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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MATTHIAS E. SCHUELE

Appeal 2019-002738
Application 14/566,800
Technology Center 3700

Before DANIEL S. SONG, STEFAN STAICOVICI, and
MICHAEL L. HOELTER, *Administrative Patent Judges*.

HOELTER, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1, 4–12, 14–18, 21, and 22. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM IN PART.

¹ 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 “pro med instruments GmbH.” Appeal Br. 2.

CLAIMED SUBJECT MATTER

The disclosed subject matter relates to “retractor systems [that] can be used in certain medical procedures where retraction, holding, or positioning of tissue, for example, would be beneficial.” Spec. ¶ 2. Apparatus claim 1 and system claim 22 are independent. Claim 1 is illustrative of the claims on appeal and is reproduced below.

1. A surgical retractor system for use in a medical procedure, said surgical retractor system comprises:

(a) a first rod;

(b) a second rod, comprising an elongated curved shape;

(c) a first coupling assembly operable to selectively and adjustably couple the first rod with a stabilization device, wherein the first coupling assembly defines a first axis of rotation and a second axis of rotation, wherein the first rod is rotatably adjustable about the first axis of rotation and the second axis of rotation, wherein rotation of the first rod about a select one or both of the first axis of rotation and the second axis of rotation adjusts a position of the first rod relative to the stabilization device; and

(d) a second coupling assembly operable to selectively and adjustably couple the second rod with the first rod, wherein the second coupling assembly defines a third axis of rotation and a fourth axis of rotation, wherein the second rod is rotatably adjustable about the third axis of rotation and the fourth axis of rotation, wherein rotation of the second rod about a select one or both of the third axis of rotation and the fourth axis of rotation adjusts a position of the second rod relative to the first rod.

EVIDENCE

Name	Reference	Date
Winqvist et al. (“Winqvist”)	US 2002/0165543 A1	Nov. 7, 2002
Olsen	US 2006/0229602 A1	Oct. 12, 2006

Krishna et al. (“Krishna”)	US 2006/0265074 A1	Nov. 23, 2006
Richelsoph et al. (“Richelsoph”)	US 2007/0049932 A1	Mar. 1, 2007

REJECTIONS

Claims 1, 4–8, 17, 18, and 21 are rejected under 35 U.S.C. § 102(a)(1) as anticipated by Olsen.

Claims 1, 7–12, 14, and 22 are rejected under 35 U.S.C. § 103 as unpatentable over Richelsoph and Krishna.

Claims 15 and 16 are rejected under 35 U.S.C. § 103 as unpatentable over Richelsoph, Krishna, and Winqvist.

ANALYSIS

*The rejection of claims 1, 4–8, 17, 18, and 21
as anticipated by Olsen*

Appellant argues these claims together. *See* Appeal Br. 6–10. We select claim 1 for review, with the remaining claims standing or falling with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Claim 1 recites the limitation of “a second rod.” The Examiner identifies Olsen’s “540 and/or 12” as disclosing this limitation. Final Act. 3. Appellant restates this finding as, “the Office relied on structures 12 or 540 of Olsen as allegedly satisfying the claimed second rod.” Appeal Br. 7. The Examiner clarifies stating that what was meant was “member 540 alone or in combination with 12.”² Ans. 17.

² The second rod “is interpreted to be member (540, Fig. 20) alone, or in combination with member” 12. Ans. 17 (referencing Olsen ¶ 121).

With such understanding, Appellant focuses attention on the limitation “a second rod, comprising an elongated curved shape.” *See* Reply Br. 2–5, Appeal Br. 6, 9. Regarding the “curved” limitation, Appellant addresses Olsen which states “joint member **540** . . . has a cylindrical body **548** that is *coupled at an angle* traverse to extension member **542**.” Reply Br. 4, Olsen ¶ 121 (emphasis added); *see also* Appeal Br. 9. Appellant provides a definition from Dictionary.com of “curved” as, “a continuously bending line, *without angles*.” Reply Br. 4 (emphasis added). Hence, Appellant argues that Olsen “describ[es] its joint member 540 as angled, which, according to the definition of ‘curved,’ is opposite of what claim 1 recites and requires.” Reply Br. 4.

Indeed, paragraph 121 of Olsen is correctly transcribed by Appellant above, but as to joint member 540, paragraph 121 of Olsen further states, “the joint members of the present invention *may have curves or other configurations*.” Emphasis added. In that regard, again, the claim limitation at issue recites “a second rod, *comprising* an elongated curved shape,” and does not require the second rod to be curved in its entirety. Thus, in view of this further clarification as to the shape of member 540 itself, we do not fault the Examiner for finding that Olsen discloses that member 540 can comprise a curved shape. Final Act. 3.

The question now, is whether the above “elongated” limitation is also disclosed in Olsen, i.e., whether Olsen further teaches the limitation, “a second rod, comprising an elongated curved shape.” Appellant again looks to Dictionary.com stating “the term ‘elongated’ means ‘extended;

lengthened; or long and thin.”³ Reply Br. 5. Appellant explains that “no one of ordinary skill in the art, including Olsen himself as evidence by his own description, would consider joint member 540 ‘elongated.’” Reply Br. 5. However, consideration of joint member 540 alone does not conclude the matter since Appellant understands, “the Office states that the claimed second rod could be satisfied by combining main body 12 with joint member 540.” Reply Br. 5; *see also supra*. In attempting to explain how such a combination still fails to disclose an “elongated” second rod (applying Appellant’s definition thereof), Appellant asserts (a) the Examiner’s combination of components used to satisfy the single claimed second rod component runs afoul of MPEP § 2131, and (b) the combination still fails because one skilled in the art would not consider joint member 540 “curved.” Reply Br. 5; *see also id.* at 6; Appeal Br. 10.

Regarding Appellant’s initial contention regarding MPEP § 2131, Appellant states,

it is improper for the Office to try to find one component that allegedly satisfies the ‘elongated’ adjective, and then try to find a separate component altogether that allegedly satisfies the ‘curved’ adjective, and then combine them to make an anticipation rejection directed to a single claimed component that has an ‘elongated curved shape.’

Reply Br. 6; *see also* Appeal Br. 10. Appellant does not identify where such combination is prohibited when the identified components (i.e., 540, 12) are

³ The Examiner also proffers a definition of “elongated” (*see* Ans. 19) but Appellant correctly identifies issues with this definition (*see* Reply Br. 5), and thus Appellant’s definition will be applied.

themselves joined directly to each other in the single reference relied upon.^{4, 5} *See Olsen generally.*

Additionally, Appellant's latter contention is not persuasive because (a) Appellant is still addressing only "joint member 540," and not its combination with elongated main body 12, and (b) paragraph 121 of Olsen clearly states that joint member 540 itself "may have curves." Thus, in view of the above, Appellant does not explain how the Examiner's combination of main body 12 and joint member 540 fails to disclose "a second rod, comprising an elongated curved shape."

Claim 1 further recites a first rod "wherein rotation of the first rod *about a select one or both* [axes of rotation] adjusts a position of the first rod relative to the stabilization device." Emphasis added. Appellant paraphrases the Examiner's findings on this point arguing that Olsen "fails to address the requirements of the claim because claim 1 requires that the *first rod* is rotatably adjustable about the claimed axes of rotation." Appeal Br. 10 (underlining added); *see also* Reply Br. 7, 8. Appellant is mistaken as to the scope of claim 1 which, instead, recites rotation about "one or both" axes of rotation, not "both" as argued.

Appellant acknowledges the Examiner's reliance on Olsen's "relative rotation between the first rod and the stabilization device." Reply Br. 7; *see*

⁴ "The office relies on the embodiment of Olsen that includes joint member 540 as an alternative to joint member 300, being identical, which is to be combined with member 12, Fig. 2." Ans. 17.

⁵ We are also reminded of *Howard v. Detroit Stove Works*, 150 U.S. 164, 170 (1893) which addresses a prior art grate that "is cast in two pieces, while the [claimed invention] is cast in one piece. This does not involve patentable invention."

also Appeal Br. 10, Final Act. 4. However, Olsen discusses more than rotation about a single axis of rotation, and specifically discusses rotation about multiple axis of rotation stating, “**FIG. 1** shows an adjustable splint 10 that is adjustable in more than one plane or axis, as illustrated by the arrows therein.” Olsen ¶ 45; *see also id.* ¶ 51, Fig. 8, Final Act. 4, Ans. 19–20. Appellant fails to explain how Olsen’s disclosed axes of rotation fail to correspond to the “first” and “second” axes of rotation recited in claim 1. Hence, Appellant’s contention that Olsen fails to disclose rotation “about a select one or both” axis of rotation is not persuasive of Examiner error.

Accordingly, and based on the record presented, we sustain the Examiner’s rejection of claims 1, 4–8, 17, 18, and 21 as anticipated by Olsen.

*The rejection of claims 1, 7–12, 14, and 22
as unpatentable over Richelsoph and Krishna*

Appellant argues that Richelsoph and Krishna are non-analogous art, and hence not subject to being combined by the Examiner for the reasons stated. *See* Appeal Br. 11–12; Reply Br. 8–11; Final Act. 10, 14. Appellant addresses both the “field of endeavor” prong of the analogous art test and also the “reasonably pertinent to the problem” prong of this test.⁶ *See* Appeal Br. 11–12; Reply Br. 8–11. The Examiner addresses only the “field of endeavor” prong stating, “there is no need to proceed for determining

⁶ “To qualify as prior art for an obviousness analysis, a reference must qualify as ‘analogous art,’ i.e., it must satisfy one of the following conditions: (1) the reference must be from the same field of endeavor; or (2) the reference must be reasonably pertinent to the particular problem with which the inventor is involved.” *K-TEC, Inc. v. Vita-Mix Corp.*, 696 F.3d 1364, 1375 (Fed. Cir. 2012) (citation omitted).

whether the references are reasonably pertinent to the particular problem.”

Ans. 22.

Appellant states:

The teachings in Krishna are directed to a lumbar disc prosthesis, and the teachings of Richelsoph are directed to a spinal rod and anchor system. The present application and claims are directed to a surgical retractor system.

Appeal Br. 11; *see also* Reply Br. 10. Appellant thereafter explains that Krishna’s lumbar disc prostheses is “used within the body,” the same as Richelsoph’s spinal rod system. Appeal Br. 11 (referencing Krishna ¶ 2, Richelsoph ¶ 3). In contrast, Appellant contends that the claimed surgical retractor system is “used primarily outside of a body” for temporary support during a medical procedure. Appeal Br. 11; *see also* Reply Br. 10–11; Spec. ¶ 43. Thus, Appellant concludes, “it cannot be fairly said that either lumbar disc prostheses or spinal rod and anchor systems are within the same field of endeavor as surgical retractor systems.” Appeal Br. 11; *see also* Reply Br. 10.

The Examiner responds, “the teachings of Richelsoph and Krishna and the claimed invention, are directed to medical systems being used relative to a human body.” Ans. 21. Further, the Examiner states that a skilled person would “understand that the disclosed and claimed systems are from the same field of Endeavor, being directed to systems related to the medical field.” Ans. 21.

The Examiner’s stated field of use is quite broad. On the other hand, Richelsoph, while not explicitly describing its device as a prosthesis for use inside a body, does explain that its spinal clamp members “are made of a biocompatible, resilient material” and are used “for the purpose of spinal

fixation and correction of spinal curvature.” Richelsoph ¶¶ 3, 35. Krishna, on the other hand, is more explicit stating in the Title that the device is a new anteriorly inserted artificial disc. *See also* Abstract (“[a] lumbar disc prosthesis is provided . . .”). We are further guided by *In re Bigio*, 381 F.3d 1320 (Fed. Cir. 2004) in which our reviewing court stated that the analogous art “test does not make the assessment of the field of endeavor a wholly subjective call for the examiner.” *Bigio*, 381 F.3d at 1326; *see also* Reply Br. 9. Thus, at least with respect to Krishna, there is merit to Appellant’s contention that a skilled person would not consider a prosthesis installed inside the body as being in the same field of endeavor as an externally employed surgical retractor, and particularly one that can provide an “ergonomic support rest for a surgeon or other medical personnel to rest their one or more arms or hands [on] during a medical procedure.” Spec. ¶ 43.

Accordingly, and based on the record presented, the Examiner has not established by a preponderance of the evidence that Richelsoph and Krishna are within the same field of endeavor. Moreover, as noted, the Examiner has not considered whether Richelsoph and Krishna are reasonably pertinent to the problem confronting the inventor. *See* Ans. 22. Thus, the Examiner has not established that the applied references are analogous art in the matter at hand, and thus suitable for combination as expressed by the Examiner. We reverse the Examiner’s rejection of claims 1, 7–12, 14, and 22 as unpatentable over Richelsoph and Krishna.

*The rejection of claims 15 and 16
as unpatentable over Richelsoph, Krishna, and Winqvist*

Claims 15 and 16 each depend directly from claim 1. The Examiner relies on Winqvist for teaching their respectively added limitations. The Examiner does not rely on Winqvist to cure the defect of the combination of Richelsoph and Krishna as discussed above. Accordingly, for similar reasons, we do not sustain the Examiner's rejection of claims 15 and 16 as being obvious over Richelsoph, Krishna, and Winqvist.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 4-8, 17, 18, 21	102(a)(1)	Olsen	1, 4-8, 17, 18, 21	
1, 7-12, 14, 22	103	Richelsoph, Krishna		1, 7-12, 14, 22
15, 16	103	Richelsoph, Krishna, Winqvist		15, 16
Overall Outcome⁷			1, 4-8, 17, 18, 21	9-12, 14-16, 22

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

AFFIRMED IN PART

⁷ 37 C.F.R. § 41.50(a)(1) states, "The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim."