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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DONALD A. GONZALES, FRED B. DINGER III, PRASAD NALLURI, JEFFREY S. WRANA, GABRIELE G. NIEDERAUER, and MICHI E. GARRISON

Appeal 2014-007407
Application 12/890,286
Technology Center 3700

Before ANNETTE R. REIMERS, JILL D. HILL, and GORDON D. KINDER, *Administrative Patent Judges*.

KINDER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 1–6 and 8–16. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

CLAIMED SUBJECT MATTER

The claims are directed to a device for providing therapy to an anatomical structure. Claim 1, reproduced below, illustrates the claimed subject matter:

> 1. A medical instrument configured for expanding a paranasal sinus, the medical instrument comprising:
>
> an articulatable shaft comprising a first end and a second end, wherein the first end is configured to receive, during use, an expandable disposable medical device comprising:
>
> a sleeve adapted to receive said articulatable shaft;
>
> a coupling member coupled to a first end of the sleeve; and
>
> an inflatable balloon coupled to a second end of the sleeve, the inflatable balloon being adapted for insertion into a paranasal sinus;
>
> a flange member coupled to the shaft, the coupling member being adapted to engage with the flange member to removably retain the disposable medical device on the shaft during use;
>
> a handle portion coupled to the articulatable shaft proximal to the second end;
>
> a positioning member configured to move the articulatable shaft from a first position to a second position; and
>
> a locking member configured to lock the positioning member so that the articulatable shaft is held in the second position.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Mikus	US 2002/0087152 A1	July 4, 2002
Kelley	US 6,836,687 B2	Dec. 28, 2004
Thompson	US 2007/0244473 A1	Oct. 18, 2007

REJECTIONS

The Examiner made the following rejections:

Claims 1 and 8–13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelley and Mikus.

Claims 2–6 and 14–16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelley, Mikus, and Thompson. [1]

ANALYSIS

Claims 1 and 8–13 Rejected under 35 U.S.C. § 103(a) over Kelley and Mikus

Appellants argue claims 1 and 8–13 as a group. Appeal Br. 10–14. We select claim 1 as the representative claim, and claims 8–13 will stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

Appellants first argue that Kelley does not disclose an "articulatable shaft." Appeal Br. 11. Appellants argue that an articulatable shaft must have a joint or be jointed because "articulation" means "jointed" or "having a joint or joints." Appeal Br. 11. The Examiner has concluded that the term articulatable means "capable of articulating, moving, bending, etc." Ans. 2.

Appellants' own selected dictionary defines "joint" as "the place at which two things, or separate parts of one thing, are joined or united, either rigidly or in such a way as to permit motion."[2] Appeal Br. 11. Appellants'

[1] The Examiner has withdrawn a rejection of claims 1–6 under 35 U.S.C. § 102(b) as being anticipated by Thompson. Ans. 2.
[2] DICTIONARY.COM, http://www.dictionary.com/browse/joint (last visited Aug. 30, 2016).

argument does not comport with the dictionary definition of "joint," which does not require separate components. Further, Appellants' gives no weight to the suffix "able."[3] We find that the common understanding to the term "articulatable" is broad enough to encompass the structure shown in Kelley in which a tubular structure is rendered bendable by a series of kerfs. Kelley 12:16–18. This interpretation of the term "articulatable" is not inconsistent with the disclosure in Appellants' Specification.

Appellants next argue that Kelley does not disclose a "locking member configured to lock the positioning member so that the articulatable shaft is held in the second position." Appeal Br. 12. The Examiner responds that Kelley teaches an activation mechanism that holds and locks the articulatable shaft in position. Ans. 5. The Examiner finds that the claim limitation "locking member" does not recite any particular structure and that Kelley's disclosure of a handle activation mechanism (items 326 and 418 in Figures 4A and 6A, respectively) meets this claim limitation. Ans. 5. We agree with the Examiner that Kelley, column 14, lines 41–59, discloses a locking member that is configured to lock the positioning member so that the articulatable shaft is held in the second position. Ans. 5. In connection with Figures 4A–4B and Figures 6A–6D, Kelley states "release of the activation mechanisms 326 and 418 after these mechanism [sic] are deployed results in the distal section remaining in a deflected position."

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[3] "–able": "a suffix meaning 'capable of, susceptible of, fit for, tending to, given to,' associated in meaning with the word **able**, occurring in loanwords from Latin (*laudable*); used in English as a highly productive suffix to form adjectives by addition to stems of any origin (*teachable; photographable*)." DICTIONARY.COM, http://www.dictionary.com/browse/-able (last visited Aug. 30, 2016).

Kelley 14:49–52. Appellants argue that the section of Kelley cited by the Examiner relates only to function and does not describe any specific structures. Appeal Br. 12. However, claim 1 requires only a "locking member" configured to perform a certain function, and the activation mechanisms 326 and 418 of Kelley are locking members which perform the claimed function. Accordingly, we are not persuaded that the Examiner erred.

Finally, Appellants argue that one skilled in the art would not have combined Kelley and Mikus, because Kelly's hemostasis valve enables rotation of the catheter about its lengthwise axis, which is inconsistent with the Luer connection in Mikus that prevents rotation. Appeal Br. 12–13. The Examiner relied on Mikus to teach "a flange on the inner articulatable shaft (300) that engages with the port at the proximal end of the expandable medical device (200)." Final Act. 4. There is no dispute that Mikus discloses a Luer coupling. *See* Mikus ¶ 38, Fig. 1B. The Examiner responds by noting "the purpose of a hemostasis valve is to provide a port through which an instrument may be passed and that closes automatically upon removal of the instrument to prevent fluid leakage." Ans. 3. Appellants' Reply Brief does not address the Examiner's finding (Reply Br. 2–5), and accordingly, we are not persuaded that the Examiner erred.

Claims 2–6 Rejected under 35 U.S.C. § 103(a) over Kelley, Mikus, and Thompson.

Appellants argue claims 2–6 as a group. Appeal Br. 14. We select claim 2 as the representative claim, and claims 3–6 will stand or fall with claim 3. 37 C.F.R. § 41.37(c)(1)(iv).

Claim 2 depends from claim 1 and adds "wherein the locking member comprises a pin extending from the positioning member and wherein the pin is configured to engage one of a plurality of recesses in the handle portion." Appeal Br., Claims App. The Examiner finds that Thompson teaches a similar device with "a locking member (¶ 0097) comprising a friction lock having a pin extending from the positioning member . . . , a plurality of apertures configured for engagement with the locking member, and a biasing member (¶ 0097-0101; Figs[.] 16-18)." Final Act. 5. The Examiner concludes that it would have been obvious to substitute the locking mechanism taught by Thompson for that in Kelley because Thompson's deflection and locking mechanisms are known functional equivalents to those in Kelley. Final Act. 5. Appellants argue that because Kelley already discloses a device that holds the position of its articulated shaft, one would have no incentive to add the locking mechanism of Thompson to the device of Kelley. Appeal Br. 14–15.

Appellants did not address the Examiner's finding that the locking mechanisms in Kelley and Thompson are functional equivalents. Therefore, we are not persuaded that the Examiner's reasoning lacks a rational underpinning. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007). Accordingly, we have not been shown that the Examiner erred in rejecting claim 2.

Claims 14–16 Rejected under 35 U.S.C. § 103(a) over Kelley, Mikus, and Thompson.

Appellants argue claims 14–16 as a group. Appeal Br. 15–16. We select claim 14 as the representative claim, and claims 15 and 16 will stand or fall with claim 14. 37 C.F.R. § 41.37(c)(1)(iv).

Appellants' only argument for reversing the rejection of claim 14 is that the skilled artisan would not substitute the segmented articulatable shaft of Thompson for the flexible, notched hypotube of Kelley. Appeal Br. 15–16. Appellants argue that the Kelley and Thompson devices differ both in size and flexibility as required by their principal uses. Reply Br. 6–7. Kelley discloses that one of its deflection mechanisms is particularly small and flexible. Kelley 9:35–45. However, Kelley also notes that the entire device may be scaled with "no limit . . . to larger or smaller sizes . . . as the particular application demands." Kelley 11:12–16. Thompson likewise teaches that size is variable. Thompson ¶ 65. Further, Thompson teaches that his instrument may include articulated segments of varying length and size to allow for different applications. Thompson ¶ 69. Although Appellants argue that the different requirements for flexibility between the two prior art devices preclude their combination (Appeal Br. 15–16, Reply 6–7), we see no support for that argument in either reference. Instead, as noted, both references suggest varying sizes and different applications, and accordingly the Examiner found it would have been obvious to substitute one known element for another element providing the same function to yield predictable results. *See KSR Int'l Co.*, 550 U.S. at 416. For the foregoing reasons, we have not been shown that the Examiner erred in rejecting claim 14.

DECISION

For the above reasons, the Examiner's rejection of claims 1–6 and 8–16 is affirmed.

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