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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KEVIN M. HUEY and MATTHEW D. HOLCOMB

Appeal 2014-009915
Application 12/766,086
Technology Center 3700

Before JOHN C. KERINS, STEFAN STAICOVICI, and LEE L. STEPINA,
Administrative Patent Judges.

STEPINA, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Kevin M. Huey and Matthew D. Holcomb (“Appellants”) appeal under 35 U.S.C. § 134 from a final rejection of claims 13–16 and 21–34.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ Claims 1–12 and 17–20 have been cancelled. Appeal Br. (App. A, A) (filed July 23, 2014).

CLAIMED SUBJECT MATTER

The claims are directed to a device for accessing a body cavity. Claims 13 and 22 are independent. Claim 13, reproduced below, is illustrative of the claimed subject matter:

13. A surgical device, comprising:

a retractor configured to be positioned in an opening in tissue such that an instrument inserted into a working channel extending through the retractor can pass through the opening in the tissue and into a body cavity underlying the tissue; and

a housing removably coupled to the retractor and having a plurality of sealing ports in communication with the working channel in the retractor, each of the sealing ports having a sealing element disposed therein, the housing including a distal base removably coupled to the retractor, and a proximal cap removably coupled to the distal base so as to form a fluid tight seal, the proximal cap being freely rotatable 360° relative to the distal base and the retractor when the proximal cap is removably coupled to the distal base.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Wenchell (hereinafter “Wenchell ’426”)	US 2004/0254426 A1	Dec. 16, 2004
Wenchell (hereinafter “Wenchell ’582”)	US 2005/0222582 A1	Oct. 6, 2005
Voegele	US 2006/0247673 A1	Nov. 2, 2006
Smith	US 2009/0227843 A1	Sept. 10, 2009

REJECTIONS

(I) Claims 13–15, 21–27, 29, and 31–34 are rejected under 35 U.S.C. § 103(a) as unpatentable over Wenchell '582.

(II) Claims 16 and 28 are rejected under 35 U.S.C. § 103(a) as unpatentable over Wenchell '582 in view of Voegele.

(III) Claim 30 is rejected under 35 U.S.C. § 103(a) as unpatentable over Wenchell '582 in view of Wenchell '426.

(IV) Claim 13 is rejected under 35 U.S.C. § 103(a) as unpatentable over Smith in view of Wenchell '582.

(V) Claims 13, 14, 22, and 24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as unpatentable over claim 1 of co-pending Application No. 12/399,482.²

ANALYSIS

Rejection (I)

Independent claim 13 recites, in part, “a housing removably coupled to the retractor and having a plurality of sealing ports in communication with the working channel in the retractor.” Appeal Br. (App. A, A). Independent claim 22 recites a substantially similar feature. *Id.* at B

The Examiner relies on Figure 24 of Wenchell '582 as depicting a housing having a plurality of sealing ports. Final Act. 2. In the Response to Arguments section of the Final Action, the Examiner notes that “Examiners are required to use broadest reasonable interpretation of the claim language

² The USPTO issued a notice of abandonment in this application on Nov. 19, 2014. Based on this, the rejection is moot.

and language within the specification should not be assumed to be part of the claim.” *Id.* at 10. Under a broadest reasonable interpretation, the Examiner interprets Figure 24 of Wenchell ’582 as showing a plurality of sealing ports because “there at least two spots that the rod goes through where a seal is formed,” and that “[w]hile these are multiple parts they are also multiple ports.” *Id.*

Appellants assert that Figure 24 of Wenchell ’582 shows “a single sealing port similar to the embodiment of Figure 3 of the present application, as opposed to the embodiment of Figure 3A of the present application that includes a plurality of sealing ports.” Appeal Br. 8. Appellants assert that “[t]he Examiner is interpreting the single sealing port of Wenchell’s Figures 1 and 24 in a way that contradicts the present specification,” which is “unreasonable in light of the specification.” *Id.* Although Appellants agree that “subject matter from the specification should not be imported into claims,” Appellants argue that, “the Examiner is interpreting the recited ‘plurality of sealing ports’ . . . in a way that completely disregards the plain language of the claim, a further indication of the Examiner’s interpretation being contradictory to the present specification’s description of sealing ports.” *Id.*; *see also* Reply Br. 3.

In response, the Examiner provides an annotated copy of Figure 24 of Wenchell ’582 “[t]o clarify how Wenchell discloses the claimed limitation.” Ans. 2–3. Therein, the Examiner relies on “the proximal opening/port that valve 218 lies in[] having a sealing element disposed therein (218 is the element that is disposed in that opening helping to create a seal at that location),” and relies on “the distal opening/port having a sealing element

disposed therein,” denoted “sealing element” in the Examiner’s annotated Figure 24. *Id.*

The Federal Circuit has established that the proper construction is not just the broadest construction, but rather the broadest reasonable construction in light of the specification. *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015). (“A construction that is unreasonably broad and which does not reasonably reflect the plain language and disclosure will not pass muster.”) (internal quotation marks omitted). Here, the Specification states that “[w]hile the proximal housing 16 can define any number of sealing ports, in the illustrated embodiment, as shown in FIG. 3, the proximal housing 16 defines *one* sealing port 22 that extends through the proximal housing 16 and that seats a sealing element, as discussed further below.” Spec., para 44 (emphasis added). The Specification contrasts the embodiment of Figure 3 with the embodiment of Figure 3A and states that “FIG. 3A illustrates another exemplary embodiment of a proximal housing 16’ that can be configured and used similar to the proximal housing 16, except the proximal housing 16’ includes a plurality of sealing ports.” *Id.*, para. 49. With respect to the embodiment of Figure 3A, the Specification discloses that each of the sealing ports 22a, 22b, 22c can have a central axis that differs from central axes of the other sealing ports 22a, 22b, 22c.” *Id.* Plural concentric sealing ports are not contemplated by the Specification. The Specification discloses that, for the single sealing port embodiment of Figure 3, “the sealing element includes a distal duckbill seal 34 that provides a channel seal, and a proximal septum seal 36 that provides an instrument seal.” *Id.*, para. 55. In view of the

above, the Examiner's broad construction of "a plurality of sealing ports" as including different seals at proximal and distal ends of the same opening is unreasonable. This unreasonably broad claim construction led to the Examiner's unsupported finding that Figure 24 of Wenchell '582 shows a plurality of sealing ports. We do not sustain the Examiner's rejection of claims 13 and 22 and of claims 14, 15, 21, 23–27, 29, and 31–34, depending therefrom as unpatentable over Wenchell '582.

Rejections (II) and (III)

The Examiner does not rely on Voegele or Winchell '426 in any manner that remedies the deficiencies in Rejection (I), which is based on Wenchell '582 alone. Accordingly, for the same reasons, we do not sustain the rejections under 35 U.S.C. § 103(a) of claims 16 and 28 over Wenchell '582 and Voegele, and of claim 30 over Wenchell '582 and Winchell '426.

Rejection (IV)

Claim 13 recites, in part, "a proximal cap removably coupled to the distal base so as to form a fluid tight seal, the proximal cap being freely rotatable 360° relative to the distal base and the retractor when the proximal cap is removably coupled to the distal base." Appeal Br. (App. A, A).

The Examiner finds that Smith discloses "a proximal cap (14a) removably coupled to the distal base so as to form a fluid tight seal," and that proximal cap 14a "is freely rotatable 360° relative to the distal base and the retractor when the proximal cap is removably coupled to the distal base." Final Act. 8 (citing Smith, Abstract; paras. 35–47; Figs. 2, 3).

Appellants assert that “Smith is completely silent as to any rotation of the seal 14a when the seal 14a is ‘removably coupled’ to the base 12a.”

Appeal Br. 30. Appellants argue that Smith’s clips 32 are used to secure the base 12a to the seal 14a and that “clips 32 ‘engage the inner circumference of flange 26 of the seal 14a, thus coupling the seal to the base.’” *Id.* at 31 (citing Smith, para. 43). Appellants thus assert that “Smith provides absolutely no teaching or suggestion that the seal 14a can rotate at all relative to the base 12a when clipped thereto, much less freely rotate 360° relative thereto.” *Id.*

The Examiner responds that “once the seal 14a is pressed onto ring 28 a seal is formed,” and this “is when the removable coupling occurs between the two parts.” Ans. 10. In view of this, the Examiner takes the position that “clips 32 are used to completely lock the seal into place,” but that “prior to locking the seal down, the seal can be rotated to any position, so the claimed limitation is met.” *Id.* (citing Smith, paras. 41–44; Fig. 2).

The Examiner’s position is inconsistent not only with Appellants’ Specification, but also with the disclosure of Smith. The Specification discloses that “[t]o couple the distal and proximal housings 14, 16 together, the proximal housing 16 can be snapped onto the distal housing 14.” Spec., para 72; Figs. 10, 12. The Specification also discloses a foot and track configuration with foot 174 “configured to engage the circumferential track 176 and slide or thread therein to couple the distal and proximal housings 114, 116,” so that “rotating the proximal housing 116 relative to the distal housing 114 will not remove it from the distal housing 114.” *Id.*, paras. 83, 84; Fig. 18. Based on this, one of ordinary skill in the art would understand

that “coupling” consistent with the Specification requires more than mere contact between the proximal and distal housings. Likewise, one of ordinary skill in the art would understand that base 12a and seal 14a of Smith are not coupled until clips 32 are clipped into place. Specifically, Smith discloses that “[w]hen in the clipped position, the clips 32 engage the inner circumference of flange 26 of the seal 14a, thus *coupling* the seal to the base.” Smith, para. 43; *see also id.*, paras. 10–12. Although we appreciate that the rotational position of Smith’s seal can be changed prior to clips 32 being in the clipped position, Smith’s device is considered to be coupled only when in the clipped position, and the Examiner has not demonstrated that Smith’s seal and base are rotatable relative to each other in the clipped position. In view of this, the Examiner has not adequately established that each of the claim limitations is met by the proposed combination of Smith and Wenchell ’582. Accordingly, we do not sustain the rejection under 35 U.S.C. § 103(a) of claim 13 based on Smith and Wenchell ’582.

DECISION

The Examiner’s rejections of claims 13–16 and 21–34 are reversed.

REVERSED