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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SCOTT REED

Appeal 2020-000056
Application 15/052,952
Technology Center 3700

Before STEFAN STAICOVICI, WILLIAM A. CAPP, and
JEREMY M. PLENZLER, *Administrative Patent Judges*.

Opinion for the Board filed by PLENZLER, *Administrative Patent Judge*

Opinion Concurring filed by CAPP, *Administrative Patent Judge*

PLENZLER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–20. 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(a). Appellant identifies the real party in interest as Covidien LP. Appeal Br. 2.

CLAIMED SUBJECT MATTER

The claims are directed to a surgical device. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A surgical device comprising:

an elongated body portion including an outer tube and an inner shaft assembly, the inner shaft assembly having a distal tube defining a non-circular bore in a distal end thereof, the inner shaft assembly being longitudinally movable through the outer tube, the outer tube and the distal tube defining corresponding openings extending transversely therethrough;

an end effector configured and dimensioned for selective connection to the elongated body portion, the end effector supporting surgical fasteners positioned to distally advance through the end effector, the end effector including a drive shaft extending proximally therefrom and defining an annular recess in an outer surface thereof, the drive shaft having a non-circular transverse cross-sectional profile that is complimentary in shape to the non-circular bore of the distal tube; and

a detent movable within the openings of the elongated body portion, the detent positionable between the annular recess of the drive shaft and the outer tube of the elongated body portion to connect the end effector to the elongated body portion in response to insertion of the drive shaft into the non-circular bore of the distal tube.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Green	US 5,356,064	Oct. 18, 1994
Milliman	US 6,953,139 B2	Oct. 11, 2005
Lehot	US 7,296,804 B2	Nov. 20, 2007
Kupferschmid	US 2002/0095177 A1	July 18, 2002
Zergiebel	US 2008/0281336 A1	Nov. 13, 2008
Barth	US 2015/0238242 A1	Aug. 27, 2015

REJECTIONS

Claims 1, 2, 5–13, 15, 16, and 18–20 are rejected under 35 U.S.C. § 103 as being unpatentable over Milliman, Lechot, and Zergiebel.

Claim 3 is rejected under 35 U.S.C. § 103 as being unpatentable over Milliman, Lechot, Zergiebel, and Kupferschmid.

Claim 4 is rejected under 35 U.S.C. § 103 as being unpatentable over Milliman, Lechot, Zergiebel, and Barth.

Claim 14 is rejected under 35 U.S.C. § 103 as being unpatentable over Milliman, Lechot, and Kupferschmid.²

Claim 17 is rejected under 35 U.S.C. § 103 as being unpatentable over Milliman, Lechot, and Green.³

OPINION

With respect to claim 1, the Examiner proposes combining teachings from Lechot and Zergiebel with those of Milliman. Final Act. 2–4. Appellant disputes the Examiner’s rationale for combining Zergiebel’s teachings with those of Milliman. Appeal Br. 7–9.

The Examiner finds that “Milliman does not disclose surgical fasteners positioned to distally advance through its end effector.” Final Act. 4. To remedy this deficiency, the Examiner finds that “Zergiebel teaches surgical fasteners (10) positioned to distally advance through the end effector (fig. 74) an inner shaft (242) assembly being actuatable to distally advance at least one surgical fastener through the end effector.” *Id.* The

² Although claim 14 depends from claim 12, and the rejection of claim 12 relies on Zergiebel, the rejection of claim 14 does not list Zergiebel.

³ Although claim 17 depends from claim 12, and the rejection of claim 12 relies on Zergiebel, the rejection of claim 17 does not list Zergiebel.

Examiner reasons that “[i]t would have been obvious . . . to *substitute* the end effector of Milliman with the end effector of Zergiebel for the purpose of applying surgical fasteners” because “[b]oth Milliman and Zergiebel teach end effectors for applying surgical fasteners” and “it would have been obvious to substitute one type for another to accomplish the same purpose.” *Id.* (emphasis added); *see also* Ans. 4 (“The proposed modification was simple substitution.”).

Appellant responds that “Milliman’s stapling device operates completely different from Zergiebel’s device (e.g., via axial translation of a drive member/rod versus via rotation of a drive member/rod), and such a modification would amount to a complete restructuring or redesign of Milliman’s surgical stapling apparatus.” Appeal Br. 8; *see also* Reply Br. 3–4 (noting that “the Examiner relies on a simple substitution rationale, yet acknowledges that such substitution ‘may require a redesign,’” (citing Ans. 4),” and further asserting that “[i]f such a redesign may be required, it is unclear to Appellant how such a substitution could constitute a simple substitution, particularly where the principle of operation of the device disclosed by Milliman would have to be materially changed to enable the substituted end effector of Zergiebel to work with the device of Milliman”).

Appellant has the better position. As Appellant notes, after making clear that “[t]he proposed modification was simple substitution,” the Examiner acknowledges that “the change of function between the two end effectors [of Milliman and Zergiebel] may require a redesign.” Ans. 4. The problem with the rejection is that the Examiner relies on substituting Zergiebel’s end effector in place of Milliman’s. Final Act. 4; Ans. 4. The Examiner does not propose modifying the actuation mechanism in Milliman

in any way in order to accommodate Zergiebel's end effector. Nor does the Examiner propose modifying Zergiebel's end effector in any way to accommodate Milliman's actuation mechanism. Most importantly, the Examiner does not dispute Appellant's contention that Zergiebel's end effector would not work when substituted into Milliman's device.

Indeed, Milliman's device operates to clamp and deploy staples by axial displacement of its drive member *without rotation*. See, e.g., Milliman 14:32–67. Zergiebel, on the other hand, requires axial displacement *and rotation* of its drive member. See, e.g., Zergiebel ¶ 193. Without rotation in Milliman's device, it is unclear how Zergiebel's end effector could simply be substituted into Milliman's device without further modifications, which are not proposed by the Examiner.

For at least these reasons, we do not sustain the Examiner's decision to reject claim 1.⁴ Claims 2–11 depend from claim 1. The stated bases for the rejection of those claims do not cure the deficiencies in the rejection of claim 1.

Claims 12 and 18 are independent, each differing in scope from claim 1. Claim 1 is directed to “[a] surgical device,” which includes “an elongated body portion,” “an end effector,” and “a detent.” Claim 12, on the other hand, is directed to the “end effector,” and claim 18 is directed to “[a] surgical fastener applying device,” which includes “an elongate body

⁴ Our affirmance of the Examiner's rejection is based solely on the rejection as presented, which requires the simple substitution rationale presented. That we do not make a new ground of rejection should not be interpreted as taking any position as to whether the claim1 would have been obvious for other reasons, even based on the same combination of references cited by the Examiner.

portion” and “a detent.” Nevertheless, the Examiner treats claims 1, 12, and 18 together in the findings and rationale for the rejection. Based on the stated rejection, we are unable to discern, for example, if there are some teachings from Milliman cited by the Examiner that are not required for the rejection of claim 12 or if there are some teachings from Zergiebel cited by the Examiner that are not required for the rejection of claim 18.

Accordingly, we also do not sustain the Examiner’s rejection of claims 12 and 18, or claims 13–17, 19, and 20, depending therefrom, for the reasons set forth above with respect to claim 1.

CONCLUSION

The Examiner’s rejections are reversed.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 2, 5–13, 15, 16, 18–20	103	Milliman, Lechot, Zergiebel		1, 2, 5–13, 15, 16, 18–20
3	103	Milliman, Lechot, Zergiebel, Kupferschmid		3
4	103	Milliman, Lechot, Zergiebel, Barth		4
14	103	Milliman, Lechot, Kupferschmid		14
17	103	Milliman, Lechot, Green		17
Overall Outcome				1–20

Appeal 2020-000056
Application 15/052,952

REVERSED

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SCOTT REED

Appeal 2020-000056
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OPINION CONCURRING

CAPP, *Administrative Patent Judge*

I concur in the result reached by the majority because I agree that the Examiner's reasoning and analysis regarding combining the teachings of the prior art to achieve the claimed invention, under the particular facts and circumstances of this case, are inadequate. However, such does not necessarily lead to the conclusion that Appellant's claims are patentable.

The dispute between Appellant and the Examiner centers on issues related to the fact that Milliman's device operates via axial motion and Zergiebel's device operates via rotational motion. *See e.g.*, Reply Br. 3. In that regard, I agree with Appellant and the panel majority that the Examiner's proposed modification of the prior art entails more than a simple substitution of one known element for another. *See* Final Act. 4.

Milliman features stationary handle 22 and movable handle 24. Milliman, col. 7, ll. 3-17. The two handles are configured to allow for a pistol-type grip of one hand on the device. *Id.* Fig. 40. Movable handle 24 pivots to move engagement finger 43 of the driving pawl 42 into contact

with toothed rack 48 of actuation shaft 46 to advance the actuation shaft linearly in the distal direction. *Id.* col. 7, ll. 3-17. In other words, squeezing movable handle 24 toward to stationary handle 22 produces axial motion at or near the end effector at the distal end of the device.

Zergiebel features trigger 54 that is movably mounted to body 52. Zergiebel ¶ 99. Zergiebel's trigger arrangement is substantially identical to the handle configuration of Milliman described in the preceding paragraph. *Id.* Fig. 2. Squeezing Zergiebel's trigger produces rotation of a planetary gear carrier which is eventually converted into rotation of socket 470 proximate the distal end of the device. *Id.* ¶¶ 192–193.

I suspect that the Examiner is sufficiently skilled in the mechanical arts to describe and explain that it is merely a matter of ordinary skill to convert axial motion to rotational motion (or *vice versa*) in a mechanical device. Yet, for reasons that remain unexplained, the Examiner fails to provide such an analysis in the rejection. The Examiner appears to concede that combining the teachings of Milliman and Zergiebel at least “*may require a redesign*” (Ans. 4), but then, nevertheless, fails to explain how or why such redesign requires no more than ordinary skill together with why a person of ordinary skill in the art would have had a reason to make the redesign. *See generally* Answer.

In my opinion, the Examiner and could have and should have provided such an explanation and analysis in the Answer, if not the Final Rejection. We sit primarily as a review tribunal. *See* 37 C.F.R. § 41.50(b); MPEP § 1213.02 (explaining that the Board's primary role is to review the adverse decision as presented by the Examiner, and not to conduct its own separate examination of the claims). While we have discretion, in

appropriate cases, to enter a new ground of rejection to remedy an Examiner's deficiencies, we are not required to do so. *Id.* (explaining that the Board enters a new ground of rejection at its discretion, and no inference should be drawn from a failure to exercise that discretion).

Thus, although I have serious doubts about the patentability of Appellant's invention, it is incumbent upon the Examiner, in the first instance, to express an obviousness conclusion that is based on explicit articulated reasoning with rational underpinning. *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) cited with approval in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). In the absence of sound articulated reasoning in the instance case, I am forced to concur in the result reached by the majority.