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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* EARL ZERGIEBEL, DAVID CHOWANIEC,  
RYAN V. WILLIAMS, and ANAND SUBRAMANIAN

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Appeal 2018-002194  
Application 14/559,308  
Technology Center 3700

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Before MICHAEL J. FITZPATRICK, PAUL J. KORNICZKY, and  
ARTHUR M. PESLAK, *Administrative Patent Judges*.

KORNICZKY, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE<sup>1</sup>

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>2</sup> appeals from the Examiner's decision, as set forth in the Final Office Action, rejecting claims 1, 2, 4, 7, 9–18 and 21–23.<sup>3</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

## THE CLAIMED SUBJECT MATTER

The claims are directed to a manual retraction tool for use with an electromechanical surgical device. Claim 1, the only independent claim on appeal, is reproduced below with disputed limitations italicized for emphasis:

1. A manual retraction tool for use with an electromechanical surgical assembly including a surgical device including at least one drive connector disposed within a connecting portion, an adapter including at least one connector sleeve defining a recess therein configured to receive the drive connector of the surgical device, and an end effector attached to the adapter, the manual retraction tool comprising:
  - a handle assembly including:
    - a first handle including an elongated handle body having a first end and a second end, and including a channel recessed within at least a portion of the handle body thereof; and

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<sup>1</sup> In this Decision, we refer to (1) the Examiner's Final Office Action dated January 3, 2017 ("Final Act."), Advisory Action dated April 17, 2017 ("Adv. Act."), and Answer dated November 2, 2017 ("Ans."), and (2) Appellant's Appeal Brief dated June 14, 2017 ("Appeal Br.") and Reply Brief dated December 20, 2017 ("Reply Br.").

<sup>2</sup> We use the word "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Covidien LP. Appeal Br. 1.

<sup>3</sup> Claims 3, 5, 6, 8, 19, and 20 are cancelled. Final Act. 2.

a second handle including an elongated handle body having a first end and a second end, and including a channel recessed within at least a portion of the handle body thereof, *the second end of the first handle being pivotally connected to and nested within the first end of the second handle,*

*wherein the first end of the first handle is nested within the second end of the second handle when the first handle and the second handle are disposed in a closed, approximated position; and*

a shaft including an elongated shaft body having a tip dimensioned to be inserted into the recess of a connector sleeve of an adapter and to effect rotation of a connector sleeve upon rotation of the shaft, and a second end pivotally connected to the handle assembly, the shaft body being movable between:

a first position wherein the shaft is at least partially disposed within the channel of the handle body of the second handle, at least partially disposed within the channel of the handle body of the first handle, and is longitudinally aligned with the handle body of each of the first handle and the second handle when the first handle and the second handle are disposed in the closed, approximated position, and

a second position wherein the shaft body is perpendicular to the handle body of at least one of the first handle or the second handle.

## REFERENCES

In rejecting the claims on appeal, the Examiner relied upon the following prior art:

Wilkinson	US 458,087	Aug. 18, 1891
Rue	Des. 111,907	Oct. 25, 1938
Smith	US 2007/0000097 A1	Jan. 4, 2007
Hung	US 2011/0041657 A1	Feb. 24, 2011

## REJECTIONS

The Examiner made the following rejections:

1. Claims 1, 2, 4, 7, 9, 10, and 13–18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Smith and Hung.
2. Claims 11 and 21–23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Smith, Hung, and La Rue.
3. Claim 12 stands rejected under 35 U.S.C. § 103 as being unpatentable over Smith, Hung, and Wilkinson.

Appellant seeks our review of these rejections.

## DISCUSSION

### *Rejection 1: Claims 1, 2, 4, 7, 9, 10, and 13–18 as Unpatentable Over Smith and Hung*

Appellant argues claims 1, 2, 4, 7, 9, 10, and 13–18 as a group. Appeal Br. 10. We select claim 1 as the representative claim, and claims 2, 4, 7, 9, 10, and 13–18 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv) (2019).

The Examiner finds that Smith discloses all of the limitations of claim 1 except for a “second end of the first handle being pivotally connected to and nested within the first end of the second handle, wherein the first end of the first handle is nested within the second end of the second handle when the first handle and the second handle are disposed in a closed, approximated position.” Final Act. 3–4. Smith discloses that each handle has a flange that lies between the flanges of the other handle, but the Examiner construes the term “nested” to mean that the entire end of the first handle, not just a portion, fits within the end of the second handle. *Id.* at 4.

Referring to Figure 1 of Hung, the Examiner finds that Hung teaches

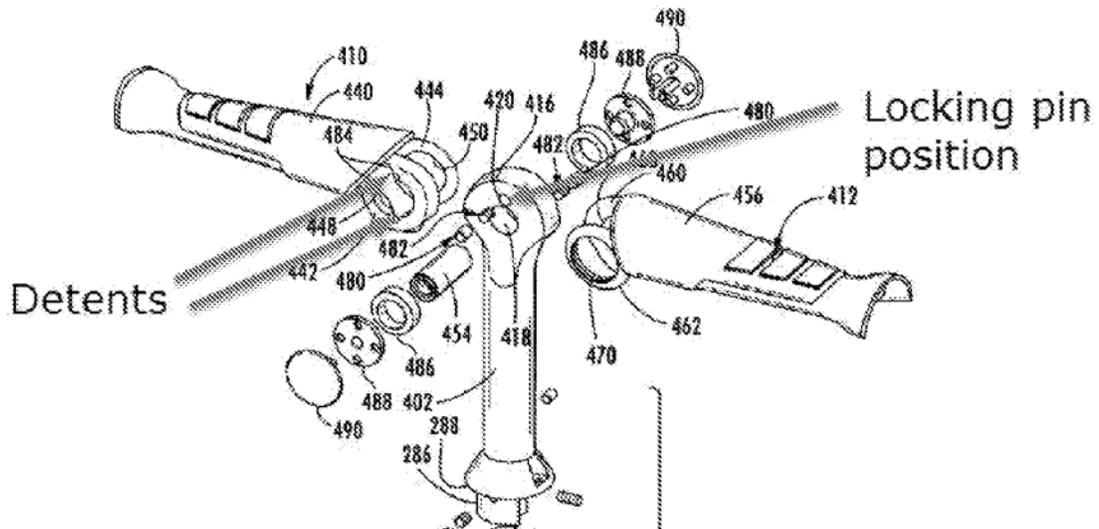
a folding handle where the second end (*the end where hole 24 is located*) of the first handle (20) being nested within the first end (*the end where hole 51*) of the second handle (50), wherein the first end (*The end where protrusion 25 is located*) of the first handle is nested within the second end (*the end where protrusion 53 is located*) of the second handle when the first handle and the second handle are disposed in a closed, approximated position.

*Id.* The Examiner reasons that it would have been obvious to one of ordinary skill in the art

to modify the first and second handles taught by Smith to nest within each other as disclosed by Hung in order to allow for the additional latching component 53 taught by Hung to be added to the handle assembly in order to prevent the two handles taught by Smith to come out the first position randomly.

*Id.* (citing Hung ¶ 17).

The Examiner's annotated Figure 8 of Smith is reproduced below:



A portion of Smith Fig 8 Annotated

Ans. 11. In annotated Figure 8, the Examiner has labeled Smith's detents 484 and locking pins 480.

Appellant argues that the Examiner's rejection is erroneous for several reasons. First, Appellant argues that the Examiner's "proposed modification of the handle wings 410, 412 of Smith to include the nesting configuration of the wrench body 20 within the grip handle 50 of Hung would have resulted in a change in the fundamental operating principle of the tool handle of Smith." Appeal Br. 7. According to Appellant,

[a] person of ordinary skill in the art would not have understood locking of the handle wings in a desired position, resulting from the engagement of the locking pins 480 with the detents 484 of the respective flanges 442, 460 of the handle wings 410, 412 positioned adjacent the flange 416 of the shank 402, to have occurred in a tool handle that includes the flanges 442, 444 of handle wing 410 nested within the flanges 460, 462 of handle wing 412. Rather, if the flanges 442, 440 of handle wing 410 were nested within the flanges 460, 462 of handle wing 412, only handle wing 410 would be lockable thereby rendering the tool handle unable to adopt the variety of configurations described by Smith. (*See e.g.*, Smith, ¶ [0014] and FIGS. 1–5).

*Id.* at 8.

Appellant's "incorporation" arguments are not persuasive. "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference[,] . . . [r]ather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425 (CCPA 1981); *see also In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983) ("[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review."); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) ("[I]f a technique has

been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.”).

Here, the Examiner, based on the teachings of Hung, proposes modifying the second end of Smith’s first handle so that it is nested within the first end of the second handle when the shaft is disposed between the two handles, and then using Hung’s latching components 53 to hold Smith’s first and second handles in the nested position. Final Act. 4; Ans. 8; Adv. Act. 2. Appellant’s arguments (Appeal Br. 8) regarding nesting flanges 442, 440 of handle wing 410 within the flanges 460, 462 of handle wing 412 do not address the rejection as articulated by the Examiner. Consequently, Appellant does not show that the Examiner’s proposed modification changes the fundamental operating principle of Smith or is beyond the skill of one skilled in the art. Thus, Appellant does not apprise us of error.

Second, Appellant argues that the Examiner “has not provided a rational underpinning for the proposed modification of the tool handle of Smith to include the positioning protrusions of Hung” because the Examiner “has not shown why a person of ordinary skill in the art would have sought to include positioning protrusions in a tool handle that already includes a locking mechanism for locking the handle wings in a desired position.” Appeal Br. 8. Appellant also argues that a person of ordinary skill in the art would not have understood “preventing handle movement to be an issue that remained to be improved upon with respect to the tool handle of Smith,” and the Examiner’s proposed combination of Smith and Hung is based on

“impermissible hindsight, using claim 1 as a roadmap for formulating the present rejection.” *Id.* Appellant’s arguments are not persuasive.

As the Examiner correctly explains, in Smith’s locking mechanism, “pin (480) is located on flange 416 such that in the normal locked position it can engage detents 484 formed about the periphery of aperture 448 in flange 442.” Ans. 10 (quoting Smith ¶ 33). The Examiner also correctly explains that Smith indicates that the pin must engage or insert into the detents to lock the mechanism, and, referring to the annotated Figure 8 above, that detents are shown only on the top and bottom of handle 410 (about 180° apart) and the only locking pin for these detents is fixed by bore 420 at the top of the shaft/shank 402. *Id.* We agree with the Examiner that, because of the positioning of the detents and locking pin, the handles are only locked when the handles are extended perpendicularly from the shaft. *Id.* Thus, there is a rational underpinning for the Examiner’s articulated rationale for combining Smith and Hung — a person of ordinary skill in the art would have known there is a need for the Hung’s nested configuration and locking mechanism to keep Smith’s handles in close approximation position to the shaft. Appellant’s hindsight argument is of no import where the Examiner has stated a rationale for the modification that we determine is supported adequately by sufficient facts. *See In re Cree*, 818 F.3d 694, 702, n.3 (Fed. Cir. 2016).

For the above reasons, the rejection of claim 1 is sustained. Likewise, we sustain the Examiner’s rejections of claims 2, 4, 7, 9, 10, and 13–18, which depend from claim 1.

*Rejection 2: Claims 11 and 21–23  
as Unpatentable Over Smith, Hung, and La Rue*

In response to the Examiner's rejection of claims 11 and 21–23, Appellant argues that this rejection is erroneous because of the erroneous rejection of independent claim 1, from which claims 11 and 21–23 depend, and La Rue does not remedy the deficiencies of Smith and Hung. Appeal Br. 10–11. As discussed above in connection with claim 1, Appellant's arguments about the alleged deficiencies of the rejection of claim 1 are not persuasive, and the rejection is sustained. Likewise, the rejection of claims 11 and 21–23 is sustained.

*Rejection 3: Claim 12  
as Unpatentable Over Smith, Hung, and Wilkinson*

In response to the Examiner's rejection of claim 12, Appellant argues that this rejection is erroneous because of the erroneous rejection of independent claim 1, from which claim 12 depends, and Wilkinson does not remedy the deficiencies of Smith and Hung. Appeal Br. 11–12. As discussed above in connection with claim 1, Appellant's arguments about the alleged deficiencies of the rejection of claim 1 are not persuasive, and the rejection is sustained. Likewise, the rejection of claim 12 is sustained.

### CONCLUSION

In summary:

<b>Claims Rejected</b>	<b>Basis (35 U.S.C.)</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 2, 4, 7, 9, 10, 13–18	§103 Smith, Hung	1, 2, 4, 7, 9, 10, 13–18	
11, 21–23	§103 Smith, Hung, La Rue	11, 21–23	
12	§103 Smith, Hung, Wilkinson	12	
<b>Overall Outcome</b>		1, 2, 4, 7, 9–18, 21–23	

For the above reasons, we AFFIRM the Examiner’s rejection of claims 1, 2, 4, 7, 9–18, and 21–23 under 35 U.S.C. § 103.

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

AFFIRMED