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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 PLACEK and ROBERT K. DECKMAN<sup>1</sup>

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Appeal 2018-002729  
Application 13/589,956  
Technology Center 3700

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Before DANIEL S. SONG, WILLIAM A. CAPP, and JILL D. HILL,  
*Administrative Patent Judges.*

SONG, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant appeals under 35 U.S.C. § 134(a) from the Examiner’s Final Office Action (“Final Act.”) rejecting claims 1–7 in the present application (App. Br. 3). We have jurisdiction under 35 U.S.C. §§ 6(b) and 134(a).

We REVERSE.

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<sup>1</sup> Collectively referred to as “Appellant” herein. The Appellant identifies the real party in interest as Gynesonics, Inc. (Appeal Brief (“App. Br.”) 3).

The claimed invention is directed to a method for treating uterine fibroids (App. Br. 15, Claims App.). Representative independent claim 1 reads as follows (App. Br. 15, Claims App., emphasis added):

1. A method for treating uterine fibroids, said method comprising:

introducing a probe into a uterus;

locating a uterine fibroid using an ultrasonic transducer carried by the probe;

*advancing a central member from the probe into uterine tissue proximate the uterine fibroid; and*

advancing a plurality of needle electrodes in a distal direction from the central member through a channel array into the uterine fibroid and/or tissue surrounding the uterine fibroid, wherein each channel has a ramp which has (1) a ramp entrance located at a first angular orientation in a transverse plane about a longitudinal axis of the central member and at a preselected radial depth beneath an outer surface of the central member and (2) a ramp exit located distally of the first ramp entrance along the longitudinal axis and at a second angular orientation in the transverse plane about the longitudinal axis angularly offset from the first angular orientation and on an outer surface of the central member; and

delivering energy from the needle electrodes to necrose the fibroid.

## REJECTIONS

The Examiner rejects claims 1, 2, and 5–7 under 35 U.S.C. § 103(a) as obvious over Gerbi et al. (US 2007/0249939 A1, pub. Oct. 25, 2007 (“Gerbi”)) in view of Epstein et al. (US 2007/0006215 A1, pub. Jan. 4, 2007 (“Epstein”)) and Agnew (US 2007/0112306 A1, pub. May 17, 2007) (Final Act. 5).

The Examiner rejects claims 3 and 4 under 35 U.S.C. § 103(a) as obvious over Gerbi in view of Epstein, Agnew, and Grossman (US 2007/0179380 A1, pub. Aug. 2, 2007) (Final Act. 7).

### ANALYSIS

The Examiner rejects independent claim 1, finding that the combination of Gerbi and Epstein discloses a method for treating uterine fibroids as substantially claimed, and in particular, that Gerbi discloses the steps of “introducing a probe into a uterus,” and “advancing a central member from the probe into uterine tissue” as recited in claim 1. (Final Act. 5–6). The Examiner concludes that it would have been obvious to a person of ordinary skill in the art to have “use[d] the teachings of Epstein to modify Gerbi to include deployment of multiple needle electrodes from a deployment shaft with curved channels,” in order to “deploy multiple electrodes that all curve around the fibroid to cover as much surface area as possible without the need to shift and move the device.” (Final Act. 5–6).

As to the recited angular orientation of the ramp in which a second angular orientation is angularly offset from the first angular orientation, the Examiner finds that

Agnew teaches a ramp which has (1) a ramp entrance located at a first angular orientation in a transverse plane about a longitudinal axis of the central member . . . and (2) a ramp exit located distally of the first ramp entrance along the longitudinal axis and at a second angular orientation in the transverse plane about the longitudinal axis angularly offset from the first angular orientation.

(Final Act. 5–6 (citing Gerbi, Fig. 3D (top and bottom of groove 325))).

Based on the disclosure of Agnew, the Examiner further concludes that it would have been obvious to a person of ordinary skill in the art to modify Gerbi to include “a spiral path for the channels such that the needles can curve around the fibroid” “such that more surface area of the fibroid can be reached.” (Final Act. 6).

The Appellant argues, *inter alia*, that none of the references disclose “advancing a central member from the probe into uterine tissue . . . and advancing a plurality of needle electrodes in a distal direction from the central member” as claimed. (App. Br. 8). In that regard, the Appellant explains that “[w]hile Gerbi shows a probe 16 and a single needle 14, there is no separate central member which is advanced into tissue.” (App. Br. 8; *see also* Reply Br. 2). The Appellant disputes the Examiner’s finding with respect to Gerbi contending that “[t]he shaft 16 [of Gerbi] cannot be both the probe which is introduced into the uterus and the central member which is advanced from the probe into tissue, as required by claim 1.” (Reply Br. 2–3). In further support of patentability, the Appellant points out that Gerbi discloses two step operation while claim 1 requires three. (Reply Br. 2–3). As such, the Appellant argues that “no reasonable combination of the teachings would result in the claimed combination, i.e. first introducing a probe into the uterus, next advancing a central member from the probe into the uterine tissue, and then advancing a plurality of needles from the central member into the uterine tissue,” as required by claim 1. (App. Br. 9). We agree with the Appellant.

As noted above, the Examiner rejection of claim 1 is premised on the finding that Gerbi discloses introducing a probe into a uterus, and

“advancing a central member from the probe into uterine tissue.” (Final Act. 5–6). Indeed, the Examiner elaborates that “the shaft [of Gerbi] reads on a central member of the probe and this probe is advanced into the uterus” such that Gerbi discloses “introducing a probe into the uterus and advancing a central member from the probe into uterine tissue.” (Ans. 3).<sup>2</sup>

However, the Appellant is correct that Gerbi does not disclose a central member that is advanced *from* the probe, wherein the needle electrodes are advanced from the central member. The Examiner appears to interpret the claim language to merely require advancing a central member “of” the probe. We consider this interpretation to be unreasonably broad. The language of the claim is clear that the central member is advanced *from* the probe, thereby requiring movement of the central member relative to the other components of the probe of which the central member is a part. This is the proper and reasonable understanding of the claim in view of the Specification. (See Figs. 8–16; ¶¶ 52–54, 64, 66). Therefore, because we disagree with the Examiner’s apparent claim construction and fact finding that Gerbi discloses a central member that is advanced from the probe as required by the language of claim 1, we reverse the rejection of claim 1.

The above noted erroneous claim construction and factual finding underlies the rejections of all the remaining claims, which ultimately depend from independent claim 1. Therefore, we reverse the rejections of the remaining claims as well. In that regard, the Examiner’s application of

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<sup>2</sup> Although not part of the actual rejection applied, the Examiner states that Epstein also teaches the central member (Ans. 3). However, the relevance of Epstein is unclear because the Epstein’s scope of disclosure as to the central member is the same as that of Gerbi.

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Epstein, Agnew, and Grossman does not remedy the deficiency of Gerbi. The remaining arguments directed to: whether Agnew is non-analogous art (App. Br. 9–11; Ans. 3–5), lack of motivation (App. Br. 11–12; Ans. 5–7), and impermissible use of teachings in the Appellant’s disclosure (App. Br. 12–13; Ans. 5–7), are all moot.

#### CONCLUSION

The Examiner’s rejections are REVERSED.

REVERSED