

File

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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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

FEB 29 1996

PAT & TM OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SURI A. SASTRI

Appeal No. 95-4935
Application 08/026,123¹

ON BRIEF

Before COHEN, LYDDANE and McQUADE, Administrative Patent Judges.
LYDDANE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's refusal to allow claims 1 through 19, which are all of the claims pending in the application.

¹ Application for patent filed March 1, 1993. According to appellant, the application is a continuation of Application 07/902,769, filed June 23, 1992, which is a continuation of Application 07/570,026, filed August 20, 1990.

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The subject matter on appeal is directed to a tubular surgical cutting instrument having an inner tubular member rotatable within an outer tubular member, such as that utilized in arthroscopic surgery. Claim 1 is exemplary of the invention and a copy thereof, as it appears in the appendix to the appellant's brief, has been appended to this decision.

The references of record relied upon by the examiner in the rejection of the claims under 35 USC 103 are:

White	4,054,426	Oct. 18, 1977
Shuler	4,923,441	May 8, 1990

Claims 1 through 19 stand rejected under 35 USC 103 as being unpatentable over Shuler in view of White.

Rather than reiterate the examiner's statement of the above rejections and the conflicting viewpoints advanced by the examiner and the appellant, we refer to pages 3 through 10 of the examiner's answer and to pages 5 through 9 of the appellant's brief for the full exposition thereof.

OPINION

At the outset, we note that appellant has chosen not to argue the patentability of dependent claims 2 through 18 with any reasonable specificity. Accordingly, these claims stand or fall with the claims from which they depend. See In re Nielson, 816 F.2d 1567, 2 USPQ2d 1525 (Fed. Cir. 1987).

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In arriving at our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art, and to the respective positions advanced by the appellant and by the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to all claims on appeal. Our reasoning for this determination follows.

In rejecting claims under 35 USC 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). "A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)). A rejection based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the examiner has the initial duty of supplying the factual basis for the rejection. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded

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assumption or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has also repeatedly cautioned against employing hindsight by using the applicant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings in the prior art. See, e.g., Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988). Like the appellant, we think that the examiner has relied here on impermissible hindsight to provide the missing motivation to combine the teachings of the applied references. That being the case, the rejection of claims 1 through 19 under 35 USC 103 cannot be sustained.

In particular, we recognize that the patent to Shuler is directed to a tubular surgical cutting instrument formed from stainless steel and which is similar to appellant's claimed instrument. Shuler has recognized problems associated with prior art tubular cutting instruments, i.e., that of cocking or skewing of the inner tubular member, and indicates that the

addition of bearing surfaces at the distal end of the surgical cutting instrument or at spaced positions along the surgical cutting instrument requires complex structure and manufacturing techniques and results in a relatively expensive product that cannot be feasibly supplied for single patient use, i.e., be disposable. Additionally, such bearing structures present increased opportunities for malfunction due to sticking and obstruction. Another manner in which to precisely

position and align the inner member is to make the outer diameter of the inner member substantially the same as the inner diameter of the outer member; however, since it is preferred to construct the inner tubular member and the outer tubular member of stainless steel and since stainless steel is relatively soft and does not serve well as a bearing surface, this approach has had the disadvantage of causing galling and subsequent seizure. That is, as the stainless steel surfaces of the inner and outer tubular members bear on each other, heat is generated from friction and causes thermal expansion creating greater friction and concomitant increase in heat eventually causing the grain structure of the stainless steel tubular members to "flake" in turn increasing temperature due to abrasion until the instrument seizes [column 1, line 66 though column 2, line 22, emphasis added].

To solve the problems noted above, Shuler proposes to use a coating of titanium nitride, which had been known as a coating for the cutting edges of cutting tools "for the purpose of hardening the cutting edge thereby providing the cutting tool with an extended useful life" (column 2, lines 47-49). However, Shuler indicates that there had been no recognition of the use of titanium nitride coatings "to limit heat conduction along a rotating tubular member to produce a bearing structure for inner and outer members made of stainless steel" (column 2, lines 52-54). Shuler uses this coating "to form a bearing along the length of the inner tubular member, rather than only on the distal end and cutting edges" (column 4, lines 66-68) which forms a bearing so that the loads placed on the inner and outer tubular members "will not cause galling due to the distribution of heat

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along the length of the bearing surface created by the TiN coating (column 5, lines 6-13, emphasis added).

It is clear from the above discussion that Shuler was concerned with the same problems as was appellant, but Shuler solved the problems by applying a coating of titanium nitride, that is a coating of hard material, along the length of the inner tubular member for the purpose of distributing heat along the length of the bearing surface created by the coating. Here, the appellant has utilized a

circumferential surface coating of a metal from the group consisting of silver and gold present along at least a portion of the working length of at least one of the outer surface of said inner tubular member and the inner surface of said outer tubular member whereby a wear resistant surface is provided to control and facilitate the rotation of said inner tubular member within said outer tubular member [appealed claim 1].

In our view, this is directly contrary to the teaching of Shuler to provide a coating of hard material to provide the bearing surface as well as the teaching in the sentence spanning columns 1 and 2 (quoted above) as to the lack of feasibility of providing bearing surfaces due to the complex structure and manufacturing techniques require.

We recognize that the examiner has applied the patent to White for the teaching of the use of gold or silver as a lubricant to provide increased bearing life and lower incident of thermal bearing failure. However, we find nothing in the

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combined teachings of the patents to Shuler and White that would provide any motivation for the combination proposed by the examiner in the rejection of the claims. As noted above, it is our view that the disclosure of Shuler clearly teaches away from this proposed combination. As stated in W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983),

[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

It is our conclusion that the only reason to combine the teachings of the applied references in the manner proposed by the examiner results from a review of appellant's disclosure and the application of impermissible hindsight. Thus, we cannot sustain the examiner's rejections of appealed claims 1 through 19 under 35 USC 103.

Having arrived at the conclusion that the prior art applied by the examiner in the rejection of the claims on appeal is insufficient to establish a prima facie case of obviousness under 35 USC 103, we have not found it necessary to consider the evidence of nonobviousness presented by the appellant, i.e., the declarations submitted by the appellant during prosecution which have been identified in Appendix B of the appellant's brief.

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APPENDIX

1. A tubular surgical cutting instrument comprising:
 - a) an inner tubular member having a proximal end and a distal end with a cutting edge disposed at said distal end;
 - b) an outer tubular member having a proximal end and a distal end with an opening disposed at said distal end, the inner channel of said outer tubular member having a diameter sufficient to accommodate the rotation and positioning of said inner tubular member so that said cutting edge of said inner tubular member is adjacent to said opening in said outer tubular member to provide said cutting edge with access through said opening to the tissue to be severed; and
 - c) a circumferential surface coating of a metal from the group consisting of silver and gold present along at least a portion of the working length of at least one of the outer surface of said inner tubular member and the inner surface of said outer tubular member whereby a wear resistant surface is provided to control and facilitate the rotation of said inner tubular member within said outer tubular member.