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MORGAN, LEWIS & BOCKIUS LLP (BO) 1111 PENNSYLVANIA AVENUE, N.W. WASHINGTON, DC 20004 UNITED STATES OF AMERICA			TON, MARTIN TRUYEN	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHELLE JOURNEY, SEAN CAFFEY,
MARK HUMAYUN, and JOHN HUCULAK

Appeal 2018-003175
Application 13/351,836
Technology Center 3700

Before JENNIFER D. BAHR, DANIEL S. SONG, and
BRETT C. MARTIN, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Michelle Journey et al. (Appellants) appeal under 35 U.S.C. § 134(a) from the Examiner's decision, set forth in the Non-Final Action dated March 30, 2017 (hereinafter "Non-Final Action" or "Non-Final Act."), rejecting claims 1–3, 6–15, and 18–27. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

THE CLAIMED SUBJECT MATTER

Claims 1 and 18 are independent. Appeal Br. 13, 15–16 (Claims App.). Claim 1, reproduced below with limitations pertinent to this appeal italicized for emphasis, is illustrative of the claimed subject matter.

1. An instrument facilitating surgical implantation of an implantable device having two opposed surface portions at least one of which has a curved surface contour, the instrument comprising:

first and second forceps arms each having first and second ends, the arms being joined at the first ends thereof and arranged to oppose but permit resisted compression of the arms toward each other into a closed position from an open position, wherein compression of the arms toward each other into the closed position forces the second ends of the arms toward each other;

a first-arm head member, having a first length defined by a distal end and a proximal end thereof, located at the second end of the first arm; and

a second-arm head member, having a second length defined by a distal end and a proximal end thereof, located at the second end of the second arm,

wherein:

(i) *the head members are flared outwardly so as to be angled away from each other along the entire first and second lengths thereof at least in the open position relative to an axis running between and coplanar with the arms,*

(ii) each of the head members defines an interior surface, the interior surfaces being opposed to each other and differently shaped to releasably engage the implantable device without damage thereto upon compression of the arms into the closed position,

(iii) the interior surface of at least one of the head members has a curved portion complementary to the curved surface contour of the implantable device whereby closure of the arms causes the head members to opposedly engage the surface contour of the implantable device to prevent release thereof from the instrument in the closed position, and

(iv) the differently shaped interior surfaces mate with different surface contours of the implantable device.

Appeal Br. 13 (Claims App.). Claim 18 also contains the italicized language. *Id.* at 16.

REJECTIONS

- I. Claims 1, 7–10, and 19–22 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Beckman (US 2008/0200923 A1, published Aug. 21, 2008) and Noniewicz (US 6,708,587 B1, issued Mar. 23, 2004).
- II. Claims 2 and 3 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Beckman, Noniewicz, and McDonald (US 6,248,123 B1, issued June 19, 2001).
- III. Claim 6 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Beckman, Noniewicz, and Conston (US 2006/0149194 A1, published July 6, 2006).
- IV. Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Beckman, Noniewicz, and Tiedemann (US 2003/0233119 A1, published Dec. 18, 2003).¹
- V. Claims 13 and 14 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Beckman, Noniewicz, Tiedemann, and Lee (US 2010/0331770 A1, published Dec. 30, 2010).

¹ The Examiner cites Conston in the statement of the rejection, but relies on Tiedemann (and not on Conston) in the detailed explanation of the rejection. *See Non-Final Act.* 9–10.

- VI. Claims 18 and 23–25 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Beckman, Noniewicz, and Avery (US 6,251,090 B1, issued June 26, 2001).
- VII. Claims 15 and 26 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Beckman, Noniewicz, and Nesbitt (US 7,160,297 B2, issued Jan. 9, 2007).
- VIII. Claims 15 and 27 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Beckman, Noniewicz, and Green (US 5,387,196, issued Feb. 7, 1995).

DISCUSSION

Independent claims 1 and 18 both recite that “the head members are flared outwardly so as to be angled away from each other along the entire first and second lengths thereof at least in the open position relative to an axis running between and coplanar with the arms.” Appeal Br. 13, 15–16 (Claims App.). We understand this limitation to mean that the head members are flared outwardly and angled away from each other along each of their entire lengths, from the proximal end to the distal end thereof, along the axial, or length, direction, at least with the arms in the open position, such that they form an outwardly flared opening between the head members to receive a device to be gripped therebetween. Although at least one of the head members has a curved surface, which may even curve toward the other head member along a direction normal to the axial or length direction, such as the curved lateral ends of head member 110a and 110b depicted in Appellants’ Figures 1 and 2, for example, the head members flare outwardly

and are angled away from each other along the axial or length direction along the entire lengths thereof.

The Examiner finds that Beckman's head members (distal ends 206, 212 of arms 202, 208) are not "flared outwardly so as to be angled away from each other along the entire first and second lengths thereof at least in the open position relative to an axis running between the coplanar arms." Non-Final Act. 4. As shown in Figures 11 and 12 of Beckman, first side jaw 214 and second side jaw 218 of Beckman's head members curve, or are angled, *inwardly toward* each other along the axial or length direction.

In order to make up for this deficiency in Beckman, the Examiner determines it would have been obvious to modify Beckman's head members to "be pivotably attached to the arms," as taught by Noniewicz, "to allow for [the] head members to be placed into a flush abutment against different implants for a firmer hold." *Id.* at 4–5 (citing Noniewicz, Fig. 2; 5:32–46). According to the Examiner, this modification would "mak[e] the head members [of Beckman] capable of being flared outwardly so as to be angled away from each other along the entire first and second lengths thereof at least in the open position relative to an axis running between and coplanar with the arms," as recited in claims 1 and 18. *Id.* at 5.

Appellants argue, and we agree, that it would not have been obvious to modify Beckman's side jaws to be pivotably attached to the arms, as proposed by the Examiner, because this would impair the ability of Beckman's jaws to securely hold the ophthalmic shunt. Appeal Br. 9–10.

As illustrated in Beckman's Figures 12 and 13, Beckman's side jaws 214 and 218 and upper prong 216 are specifically designed to grip shunt 222, comprising body 220 and head 224, and insert it through an incision, as

described in paragraphs 85 and 86, “similar to inserting a button into a button hole.” Modifying Beckman’s head members (distal ends 206, 212) so as to attach them pivotably to arms 202 and 208 would result in a less secure hold, not a firmer hold, on the shunt, and would make the insertion process more difficult.

Further, as Appellants point out, even if Beckman’s head members (distal ends 206, 212) were modified so as to attach them pivotably to arms 202 and 208, as proposed by the Examiner, they would still be curved inwardly, toward one another at side jaws 214 and 218, and, thus, would not be “flared outwardly so as to be angled away from each other along the entire first and second lengths thereof at least in the open position relative to an axis running between and coplanar with the arms,” as recited in claims 1 and 18. *See Reply Br. 3.*

The Examiner cites additional references (McDonald, Conston, Tiedemann, Lee, Avery, Nesbitt, and Green) in addressing additional limitations of claims 2, 3, 6, 11–15, and 23–27. *See Non-Final Act. 7–17.* However, the Examiner’s application of these references does not make up for the aforementioned deficiency in the combination of Beckman and Noniewicz. *See id.*

For the above reasons, the Examiner fails to establish that the subject matter of claims 1 and 18, or their dependent claims 2, 3, 6–15, and 19–27, would have been obvious. Accordingly, we do not sustain any of the rejections of these claims before us in this appeal.

Appeal 2018-003175
Application 13/351,836

DECISION

The Examiner's decision rejecting claims 1–3, 6–15, and 18–27 is reversed.

REVERSED