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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHIA-YUAN LIU and CHING-CHUNG LIN

Appeal 2020-000718
Application 15/321,848
Technology Center 3700

Before JOHN C. KERINS, JEREMY M. PLENZLER, and
CARL M. DEFRANCO, *Administrative Patent Judges*.

DEFRANCO, *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, 7, and 8. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

CLAIMED SUBJECT MATTER

The sole independent claim on appeal, claim 1, is directed to an “auxiliary system for assisting the insertion of an ultrathin endoscope into a subject.” Claim 1 is reproduced below.

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 MacKay Memorial Hospital. Appeal Br. 3.

1. An ultrathin endoscope auxiliary system for assisting the insertion of an ultrathin endoscopic into a subject, comprising:

an overtube, configured to allow the ultrathin endoscope to be inserted therein, wherein the overtube comprises:

a transparent cap, disposed at the front end of the overtube;

a side opening, disposed on the overtube and approximating to the front end of the overtube;

a deflecting member, disposed within the overtube and configured to adjust the orientation of the ultrathin endoscopic; and

a positioning member, disposed outside the overtube and approximating to the side opening, configured to position the front end of the overtube in place in the subject;

wherein the deflecting member is capable of deflecting the ultrathin endoscope and thereby allows the ultrathin endoscope to be extended outside the overtube through the side opening; and

a mouth piece, comprising:

a passage configured to allow the overtube to pass there through; and

a strip configured to secure the overtube preventing it from moving.

Claims App. 15 (emphasis added).

EVIDENCE OF RECORD

Name	Reference	Date
Sandstrom	US 4,167,946	Sept. 18, 1979
Utsugi	US 4,452,236	Jun. 5, 1984
Kimura	US 5,695,448	Dec. 9, 1997
Matsui	US 6,352,503 B1	Mar. 5, 2002
Scopton	US 2007/0293719 A1	Dec. 20, 2007
Komi	US 2012/0238815 A1	Sept. 20, 2012

EXAMINER'S REJECTIONS

Claims Rejected	35 U.S.C. §	Basis
1–3, 7	103	Matsui, Sandstrom
4	103	Matsui, Sandstrom, Utsugi
8	103	Matsui, Sandstrom, Scopton
1–3, 7	103	Komi, Kimura, Sandstrom

ANALYSIS

A. Claims 1–3 and 7

The Examiner rejected claim 1, along with dependent claims 2, 3, and 7, as unpatentable over the combined teachings of Matsui and Sandstrom. Final Act. 3–5. Specifically, the Examiner found that Matsui discloses all the limitations of the claims with the exception of the final limitation—the “mouthpiece.” *Id.* at 3–4 (citing Matsui, Figs. 1, 3, 48–55). For that missing limitation, the Examiner found that Sandstrom teaches a mouthpiece 2 comprising (1) a passageway 3, 5 for insertion of an endoscopic instrument, and (2) a strip 1 for fixedly securing the instrument “in a desired position during a medical procedure.” *Id.* (citing Sandstrom, 3:5–35, Figs. 1, 2). According to the Examiner, a skilled artisan would have been led to use a mouthpiece with Matsui’s endoscopic overtube “to protect [the] teeth of a patient, as well as enable a user to selectively fix the endoscope at a desired location during use of the device as taught by Sandstrom.” *Id.*

Appellant, in turn, argues that claims 1–3 and 7 are allowable because, as claimed, the endoscopic auxiliary system solves “the looping problem, a common issue often associated with the use of a conventional ultrathin endoscope.” Appeal Br. 9. According to Appellant, the claimed endoscopic auxiliary system solves this problem by providing:

“two supporting positions” as leverage points for easily adjusting the length and axial orientation of the overtube and the ultrathin endoscope. *The two supporting positions are respectively provided by the positioning member and the mouth piece, in which the configuration of the strip of the mouth piece ensures the overtube being secured within the passage of the mouth piece, so as to prevent the overtube from moving during operation.* Such the mouth piece works with the positioning member in a cooperative manner to prevent the overtube from looping in the gastrointestinal tract (e.g., stomach) of the subject during cholangioscopy.

Id. (emphasis added). In contrast, Matsui and Sandstrom “only provide ‘one-supporting point’ for leverage when it comes to position adjustment,” according to Appellant. *Id.*

As for Matsui, Appellant contends it teaches only a balloon positioning member 20 at the distal end of the endoscopic system, but is “silent with respect to the mouth piece of the claimed invention.” *Id.* at 9–10 (citing Matsui, 5:4–16, Fig. 1). As for Sandstrom, Appellant contends it teaches only a mouthpiece positioning member 2 for securely fixing a medical instrument in the mouth of a patient, but “nowhere has Sandstrom taught or suggested other securing members . . . for securing the medical instrument within the cavity of the subject.” *Id.* at 10 (citing Sandstrom, 3:5–35). Because neither reference teaches a positioning member at *both* the mouth *and* distal ends of the endoscopic system, Appellant surmises that

“none of the cited references is directed to providing a solution” to the looping problem in endoscopic surgery, and, thus, they differ from the claimed endoscopic system “where two-supporting structures are employed as two leverage points to address the looping problem.” *Id.* at 10–11.

We do not find Appellant’s arguments persuasive. At the outset, we reject Appellant’s attempt to construe the claims as encompassing the purpose of the positioning member and mouthpiece, i.e., “prevent the overtube from looping in the gastrointestinal tract (e.g., stomach of the subject,” permit “controlling the length of the overtube . . . in the gastrointestinal tract” and “adjusting the axial orientation of the overtube.” *See* Appeal Br. 9. Although the Specification may very well describe the purpose achieved by the claimed invention, the claims clearly are not so limiting and it would be improper for us to read such limitations from the Specification into the claims.

As claimed, the positioning member is simply “configured *to position the front end of overtube* in a place in the subject” and the mouthpiece is simply “configured *to secure the overtube preventing it from moving.*” Claims App. 15 (emphasis added). Nowhere does Appellant dispute that the asserted combination of Matsui and Sandstrom discloses each of those limitations. *See* Appeal Br. 10. Indeed, as the Examiner confirms, Matsui teaches providing an endoscopic overtube with a positioning member (i.e., balloon 20) at the distal end of the overtube for holding it in place within a human subject (*see* Matsui, 7:4–40, Figs. 1), while Sandstrom teaches providing a tubular mouthpiece 2 through which an endoscopic instrument 4 is inserted and tied in a fixed position to prevent the instrument from moving

within a passage 3, 5 of the mouthpiece (*see* Sandstrom, 3:5–32, 3:65–4:14, Fig. 1).

Rather than dispute the *combined* teachings of Matsui *and* Sandstrom, Appellant attacks the references separately. Appeal Br. 10–11. Nonobviousness, however, cannot be shown by arguing references individually, as Appellant does, when the rejection is based on the combination of their teachings. Here, the Examiner clearly combines Sandstrom’s teaching of providing a mouthpiece and strap for securing an endoscopic instrument where it enters the mouth of a patient with Matsui’s teaching of an endoscopic overtube having a positioning member at its distal end. *See* Final Act. 3–4; *see also* Exr. Ans. 4–7. Because Appellant never addresses the asserted *combination* of Matsui *and* Sandstrom nor the Examiner’s reasoning for why a skilled artisan would have undertaken to combine their teachings, we are not persuaded by Appellant’s attacks on the references individually. Thus, we sustain the Examiner’s rejection of claim 1. Given that Appellant does not argue dependent claims 2, 3, and 7 separately from claim 1 (*see* Appeal Br. 9–11), we also sustain the Examiner’s rejection of those claims (*see* Final Action 4–5).

B. Claims 4 and 8

Appellant argues that dependent claim 4 is allowable over the Examiner’s asserted combination of Matsui, Sandstrom and Utsugi because “none of the references has provided a clue on how to solve the looping problem” and “Utsugi is silent on the securing members for securing the endoscope within the cavity of the subject. Appeal Br. 12–13. As discussed above, the claims do not recite limitations directed to preventing a looping problem in an endoscopic system. Moreover, with respect Utsugi’s lack of

teaching securing members for the endoscopic overtube, the Examiner relies on Matsui and Sandstrom, not Utsugi, for that teaching. Thus, we are not persuaded by Appellant's argument in that regard. As such, we sustain the Examiner's rejection of claim 4.

As for dependent claim 8, the Examiner rejected it as unpatentable over the combined teachings of Matsui, Sandstrom, and Scopton. In response, Appellant essentially repeats its previous arguments, while submitting that "Scopton fails to remedy the insufficiency of Matsui and Sandstrom" with respect to "the securing members for securing the endoscope within the cavity of the subject." Appeal Br. 13. But, as discussed above, the Examiner relied on Matsui and Sandstrom, not Scopton, for teaching the claimed "positioning member" and "mouth piece" for securing the endoscopic overtube within a subject. The Examiner relied on Scopton solely for teaching the "two balloons" configuration recited in dependent claim 8. *See* Final Act. 8. Because we are not persuaded by Appellant's attempt to refute the Examiner's rejection of claim 8 by repeating arguments applicable to claim 1, we sustain the Examiner's rejection of claim 8.

C. The Examiner's Alternative Rejection of Claims 1–3 and 7

The Examiner additionally rejected claims 1–3 and 7 as unpatentable over Komi, Kimura, and Sandstrom. Final Act. 5–7; Exr. Ans. 7–8. We need not address this rejection, as it appears to be merely cumulative of the Matsui/Sandstrom-based rejection of the same claims.

CONCLUSION

The Examiner's Matsui/Sandstrom-based rejections are AFFIRMED.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
1-3, 7	103	Matsui, Sandstrom	1-3, 7	
4	103	Matsui, Sandstrom, Utsugi	4	
8	103	Matsui, Sandstrom, Scopton	8	
1-3, 7	103	Komi, Kimura, Sandstrom		
Overall Outcome			1-4, 7, 8	

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED