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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte VADIM MOROZOV

Appeal 2018-002921
Application 14/715,772
Technology Center 3700

Before MICHAEL J. FITZPATRICK, SUSAN L. C. MITCHELL, and
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

FITZPATRICK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's final decision rejecting claims 1–3, 5, and 9–11. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

¹ Appellant identifies the University of Maryland, Baltimore, as the real party in interest. Appeal Br. 1.

STATEMENT OF THE CASE

The Specification

The claimed invention “relates generally [to] the field of surgical devices, and more particularly the invention relates to an improvement to a uterine manipulator device used for total laparoscopic hysterectomy procedures.” Spec. 1:13–15. “The present invention is an improvement of a pre-existing uterine manipulator. The improvement involves the addition of a retractable electrosurgical needle into the uterine manipulator.” *Id.* at 6:6–8.

Figure 1 is reproduced below.

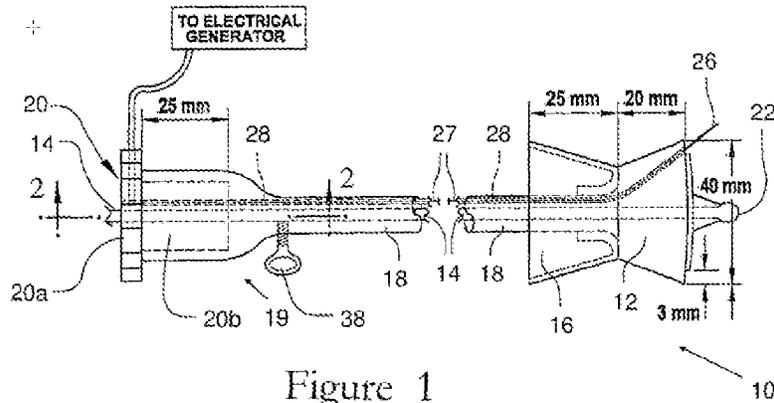


Figure 1

Figure 1, reproduced above, shows “a combination uterine manipulator and electrosurgical element according to an embodiment of the present invention.” *Id.* at 5:7–8. This combination surgical instrument is used “to perform a colpotomy, the separation of the uterus 30 and cervix 32 from the vagina 24.” *Id.* at 8:12–13, Fig. 3.

The instrument includes manipulator tube 18, which Appellant corresponds to the “elongated tube” recited in claim 1 and which includes manipulator shaft 14 therein. *Id.* at 6:10–13; Appeal Br. 3. “A cervical cup 12 is molded to a manipulator tube 18 that surrounds the manipulation shaft

14.” *Id.* at 6:13–14. Retractable and flexible electrosurgical needle 26 traverses the manipulator tube 18 from a proximal (physician) end of the instrument to a distal (working) end of the instrument. *Id.* at 6:14, 7:20–23, Fig. 1. The needle can extend from within the cervical cup distally beyond the cup and can bend as seen in Figure 1. The needle is rotatable about the axis of the manipulator tube and shaft. *Id.* at 9:3–4.

The Rejected Claims

Claims 1–11 are pending. Final Act. 1. Of them, claims 1–3, 5, and 9–11 are rejected, with claims 4 and 6–8 being objected to. Final Act. 1. Claim 1, the sole independent claim, is representative and reproduced below.

1. An electrosurgical element and uterine manipulator comprising:
 - an elongate tube having a proximal end and a distal end;
 - a cervical cup fixed to said elongate tube and opening toward said distal end of said elongate tube; and
 - an electrosurgical needle retractably mounted in and extensible from said cervical cup.

Appeal Br. 16.

The Appealed Rejection

The following rejection under 35 U.S.C. § 103 is before us for review: claims 1–3, 5, and 9–11 over Donnez² and Kjeken.³ Final Act. 5.

² US 2001/0021854 A1, published Sept. 3, 2001 (“Donnez”).

³ US 2008/0287857 A1, published Nov. 20, 2008 (“Kjeken”).

DISCUSSION

Independent Claim 1

Donnez discloses a uterine manipulator. Donnez, at [57]. The Examiner found that the Donnez uterine manipulator includes: “a. an elongate tube having a proximal end and a distal end (Fig. 1, 2); b. a cervical cup fixed to said elongate tube and opening toward said distal end of said elongate tube (Fig. 1, 3); and c. an electrosurgical needle (4, [0074]).” Final Act. 5; *see also id.* at 2 (identifying Donnez’s cupula 3 as cervical cup and finding that “the electrosurgical needle (4) of Donnez is axially movable and rotates around the cupula in a 360 degree fashion [and] also moves in a longitudinal direction (up and down) relative to the arm as described in paragraph [0074]”). *Id.* at 2. In an Advisory Action mailed April 28, 2017, and well as the Answer, the Examiner refined the rejection to assert that shaft 8 of Donnez, which extends within arm 2, is the structure asserted to be an “elongate tube.” Advisory Act. 2; Ans. 3. In total, the Examiner relied on Donnez as teaching all of the subject matter of claim 1 except for the recitation in claim 1 that the electrosurgical needle be “retractably mounted *in* and extensible *from said cervical cup.*” *Id.* at 6 (emphasis added).

The Examiner found that “Kjeken discloses an electrosurgical needle which is retractably mounted in and extensible from the center of a cup (Fig. 5A, 10, [0020]).” *Id.* The Examiner concluded that it would have been obvious to modify Donnez to include a retractable electrosurgical needle by Kjeken in order to penetrate and treat the tissue grasped within the cup. *Id.*; *see also* Donnez ¶5 (“In the particular case of a surgical operation, an additional difficulty arises from the fact that the incision must be precise and must avoid damaging the surrounding tissues.”).

Appellant argues that Donnez’s cupula is not “a cervical cup fixed to said elongate tube,” as recited in claim 1, because it is not fixed *directly* to Donnez’s arm 2. Appeal Br. 8. According to Appellant, “Donnez shows head 3 mounted to an interior shaft, which interior shaft is positioned within outer arm 2. There is no connection whatsoever between Donnez’s head 3 and outer arm 2.” *Id.* at 9.⁴ This argument is not persuasive for multiple reasons. First, there is no requirement in the claim that the fixation be direct with no intervening structure. Second, and as discussed above, the Examiner ultimately asserted, not Donnez’s outer arm 2, but rather shaft 8 within it, as teaching an elongate tube. Advisory Act. 2; Ans. 3. The Examiner explained:

In regards to the argument that Donnez’s cupula is not fixed to arm 8, the applicant appears to be defining that the cupula cannot be fixed to arm 8 through the connection assembly near 22 because arm 8 is movable. Merriam-Webster defines “fixed” as securely placed or fastened. Clearly Donnez shows that the cupula is fastened to arm 8 in such a way that the cupula does not detach from arm 8 through regular operation.

Advisory Act. 2; *see also* Ans. 3 (quoting Advisory Act. 2).

Appellant further argues that the Examiner cannot rely on inner shaft 8 to meet both the limitation “elongate tube” of claim 1 and the further limitation “an inner tube extending through said elongate tube” of dependent claim 3. Appeal Br. 9–10. We agree, but we find that the Donnez shaft meets the “elongate tube” of claim 1; it does not meet the “inner tube” of claim 3, as further addressed below.

⁴ Donnez sometimes refers to “cupula 3” as “head 3.” *Compare* Donnez ¶79, *with id.* ¶83. The Appeal Brief uses the latter term while the Examiner and this Decision use the former term.

Appellant argues that a person of ordinary skill in the art would not make the asserted combination because Donnez “requires” that its electrode 4 be mounted outside of the cupula 3. Appeal Br. 11. Appellant explains:

The fact that a medical device, such as a hypodermic needle as taught by Kjekken, may include a centrally positioned, extensible electrode does not in any way provide a person of ordinary skill in the art any motivation to move Donnez’s sectioning device 4 inside of head [cupula] 3. The sectioning device 4 of Donnez must be positioned on the outside of head 3 in order to be able to perform the intended rotational incision around the patient’s uterus.

Id. at 12. But Donnez does not state that its sectioning device *must be* positioned outside of the cupula. Donnez’s sectioning device (electrode 4) is positioned outside the cupula 3 because that is where Donnez’s rotating means is located (i.e., “circular belt 5” to which the sectioning device is mounted). *See* Donnez ¶¶74–75, Figs. 9a–b.

Appellant’s arguments regarding the position of Donnez’s electrode attacks that references individually instead of fairly responding to the obviousness rejection, which is based on a combination of references. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (“Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references. . . . [The reference] must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole.”). In other words, that Donnez does not anticipate claim 1 because it does not teach “an electrosurgical needle retractably mounted in and extensible from said

cervical cup” does not mean that claim 1 is not obvious over Donnez and Kjekken.

Appellant also argues that the proposed modification “would render Donnez wholly unsatisfactory for its intended purpose.” Appeal Br. 13. That argument, however, is premised on an automaton blindly repositioning Donnez’s electrode 4 from outside the cupula to within while leaving the means for rotating the electrode (i.e., circular belt 5) outside the cupula. But, a claim is unpatenable under 35 U.S.C. § 103 if it “would have been obvious . . . to a person having ordinary skill in the art,” not an automaton. 35 U.S.C. § 103; *see also KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”).

Appellants do not apprise us of error in the Examiner’s rejection of claim 1 over Donnez and Kjekken. We accordingly affirm it.

Dependent Claim 2

Claim 2 depends from claim 1 and further comprises “an occlusion cup rotatably mounted to said elongate tube and opening toward said proximal end of said elongate tube; wherein said elongate tube, said cervical cup, and said electrosurgical needle are rotatable as a unit with respect to said occlusion cup.” Appeal Br. 16.

The Examiner rejected claim 2 as obvious over Donnez and Kjekken, finding that:

Donnez discloses a uterine manipulator comprising: . . . an occlusion cup rotatably mounted to said elongate tube and opening toward said proximal end of said elongate tube (42, [0089]); wherein said elongate tube, said cervical cup, and said

electrosurgical needle are rotatable as a unit with respect to said occlusion cup ([0089]).

Final Act. 5.

Appellant makes two arguments in response. The first argument is simply that “Donnez fails to disclose, teach or suggest at least (i) an occlusion cup, or (ii) that the elongate tube, cervical cup, and electrosurgical needle are rotatable as a unit.” Appeal Br. 14. This argument is not persuasive because it is a simple denial of the Examiner’s findings without any explanation as to why those findings are in error.

The second argument is that “in the Advisory Action of April 28, 2017, the Examiner agreed that such features of claim 2 distinguished from the prior art, such that claim 2 is even further patentably distinguished.” *Id.* This argument is not persuasive because it is factually inaccurate. The Examiner agreed that claim 2 would be patentably distinguishable over the prior art *if* it were amended. *See* Advisory Act. 2 (“The applicant’s arguments in regards to claim 2 are persuasive and the rejection would be removed if these claims were filed as a proper amendment.”). Claim 2 was not so amended. *See* Appeal Br. 16 (“2. (Original)”).

For the foregoing reasons, we affirm the rejection of claim 2 over Donnez and Kjeken.

Dependent Claims 3 and 5

Claim 3 depends indirectly from claim 1 and recites “an inner tube extending through said elongate tube, wherein said elongated tube is free to slide and rotate on said inner tube.” Appeal Br. 16. Claim 5 depends from claim 3. *Id.* at 17.

The Examiner rejected claim 3 as obvious over Donnez and Kjekken, finding that Donnez's shaft 8 meets the "inner tube" limitation. Final Act. 6. As discussed above, however, the Examiner ultimately relied on shaft 8 to meet the "elongate tube" of claim 1. We agree above with the Examiner's finding that Donnez's shaft 8 meets the "elongate tube" limitation of claim 1. Accordingly, we disagree that it could also meet the "inner tube" limitation of claim 3, which must "extend[] through said elongate tube." *See* Appeal Br. 9–10 (arguing that the shaft 8 cannot meet both limitations).

Indeed, in the Answer, the Examiner does not argue for affirming the rejection of claim 3. Instead, the Examiner asserts (erroneously) that the rejection is moot, stating:

[T]he Examiner stated in the advisory action on 4/28/2017 that following the arguments of 4/10/2017 made by the applicant, claim 2 would be allowable over Donnez and Kjekken, which would make claim 3 also allowable. Therefore this argument is moot.

Ans. 3. But the amendment was not entered. Thus, the rejection of claim 3 is not moot.

For the foregoing reasons, we reverse the rejection of claim 3 over Donnez and Kjekken. Claim 5 depends from claim 3, and we therefore reverse the rejection of claim 5 for the same reasons.

Dependent Claims 9–11

For claims 9–11, Appellant does not present arguments for patentability beyond that they ultimately depend from claim 1. Appeal Br. 14. Thus, we affirm the rejection of claims 9–11 for the same reasons we affirm the rejection of claim 1.

CONCLUSION

For the reasons discussed, we affirm the Examiner's rejection of claims 1, 2, and 9–11 and reverse the rejection of claims 3 and 5.

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-IN-PART