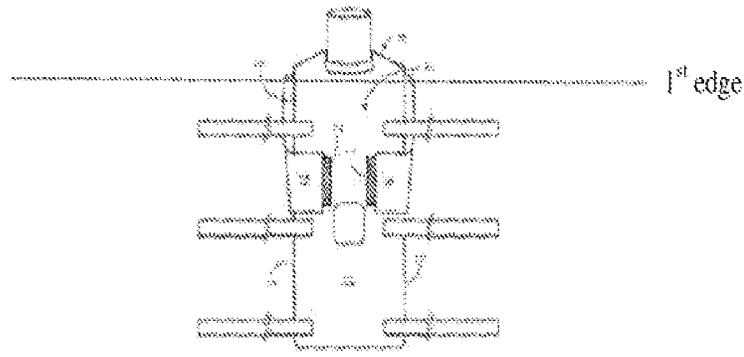


FIG. 5

The Examiner’s annotated Figure 5 of Appellant’s Drawings shows fasteners 214, 215 located along what the Examiner determines to be a first edge. *See id.* at 14. According to the Examiner, the “location of the fasteners 214, 215 **along** the first edge is interpreted to be less than the first edge.” *Id.* at 13–14.

It is not clear whether the Examiner interprets the claimed “first side” as the “first edge” illustrated above in the Examiner’s annotated Figure 5 of Appellant’s Drawings. Nonetheless, even assuming *arguendo* that such is the case, we do not agree that such an interpretation is reasonable in light of Appellant’s Specification and explicit claim language. The claimed “first side” in independent claim 1 is defined as a “side of the central portion” from which “a pair of shoulder restraints extend[] distally” and where “a pair of fasteners . . . [are] disposed along” it. *See* Appeal Br. 26 (Claims App.). Hence, in Appellant’s Figures 1 and 2, the claimed “first side” is a *boundary* of central portion 102 that is located near concave

curvature 142.³ Such a location satisfies all requirements of the claimed “first side,” namely, that it is a “side of the central portion [102],” “a pair of shoulder restraints [105, 106] extend[] distally” from it, and “a pair of fasteners [214, 215] . . . [are] disposed along” it. Accordingly, we do not agree with the Examiner’s position that the claimed “first side” is the “first edge” illustrated above in the Examiner’s annotated Figure 5 of Appellant’s Drawings.

We also do not agree with the Examiner’s finding that White’s bottom edge 16 constitutes the claimed “first side” (*see* Non-Final Act. 3) because shoulder restraints 15 in the Examiner’s modified positioner of White *overlap*, that is, extend *over*, bottom edge 16, and, thus, do not extend distally *from* bottom edge 16.⁴ *See* White, Fig. 2. Rather, shoulder restraints 15 extend distally *from* top edge 14, and, hence, bottom edge 16 is not the starting point of shoulder restraints 15. *Id.*, Fig. 1.

As such, White fails to disclose “a pair of shoulder restraints extending distally from a first side of the central portion” and “a pair of fasteners . . . each disposed along the first side,” as called for by independent claim 1. The Examiner’s use of the Wootan disclosure does not remedy the deficiency of the Examiner’s modification of White discussed *supra*. *See* Non-Final Act. 4.

Accordingly, for the foregoing reasons, we do not sustain the rejection under 35 U.S.C. § 103(a) of claims 1, 2, 7, 11, 12, and 14 as unpatentable over White and Wootan.

³ Appellant’s Specification refers to index number 107 as the “first side,” but we could not find it illustrated in any of Appellant’s drawings. *See* Spec. para. 29.

⁴ An ordinary and customary meaning of the term “from” is “a function word to indicate . . . a *starting point* in measuring.” *See* <https://www.merriam-webster.com/dictionary/from> (last visited January 16, 2019).

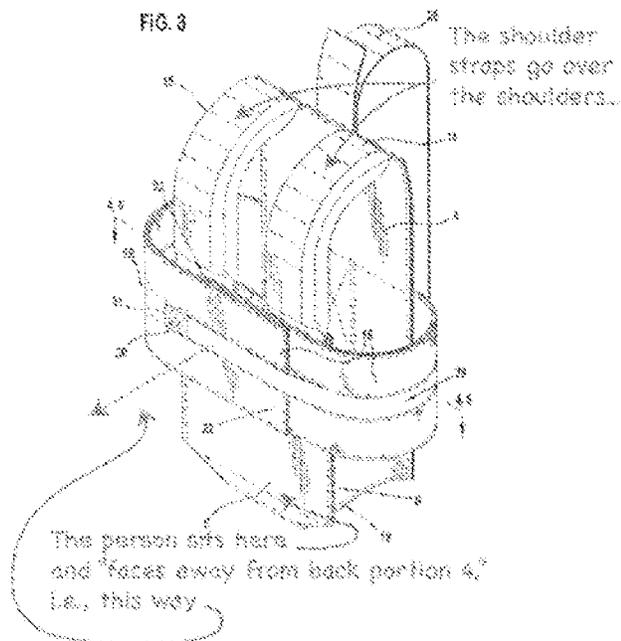
Rejections II–V

The Examiner’s use of the Van Pelt, Cooley, Long, and Yellen disclosures does not remedy the deficiency of the White and Wootan combination discussed *supra*. See Non-Final Act. 6–10. Therefore, for the reasons discussed above, we also do not sustain the rejections under 35 U.S.C. § 103(a) of claims 3–6, 8–10, 13, and 15.

Rejection VI

The Examiner finds that White discloses the placing, folding and wrapping steps of the above noted independent claim 18. See Non-Final Act. 10–11.

Appellant argues that White’s “shoulder straps [15] attach to a surface facing away from the **front side**, not the backside [of the patient] as set forth in . . . claim 18,” and illustrated below in White’s annotated Figure 3. Appeal Br. 23.



Appellant’s annotated Figure 3 of White shows shoulder straps 15 attached to a surface facing away from the patient’s front side.

The Examiner responds that because “attachment areas (3, 5) attach[] to outer side (13) of portion (6) . . . outer side (13) faces away from patient’s backside.” Ans. 15. According to the Examiner, because “inner side (11) of portion (6) [is] on [the same] side [4] contacting patient’s backside and outer side (13) of portion (6) [is] on opposite side of inner side (11) . . . means that the outer side (13) faces away from patient’s backside.” *Id.* (citing White, Figs. 1, 2).

“While the Board must give the terms their broadest reasonable construction, the construction cannot be divorced from the specification and the record evidence.” *In re NTP, Inc.*, 654 F.3d 1279, 1288 (Fed. Cir. 2011). Here, we do not agree with the Examiner’s interpretation of White’s outside surface 13 of front portion 6 as “facing away from the patient’s backside.” Such an interpretation of the phrase “facing away from the patient’s backside” is inconsistent with Appellant’s Specification, which differentiates between a back (rear) side of the patient positioner, which contacts a patient’s back (*see* Appellant’s Figure 5) and a front side of the patient positioner, which contacts a patient’s front (*see* Appellant’s Figure 4). *See also* Spec. paras. 12, 13.

Furthermore, we appreciate the Examiner’s position that White’s inside surface 11 is on the same side (surface) as back portion 4 that contacts a patient’s back; however, inside surface 11 is also on the same side (surface) as front portion 6 that ultimately contacts a patient’s front. *Compare* White, Fig. 1 *with* Fig. 2.⁵

⁵ The term “side” appears to be used differently in claim 18 than in claim 1. In particular, claim 18 appears to use the term “side” to denote a face or surface, rather than a boundary of a portion of an element or surface, as in claim 1. Terminology should be used consistently throughout the specification and claims of a patent application. Thus, Appellant should consider amending the application, and the claims in particular, to avoid the inconsistent use of the term “side.”

As such, in contrast to claim 18, which requires first and second attachment areas attached to a side of the patient positioner facing away from the patient's backside (*see* Appeal Br. 28), White's shoulder straps 15 face away from the front side of the patient as they are attached to outside surface 13 of front portion 6. *See* White, Fig. 2.

Hence, Appellant is correct that White fails to disclose attaching first and second attachment straps "to a side of the patient positioner facing away from the patient's backside," as called for by independent claim 18. The Examiner's use of the Wootan and Patel disclosures does not remedy the deficiency of White discussed *supra*. *See* Non-Final Act. 11–12.

Accordingly, for the foregoing reasons, we do not sustain the rejection under 35 U.S.C. § 103(a) of claims 18 and 19 as unpatentable over White, Wootan, and Patel.

SUMMARY

The Examiner's decision to reject claims 1–15, 18, and 19 under 35 U.S.C. § 103(a) is reversed.

REVERSED