

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER M. BONUTTI and JAMES S. HAWKINS

Appeal No. 97-2550
Application 08/467,698¹

HEARD: April 8, 1999

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

McQUADE, Administrative Patent Judge.

¹ Application for patent filed June 6, 1995. According to the appellants, the application is a continuation-in-part of Application 08/254,368, filed June 6, 1994, now U.S. Patent 5,573,517, issued November 12, 1996; which is a division of Application 08/013,942, filed February 4, 1993, now U.S. Patent 5,320,611, issued June 14, 1994.

DECISION ON APPEAL

Peter M. Bonutti et al. originally appealed from the final rejection of claims 12, 13, 15, 16, 18, 20 through 22, 25 through 38, 41 through 44 and 46.² Since then, the examiner has withdrawn all rejections of claims 16, 18, 20 through 22, 25, 26, 29 through 38, 41 through 44 and 46 (see page 2 in the examiner's answer, Paper No. 16). These claims, as well as non-appealed claims 14, 17, 19, 23, 24, 39, 40, 45 and 47 through 56 (the only other claims pending in the application), now stand either allowed or objected to as depending from a rejected base claim (see page 1 in the answer). Thus, the appeal as to claims 16, 18, 20 through 22, 25, 26, 29 through 38, 41 through 44 and 46 is hereby dismissed, leaving for review the standing rejections of claims 12, 13, 15, 27 and 28.

The subject matter on appeal relates to a cannula having a variable volume chamber which is expandable by fluid pressure into engagement with surrounding body tissue to retain the cannula in place. A copy of claims 12, 13, 15, 27

² Claims 12 and 41 have been amended subsequent to final rejection.

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and 28 appears in the appendix to the appellants' brief (Paper No. 15).

The references relied upon by the examiner as evidence of obviousness are:

Bonutti	5,197,971	Mar. 30, 1993 (filed Dec. 18, 1990)
Lee et al. (Lee)	5,226,899	Jul. 13, 1993 (filed Aug. 15, 1991)

Claims 12, 13, 15, 27 and 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bonutti in view of Lee.

Reference is made to the appellants' brief (Paper No. 15) and to the examiner's answer (Paper No. 16) for the respective positions of the appellants and the examiner with regard to the merits of this rejection.

Bonutti, the examiner's primary reference, pertains to retractors "for use in selectively and specifically moving sub-surface tissue in arthroscopic surgery[,] endoscopic surgery and fiber optic surgery" (column 1, lines 17 through 19). In the embodiment relied upon by the examiner (see Figures 9 and 10),

retractor 140 includes a sleeve 14 with an expanding portion 60 including a plurality of expanding arms 62. The body portion [12] of the retractor 140 has a pointed distal end 142 for easier passage through tissues. Proximal to the threaded portion 22 of the retractor body [12], a portion 144 of the retractor includes a fluid supply port 146. An inflatable bladder 150 is bonded to the retractor sleeve 14 at two circumferential, axially spaced locations 152 and 154. Appropriate fluid passages are provided in the retractor body and the retractor sleeve to provide fluid communication between the fluid supply port 146 and the bladder 150. The bladder can be deflated with suction [column 8, lines 18 through 31].

As tacitly conceded by the examiner (see page 3 in the answer), Bonutti does not respond to the limitations in independent appealed claim 12 calling for the claimed cannula to include a plurality of wires and a variable volume chamber conduit which are enclosed by and extend along an inner side of a sheath, with the conduit being disposed between adjacent wires.

Lee discloses a catheter tubing 10 having one or more stiffening "stripes" or wires 20 disposed longitudinally therein to provide the tubing with a desired balance of pliability and stiffness.

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In proposing to combine Bonutti and Lee to support the rejection of claim 12, the examiner concludes that

[i]ncluding stiffening wires in the Bonutti device of figures 9-10 (in member 12 and/or 14) in order to reinforce it and thus prevent it from collapsing or bending excessively would have been obvious in view of the Lee et al. teaching of using stiffening wires 20 to reinforce a surgical device. The Bonutti inflation conduit would obviously be between adjacent wires since the wires and the inflation conduit would all be within the same wall of the Bonutti device [answer, page 3].

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id.

As indicated above, Bonutti teaches that appropriate fluid passages are provided in the retractor body 12 and the retractor sleeve 14 to provide fluid communication between the fluid supply port 146 and the bladder 150. Even if Bonutti and Lee were combined in the manner proposed by the examiner,

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this broad and somewhat ambiguous teaching concerning the location of Bonutti's fluid/inflation conduit(s) would fail to provide the factual basis necessary to support the examiner's conjecture that the fluid/inflation conduit in the resulting device would extend along the inner side of a sheath between adjacent wires as required by claim 12. In other words, the examiner has resorted to speculation, unfounded assumptions and/or hindsight reconstruction to supply conceded deficiencies in the reference evidence applied in support of the rejection on appeal.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103 rejection of claim 12, or of claims 13, 15, 27 and 28 which depend therefrom, as being unpatentable over Bonutti in view of Lee.

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The decision of the examiner is reversed.

REVERSED

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

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