

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL CICCOLLELLA and PAUL A. MATULA

Appeal No. 1996-0456
Application No. 08/072,654¹

ON BRIEF

Before FRANKFORT, PATE, and McQUADE, Administrative Patent Judges.

PATE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 12 through 17, 21 and 24 through 27. Claims 23 and 28 were cancelled subsequent to final rejection. These are the only claims in the application.

¹ Application for patent filed June 3, 1993. According to appellants, the application is a continuation of Application 07/565,626, filed August 10, 1990; now abandoned.

The claimed invention is directed to a trocar positioning device. The device has an inner housing with gripping fingers. The gripping fingers on the inner housing cooperate with an outer housing to frictionally grip the trocar guide tube. The outer housing is provided with a threaded section, the threads of which engage the body tissue to lock the trocar positioning device in place. The threads have a special thread profile to securely lock the trocar positioning device while doing little damage to body tissue. Claim 12 reproduced below is illustrative of the claimed subject matter:²

Claim 12. A trocar positioning device comprising:

(i) first housing means configured and dimensioned to slidably engage a trocar guide tube, said first housing means having guide tube gripping means for selectively gripping the guide tube; and

(ii) second housing means configured and dimensioned to engage said first housing means to cause said gripping means to grip the guide tube and prevent movement of said trocar positioning device relative to the guide tube, said second housing means having tissue engaging thread means for engaging

² We note that paragraph ii of claim 12 states that the thread means extend from said second housing to a thread apex. In fact, the thread means is formed integrally with the second housing. Therefore the claim should state that the thread means extend from the cylindrical surface of the second housing. This indefiniteness is worthy of correction in any prosecution before the examiner.

Appeal No. 96-0456
Application No. 08/072,654

body tissue and securing the position of the trocar positioning device relative thereto, said thread means having a base, a distal surface extending from said second housing to a thread apex, and a proximal thread wall extending from the second housing to said thread apex;

wherein a distal thread surface flank angle is defined by the angle between a vertical line perpendicular to said base extending through said thread apex and a line extending from said distal thread based surface to said thread apex, and a proximal end wall flank angles is defined by the angle between a vertical line perpendicular to said base extending through said thread apex and said proximal end wall;

wherein said flank angle of said distal thread surface is greater than said flank angle of said proximal end wall, at a ratio of about 6 to about 1 respectively;

wherein said distal thread surface has a radius of curvature of about .07 to about .09 inches.

The references of record relied upon of evidence of obviousness are:

Burdick (Burdick)	137,414	Apr. 1, 1873
Silberman (Silberman)	3,726,522	Apr. 10, 1973
Von Albertini (Von Albertini)	4,670,008	Jun. 2, 1987
Reich et al (Reich)	5,009,643	Apr. 23, 1991
Sherwood Medical (Sherwood) (European Patent)	232,600	Aug. 19, 1987

THE REJECTION

Claims 12, 15 through 17, 21 and 24 through 27 stand rejected under 35 U.S.C. § 103 as unpatentable over Von Albertini in view of Burdick.

Appeal No. 96-0456
Application No. 08/072,654

Claim 13 stands rejected under 35 U.S.C. § 103 as unpatentable over Von Albertini in view of Burdick as applied to claim 12 and further in view of the Sherwood Medical Company European Patent.

Claim 14 stands rejected under 35 U.S.C. § 103 as unpatentable over Von Albertini in view of Burdick and further in view of Sherwood as applied to claim 13 and further in view of Silberman.

We also note that the examiner has cited the patent to Reich in his discussion of the state of the art on pages 5 and 6 of the examiner's answer.

On page 3 of the appeal brief, appellants state that the claims on appeal stand or fall together. Accordingly, we will limit our consideration to the representative independent claim 12 on appeal.

OPINION

We have carefully reviewed the rejections on appeal in light of the arguments of the appellants and the examiner. As a result of this review we have reached the determination that the applied prior art does not establish a prima facie case of obviousness with respect with the subject matter on appeal.

Appeal No. 96-0456
Application No. 08/072,654

Accordingly, the rejections on appeal are reversed. Our reasons follow.

We are in agreement with the examiner's finding of fact with respect to Von Albertini as stated at the conclusion of page 3 of the examiner's answer. We also agree that Von Albertini does not disclose the specific thread structure to prevent coring of body tissue and to allow easy and secure insertion of the positioning device.

Turning to a consideration of the Burdick reference, we note that Burdick discloses a wood-screw or lag screw for use in wooden materials. Appellants' chief argument with respect to the rejections on appeal is that Burdick is non-analogous art. We are in agreement with the appellants that the Burdick reference is non-analogous art and as such cannot be properly considered as pertinent prior art under Section 103. See In re-Pagliaro 657 F.2d 1219, 1224, 210 USPQ 888 (CCPA 1981). First of all, the Burdick reference is clearly outside the inventors' field of endeavor, as the appellant's specification makes clear that the inventors' field of endeavor is that of trocars, catheters, cannulas and the like for use in humans or other animals. Secondly, we consider the wood screw of

Appeal No. 96-0456
Application No. 08/072,654

Burdick as not reasonably pertinent to the particular problem of the inventors-that of securing a catheter, cannula or the like in the body of a human or other animal.

Furthermore, the examiner's finding that the thread profile of Burdick, which is disclosed as not crushing wood fiber, would function to secure a trocar guide tube in human tissue without being destructive thereof is purely speculative. In our view, this finding by the examiner is not supported by any disclosure in Burdick, nor is it supported by a convincing rationale stated by the examiner. Therefore, it lacks the factual basis required to validate a rejection under Section 103. See In re GPAC, Inc., 57 F.3d 1573, 1581, 35 USPQ2d 1116, 1123. Additionally, the examiner's conclusion that the thread profile of Burdick satisfies appellants' claimed ratio of 6-to-1 and has a radius of curvature of .07 inches to .09 inches is again apparently based on speculation. There is no express disclosure in Burdick of such features. The drawing of Burdick is not of sufficient detail to glean such information. The examiner may not resort to speculation, unfounded assumptions or hindsight reconstruction to supply

Appeal No. 96-0456
Application No. 08/072,654

deficiencies in the factual basis for a Section 103 rejection.
GPAC at 1581, 35 USPQ2d at 1123.

We have carefully reviewed the other cited and applied prior art and we find therein no disclosure which would provide a factual basis or remedy the defects in this Section 103 rejection.

In summary, we are reversing the rejections of all claims on appeal for the reason that Burdick is non-analogous art and cannot be properly considered pertinent prior art for a Section 103 rejection. Even if Burdick could be considered pertinent prior art under Section 103, the examiner's findings with respect to Burdick are not supported by the reference itself.

The rejections of the claims on appeal are reversed.

Appeal No. 96-0456
Application No. 08/072,654

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

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
WILLIAM F. PATE III)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

lp

Appeal No. 96-0456
Application No. 08/072,654

MARK FARBER
UNITED STATES SURGICAL CORPORATION
150 GLOVER AVE.
NORWALK, CT 06850

Leticia

Appeal No. 96-0456
Application No. 08/072,654

APJ PATE

APJ FRANKFORT

APJ McQUADE

DECISION:

Send Reference(s): Yes No
or Translation (s)

Panel Change: Yes No

Index Sheet-2901 Rejection(s):103

Prepared: June 21, 2001

Draft Final

3 MEM. CONF. Y N

OB/HD GAU 3306

PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT