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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
12/421,191 04/09/2009 Jonas V. Lieponis 04012-P0001D GSW/SBS 3967

24126 7590 11/07/2016
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EXAMINER

TREYGER, ILYA Y

Table with 2 columns: ART UNIT, PAPER NUMBER

3761

Table with 2 columns: NOTIFICATION DATE, DELIVERY MODE

11/07/2016

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JONAS V. LIEPONIS

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Appeal 2013-005987  
Application 12/421,191<sup>1</sup>  
Technology Center 3700

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Before MICHAEL C. ASTORINO, BRUCE T. WIEDER, and  
MATHEW S. MEYERS, *Administrative Patent Judges*.

WIEDER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1–27.<sup>2</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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<sup>1</sup> According to Appellant, the real party in interest is Dr. Jonas V. Lieponis, M.D. (Appeal Br. 2.)

<sup>2</sup> The Office Action (mailed August 2, 2012), from which this appeal is taken, states that “[c]laims 1–27 are rejected.” (Non-Final Act. 3.) The Office Action explains the bases for the rejection of claims 1–27. (*Id.* at 3–9.) Therefore, we treat the statement that “[c]laims 1–21 is/are rejected” on page 1 of the Office Action as a typographical error.

### CLAIMED SUBJECT MATTER

Appellant's claimed "invention relates to a surgical instrument, more specifically this invention relates to a combination suction/irrigation device and optical device that may provide a visual indication of the area in which the tool is inserted." (Spec. ¶ 2.)

Claims 1, 7, 16, and 22 are the independent claims on appeal. Claim 1 is representative. It recites (emphasis added):

1. A medical instrument for providing illuminating light to and aspiration of a cavity, the device comprising:
  - an aspiration pipe coupleable to an aspirator, said aspiration pipe having a conduit passing therethrough and a distal tip terminating the conduit, *said conduit being coaxial with said pipe and having an opening coaxial with the conduit and positioned at the distal tip;*
  - a sheath enclosing a plurality of optical fibers, said plurality of optical fibers positioned circumferentially about a cavity located along a longitudinal axis of said sheath, said optical fibers having distal ends for illuminating light to exit;
  - said plurality of optical fibers coupleable a light source;
  - said aspiration pipe is insertable into said cavity such that said distal end of said aspiration pipe is adjustable relative to said distal ends of said plurality of optical fibers.

### REJECTION

Claims 1–27 are rejected under 35 U.S.C. § 103(a) in view of Blanchard (US 6,572,578 B1, iss. June 3, 2003) and Wardle (US 5,415,653, iss. May 16, 1995).

### ANALYSIS

Blanchard discloses a fluid jet catheter. (Blanchard, Title.) In particular, Blanchard discloses:

The end piece **2** incorporates a hollow chamber **4** through which the saline solution fluid jet flows. . . . As saline solution is jetted through the chamber toward the distal or proximal end of the fluid-jet catheter, negative pressure in the chamber and opening is caused by saline solution jetting through the chamber past the lateral opening **8**. Creating a Bernoulli effect causes suction, which allows targeted tissue to be drawn into the lateral opening **8** of the end piece **2**. The surface of the inward-drawn tissue is abraded by the jet stream of saline solution which strips clusters of cells from the tissue. The clusters of cells are entrained in the saline solution and flow through a cell trap recovery opening **12** which decreases diameter in a downstream direction toward the proximal end of the catheter.

(*Id.* at col. 4, l. 66 – col. 5, l. 18; *see also id.* at Figs. 1, 5A.)

The Examiner finds that return tube 26 of Blanchard corresponds to the claimed conduit. (Answer 11.) The Examiner also finds that “Blanchard in view of Wardle do [sic] not expressly disclose the device, wherein the opening is coaxial with the conduit,” as required by independent claims 1, 7, and 16. (*See* Non-Final Act. 5.) However, the Examiner determines that

[s]ince shifting the position of the opening would not have modified the operation of the device, it would have been obvious to one having ordinary skill in the art at the time the invention was made to position the opening coaxial with the conduit in order to convenience operation of the device.

(*Id.*)

Appellant disagrees and argues that “Blanchard is a device provided for collecting tissue samples, not for aspirating a cavity as currently claimed.” (Appeal Br. 7.) Specifically, Appellant argues that “for Blanchard to function properly, the opening must be placed on a lateral side of the conduit to create the jet action (Bernoulli effect) across the opening to collect cell samples (e.g. the saline solution must be shot out of the supply

conduit directly toward the return conduit).” (*Id.*, citing Blanchard Figs. 1–6.)

Figure 12 of Blanchard shows operation of the Blanchard device. In particular, Figure 12 “schematically shows drawing a polyp into the operative opening and abraiding [sic] cell clusters from the polyp with fluid jets.” (Blanchard, col. 4, ll. 27–29.)

It is not clear, and the Examiner does not explain, how one would shift the position of the opening in Blanchard to make the opening coaxial with the conduit, as required by claims 1, 7, and 16 (or position the opening in an “end face” of the aspiration pipe, as required by claim 22) so as to maintain the Bernoulli effect Blanchard uses to collect cell samples. (*See* Non-Final Act. 5, 9; *see also* Answer 13.)

Therefore, we are persuaded that the Examiner erred in determining that “shifting the position of the opening would not have modified the operation of the [Blanchard] device” and thus also erred in determining that

[s]ince shifting the position of the opening would not have modified the operation of the device, it would have been obvious to one having ordinary skill in the art at the time the invention was made to position the opening coaxial with the conduit in order to convenience operation of the device.

(*See* Non-Final Act. 5.)

#### DECISION

The Examiner’s rejection of claims 1–27 under 35 U.S.C. § 103(a) is reversed.

REVERSED