



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
13/682,548 11/20/2012 Christopher A. Benning 06530-0524-00000 3128

109610 7590 11/19/2018
Bookoff McAndrews, PLLC
2020 K Street, NW
Suite 400
Washington, DC 20006

EXAMINER

NEAL, TIMOTHY JAY

ART UNIT PAPER NUMBER

3795

NOTIFICATION DATE DELIVERY MODE

11/19/2018

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptomail@bomcip.com
Kross@bomcip.com
eofficeaction@apcoll.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRISTOPHER A. BENNING, PAUL AQUILINO,
JOHN HUTCHINS, and SCOTT TUPPER

Appeal 2017-011127
Application 13/682,548
Technology Center 3700

Before RICHARD M. LEBOVITZ, MICHAEL J. FITZPATRICK, and
RACHEL H. TOWNSEND, *Administrative Patent Judges*.

FITZPATRICK, *Administrative Patent Judge*.

DECISION ON APPEAL

Christopher A. Benning, Paul Aquilino, John Hutchins, and Scott
Tupper (“Appellants”)¹ appeal under 35 U.S.C. § 134(a) from the
Examiner’s final decision rejecting claims 9, 11–15, 24–29, 31, 32, and 34.
We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ The real party in interest is identified as Boston Scientific Scimed, Inc.
Appeal Br. 2.

STATEMENT OF THE CASE

The Specification

According to Appellants, the claimed invention relates to endoscopic systems and “is directed to systems and methods to optimize visualization by controlling distribution of light in a field of view within the body from outside the body.” Spec. ¶¶3–4. In particular, the claimed invention is directed to a cap positioned on the distal end of an endoscope.

Figure 2 is reproduced below.

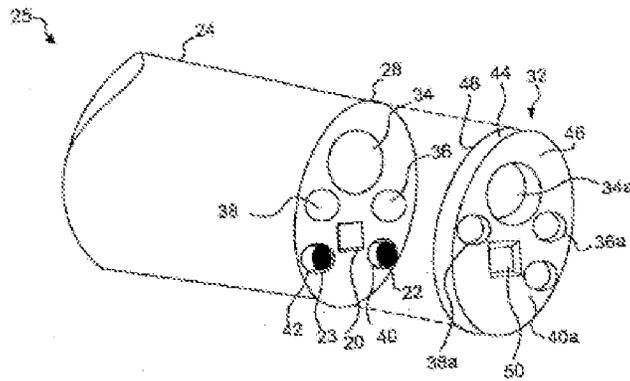


Figure 2, reproduced above, shows “an exploded view of a distal portion [25] of the endoscopic device having a cap [32], according to a first embodiment of the disclosure.” Spec. ¶16.

Figures 3a and 3b are reproduced below.

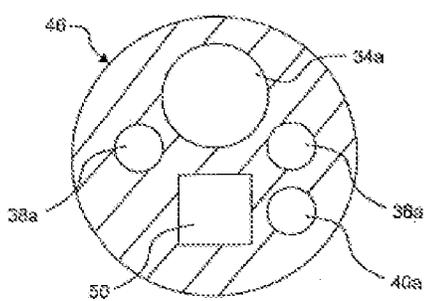


FIG. 3A

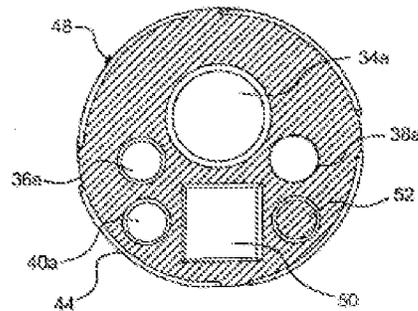


FIG. 3B

Figures 3a and 3b, reproduced above, respectively show distal end 46 and proximal end 48 of cap 32. *Id.* ¶34. The cap includes ports extending from the proximal end to distal end. *Id.* In this particular embodiment, they are “working port 34a, an irrigation port 36a, an aspiration port 38a, a viewing port 50, and a light port 40a.” *Id.* The proximal end of the cap also includes recess 52, which does not extend to the distal end. *Id.* An illumination device may be configured to terminate in the recess. *Id.* ¶36. The cap may be made of a translucent material and/or a material that scatters light. *Id.* ¶52.

The Rejected Claims

Claims 9, 11–15, 24–29, 31, 32, and 34 stand rejected. Final Act. 1. Independent claim 9 is representative and reproduced below.

9. A cap for an endoscope, comprising:

a body having a proximal end and a distal end;

a rim extending around a perimeter of the proximal end of the body and projecting proximally from the body, wherein the rim is dimensioned to receive a distal end of the endoscope and position the distal end of the endoscope adjacent the proximal end of the body, and wherein the rim is configured to extend over and radially outward of the distal end of the endoscope when the endoscope is received within the rim;

a lumen extending through the body from the proximal end of the body to the distal end of the body; and

at least one recess extending into the body from the proximal end and terminating at a position within the body proximal of the distal end of the body, wherein the at least one recess is defined by a proximally-facing wall of material covering an entire distal end of the recess and extending to the distal end of the body, wherein the material within the wall is adapted to scatter light throughout the body, and a complete

cross-section of the body including the proximally-facing wall consists of a uniform composition of the material.

Appeal Br. 19.

The Appealed Rejections

The following rejections are before us for review:

1. claims 9, 11, 14, 15, 24, 25, 28, 29, and 31, 32, and 34 under 35 U.S.C. § 102(b) (pre-AIA) as anticipated by Hoffman² or, in the alternative, under 35 U.S.C. § 103(a) (pre-AIA) as obvious over the same (Final Act. 2); and

2. claims 12, 13, 26, and 27 under 35 U.S.C. § 103(a) (pre-AIA) as obvious over Hoffman and Robertson³ (Final Act. 10).

DISCUSSION

Rejection 1

The Examiner rejected claims 9, 11, 14, 15, 24, 25, 28, 29, 31, 32, and 34 as anticipated by, or obvious over, Hoffman. Final Act. 2. Hoffman discloses an endoscope assembly including a cap. Hoffman ¶3.

Figure 2 of Hoffman is reproduced below.

² US 2007/0066869 A1, published Mar. 22, 2007 (“Hoffman”).

³ US 2010/0286475 A1, published Nov. 11, 2010 (“Robertson”).

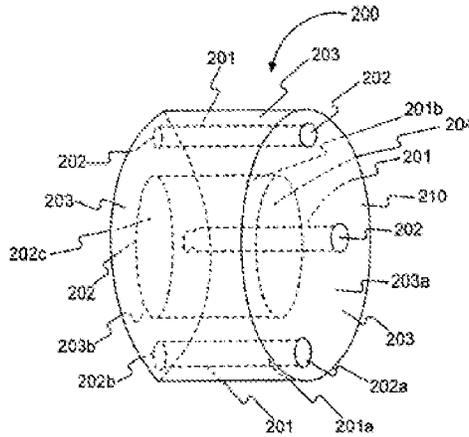


Figure 2 of Hoffman, reproduced above, shows “a schematic view of an endoscopic cap” 200. Hoffman ¶¶11, 22. The cap includes body 210 with a plurality of channels 201 extending from “first surface 203a” (corresponding to claim 9’s “distal end”) to “second surface 203b” (corresponding to claim 9’s “proximal end”). *Id.* ¶23. The cap also includes “second channel 201b extend[ing] partially through endoscope cap 200.” *Id.* ¶24. The second channel’s sole opening is on the second surface or proximal end. *Id.*

“At least a portion of endoscopic cap 200 may be translucent and/or made of a translucent material.” *Id.* ¶25.

The Examiner found that Hoffman discloses all of the limitations of claim 9. Final Act. 2–4. Additionally, the Examiner found that the subject matter of claim 9 would have been obvious over Hoffman, because even if Hoffman does not disclose “a complete cross-section of the body including the proximally-facing wall consists of a uniform composition of the material,” as recited in claim 9, such a feature would have been obvious. Final Act. 4–5.

Appellants dispute that Hoffman discloses or suggests “a complete cross-section of the body including the proximally-facing wall consist[ing] of a uniform composition of the material,” as recited in claim 9. Appeal Br. 10–16. Appellants do not dispute that Hoffman teaches all other limitations of claim 9. *Id.*

The Examiner found that Hoffman teaches this limitation of claim 9, citing paragraphs 4, 6, and 24–26 and claim 4 of Hoffman. Final Act. 4. In particular, the Examiner relied on Hoffman’s teachings that “the cap may be translucent” (¶¶4, 6), “the cap is translucent” (claim 4), that “[a]t least a portion of endoscopic cap 200 may be translucent and/or made of a translucent material” (¶25), and that the cap may be made using “injection molding or machining” (¶22). *See* Ans. 12–13. Based on these teachings, as well as the illustration of the cap in Figure 2 as a single integral component, the Examiner found that a person of ordinary skill in the art would understand Hoffman to disclose a cap of uniform translucent material. Ans. 12.

Appellants argue that the Examiner has failed to establish that Hoffman inherently teaches “a complete cross-section of the body including the proximally-facing wall consists of a uniform composition of the material.” Appeal Br. 11–14. Appellants’ arguments are inapposite because the Examiner’s rejection did not rely on an inherent teaching. The Examiner’s rejection relied instead on explicit disclosure of Hoffman, which sufficiently informs the person of ordinary skill in the art of the claimed feature. *See In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009) (anticipatory “reference need not satisfy an *ipsissimis verbis* test”).

We find no error in the Examiner's finding that Hoffman teaches "a complete cross-section of the body including the proximally-facing wall consists of a uniform composition of the material," as recited in claim 9. We also find no error in the Examiner's determination that such a feature would have been obvious over the same teachings of Hoffman.

Accordingly, we affirm the rejection of claim 9 as anticipated by, or obvious over, Hoffman. Claims 11, 14, 15, 24, 28, 29, and 31, 32, and 34 were not separately argued and thus fall with claim 9. *See* 37 C.F.R. § 41.37(c)(iv). Although claim 25 was argued separately, it was not argued on a different basis. *See* Appeal Br. 17 ("Thus, for the same/similar reasons as discussed above in regards to claim 9, the Section 102, or, alternatively, Section 103, rejection of claim 25 based on Hoffman is improper and should be reversed.").

We affirm Rejection 1.

Rejection 2

The Examiner rejected claims 12, 13, 26, and 27 as obvious over Hoffman and Robertson.

Appellants argue against this rejection only on the basis that Robertson fails to cure the purported deficiency in the Examiner's rejection of base claims 9 and 25. *See* Appeal Br. 17–18. As discussed above, there is no such deficiency.

We affirm Rejection 2.

CONCLUSION

For the reasons discussed, we affirm the Examiner's rejections of claims 9, 11–15, 24–29, 31, 32, and 34.

Appeal 2017-011127
Application 13/682,548

TIME PERIOD

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

AFFIRMED