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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DOLLY JEANNE HOLT

Appeal 2018-004052
Application 13/796,607
Technology Center 3700

Before MICHAEL L. HOELTER, ANNETTE R. REIMERS, and
LISA M. GUIJT, *Administrative Patent Judges*.

REIMERS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Dolly Jeanne Holt (“Appellant”) appeals under 35 U.S.C. § 134(a) from the Examiner’s decision to reject claims 1–6, 8, 9, 14, 15, 17, 18, 20, 30, 32, and 34–43. Claims 7, 10–13, 16, 19, 21–29, 31, and 33 have been canceled. Claims App. 3–5.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ A Response to Notification of Non-Compliant Appeal Brief was filed to submit a corrected Claims Appendix (“Claims App.”), filed Apr. 3, 2017. We rely on the claims as presented in the amended Claims Appendix.

CLAIMED SUBJECT MATTER

The claimed subject matter “relates to devices and methods to support weak tissue or for moving two regions of tissue towards each other to reconnect or support tissue that is separated or at risk of separation.” Spec.

¶ 2, Figs. 1A–1C. Claims 1 and 38 are independent.

Claim 1 is illustrative of the claimed subject matter and recites:

1. A device for treating wounded, separated, and/or partially separated elongate tissue of a patient, the device comprising:

a coil comprising a plurality of interconnected turns in series, the coil formed of an elongate coil member of biocompatible material, the coil member having a first end and a second end and configured in a spiral pattern to form the series of interconnected turns of the coil and define a lumen through the coil, the lumen being open at both ends and configured to receive the elongate tissue to be repaired, the coil being extendable to increase a distance between adjacent turns of the plurality of turns and increase a length of the coil,

wherein—

when the coil is in a relaxed state, each turn of the plurality of turns of the coil has a corresponding first diameter and is configured to encircle and engage the elongate tissue,

when the coil is in an extended state, each turn of the plurality of turns has a corresponding second diameter smaller than the corresponding first diameter and is configured to more tightly engage the elongate tissue than when the coil is in the relaxed state,

the coil is configured to engage the elongate tissue continuously as it transforms from the relaxed state to the extended state, and

the coil is configured to distribute axial tensile stress along tissue contact points, and

a first subset of the interconnected turns of the coil at the first end of the coil is configured to engage a first portion of the elongate tissue and a second subset of the interconnected turns at the second end of the coil is configured to engage a second portion of the elongate tissue such that an axial tensile stress along the elongate tissue pulls the first and second subsets in an axial direction away from one another and extends the coil, and thereby changing each turn of the plurality of turns from the relaxed state to the extended state to achieve the second diameter to more tightly engage the elongate tissue.

THE REJECTIONS²

I. Claims 1, 2, 4, 20, 34–38, and 40–43 stand rejected under 35 U.S.C. § 102(b) as anticipated by Shaked (US 2008/0228146 A1, published Sept. 18, 2008).³

² The Examiner states that Appellant “has overcome the following rejection(s): the 35 U.S.C. 112 first and second paragraph rejections and the Claim Objections.” Advisory Action 2, dated Oct. 7, 2016. Thus, the objection of claims 1, 20, 36, 38, and 42, and the rejections of claims 1–6, 8, 9, 14, 15, 17, 18, 20, 30, 32, and 34–43 under 35 U.S.C. § 112, first paragraph and second paragraph, are not before us on appeal. *See* Final Office Action 2–4 (“Final Act.”), dated June 9, 2016.

³ The Examiner includes canceled claim 19 in the heading of Rejections I and II. We consider this an inadvertent typographical error. *See* Final Act. 4, 7.

- II. Claims 1–5, 20, 34–38, and 40–43 stand rejected under 35 U.S.C. § 102(e) as anticipated by Bills (US 2013/0013065 A1, published Jan. 10, 2013).
- III. Claims 6, 17, 18, 30, and 39 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bills and Allen (US 2004/0260384 A1, published Dec. 23, 2004).
- IV. Claims 8, 14, and 15 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bills and Talja (US 6,171,338 B1, issued Jan. 9, 2001).
- V. Claim 9 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Bills and Cook (US 2009/0132031 A1, published May 21, 2009).
- VI. Claims 17 and 32 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bills and Furst (US 2010/0168841 A1, published July 1, 2010).

ANALYSIS

Rejection I – Anticipation by Shaked

Claims 1, 2, 4, 20, 34–38, and 40–43

The Examiner finds that Shaked discloses a device 10 that “is capable of encircling and engaging the elongate tissue (paragraphs 38, 41)” as required by independent claim 1. Final Act. 4–5 (also citing Shaked Figs. 3A, 3B, 6A, 6B); *see also* Ans. 2. The same can be said for independent claim 38 (i.e., “configured to encircle the elongate tissue” (Claims App. 5)). The Examiner explains that the coil of Shaked is configured to encircle and

engage elongate tissue because the coil “has a lumen which can receive elongate tissue.” Ans. 2.⁴

Appellant contends that “Shaked’s device 10 is not configured to encircle and engage tissue” but is “is configured to surround a catheter . . . and [to] be anchored to a shaft of the catheter.” Br. 7 (emphasis omitted) (citing Shaked Figs. 2A, 11B; quoting Shaked ¶ 35).⁵

Our reviewing court, has, at least in the context of structural limitations, found that “configured to” can have a meaning narrower than “capable of” based on the way the term is used. *See Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.*, 672 F.3d 1335, 1349 (Fed. Cir. 2012) (in construing “adapted to,” adopting the “narrower definition” of “configured to” instead of the “broader sense” of “capable of”); *see also In re Giannelli*, 739 F.3d 1375, 1379 (Fed. Cir. 2014) (discussing the distinction identified in *Aspex*). Figure 11C of Shaked shows expandable portion 18 encircling the catheter and “anchored to a shaft of the catheter.” Shaked ¶ 35. Shaked further explains, “extension elements **19** of expandable portion **18** of device **10**” are “used as stoppers to prevent catheter **24** from advancing beyond that point.” *See* Shaked ¶ 46; *see also* Br. 7. Thus, Shaked’s device 10 is employed to surround and anchor a catheter in place; however, it is not configured to encircle tissue as asserted by the Examiner because when Shaked’s device 10 is deployed, tissue does not enter the lumen of expandable portion 18 thereof.

⁴ Examiner’s Answer (“Ans.”), dated Dec. 29, 2017.

⁵ Appeal Brief 1 (“Br.”), filed Feb. 8, 2017.

For these reasons, we do not sustain the Examiner’s rejection of claims 1 and 38, and dependent claims 2, 4, 20, 34–37, and 40–43 as anticipated by Shaked.

Rejection II – Anticipation by Bills

Claim 1

The Examiner finds that Bills discloses a device (tendon repair device 10) having all limitations of claim 1. Final Act. 7–9 (citing Bills Fig. 3). The Examiner explains that because: (1) Bills discloses at paragraph 41 that its device may be in the form of a “helically wound braid”; (2) the term “helical” is defined as “having the shape or form of a helix; spiral”; and (3) the term “wound” is defined as “repeatedly twisted or coiled,” Bills’ device can be viewed as a coil. *Id.* at 7; citing oxforddictionaries.com.

Appellant contends that Bills does not disclose “a coil comprising a plurality of interconnected turns in series” that is “configured in a spiral pattern to form the series of interconnected turns of the coil” as claimed. Br. 9. According to Appellant, the Examiner’s “interpretation of the term ‘helically wound braid’ ignores the fact that ‘helically wound’ is simply adding description to the main structural component—a braid, and those having skill in the art would not have understood a ‘braid’ to be a coil.” Br. 9 (emphasis omitted).

Appellant’s Specification does not provide an explicit definition of the term “coil.” However, Appellant’s Specification provides guidance as to the meaning of this term stating, “[t]he tissue repair device 100 comprises a coil or spiral shape formed by a coil member 103 arranged in a coil or spiral to form a plurality of interconnected turns 106 that creates a lumen 105 at its center.” Spec. ¶ 64. This characterization is consistent with the dictionary

definition of the term “coil,” which is defined as a “length of something wound in a joined sequence of concentric rings.”⁶ Based on the above, we agree with the Examiner that Bills discloses a coil as claimed, only braided, i.e., a “helically wound braid (similar to a ‘Chinese finger trap’).” Bills Abstract; *see also* Ans. 3 (“Bills discloses a *helically wound* braid (para. 41)”); *see also id.* at 4; Bills ¶ 41 (“The tendon repair device **10** may be formed of a helically wound braid.”; Fig. 3).

Appellant does not provide evidence or persuasive argument to show that “those having skill in the art would not have understood [Bills’] ‘braid’ to be a coil.” “Attorney’s argument in a brief cannot take the place of evidence.” *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974). Further, as the Examiner points out, Bills discloses that its device functions similar to a “Chinese finger trap.” Final Act. 7 (citing Bills Abstract, ¶ 40 (“The tendon repair device **10** includes a body which approximates or functions in a manner somewhat similar to a ‘Chinese finger trap’ in structure and concept.”); Fig. 3); *see also* Ans. 3–4. In addition, Appellant’s own Specification discloses that the “tissue repair device 100 may approximate or function in a manner similar to a ‘Chinese finger trap.’” Spec. ¶ 64. Thus, we are not persuaded by Appellant’s contention that Bills’ device, being braided, is different from what would generally be understood as a coil.

Appellant argues that “Bills describes [the] braid as having a ‘weaved’ construction” and Bills’ “Figure 6 clearly shows the weft threads 34 and their crossing points.” Br. 11. Thus, Appellant contends that “one having

⁶ *See* <https://en.oxforddictionaries.com/definition/coil> (last accessed Jan. 6, 2019).

ordinary skill in the art would not have considered Bills' braid to be the coil of claim 1, and such a reading by the Examiner is improper." *Id.* (emphasis omitted).

Appellant's argument is unpersuasive as the claims do not preclude a weaved construction or weft threads having cross points. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) (Limitations not appearing in the claims cannot be relied upon for patentability). Moreover, *each* strand of Bills' helical wound braid has "a plurality of interconnected turns in series" and "a spiral pattern to form the series of interconnected turns of the coil" as claimed. *See* Bills, Fig. 3; *see also* Final Act. 7; Ans. 3–4.

In summary, and based on the record presented, we are not persuaded the Examiner erred in rejecting independent claim 1 as anticipated by Bills. Accordingly, we sustain the Examiner's rejection of claim 1 as anticipated by Bills.

Claims 2–5, 20, and 34–37

Appellant contends that the rejection of "dependent claims 2–5, 20 and 34–37 should be withdrawn for at least the same reasons detailed above with respect to base claim 1." Br. 12. As we are not persuaded that the Examiner erred in the findings discussed above with respect to claim 1, we likewise sustain the Examiner's rejection of claims 2–5, 20, and 34–37 as anticipated by Bills.

Claims 38 and 40–43

Appellant contends that independent "claim 38 is patentable over Bills for at least the reasons discussed above with reference to independent claim 1" and that the rejection of "dependent claims 40–43 should be withdrawn for at least the same reasons detailed above with respect to base claim 38."

Br. 12–13. As we are not persuaded that the Examiner erred in the findings discussed above with respect to claim 1, we likewise sustain the Examiner’s rejection of claims 38 and 40–43 as anticipated by Bills.

Rejections III – VI Obviousness over Bills and any of Allen, Talja, Cook, or Furst

Claims 6, 8, 9, 14, 15, 17, 18, 30, 32, and 39

For these rejections, Appellant relies on arguments presented for Rejection II. Br. 13–14. As we find no deficiencies in the Examiner’s rejection of independent claims 1 and 38 as anticipated by Bills for the reasons discussed above, we likewise sustain the Examiner’s rejections of claims 6, 17, 18, 30, and 39 as unpatentable over Bills and Allen, of claims 8, 14, and 15 as unpatentable over Bills and Talja, of claim 9 as unpatentable over Bills and Cook, and of claims 17 and 32 as unpatentable over Bills and Furst.

DECISION

We REVERSE the decision of the Examiner to reject claims 1, 2, 4, 20, 34–38, and 40–43 as anticipated by Shaked.

We AFFIRM the decision of the Examiner to reject claims 1–5, 20, 34–38, and 40–43 as anticipated by Bills.

We AFFIRM the decision of the Examiner to reject claims 6, 17, 18, 30, and 39 as unpatentable over Bills and Allen.

We AFFIRM the decision of the Examiner to reject claims 8, 14, and 15 as unpatentable over Bills and Talja.

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We AFFIRM the decision of the Examiner to reject claim 9 as unpatentable over Bills and Cook.

We AFFIRM the decision of the Examiner to reject claims 17 and 32 as unpatentable over Bills and Furst.

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

AFFIRMED