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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SEAN T. DYCUS and DARION R. PETERSON

Appeal 2018-002522
Application 14/719,564
Technology Center 3700

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

KERINS, *Administrative Patent Judge.*

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant appeals from the Examiner's decision to reject claims 21–29.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ The term “Appellant” is used herein to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Covidien AG, whose parent entity is Medtronic plc. Appeal Br. 1.

THE CLAIMED SUBJECT MATTER

Appellant's invention relates to an electrosurgical instrument. Spec.

1. Claim 21 is illustrative, and is reproduced below:

21. A bipolar forceps, comprising:

a housing;

an elongated shaft extending distally from the housing;

an end effector assembly disposed at a distal end of the elongated shaft, the end effector assembly including a first jaw member and a second jaw member, the first jaw member pivotable relative to the second jaw member between a first position, wherein the first and second jaw members are spaced apart from one another, and a second position, wherein the first and second jaw members are closer to one another, the first and second jaw members each adapted to connect to an electrosurgical energy source, the second jaw member including at least one stop member associated with a sealing surface thereof, the at least one stop member electrically-insulated from the sealing surface of the second jaw member;

a movable handle connected to the housing and operable to pivot the first jaw member between the first position and the second position in response to proximal movement of the movable handle relative to the housing;

a knife advanceable at least partially through a knife channel defined in the sealing surface; and

a trigger assembly including a finger tab positioned distally adjacent the movable handle, the trigger assembly connected to the housing and operable to advance the knife in response to proximal movement of the finger tab relative to the housing.

THE REJECTIONS

The Examiner rejects:

(i) claims 21, 23–26, 28, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Yoon (US 6,099,550, issued Aug. 8, 2000) in view of Eggers (US 5,891,142, issued Apr. 6, 1999) and Baden (US 5,735,849, issued Apr. 7, 1998);

(ii) claim 22 under 35 U.S.C. § 103(a) as being unpatentable over Yoon in view of Eggers, Baden, and Parins (US 5,197,964, issued Mar. 30, 1993); and

(iii) claim 27 under 35 U.S.C. § 103(a) as being unpatentable over Yoon in view of Eggers, Baden, and Slater (US 5,482,054, issued Jan. 9, 1996).

ANALYSIS

Claims 21, 23–26, 28, and 29--35 U.S.C. § 103(a)--Yoon/Eggers/Baden

The Examiner cites to Yoon as disclosing most limitations set forth in claim 21. Final Act. 4–5. The Examiner relies on Eggers as teaching a second jaw member having at least one stop member, a limitation not found in Yoon, and concludes that it would have been obvious to modify Yoon to include a stop member as claimed in order to provide a more efficient electrode contact geometry and more efficient hemostasis of tissue or blood vessels. *Id.* at 4. Appellant does not take issue with the finding and conclusion involving Eggers.

The Examiner additionally finds Yoon lacking a teaching of a trigger assembly having a finger tab positioned distally adjacent a moving handle, with the trigger assembly being operable to advance a knife in response to

proximal movement of the finger tab relative to the housing.² Final Act. 5. The Examiner finds that Baden teaches such a trigger assembly, and concludes that it would have been obvious to modify Yoon to include a trigger assembly of the type disclosed in Baden. *Id.* at 5–6. The Examiner states that a person of ordinary skill in the art would have recognized the desirability of including the Baden trigger assembly in Yoon, but does not appear to have articulated any particular reason as to why one of ordinary skill in the art would have found it obvious to have made such a modification. *Id.*

Appellant challenges this finding and conclusion, especially emphasizing that Baden does not teach a trigger assembly that advances a blade in response to a proximal movement of the finger tab portion of the trigger assembly. Appeal Br. 7–8; Reply Br. 2–3. As such, according to Appellant, the proposed combination, even if proper, would not include the trigger assembly operating in the claimed manner. Appeal Br. 8.

Appellant cites to Baden as disclosing that “[t]he blade lever 24 of the handle 22 is . . . *pivoted towards the distal end of handle 22,*” which “causes the blade rod 50 to be longitudinally moved towards the distal end, causing the blade 26 to extend.” Appeal Br. 7 (quoting Baden 7:5–10, and citing to Fig. 1). The Examiner does not dispute the accuracy of the citation to the Baden disclosure; instead taking the position that, when the blade lever is pivoted in a distal direction, at least a portion of the blade lever on

² The Examiner does find that Yoon teaches a knife that is advanceable through a knife channel, but does not teach the particular trigger assembly set forth in claim 21. Final Act. 5. Yoon teaches what is referred to as handle 90 that is slidable distally to advance the knife in a distal direction. Yoon 5:31–33, Fig. 15.

the opposite side of pivot pin 58 necessarily moves toward the proximal end of the handle. Final Act. 2; Ans. 10.

We agree with Appellant that the Examiner's reliance on the small arc of material extending around pivot pin 58 on a side opposite the actual blade lever as corresponding to the claimed finger tab of the trigger assembly is an unreasonably broad interpretation of the claim language. *See* Reply Br. 3. Appellant points out that the Examiner improperly interprets the recitation of "finger" in the limitation directed to a "finger tab" as intended use, affording "finger" no patentable weight. *Id.* Not only do we agree that the claim term "finger tab" connotes structure with which a finger can engage to operate the trigger assembly as intended, we also note that, even if "finger" is afforded no patentable weight, the Examiner has not established that the portion of the blade lever relied on in Baden would be regarded as a "tab" by a person of ordinary skill in the art.

Accordingly, the rejection of independent claim 21, and of claims 23–26, 28, and 29 depending therefrom, is not sustained.

Claim 22--§ 103(a)--Yoon/Eggers/Baden/Parins

The Examiner does not rely on Parins in any manner that overcomes the deficiencies of the proposed combination of Yoon, Eggers, and Baden, in rejecting claim 22. The rejection is therefore not sustained.

Claim 27--§ 103(a)--Yoon/Eggers/Baden/Slater

The Examiner does not rely on Slater in any manner that overcomes the deficiencies of the proposed combination of Yoon, Eggers, and Baden, in rejecting claim 27. The rejection is therefore not sustained.

DECISION

The rejection of claims 21, 23–26, 28, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Yoon, Eggers, and Baden is reversed.

The rejection of claim 22 under 35 U.S.C. § 103(a) as being unpatentable over Yoon in view of Eggers, Baden, and Parins is reversed.

The rejection of claim 27 under 35 U.S.C. § 103(a) as being unpatentable over Yoon in view of Eggers, Baden, and Slater is reversed.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
21, 23–26, 28, 29	103(a)	Yoon, Eggers, Baden		21, 23–26, 28, 29
22	103(a)	Yoon, Eggers, Baden, Parins		22
27	103(a)	Yoon, Eggers, Baden, Slater		27
Overall Outcome				21–29

REVERSED