



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/408,999	01/18/2017	Richard M. Chesbrough	740- PDD-07-29USDIVCON3DIV	4659
96000	7590	09/16/2020	EXAMINER	
AUST IP LAW Ronald K. Aust 12029 E. WASHINGTON STREET INDIANAPOLIS, IN 46229			BUI, VY Q	
			ART UNIT	PAPER NUMBER
			3771	
			NOTIFICATION DATE	DELIVERY MODE
			09/16/2020	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ip.docket@bd.com
raust@austiplaw.com
tshort@austiplaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RICHARD M. CHESBROUGH, STEVEN E. FIELD,
RYAN L. GOOSEN, JEFFERY W. ZERFAS, and RICHARD E. DAVIS

Appeal 2018-009237
Application 15/408,999
Technology Center 1600

Before DONALD E. ADAMS, ERIC B. GRIMES, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

PAULRAJ, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 100–119 for anticipation and obviousness. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real parties in interest as C.R. Bard, Inc. and Becton, Dickinson and Company. Appeal Br. 3.

STATEMENT OF THE CASE

The invention described in the specification relates generally to an apparatus for the percutaneous positioning of a radiopaque marker for identifying the location of a lesion in a stereotactic biopsy procedure. Spec.

1. The claims on appeal recite methods of operating the apparatus during a procedure for the percutaneous placement of an imaging marker in the patient.

Claim 100 is representative of the claims on appeal, and reads as follows:

100. A method for safely operating a marking apparatus in a percutaneous imaging marker placement procedure, comprising:

providing a handle, a cannula that extends from the handle, a stylet slidably received within a lumen of the cannula for movement between a ready position and an extended position, an imaging marker disposed completely within a marker recess formed by the cannula and the stylet, and an actuator having a plunger connected to the stylet to move the stylet from the ready position to the extended position to expel the imaging marker from the cannula;

providing a safety that comprises a channel provided on one of the handle and the plunger and a catch provided on the other of the handle and the plunger, the catch being rotatable relative to the channel;

defining a safety-on position wherein the catch and the channel are rotationally misaligned so as to prevent movement of the plunger and stylet from the ready position to the extended position;

defining a safety-off position wherein the catch and the channel are rotationally aligned so as to permit movement of the plunger and stylet from the ready position to the extended position; and

rotating the catch with respect to the channel to move the safety from the safety-on position to the safety-off position to

permit movement of the plunger and stylet from the ready position to the extended position to expel the imaging marker from the cannula.

Appeal Br. 31 (Claims App'x).

The Examiner has rejected claims 100–107 and 119 under pre-AIA 35 U.S.C. § 102(a)/102(e) as being anticipated by Heaton.²

The Examiner has rejected claims 108–118 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Heaton in view of Dowlatshahi.³

DISCUSSION

Rejection 1 – Anticipation Based On Heaton

With respect to the anticipation rejection of claims 100–107 and 119, the Examiner contends that Heaton “inherently discloses a method for safely operating a marking apparatus in a percutaneous imaging marker placement procedure.” Final Act. 2. With respect to the claimed safety mechanism, the Examiner identifies “transverse slot 122” in the body portion of Heaton’s apparatus as the “channel” and the deployment arms 152 in the plunger as the “catch.” *Id.* The Examiner contends that Heaton teaches “defining a safety-on position wherein the catch 152 is positioned outside the channel 122 are rotationally misaligned so as to prevent movement of the plunger and stylet from the ready position to the extended position.” *Id.* The Examiner further contends that Heaton teaches “defining a safety-off position (see Fig. 11) wherein the catch and the channel are rotationally aligned so as to permit movement of the plunger and stylet from the ready position to the extended position.” *Id.*

² Heaton et al., US 5,879,357, issued Mar. 9, 1999.

³ Dowlatshahi, US 5,853,366, issued Dec. 29, 1998.

Appellant contends that the Examiner's reliance upon the disassembly of the Heaton apparatus shown in the exploded view of Figure 2 does not meet the claim requirements of "defining a safety-on position wherein the catch and the channel are rotationally misaligned so as to prevent movement of the plunger and stylet from the ready position to the extended position" and "rotating the catch with respect to the channel to move the safety from the safety-on position to the safety-off position to permit movement of the plunger and stylet from the ready position to the extended position to expel the imaging marker from the cannula." Appeal Br. 18–24. We find Appellant's arguments persuasive.

The Examiner contends that "there is nothing in the claims to limit the scope of the claims only to operation during a procedure on a patient, but rather providing and assembling." Ans. 3. We find that to be an unreasonable interpretation of the claims. Independent claims 100 and 119 are directed to methods of "safely operating a marking apparatus," not merely providing and assembling such an apparatus. Claim 100 more specifically is directed to operating a marking apparatus "in a percutaneous imaging marker placement procedure." We agree with Appellant that the claims are directed to steps associated with a method of operating the apparatus to place an imaging marker through a patient's skin, and not merely to the assembly of the apparatus. Reply Br. 8–9.

Furthermore, the claims require "rotating the catch with respect to the channel to move the safety from the safety-on position to the safety-off position to permit movement of the plunger and stylet from the ready position to the extended position to expel the imaging marker from the cannula." The Examiner does not explain why, and we find nothing in the

reference itself to suggest that, the device of Heaton during its “normal and usual operation” could be rotated in such a manner to move from a safety-on to a safety-off position. *See* MPEP § 2112.02 (“Under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device.”). As such, the Examiner has not satisfied the requirements for inherency.

Accordingly, we determine that the Examiner has not established that claims 100–107 and 119 are anticipated by Heaton. We, therefore, reverse the rejection under 35 U.S.C. § 102(a)/(e).

Rejection 2 – Obviousness Based On Heaton in View of Dowlatshahi

With respect to the obviousness rejection of claims 108–118, the Examiner relies upon the teachings of Heaton in a manner similar to that discussed above with regard to the anticipation rejection. Final Act. 4. Independent claim 108, like independent claim 100, recites “[a] method of operating a marking apparatus for the percutaneous placement of an imaging marker at a location in a patient.” Furthermore, claim 108 recites:

operating a safety to selectively prohibit the sliding of the stylet, wherein the safety comprises a channel provided on one of the handle and the plunger and a catch provided on the other of the handle and the plunger such that when the catch and channel are aligned, the stylet can slide from the ready position to the extended position, and when the catch and the channel are misaligned, the stylet cannot slide from the ready position to the extended position.

Again, the Examiner does not explain why, and we find nothing in the reference itself to suggest that, the device of Heaton during its “normal and usual operation” could be operated in such a manner to selectively prohibit

the sliding of the stylet. The Examiner does not rely upon the teachings of Dowlatshahi to make up the foregoing deficiency with respect to Heaton.

Accordingly, we determine that the Examiner has not established that claims 108–118 are rendered obvious by Heaton in view of Dowlatshahi. We, therefore, reverse the rejection under 35 U.S.C. § 103(a).

CONCLUSION

In summary:

Claim(s) Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
100–107, 119	102(a)/(e)	Heaton		100–107, 119
108–118	103(a)	Heaton, Dowlatshahi		108–118
Overall Outcome				100–119

REVERSED