

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte JACQUES CHELLY, JEFFREY KATZ and THOMAS SMITH

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Appeal No. 2001-1611  
Application No. 08/867,748

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ON BRIEF

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Before ABRAMS, STAAB, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 16 to 19, 21, 22, 25 and 26, which are all of the claims pending in this application. Claims 1

BACKGROUND

The appellants' invention relates to endotracheal tube guides and their use in related tracheostomy procedures (specification, p. 1). A copy of claims 16 and 25 are reproduced in the opinion section below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Mizus	4,960,122	Oct. 2, 1990
Augustine	5,235,970	Aug. 17, 1993
Nye	5,590,647	Jan. 7, 1997

Claims 16 to 18, 22 and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mizus.

Claims 19 and 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mizus in view of Nye.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 20, mailed December 5, 2000) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 19, filed October 13, 2000) and reply brief (Paper No. 21, filed February 5, 2001) for the appellants' arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

In the brief (p. 3), the appellants stated that "Claims 16 through 24 and 26 [sic, 16 through 19, 21, 22 and 26] rise or fall together. Claim 25 stands or falls independently of the aforesaid group."

### Claims 16 and 25

We sustain the rejection of claims 16 and 25 under 35 U.S.C. § 103.

Claims 16 and 25 read as follows:

16. An endotracheal tube guide for guiding an endotracheal tube over it, if needed, while making an incision into the trachea for a tracheostomy, comprising:

an elongated body comprising a proximal segment and a distal segment, said distal segment having a solid cross-section;

said distal segment having a smaller cross-section area that [sic, than] said proximal segment which is sufficiently small so as to allow said distal segment to remain in the trachea, clear of the incision location, while a tracheostomy procedure is performed.

25. An endotracheal tube guide which can remain in the trachea while an incision is made for a tracheostomy, comprising:

an elongated body comprising a proximal segment having a rounded cross-section and a distal segment having a solid cross-section that is narrower and smaller than said proximal segment cross-section,

said distal segment being sufficiently small to remain in the trachea and not obstruct the incision process.

In the rejection of claims 16 and 25, the examiner (answer, pp. 4-5) determined that (1) all the claimed limitations were met by the obturator 22 shown in Figure 5 of Mizus except for the limitation that the distal segment of the endotracheal tube guide

The appellants argue that Mizus's obturator lacks (1) a distal segment having a smaller cross-section area than the proximal segment which is sufficiently small so as to allow the distal segment to remain in the trachea, clear of the incision location, while a tracheostomy procedure is performed as recited in claim 16; and (2) a distal segment being sufficiently small to remain in the trachea and not obstruct the incision process as recited in claim 25. We do not agree.

Mizus teaches a system for replacing a tracheal tube which uses an obturator that is inserted into the existing tube until it protrudes out from the distal end. The old tube is then slid out using the obturator as a guide. A new tube is inserted along the obturator until it has been properly inserted. The obturator is then removed. The obturator has a flexible atraumatic tip at one end and a gripping section at the outer end. It is made from a flexible radiopaque material and has positioning marks to facilitate use with both endotracheal and tracheostomy tubes. As shown in Figure 5, the obturator 22 is approximately 80 cm. in length having a diameter of approximately 0.63 cm. The obturator is generally made utilizing a smooth elastomer or plastic sheath with a flexible metal core 27. The insertion or distal end 24 of the obturator 22 is made

distal trachea such that the obturator does not move during withdrawal of an endotracheal tube. That is, the endotracheal tube is slid upward utilizing the obturator 22 as a guide. When the tube 10 has been removed only the obturator is in the patient's air passage serving as a guide and at the same time maintaining the passage in an open condition. The original endotracheal tube 10 can then be discarded and a new endotracheal tube 10 inserted as illustrated in Figure 3.

In our view, the tapered distal tip 24 of the obturator 22 has a smaller cross-section area than the proximal segment of the obturator 22 since the tip is tapered. Additionally, the tapered distal tip 24 of the obturator 22 is sufficiently small so as to be capable of allowing the tip 24 to remain in the trachea, clear of the incision location where a tracheostomy procedure would be performed since Mizus teaches that the tapered distal tip 24 of the obturator 22 is maintained in the distal trachea and as shown in Figure 2 the tapered distal tip 24 of the obturator 22 is not located at the site where the incision for a tracheostomy procedure would be performed. Thus, the tapered distal tip 24 of the obturator 22 is sufficiently small to remain in the trachea and not obstruct an incision process.

procedure is being performed. However, the claims under appeal do not require that since the claims under appeal are directed to the endotracheal tube guide, per se, and not to an endotracheal tube guide located in the trachea when an incision for a tracheostomy procedure is being performed. It is well settled that if a prior art device inherently possesses the capability of functioning in the manner claimed, anticipation exists whether there was a recognition that it could be used to perform the claimed function. See, e.g., In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). See also LaBounty Mfg. v. Int'l Trade Comm'n, 958 F.2d 1066, 1075, 22 USPQ2d 1025, 1032 (Fed. Cir. 1992).

Lastly, we note that the appellants' argument that claim 25 should be allowed since claim 20 has been allowed is without merit since claim 20 includes the limitation that the distal end has a "flattened" cross-section which limitation is not present in claim 25 or met by Mizus.

For the reasons set forth above, the decision of the examiner to reject claims 16 and 25 under 35 U.S.C. § 103 is affirmed. In accordance with the above-noted

CONCLUSION

To summarize, the decision of the examiner to reject claims 16 to 19, 21, 22, 25 and 26 under 35 U.S.C. § 103 is affirmed.

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

AFFIRMED

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JEFFREY V. NASE	)	

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