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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GENE H. ARTS

Appeal 2018-003283
Application 11/900,715
Technology Center 3700

Before JENNIFER D. BAHR, MICHELLE R. OSINSKI, and BRANDON J. WARNER, *Administrative Patent Judges*.

OSINSKI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Gene H. Arts ("Appellant")[1] appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1, 2, and 5–19.[2] We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

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[1] According to Appellant, "[t]he real party in interest for this application is the Assignee of record, Covidien LP. The ultimate parent of Covidien LP is Medtronic plc." Appeal Br. 1.

[2] Claims 3 and 4 are cancelled. Appeal Br. 12 (Claims App.).

THE CLAIMED SUBJECT MATTER

Claims 1, 13, and 14 are independent. Claim 1, reproduced below, is illustrative of the subject matter on appeal.

> 1. An electrosurgical instrument comprising:
>
> a housing including a tube extending therethrough, the tube having proximal and distal ends, the proximal end being adapted to connect to at least a first source of gas and the distal end being configured to deliver gas to a surgical site; and
>
> an actuator configured to selectively regulate the flow of gas through the tube, the actuator having at least a first position which allows a first predetermined rate of gas to flow through the tube for pneumatically dividing tissue planes, and at least one subsequent position which allows at least one different rate of gas to flow through the tube for at least coagulating tissue, the at least first predetermined rate of gas flow being greater than 4 liters/min.

EVIDENCE

The Examiner relied on the following evidence in rejecting the claims on appeal:

Sartor ("Sartor '528")	US 2005/0171528 A1	Aug. 4, 2005

REJECTIONS

I. Claims 1, 2, 5–12, and 15–19 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Final Act. 3.

II. Claims 13 and 14 stand rejected under 35 U.S.C. § 102(b) as anticipated by Sartor '528. *Id.* at 4–5.

III. Claims 1, 2, 5–10, 12, and 15–17 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Sartor '528. *Id.* at 6–9.

OPINION

Rejection I

Independent claim 1 recites, in relevant part, "a first predetermined rate of gas to flow through the tube for pneumatically dividing tissue planes, . . . the at least first predetermined rate of gas flow being greater than 4 liters/min." Appeal Br. 12 (Claims App.). Claims 18 and 19, which depend from independent claims 13 and 14, respectively, recite similar limitations. *Id.* at 15–16. The Examiner finds that this feature was not described in the Specification in such a way as to reasonably convey to a person of ordinary skill in the art that Appellant had possession of the claimed subject matter at the time the application was filed. Final Act. 3.

Appellant argues that "a person of ordinary skill in the art of tissue coagulation and dividing would appreciate that a gas flow rate greater than 4 liters/min would be effective for 'pneumatically dividing tissue planes.'" Appeal Br. 5. Appellant points to the disclosure of U.S. Application 11/229,814, now U.S. Patent 7,572,255 (hereafter "Sartor '255"), which the instant Specification incorporates by reference, as support for this position. *Id.* (citing Sartor '255, col. 11, ll. 8–13); *see also* Spec. ¶ 4. We are unpersuaded by this argument.

The portion of Sartor '255 cited by Appellant discloses that, "for a typical coagulation procedure . . ., the flow rate provided by the cylinder can range from about 0.2 liters/min. to about 4 liters/min, and the nominal flow rate may be about 2 liters/min." Sartor '255, col. 11, ll. 9–13. In other words, Sartor '255 discloses gas flow rates for a *coagulation* procedure. However, Appellant does not point to, nor do we discern, any disclosure in Sartor '255 with respect to pneumatically *dividing* tissue planes. That a

person of ordinary skill in the art "would understand from the prior art that a gas flow rate of greater than 4 liters/min *would not be suitable* for a coagulation procedure" (Appeal Br. 5 (emphasis added)) is not evidence that a person of ordinary skill in the art would understand that such a gas flow rate *would be suitable* for tissue dividing. Appellant does not proffer any other evidence in support of the assertion that one of ordinary skill in the art would appreciate that a gas flow rate greater than 4 liters/minute would be effective for pneumatically dividing tissue planes. *See* Appeal Br. 5.

Thus, Appellant does not apprise us of error in the Examiner's finding that the original disclosure of the present application, which includes the disclosure of Sartor '255, fails to reasonably convey to those skilled in the art that Appellant had possession of the claimed subject matter as of the filing date. *See Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (*en banc*). Accordingly, we sustain the rejection of claims 1, 18, and 19, and claims 2, 5–12, and 15–17, which depend from claim 1 and for which Appellant relies on the same argument (Appeal Br. 5), under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

Rejection II

Appellant presents arguments for the patentability of independent claims 13 and 14 together as a group. Appeal Br. 5–8. We select claim 13 as the representative claim, and claim 14 stands or falls therewith. *See* 37 C.F.R. § 41.37(c)(1)(iv).

In rejecting claim 13, the Examiner finds that Sartor '528 discloses, in relevant part,

> an actuator configured to selectively regulate the flow of gas through the tube, the actuator (31) having at least a first position

> which allows a first predetermined rate of gas to flow through the tube for pneumatic separation of tissue planes, and at least one subsequent position which allows at least one different rate of gas to flow through the tube for coagulation of tissue (paragraphs 0015, 0045, 0051–0052, 0054–0056; Figure 1) and an electrode (350) mounted in proximity to the distal end of the tube (60), the electrode (350) operably connected to the electrosurgical generator (300) and configured to selectively ionize the gas passing thereby (paragraph 0045).

Final Act. 4.

Appellant argues that "the gas coagulator of Sartor ['528] is not configured for pneumatically separating or dividing tissue planes -- a procedure which requires the instrument to emit a ***non-ionized gas*** at a ***high flow rate***, i.e., greater than 4 liters/min." Appeal Br. 7. Appellant asserts that "the gas coagulator of Sartor ['528] is configured for fulguration, coagulation, cauterization or coagulative painting of tissue - a procedure which requires the instrument to emit an ***ionized gas*** at a ***low flow rate***, i.e., 4 liters/min or less." *Id.* According to Appellant, "Sartor ['528] does not provide any indication that the gas coagulator would be capable of providing a gas at a high flow rate, and especially a high flow rate suitable for pneumatically dividing or separating tissue planes" and instead is "only described as being used with gas at a low flow rate." *Id.* at 7–8. We are not persuaded by this line of argument.

Sartor '528 discloses an electrosurgical instrument including a gas cylinder that provides gas at "a flow rate of from about 0.2 liters/min. to *about* 4 liters/min." Sartor '528 ¶ 17 (emphasis added). Appellant does not contest the Examiner's position that Sartor '528's disclosure of "'about 4 liters/min' allows for gas flow slightly *above* 4 liters/min." Ans. 5 (emphasis added). Thus, Appellant has not persuaded us that Sartor fails to

disclose an instrument capable of providing gas at least somewhat greater than 4 liters/min. Sartor '528 also discloses that the instrument can *selectively* deliver energy to an electrode for ionizing the gas. Sartor '528 ¶ 45.

Although features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477–78 (Fed. Cir. 1997); *see also Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990) ("[A]pparatus claims cover what a device *is*, not what a device *does*"). Therefore, an apparatus of the prior art meets the recited functionally-defined limitation (here, "an actuator having at least a first position which allows a first predetermined rate of gas to flow through the tube for pneumatically dividing tissue planes") if it is *capable of* the recited function. The prior art reference need *not* envision the device *actually being used to* perform the claimed function. *See Schreiber*, 128 F.3d at 1477 ("Although Schreiber is correct that [the prior art] Harz does not address the use of the disclosed structure to dispense popcorn, the absence of a disclosure relating to function does not defeat the Board's finding of anticipation."). "[C]hoosing to define an element functionally, *i.e.*, by what it does, carries with it a risk." *Id.* at 1478. This risk is that Appellant may bear the burden to prove that the prior art does not possess the functional characteristic.

Although we acknowledge Appellant's observation that Sartor '528 does not explicitly disclose using the instrument to pneumatically *divide* tissue planes (Appeal Br. 7–8), Appellant does not offer any argument or evidence to rebut the Examiner's position that Sartor '528's instrument

would be able to "operate in the same manner [as Appellant's claimed system] to pneumatically divide tissue." Ans. 4. In other words, given that Sartor '528 discloses an instrument that can emit gas at a flow rate at least somewhat greater than 4 liters/minute (Sartor '528 ¶ 17) and selectively deliver energy to an electrode for ionizing the gas (*id.* ¶ 45), we are unpersuaded that Sartor '528's instrument would be incapable of performing the claimed function of pneumatically separating tissue planes. *See In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990) (citations omitted) ("when the PTO shows sound basis for believing the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not").

For the foregoing reasons, Appellant does not apprise us of error in the Examiner's finding that Sartor '528 discloses all of the limitations of independent claim 13. Accordingly, we sustain the rejection of claim 13, and of claim 14 falling therewith, under 35 U.S.C. § 102(b) as anticipated by Sartor '528.

Rejection III

In contesting the rejection of claims 1, 2, 5–10, 12, and 15–17 under 35 U.S.C. § 103(a) as unpatentable over Sartor '528, Appellant relies on the same arguments and reasoning we found unpersuasive in connection with the rejection of independent claims 13 and 14. *See* Appeal Br. 9–10 (asserting that Sartor '528 is not configured for providing non-ionized gas at a high flow rate for pneumatically dividing tissue planes). Accordingly, for the same reasons discussed above in connection with the rejection of claims 13 and 14, we also sustain the rejection of claims 1, 2, 5–10, 12, and 15–17 under 35 U.S.C. § 103(a) as unpatentable over Sartor '528.

DECISION

The Examiner's decision to reject claims 1, 2, 5–12, and 15–19 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is AFFIRMED.

The Examiner's decision to reject claims 13 and 14 under 35 U.S.C. § 102(b) as anticipated by Sartor '528 is AFFIRMED.

The Examiner's decision to reject claims 1, 2, 5–10, 12, and 15–17 under 35 U.S.C. § 103(a) as unpatentable over Sartor '528 is AFFIRMED.

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