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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* DAVID E. FRANCISCHELLI

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Appeal 2011-004270  
Application 11/881,443  
Technology Center 3700

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Before EDWARD A. BROWN, ANNETTE R. REIMERS and  
RICHARD E. RICE, *Administrative Patent Judges*.

REIMERS, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

David E. Francischelli (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision to reject claims 1-5 and 8-12 under 35 U.S.C. § 102(e) as anticipated by Wang (US 6,527,767 B2; issued Mar. 4, 2003). Claims 6 and 7 have been withdrawn from consideration. We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

We REVERSE.

## THE INVENTION

Appellant's invention relates to methods of tissue ablation to treat atrial fibrillation and other disorders. Spec.1, ll. 17-18; fig. 1.

Claim 1 is illustrative of the claimed invention and reads as follows:

1. A method of ablating tissue comprising:
  - selecting a first elongated ablation component carrying a longitudinally extending first means for delivery of ablation energy and a second elongated ablation component and movable relative to the first ablation component, wherein the first and second components are provided with means mounted to and extending along the first and second components for magnetically attracting the first and second ablation components toward one another along the length of the first means for delivery of ablation energy;
  - placing selected one of the first and second components along a first portion of tissue of the atrium on an external portion of the heart adjacent one or more pulmonary veins;
  - placing the other of the first and second components along a second portion of tissue of the atrium on an external portion of the heart adjacent the one or more pulmonary veins to allow the magnetically attracting means to draw the first and second components toward one another to compress the first and second

portions of tissue therebetween, along the length of the first and second components; and applying ablation energy.

### ANALYSIS

Both independent claims 1 and 2 require a first “ablation component” and a second “ablation component.” App. Br., Claims Appendix. Independent claim 1 further requires “a first elongated ablation component carrying a longitudinally extending first means for delivery of ablation energy.” *Id.* The Examiner finds that Wang teaches first and second ablation components 108, 110, respectively. Ans. 4; Wang, fig. 21. In addition, the Examiner takes the position that Wang teaches “an ‘ablator’ 68 on the ‘endocardial catheter’ 108, wherein the first means for delivery of ablation energy on the first ablation component is interpreted as the ‘ablator’ 68 located on the ‘endocardial catheter’ 108.” Ans. 4-5. The Examiner further takes the position that “[t]he claims do not recite a second elongated ablation component carrying a longitudinally extending second means for delivery of ablation energy and so only a single ablator is required.” Ans. 6. In other words, the Examiner takes the position that the claims only require one of the first and second ablation components to have the ability to perform ablation, and that the endocardial catheter 108 of Wang meets this requirement.

Appellant argues that the Examiner’s interpretation of the term “ablation component” “is overly broad and thus unreasonable in light of the specification.” App. Br. 11. Specifically, Appellant argues that

None of the proffered claim constructions in the Examiner’s Answer that the ablation

component does not require ablation is supported by proper claim construction principles. Rather, each one of the claim constructions in the Examiner's Answer is inconsistent with the principle that the claims are to be given their broadest reasonable interpretation *consistent with the specification*, which requires the ablation component to perform ablation. Thus any interpretation of the feature "ablation component" that does not require it to perform ablation is unreasonable.

Reply Br. 5.

Appellant further argues that Wang does not teach a system that includes two ablation components for performing ablation, as required by independent claims 1 and 2. App. Br. 8, 10. According to Appellant, Wang teaches "an endocardial catheter [108] having an ablator [68] and an epicardial probe [110] that is magnetically attracted to the catheter but does not include an ablator. Thus, the Wang patent teaches only one ablator."

Reply Br. 2. Appellant concludes that "[b]ecause the claims set forth first and second ablation components that each provide ablation, the Wang patent cannot anticipate the claims as it teaches only one ablator." Reply Br. 5.

Regarding Appellant's first argument, claims are to be given their broadest reasonable interpretation consistent with the specification, reading claim language in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). First, we note that although Appellant's Specification does not expressly define the term "ablation component,"<sup>1</sup>

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<sup>1</sup> An ordinary and customary meaning of the term "ablate" is "to remove or destroy especially by cutting, abrading, or evaporating." MERRIAM WEBSTER'S COLLEGIATE DICTIONARY (11TH ED. 2005).

Appellant's Specification does disclose that "[t]he ablation components are adapted to . . . ablate or create lesions in the tissue between the components." Spec. 2, ll. 27-30; App. Br. 11; Reply Br. 3. We further note that both independent claims 1 and 2 define the subject invention to require a first "ablation component" and a second "ablation component." App. Br., Claims Appendix. In other words, the nomenclature of the first and the second components is identical, (i.e., they are both "ablation" components). "We apply a 'presumption that the same terms appearing in different portions of the claims should be given the same meaning unless it is clear from the specification and prosecution history that the terms have different meanings at different portions of the claims.'" *PODS, Inc. v. Porta Stor, Inc.*, 484 F.3d 1359, 1366 (Fed.Cir.2007) (quoting *Fin Control Sys. Pty., Ltd. v. OAM, Inc.*, 265 F.3d 1311, 1318 (Fed.Cir.2001)); *see also, e.g., Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005) (en banc) ("Because claim terms are normally used consistently throughout the patent, the usage of a term in one claim can often illuminate the meaning of the same term in other claims.").

A person of ordinary skill in the art would readily recognize that the claimed first and second "ablation" components would require that *both* the first and the second components provide ablation. Hence, we agree with Appellant that the Examiner's interpretation of the claim limitation "ablation component" is unreasonably broad in light of what persons of ordinary skill in the art would understand from reading the Specification. App. Br. 11-12; Reply Br. 3.

Further, in regard to the Examiner's position that independent claim 1 requires only the first component to be an ablator, because the claim fails to

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“positively recite a second means for delivery of ablation energy on the second ablation component” (Ans. 5; *see also* Ans. 6), we agree with Appellant that “the inclusion of the feature ‘means for delivery of ablation energy’ does not preclude an interpretation that both ablation components provide ablation.” Reply Br. 4.

Regarding Appellant’s second argument, we find that Wang teaches a first component (endocardial catheter 108) including an ablator 68 and a second component (epicardial probe 110) including a detector 106 that is used to detect the location of the ablator 68 on the first component (endocardial catheter 108). Wang, col. 10, ll. 19-31; fig. 21. As such, we agree with Appellant that Wang teaches “an endocardial ablation catheter 108 for performing an ablation and an epicardial probe [110] for performing a detection and not an ablation.” App. Br. 8. We further agree with Appellant that Wang does not teach every limitation of independent claims 1 and 2, because both claims require first and second ablation components, wherein each component provides ablation. Reply Br. 2, 5.

Accordingly, for the foregoing reason, the Examiner’s rejection of claims 1-5 and 8-12 under 35 U.S.C. § 102(e) as anticipated by Wang cannot be sustained.

#### DECISION

The decision of the Examiner is reversed as to claims 1-5 and 8-12.

REVERSED

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