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EXAMINER
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HANKINS, LINDSEY G

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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* BRIAN D. ZELICKSON and ROBERT A. GANZ

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Appeal 2015-000461  
Application 13/658,384<sup>1</sup>  
Technology Center 3700

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Before JILL D. HILL, THOMAS F. SMEGAL, and  
ERIC C. JESCHKE, *Administrative Patent Judges*.

SMEGAL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Brian D. Zelickson and Robert A. Ganz (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner’s Final Rejection<sup>2</sup> of claims 75–78, 80–83, 85–88, 90, 91, and 94–98 under 35 U.S.C. § 102(b) as anticipated by Hull (US 5,056,532, iss. Oct. 15, 1991); of claim 79 under 35 U.S.C. § 103(a) as unpatentable over Hull and Reid (US 5,464,437, iss. Nov. 7, 1995); and of claims 84, 89, 92, and 93 under 35 U.S.C. § 103(a) as

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<sup>1</sup> According to Appellants, Boston Scientific Scimed, Inc., is the real party in interest. Appeal Br. 2.

<sup>2</sup> Appeal is taken from the adverse decision of the Examiner as set forth in the Final Action (mailed October 25, 2013 (“Final Act.”)).

unpatentable over Hull and Hussein (US 4,470,407, iss. Sept. 11, 1984).<sup>3</sup>

We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

#### CLAIMED SUBJECT MATTER

Claims 75, 86, and 97 are independent. Claim 75 is reproduced below and illustrates the claimed subject matter, with disputed limitations emphasized.

75. A medical treatment system, comprising:
- an elongate insertion device configured for insertion into an opening of a body;
  - an energy source disposed outside the body;  
*an energy transmitting device located at a distal end of the insertion device, the energy transmitting device comprising an expandable portion which extends radially from the insertion device, and an antenna located in an exterior surface of the expandable portion, the antenna configured to transmit energy generated by the energy source to a target tissue area in the body; and*
  - a manifold through which a transmission line of the energy source passes, the transmission line coupled to the energy transmitting device,  
*wherein the distal end of the insertion device is controllable to position the energy transmitting device in relation to the target tissue area.*

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<sup>3</sup> Claims 1–74 are canceled. Final Act. 2 (*see* Preliminary Amendment, filed October 23, 2012). In that an After Final Amendment (filed January 22, 2014) was not entered by the Examiner, a correct copy of the claims 75–98 is found in the Amendment filed June 18, 2013.

## ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants' arguments in the Appeal Brief, the Examiner's Answer, and the Reply Brief. We disagree with Appellants' conclusions, and agree with, and adopt as our own, the Examiner's findings and conclusions of law set forth at pages 3–8 of the Examiner's Answer. Specific arguments are highlighted and addressed below for emphasis.

*Anticipation of Claims 75–78, 80–83, 85–88, 90, 91, and 94–98 by Hull*

The dispositive issue in this case is whether the Examiner correctly construes Hull to disclose a medical treatment system having an energy transmitting device located at a distal end of an insertion device, as recited by the claims. Appellants argue claims 75–78, 80–83, 85–88, 90, 91, and 94–98 together in contesting the rejection of these claims as anticipated by Hull. Appeal Br. 4–9; *see also* Reply Br. 2–11. We select claim 75 as the representative claim for this group, and the remaining claims stand or fall with claim 75. *See* 37 C.F.R. § 41.37(c)(1)(iv). We have considered Appellant's arguments raised in the Appeal Brief, but do not find them persuasive to demonstrate error in the Examiner's rejection of claim 75 as being anticipated by Hull.

The Examiner finds that Hull anticipates claim 75 by teaching a medical treatment system, including, *inter alia*:

- (1) an elongate insertion device, an energy source, and “an energy

transmitting device located *at a distal end of the insertion device*”<sup>4</sup> (Final Act. 2 (citing Hull, col. 4, ll. 45–56) (emphasis added));

(2) where “the energy transmitting device [comprises] an expandable portion . . . which extends radially from the insertion device [] and an antenna located in an exterior surface of the expandable portion [is] configured to transmit energy generated by the energy source to a target tissue area in the body,”<sup>5</sup> (*id.* at 2–3 (citing Hull, col. 2, ll. 20–39; and col. 4, l. 45–col. 5, l. 5)); and

(3) where “the distal end of the insertion device is controllable to position the energy transmitting device in relation to the target tissue area, such as via a control mechanism at a proximal portion of the elongate insertion device controlling movement of the energy transmitting device” (*id.* at 3 (citing Hull, col. 2, ll. 20–52, and col. 4, ll. 20–34)).

Appellants take issue with the analysis and conclusions presented in the Final Action, first contending that “Hull fails to teach or suggest an energy transmitting device located *at a distal end* of the insertion device,” asserting that “[Appellants’ claim] specifically recites a distal end, and not a ‘distal portion’ of the insertion device that is proximal to the distal terminus of the device.” Appeal Br. 5; *see also* Reply Br. 3–6.

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<sup>4</sup> At page 2 of the Advisory Action (mailed February 25, 2014), the Examiner further explains “the area of Hull that includes the electrode portions and balloons are considered to be on a distal end of the elongated member,” reasoning that claim 75 “does not [recite] the distal end to be a distal tip or the distalmost point on the elongated member.”

<sup>5</sup> The Examiner also points out that “[f]igure 3 [of Hull] more clearly shows the electrode portion located on an exterior surface of the balloon.” Final Act. 8.

In response, the Examiner points out having previously found that “the area of Hull that includes the electrode portions and balloons are considered to be on the distal end of the elongated member,” and that “the broadest reasonable interpretation of ‘distal end’ in the scope of the claims as well as what is known in the art encompasses a ‘distal portion’ of the elongated member, as the wording of the claim does not define this term more specifically.” Ans. 3.

We determine the scope of the claims in a patent application by giving claims “their broadest reasonable interpretation consistent with the [S]pecification” and “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) (citations omitted). “Construing claims broadly during prosecution is not unfair to the applicant . . . because the applicant has the opportunity to amend the claims to obtain more precise claim coverage.” *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d at 1364.

Appellants have not pointed to any lexicographic definition in the Specification of the term “a distal end” or identified any other disclosure therein that precludes the Examiner from construing “all of the features as shown in figure 1 [of Hull] are part of the ‘distal end,’” and reasoning that “it doesn’t matter if a feature is ‘proximal’ or ‘distal’ to another feature, as all of the features [in figure 1 of Hull] are located on a ‘distal end.’” Ans. 4–5. The Examiner also observes that claim 75 “does not specifically state a ‘distal tip’ or a ‘distal terminus,’ [but] merely a ‘distal end’ which the

Examiner interprets to be a general area rather than a fixed point on the [insertion device].”<sup>6</sup> *Id.* at 5. We agree.

Appellants next contend that “Hull does not teach or suggest that lead 24 or the electrodes 26, 28 are located in an exterior surface of an expandable portion, *whether in a collapsed or expanded configuration.*” Appeal Br. 6 (emphasis added). However, Appellants’ contention is unavailing as it is not commensurate with the scope of claim 75, which does not recite electrodes located in an exterior surface of an energy transmitting device whether in a collapsed or expanded configuration, but merely recites “an antenna located in an exterior surface of the expandable portion.” Appeal Br. 11, Claims App. As we are instructed by our reviewing court, “limitations are not to be read into the claims from the [S]pecification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

After quoting extensively from the Final Action and Advisory Action, Appellants continue by concluding that “Hull does not teach or suggest an antenna located in an exterior surface of the expandable portion, as recited in claim 75.” Appeal Br. 6–7, *see also* Reply Br. 7–9. However, Appellants misread Hull. *See supra* n.5. As the Examiner explains in the Final rejection, “[w]hen inflated, the electrodes are pressed against the target tissue.” Final Act. 8 (citing Hull, col. 3, ll. 20–34).<sup>7</sup> The Examiner also

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<sup>6</sup> Hull discloses that figure 1 “shows a plan view of the lower surface of *the distal end* of an esophageal lead of the present invention.” Hull, col. 2, ll. 20–22 (emphasis added).

<sup>7</sup> Hull discloses that “[i]nflation of the balloon urges the aperture and the electrodes located therein adjacent the anterior surface of the esophagus.” Hull, Abstract.

notes “that not only are the electrodes adjusted relative to the position of the balloon, but also [adjusted relative to] the location of the target tissue [] via contact between the electrodes and tissue through the aperture 22.” *Id.* (citing Hull, col. 2, ll. 39–52; col. 3, ll. 8–34; and col. 4, ll. 40–53). Appellants have not apprised us that the Examiner’s findings and conclusions regarding Hull are in error.

Appellants rephrase their first contention, further asserting that “Hull does not disclose or suggest a distal end of the insertion device [that is] ‘controllable to position the energy transmitting device in relation to the target tissue area,’ as recited in claim 75.” Appeal Br. 7. While acknowledging that Hull describes “distal end 18 as facilitating passage of the [insertion] device down the esophagus,” and “lead [electrode] 24 as being ‘slidably mounted’ within a lumen of the lead body 10,” Appellants contend that Hull “teaches separately moving lead [electrode] 24 independent of the distal end 18 of the lead body 10.” *Id.* at 8. From the foregoing, Appellants conclude that “Hull does not teach or suggest a distal end of the insertion device being controllable to position the energy transmitting device in relation to the target tissue area, as recited in claim 75.” *Id.*; *see also* Reply Br. 9–11.

We disagree with Appellants for several reasons. First, the presence of additional structure in Hull, such as separately movable lead electrode 24, does not undermine a rejection where the claim uses an open-ended transition “comprising.” *See Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 1319 (Fed. Cir. 2009) (“The claim uses the term ‘comprising,’ which is well understood in patent law to mean ‘including but not limited

to.” (citing *CIAS, Inc. v. Alliance Gaming Corp.*, 504 F.3d 1356, 1360 (Fed. Cir. 2007)).

Furthermore, Appellants are not responding to the Examiner’s final rejection. *See* Final Act. 3. The Examiner again explains, *inter alia*, that “Hull discloses control of the distal end of the insertion device to position the electrodes relative to target tissue.” Ans. 7 (citing Hull, col. 2, ll. 39–52; col. 3, ll. 8–34). More specifically, the Examiner points to the cited passages of Hull as describing that “proper placement of the electrodes . . . includes movement of the distal end of the insertion device to position the [energy transmission device] relative to target tissue (the inner surface of the esophagus)” and that “this initial placement of the insertion device is part of positioning the energy transmitting device in relation to the target tissue area.” *Id.* at 7–8. The Examiner also finds that “[t]he movement of the lead body to further position the electrodes is only to refine the location of the electrodes.” *Id.* at 8 (citing Hull, col. 4, ll. 40–53). Again, we agree with the Examiner.

For the foregoing reasons, we discern no error in the Examiner’s findings and agree that Hull anticipates claims 75–78, 80–83, 85–88, 90, 91, and 94–98.

*Obviousness of Claim 79 over Hull and Reid*

Other than observing that “Reid does not cure the deficiency of Hull, as discussed above in regard to claim 76” (Appeal Br. 9; *see also* Reply Br. 11), we understand Appellants’ appeal of the rejection of claim 79, dependent on claim 76, rests on the arguments presented against the rejection of claim 75, which we found not demonstrative of error in the

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Examiner's rejection of claims 75–78, 80–83, 85–88, 90, 91, and 94–98, as set forth *supra*.

*Obviousness of Claims 84, 89, 92, and 93 over Hull and Hussein*

Other than observing that “Reid [sic] does not cure the deficiency of Hull, as discussed above in regard to claims 76 [sic] and 86” (Appeal Br. 10; *see also* Reply Br. 12), we understand Appellants’ appeal of the rejection of claim 84, and the rejection of claims 89, 92, and 93, rests on the arguments presented against the rejection of claim 75 and 86, which we found not demonstrative of error in the Examiner’s rejection of claims 75–78, 80–83, 85–88, 90, 91, and 94–98, as set forth *supra*.

DECISION

We affirm the Examiner’s rejections.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED