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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID CHOTENOVSKY and MITCHEL GUTTENPLAN

Appeal 2019-002743
Application 13/972,202
Technology Center 3700

Before JOHN C. KERINS, MICHAEL L. HOELTER, and
MICHELLE R. OSINSKI, *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, 2, 4, 5, 7, and 9–20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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 “CRH Medical Corporation.” Appeal Br. 3.

CLAIMED SUBJECT MATTER

The disclosed subject matter “relates to the treatment of hemorrhoids by elastic band ligation.” Spec. ¶ 1. Sole apparatus claim 1 is independent. Claim 1 is illustrative of the claims on appeal and is reproduced below with bracketed parentheticals added.

1. An elastic band ligation device for treatment of hemorrhoidal tissue, comprising:

an inner tubular member having a front end and a rear end, for retaining a stretched elastic band over the front end thereof, the front end having an opening,

a plunger in the inner tubular member with a handle extending away from the front end of the inner tubular member, the handle for sliding the plunger away from the rear end of the inner tubular member to provide a suction for drawing hemorrhoidal tissue into the inner tubular member through the opening at the front end,

an obturator having an outer surface and disposed within the inner tubular member, said obturator having a distal end with an outer surface, the distal end of the obturator and the inner surface of the inner tubular member defining an anti-pinch structure comprising a flexible wiper element integrally formed with the front terminal end of the inner tubular member, said flexible wiper element comprising a distal end, a proximal end, a wiper element inner surface and a wiper element outer surface, said wiper element outer surface being inclined, said inner and outer wiper element surfaces converging from said proximal end to said distal end, said distal end abutting against the outer surface of the obturator and preventing tissue from being trapped or pinched between the outer surface of the end of the obturator and the inner surface of the inner tubular member [(hereinafter the “wiper” limitation, *see* Fig. 17)],

an outer tubular pusher sleeve configured to provide a limited friction fit over the inner tubular member, with an external end of the outer tubular pusher sleeve adjacent the stretched elastic band,

wherein the outer surface of the end of the obturator is convergent towards the distal end of the obturator and creates an angle of 5-25 degrees between the outer surface of the end of the obturator and the inner surface of the inner tubular member [(hereinafter the “taper” limitation, *see* Fig. 2B)].

REJECTION²

Claims 1, 2, 4, 5, 7, and 9–20 are rejected under 35 U.S.C. § 112(a) as failing to comply with the written description requirement.^{3, 4}

ANALYSIS

The following discussion makes repeated reference to Appellant’s Figures 2B and 17. We replicate these two Figures (and also Fig. 16) for clarity and understanding.

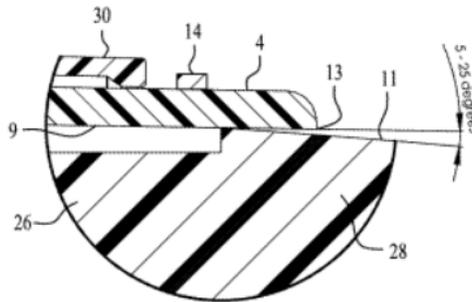


FIG. 2B

² The rejection of claims 1, 2, 4, 5, 7, and 9–20 under 35 U.S.C. § 112(b) as being indefinite has been withdrawn. *See* Ans. 3.

³ The Examiner initially listed claims 7–20 (Final Act. 4), but claim 8 was canceled. *See* Advisory Action dated July 12, 2018.

⁴ The rejection of claims 1–3, 5, 7, and 9–20 under 35 U.S.C. § 103 has been withdrawn. *See* Final Act. 9.

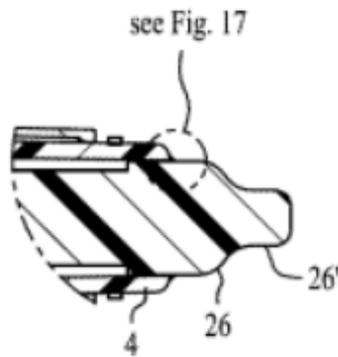


FIG. 16

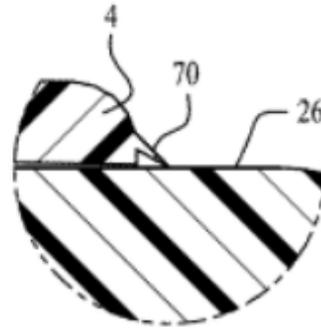


FIG. 17

The above are cross-sectional views of Appellant's ligation device, each illustrating obturator 26 projecting from (i.e., to the right of) inner tubular member 4. Figure 2B discloses "one embodiment" (Spec. ¶ 12) illustrating what is identified in claim 1 above as the "taper" limitation. Figure 17 discloses "another embodiment" (Spec. ¶ 13; *see also id.* ¶ 74) illustrating the above-identified "wiper" limitation. Figure 16 discloses yet another embodiment (*see Spec.* ¶¶ 72, 73).

The Examiner addresses limitations recited in sole independent claim 1, which have been identified in the replication of claim 1 above as the "wiper" limitation and the "taper" limitation. Final Act. 5. The Examiner references both these limitations stating "[t]he combination of these limitations is not supported by the originally filed application." Final Act. 5. To reiterate, the Examiner states, "[t]he specification does not disclose that these two embodiments can be combined and the drawings do not illustrate the combination of these two embodiments." Final Act. 5; *see also* Ans. 4.

Hence, according to the Examiner, their combination together “is considered new matter.”⁵ Final Act. 6.

We note that Appellant does not identify where Appellant’s Specification, or any accompanying Figure, *explicitly* discloses the combination of these two limitations. Instead, Appellant states that one skilled in the art “would have understood that the specification describes, at least implicitly and/or inherently” their combination together. Appeal Br. 10; *see also id.* 12, 15, 16. As support, Appellant references case law stating, “the test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” Appeal Br. 8 (referencing *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc)). Appellant also identifies where “the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.” Appeal Br. 9 (referencing *In re Wertheim*, 541 F.2d 257, 263 (CCPA 1976)). Appellant also states that “there is no *in haec verba* requirement in regard to the written description requirement.” Appeal Br. 9.

In view of the above, Appellant contends that the disclosed obturator has the same reference numeral (26) in both Fig. 2B (illustrating the “taper” limitation) and Fig. 17 (illustrating the “wiper” limitation). Appeal Br. 11. Further, in both instances, Appellant indicates the recited “inner tubular member” also has the same reference numeral “4” in both Figures. Appeal

⁵ The Examiner does not allege that each limitation, alone, is not disclosed, only their combination together. *See, e.g.*, Spec. ¶¶ 62, 74, Figs. 2B and 17.

Br. 11. Thus, when addressing Fig. 17 (which illustrates the “wiper” limitation), Appellant states that it is the same device as that depicted in Fig. 2B (which illustrates the “taper” limitation) “but this time with the flexible anti-pinch wiper element 70 mounted on the end of the inner tubular member 4.” Appeal Br. 11. Hence, in summation, Appellant contends,

it is clear that the description in the original specification and drawings would have reasonably conveyed to one of skill in the art of hemorrhoidal ligation devices, at least implicitly or inherently, that the inventors, at the time the application was filed, had possession of the claimed invention [which includes both the “wiper” limitation and the “taper” limitation].

Appeal Br. 11.

The Examiner, referencing “the non-final mailed 06/27/201[7], [] the final mailed 03/21/2018, and [] the advisory action mailed 07/12/2018” states, “the specification described two alternate embodiments for a pinch structure,” one concerning the “wiper” limitation and the other the “taper” limitation. Ans. 3–4. Appellant’s Specification “did not state that these two embodiments could be combined and the drawings did not show them as combined.” Ans. 4. Thus, “[t]he Office provided adequate evidence and reasons as to why one of ordinary skill in the art would not have recognized that appellant had possession of the claimed invention at the time of filing.” Ans. 4.

Indeed, Appellant’s Specification describes the “wiper” Figure 17 embodiment as “another” or “an alternative embodiment.” Spec. ¶¶ 13, 74. In fact, this Figure 17 version is described as an alternative embodiment of yet a third anti-pinch design (*see* Figs. 13–16). Spec. ¶ 74 (“FIG. 17 is a cross-sectional view of the circled portion of FIG. 16 showing an alternative embodiment”). This Figure 17 alternative embodiment is described

“whereby a flexible anti-pinch wiper element 70 . . . is connected to, or integrally formed with, the end of the inner tubular member 4.” Spec. ¶ 74 Further, this third anti-pinch version (illustrated in Figs. 13–16) is itself described as “an alternative embodiment showing a differently shaped end” for obturator 26. Spec. ¶ 72. It is not altogether clear that the tapered obturator Fig. 2B embodiment would have been envisaged as combinable with the non-tapered obturator Fig. 17 embodiment because the ends of obturator 26 depicted in these two embodiments are different. As shown in Figure 2B, the end of obturator 26 creates an angle of from 5–25 degrees with “the inner surface 9 of the inner tubular member 4.” Spec. ¶ 62. However, there is no such tapering or angling of the end of obturator 26 in the Figure 17 embodiment, which illustrates, instead, a parallel surface. *See* Ans. 7. As described, wiper 70 “abuts against” and wipes obturator 26 during their relative movement to avoid pinching. Spec. ¶ 74. However, when describing the Figure 2B embodiment, Appellant’s Specification states that this embodiment intentionally incorporates a “gap” or “opening 13” between obturator 26 and inner surface 9 to avoid pinching. Spec. ¶ 62. It would thus appear that the two embodiments (*i.e.*, Figure 2B and Figure 17) are mutually exclusive of each other, one employing a gap to avoid pinching and the other employing an abutting wiper (*i.e.*, no gap) to avoid pinching.

Appellant attempts to argue that “the ends in Fig. 2B and Fig. 16 are **not** different in regard to the region where the anti-pinch wiper blade contacts the surface of” obturator 26.⁶ Appeal Br. 14; *see also id.* at 15.

⁶ Although Appellant argues this with respect to “Fig. 16,” the same can be said for Figure 17 as well since Figure 17 is “an alternative embodiment” of Figure 16. Spec. ¶ 74.

However, this is clearly not correct because in the Fig. 17 embodiment the “region where the anti-pinch wiper blade contacts the surface” of obturator 26 remains spaced a constant distance from tube 4 during their relative movement so that wiping can occur. Appeal Br. 14. That is not the case in the Figure 2B embodiment where, at the region identified by Appellant, the distance between obturator 26 and tube 4 varies during their relative movement due to the 5–25 degree angle at the end of obturator 26. See ¶¶ 12, 62.

Accordingly, we agree with the Examiner’s conclusion that “[t]he specification does not disclose that these two embodiments can be combined and the drawings do not illustrate the combination of these two embodiments.” Final Act. 5. Further, such combination is not self-evident, or implicit, as Appellant argues. See Appeal Br. 9–12, 15–17. We sustain the Examiner’s written description rejection of independent claim 1, and of dependent claims 2, 4, 5, 7, and 9–20.⁷

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 2, 4, 5, 7, 9–20	112(a)	Written Description	1, 2, 4, 5, 7, 9–20	

⁷ We further note that claim 1 recites “the inner surface of the inner tubular member defining an anti-pinch structure comprising a flexible wiper element integrally formed with the front terminal end of the inner tubular member.” It is not altogether clear how an anti-pinch structure specifically defined as being on the *inner surface* of tubular member 4 can comprise a wiper that is integrally formed with an (external) *end* of tubular member 4. See Figure 17; Spec. ¶ 74.

Appeal 2019-002743
Application 13/972,202

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

AFFIRMED