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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROD HUSK

Appeal 2018-007959
Application 14/923,750¹
Technology Center 3700

Before STEFAN STAICOVICI, MICHAEL J. FITZPATRICK, and
JEREMY M. PLENZLER, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner’s decision in the Final Office Action (dated Nov. 13, 2017, hereinafter “Final Act.”) rejecting claims 1–27. We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM-IN-PART.

¹ The inventor, Mr. Rod Husk, is identified as the real party in interest in Appellant’s Appeal Brief (filed May 1, 2018, hereinafter “Appeal Br.”). Appeal Br. 3.

INVENTION

Appellant's invention relates to a spray shield used in conjunction with a surgical scissor to protect a user from blood spray during surgery. Spec. para. 2.

Claims 1, 12, 17, and 19 are independent. Claim 1 is illustrative of the claimed invention and reads as follows:

1. A combination comprising:
a pair of scissors having a first and a second scissor arm pivotally coupled together at a joint, each scissor arm having a blade portion extending in a first direction from the joint and a handle portion extending in a second direction from the joint, the first and second blade portions being adapted for movement relative to each other in a generally vertical orientation during a cutting action of the pair of scissors, the blade portion of each scissor arm having a tip; and
a spray shield having a shield portion, a mount and an opening through which both the first and second scissor arms extend, wherein the spray shield substantially surrounds portions of the first and second scissor arms extending through the opening;
wherein the mount is releasably coupled to the handle portion of the first scissor arm to thereby position the shield portion vertically above the blade portion of the first scissor arm in a covering relationship to deflect and contain a discharge emanating from a member positioned between the first and second blade portions during the cutting action.

REJECTIONS

- I. The Examiner rejects claims 1–9, 11, and 17–26 under 35 U.S.C. § 102(a)(1) as being anticipated by Halpern (US 1,600,225, issued Sept. 21, 1926).
- II. The Examiner rejects claims 1–27 under 35 U.S.C. § 102(a)(1) as being anticipated by Cook et al. (US 2004/0194319 A1, published Oct. 7, 2004, hereinafter “Cook”).

- III. The Examiner rejects claims 1–27 under 35 U.S.C. § 103(a) as being unpatentable over Kelly et al. (US 5,542,435, issued Aug. 6, 1996, hereinafter “Kelly”) and Cook.²

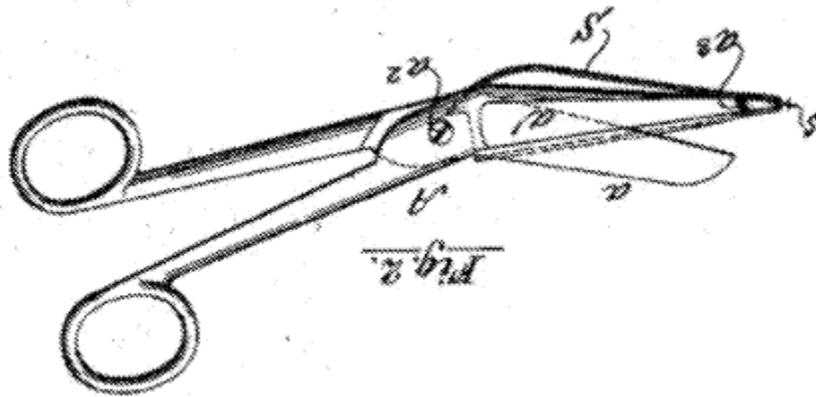
ANALYSIS

Rejection I

Each of independent claims 1, 17, 19 requires, *inter alia*, a pair of scissors having scissor arms and a spray shield having a shield portion and a mount to position the shield portion “vertically above the blade portion” of a scissor arm. *See* Appeal Br. 24, 29, 30 (Claims App.).

The Examiner finds that Halpern discloses a pair of scissors A having first and second scissor arms pivotally connected at joint a² and a spray shield S having a shield portion and a mount S’ to position the shield portion vertically above blade portions a, a’ of the scissor arms. *See* Final Act. 2 (citing Halpern, Fig. 2). According to the Examiner, when rotating Halpern’s scissors 180 degrees the shield portion of shield S is located “vertically above the blade portion” of a scissor arm, as required by each of independent claims 1, 17, and 19. *Id.* at 22. To illustrate this position the Examiner provides an inverted Figure 2 of Halpern, as shown below:

² We view the Examiner’s omission of claim 27 from the heading of the rejection as a mere typographical error because the claim is discussed in the body of the rejection. *See* Final Act. 14, 22.



The Examiner's inverted Figure 2 of Halpern illustrates a view of Halpern's pair of scissors rotated by 180 degrees. *See* Ans. 23.

Appellant first argues that, in contrast to the Examiner's findings regarding independent claims 1, 17, and 19, Halpern's shield portion "is positioned vertically below the blade portions of the scissors," and, thus, "[t]he components of Halpern are not arranged as is required in the claims." Appeal Br. 9–10 (citing Halpern, Fig. 2). Appellant contends that, because Halpern specifically discloses "that the shield is attached to the lower shearing blade," the Examiner's rotation of Halpern's scissors is improper as Halpern's scissors would fail to operate as intended. *Id.* at 9–10 (citing Halpern, ll. 15–18, 53–56).

We are not persuaded by Appellant's arguments because "apparatus claims cover what a device *is*, not what a device *does*." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990). Here, the Examiner is correct that Halpern discloses all the limitations of independent claims 1, 17, and 19, as is particularly evident from inverting Figure 2. *See* Final Act. 2–3. We further agree with the Examiner that Appellant's arguments are directed to the use of Halpern's pair of scissors and whether Halpern's scissors are used as shown in Halpern's Figure 2 or in Halpern's inverted Figure 2 does not result in a structural difference

and, moreover, the scissors of Halpern can be used in both orientations. *See* Ans. 23.

We appreciate Appellant's position that Halpern discloses shield S as located on the bottom blade. Appeal Br. 10. However, we do not agree that this teaching means that Halpern explicitly discloses that its scissors cannot be used in an inverted orientation in order "to be operational for its intended purpose" (*id.*); nor would we agree that such a result even would be relevant to the instant rejection, which is for anticipation not obviousness. In any event, Halpern discloses that the lower blade of scissors A is formed with a "blunt flat circular nose a^3 ." Halpern, p. 1, l. 44, Fig. 1. A skilled artisan would readily understand that when a patient is located below medical personnel, such as when the patient is laying on a surgical table, the medical personnel uses Halpern's scissors in the orientation shown in Halpern's Figure 2 where the lower blade with the blunt tip moves safely along tissue surface until reaching the incision area. However, when a patient is located above medical personnel, such as, for example, when a patient is trapped in an automobile after an accident, the medical personnel uses Halpern's scissors in the orientation shown in Halpern's inverted Figure 2 where the upper blade with the blunt tip moves safely along tissue surface until reaching the incision area. *See In re Jacoby*, 309 F.2d 513, 516 (CCPA 1962) (An artisan must be presumed to know something about the art apart from what the reference discloses). Accordingly, we agree with the Examiner that Halpern's scissors are capable of use in both orientations. *See e.g.*, Ans. 23–24.

In a second instance, Appellant argues that Halpern's mount S' does not include an opening through which both scissor arms extend and is not releasably coupled to the handle portion of the first scissor arm, as called for by independent claims 1 and 19. Appeal Br. 11. According to Appellant, Halpern specifically

discloses that shield S “is ‘rigidly attached to the said lower blade a’ of the scissor A” and “is mounted to the fulcrum a² as shown in Fig. 1.” *Id* (citing Halpern, p. 1, ll. 54–55). Appellant asserts that “[t]he fulcrum of the scissors is not the handle portion as required by the claims.” *Id*.

We are not persuaded by Appellant’s second argument because Halpern discloses a separate embodiment where shield S is “detachably connected” such that an opening between flanges s’, s’ straddle *both* blades of scissor A. *See* Halpern, p. 1, ll. 55–61. As such, we agree with the Examiner that Halpern’s opening between flanges s’, s’ constitutes an opening through which both scissor arms extend, as called for by independent claims 1 and 19. *See* Ans. 24.

We further agree with the Examiner that Halpern’s mount S’ “is coupled to the handle portion of the first scissor arm.” Ans. 24. The limitation of a “mount [that] is releasably coupled to the handle portion,” as per claim 1, or “a mount adapted to releasably couple the shield portion to the handle portion,” as per claim 19, does not require a *direct* coupling to the handle portion.³ *See Genentech, Inc. v. Chiron Corp.* 112 F.3d 495, 501 (Fed. Cir. 1997) (“To be joined or connected does not necessitate a *direct* joining or connection.”). As such, we are not apprised of Examiner error because the feature of a *direct* coupling between the mount and the handle portion is not positively recited in claims 1 and 19. Limitations not appearing in the claims cannot be relied upon for patentability. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982). As stated by our reviewing court in *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998), “the name of the game is the claim.” Here, because Halpern discloses that mount S’ is detachably (releasably) coupled

³ An ordinary and customary meaning of the term to “couple” is “to join, connect.” *See* <https://www.dictionary.com/browse/couple> (last visited September 4, 2019).

“adjacent” fulcrum a², Halpern discloses that mount S’ is detachably (releasably) coupled to the handle portion as well. *See* Halpern, p. 1, ll. 59–62, Fig. 1.

Finally, in regards to the rejection of claim 18, the Examiner finds that Halpern discloses a “shield portion having an end cap portion with a terminal edge which rests on the surface to thereby support the pair of scissors in the upright orientation.” Final Act. 5.

In response, Appellant argues “Halpern is entirely silent on this feature and any attempt to find this feature in Halpern is pure conjecture and speculation.” Appeal Br. 11. Moreover, according to Appellant, “[c]ontrary to the Final Office Action, the terminal edge of the shield end cap in Halpern does not rest on the underlying surface.” *Id.*

We are not persuaded by Appellant’s argument because like the Examiner we construe the limitation “which rests on the surface to thereby support the pair of scissors in the upright orientation” as a functional limitation. Thus, claim 18 requires the claimed shield portion to have “an end cap portion having a terminal edge” that is capable of “rest[ing] on the surface to support the pair of scissors in the upright orientation.” Accordingly, we agree with the Examiner’s finding that “the end of the shield (S) [of Halpern] includes an end cap or rounded tip [s] . . . that is capable of supporting the scissors in an upright orientation when it is position[ed] o[n] a surface.” Ans. 24 (citing Halpern, Fig. 3). Appellant does not persuasively explain why Halpern’s end cap “s” lacks the capability to perform the function of “rest[ing] on the surface to support the pair of scissors in the upright orientation.”

In conclusion, for the foregoing reasons, we sustain the rejection under 35 U.S.C. § 102(a)(1) of claims 1–9, 11, and 17–26 as anticipated by Halpern.

Rejection II

Each of independent claims 1, 12, 17, and 19 requires, *inter alia*, a spray shield having a shield portion positioned “to deflect and contain a discharge emanating from a member positioned between the first and second blade portions during the cutting action.” *See* Appeal Br. 24, 27, 29, and 30 (Claims App’x.).

The Examiner finds that Cook’s shield portion 32, 34 of spray shield 30 is “capable of deflecting and contain[ing] a discharge emanating from a member positioned between the first and second blade portions during the cutting action.” Final Act. 7–8 (citing Cook, Figs. 1–3).

We agree with Appellant that because Cook discloses element 32 “as ‘a thin, rigid generally rectangular frame with an *open* center,’” Cook “fails to disclose any shield which would contain a discharge emanating from a member being cut as required by the claims.” Appeal Br. 13–14 (citing Cook, para. 33 (emphasis added)). The Examiner’s position that “[t]he discharge *could* be deflected by Cook’s shield and also stick to the surface of the shield” is speculative and does not adequately explain how Cook’s shield portion 32, 34, which has an open center, is capable of performing the claimed function noted above. *See* Ans. 25. More specifically, the Examiner does not sufficiently explain how Cook’s shield portion 32, 34 is capable “to deflect and contain a discharge emanating from a member positioned between the first and second blade portions during the cutting action” as its open center would in fact allow the discharge to disperse.

Accordingly, for the foregoing reasons, we do not sustain the rejection under 35 U.S.C. § 102(a)(1) of claims 1–27 as anticipated by Cook.

Rejection III

Claims 1–16 and 19–27

The Examiner finds that Kelly discloses most of the limitations of independent claims 1, 12, and 19, but fails to disclose that “spray shield [10] has an opening through which both the first and second scissor[] arm[s 55] extend, wherein the spray shield [10] substantially surrounds portions of the first and second scissor arms extending through the opening.” Final Act. 14–15 (citing Kelly, Figs. 1–3), 17–18, 20. Nonetheless, the Examiner finds that “the use of an opening in the shield to receive both arms of a pair of scissors is old and well known in the art such as taught by Cook.” *Id.* at 15. Hence, the Examiner concludes that “[i]t would have been obvious to a person of ordinary skill in the art to provide Kelly’s spray shield with the opening, as taught by Cook, in order to increase the space that the blades could pivot away from each other.” *Id.*

It is well settled that the mere fact that elements can be combined is not, in itself, a reason to combine them. Rather, an obviousness rejection further must explain the reasoning by which those findings support the Examiner’s conclusion of obviousness. *Perfect Web Techs., Inc. v. Info USA, Inc.*, 587 F.3d 1324, 1328–30 (Fed. Cir. 2009). Here, Kelly specifically discloses that mount 20 includes curved channel 25, which matches the shape of arm 55, and wings 30, 30 for locking mount 20 onto arm 55. Kelly, col. 1, l. 60–col. 2, l. 4, Fig. 2. As Kelly’s mount already includes an opening, i.e., channel 25, it is not clear how the Examiner proposes to modify Kelly’s mount 20, according to Cook, in general, and channel 25 in particular, to include an opening, as called for by each of independent claims 1, 12, and 19. Although we appreciate the Examiner’s position that Cook’s “U-shaped mount 34 . . . clearly surrounds the top portion and side

portions of the first end second arms,” this does not explain how to modify Kelly’s mount 20.

Perhaps the Examiner’s combination results in Kelly’s mount 20 having an enlarged U-shaped channel 25 through which both arms 55 of Kelly’s pair of scissors 50 pass. However, in such a situation, it would not be clear how such an arrangement “increase[s] the space that the blades could pivot away from each other” as the shield portion, like in Cook, would mount on *both* scissor arms and, thus, the opening of the blades would be restricted. Therefore, based on the record before us we would only be speculating as to the Examiner’s position. We will not resort to speculation or assumptions to cure the deficiencies in the Examiner’s fact finding and/or reasoning. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967) (holding that “[t]he legal conclusion of obviousness must be supported by facts. Where the legal conclusion is not supported by facts it cannot stand.”).

Accordingly, for the foregoing reasons, we do not sustain the rejection under 35 U.S.C. § 103(a) of independent claims 1, 12, and 19, and their respective dependent claims 2–11, 13–16, and 20–27 as unpatentable over Kelly and Cook.

Claims 17 and 18

As independent claim 17 does not require the above disputed limitation found in independent claims 1, 12, and 19, Appellant makes separate arguments. *See* Appeal Br. 19, 21–22.

Appellant notes that independent claim 17 requires that “the shield portion is closer to the blade portion of the scissor arm to which the shield portion is mounted than to the blade portion of the other scissor arm during the cutting action.” *Id.* at 19. Appellant argues that “the shield portion [40] is closer to the upper blade

portion, but the shield portion is mounted to the scissor arm associated with the lower blade portion in this device.” *Id.*; *see also id.* at 21–22 (citing Kelly, Fig. 3).

We are persuaded by Appellant’s arguments because, in reviewing the record, we note that the Examiner’s Answer offers *no* rebuttal to Appellant’s argument. As we have an un rebutted argument, we do not sustain the rejection of claims 17 and 18 over the combined teachings of Kelly and Cooke.

SUMMARY

The Examiner’s decision to reject claims 1–9, 11, and 17–26 under 35 U.S.C. § 102(a)(1) as anticipated by Halpern is affirmed.

The Examiner’s decision to reject claims 1–27 under 35 U.S.C. § 102(a)(1) as anticipated by Cook is reversed.

The Examiner’s decision to reject claims 1–27 under 35 U.S.C. § 103(a) as unpatentable over Kelly and Cook is reversed.

AFFIRMED-IN-PART