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14/198,877	03/06/2014	Ioan Cosmescu	30359.3100	3564
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Zeman-Mullen & Ford, LLP 233 White Spar Road Prescott, AZ 86303			FOWLER, DANIEL WAYNE	
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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* IOAN COSMESCU<sup>1</sup>

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Appeal 2018-004431  
Application 14/198,877  
Technology Center 3700

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Before STEFAN STAICOVICI, LEE L. STEPINA, and  
ARTHUR M. PESLAK, *Administrative Patent Judges*.

STEPINA, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Ioan Cosmescu (“Appellant”) appeals under 35 U.S.C. § 134(a) from the Examiner’s decision rejecting claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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<sup>1</sup> Appellant is the Applicant, I.C. Medical Inc., which the Appeal Brief identifies as the real party in interest. Appeal Br. 2.

### CLAIMED SUBJECT MATTER

The claims are directed to an argon beam assisted electrosurgery pencil with smoke evacuation. Spec. ¶ 2. Claims 1, 8, and 15 are independent. Claim 1, reproduced below, with emphasis added, is illustrative of the claimed subject matter:

1. A surgical pencil comprising:
  - a handpiece having a conduit contained therein and at least one electrical contact element;
  - a hollow tubular member comprised of a conducting material wherein *said hollow tubular member is concentrically contained within said conduit such that it extends along an entire length of said handpiece* and such that there is a space between an inner circumference of said handpiece and an outer circumference of said hollow tubular member along an entire length of said handpiece, and said at least one electrical contact element is in contact with said hollow tubular member;
  - an electrode connected to said hollow tubular member;
  - means for connecting an energy source to said at least one electrical contact;
  - means for providing a coagulating material supply to said hollow tubular member; and
  - means for supplying a vacuum to said space between said handpiece and said hollow tubular member.

Appeal Br. 14 (Claims App.).

### REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Cosmescu	US 6,458,125 B1	Oct. 1, 2002
“Cosmescu ’125”		
Cosmescu	US 2009/0018539 A1	Jan. 15, 2009
“Cosmescu ’539”		

## REJECTIONS

I. Claims 1, 3–6, 8, 10–13, 15, 16, 18, and 19 are rejected under 35 U.S.C. § 102(a)(1) as anticipated by Cosmescu '125

II. Claims 2, 9, and 17 are rejected under 35 U.S.C. § 103 as unpatentable over Cosmescu '125 and Cosmescu '539.

III. Claims 7, 14, and 20 are rejected under 35 U.S.C. § 103 as unpatentable over Cosmescu '125.

## OPINION

### *Rejection I*

Appellant argues that Cosmescu '125 does not anticipate claim 1 because “conductive hollow tubular member 105 does not extend along the entire length of the handpiece 122.” Appeal Br. 9. Appellant asserts that because Cosmescu '125 refers to element 122 as a “handpiece,” the Examiner cannot define that element “as something that is different than what the patentee defined or disclosed as the same element,” and cannot “arbitrarily broaden the definition” of that element. Appeal Br. 10; *see also* Reply Br. 2–4.

The Examiner replies that the term “handpiece is not recognized by the prior art to have any specific qualities other than it is grasped by a hand.” Ans. 2. The Examiner concludes the proffered definition is “its plain meaning,” and that “the definition has not been ‘arbitrarily broadened’ because (1) the change in definition is not arbitrary, being one of many reasonable definitions of ‘handpiece,’ and (2) the definition has not been broadened, merely changed to another that falls within the general scope of the term.” Ans. 3.

Although we agree with the Examiner that a handpiece is an element that is grasped by a hand, the Examiner does not explain adequately how a user would grasp the pencil apparatus of Cosmescu '125 so that hollow tubular member 105 *extends over the entire portion being grasped*. That is, it appears that the Examiner arbitrarily chooses a portion of the pencil apparatus being grabbed, but does not provide objective evidence or persuasive technical reasoning to support that any particular portion grasped by the hand is a handpiece consistent with how one of ordinary skill in the art would construe the term handpiece. Here, the pencil apparatus 121 of Cosmescu '125 having handpiece 122 and hollow tubular member 105 is depicted in Figure 5 of Cosmescu '125, reproduced below.

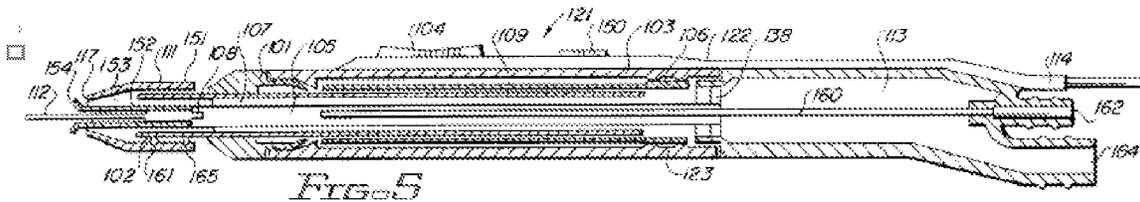


Figure 5 of Cosmescu '125 is a cross-sectional view of an ESU-argon beam coagulator pencil apparatus. Cosmescu '125, col. 5, ll. 45–47.

In describing the pencil apparatus, Cosmescu '125 discloses that the outside of the handpiece has two hand switches 104 and 150 that respectively regulate the supply of RF energy and the flow of argon to the inlet port 162. Cosmescu '125, col. 8, ll. 29–33. Cosmescu '125 does not, however, disclose the specific length of the apparatus. Nonetheless, in order for a user to operate both switches 104 and 150 during a surgical operation, a reasonable interpretation of the placement of the user's hand with respect to

the switches would require the switches to be spaced so that the user could comfortably reach both switches with the user's thumb, and with the user's hand to the right of switch 150, in Figure 5 above. Based on this interpretation and the relative size of an average user's hand, a fair reading of Cosmescu '125 is that the user's hand would grasp the device about where the lead line for element 122 is located.

In view of this, one of ordinary skill the art would understand that Cosmescu '125 fairly discloses that the portion being grasped by the hand includes part of the surgical pencil that includes hatching extending at an angle from the upper-right to lower-left at 103 and part of the surgical pencil that includes hatching extending from the upper-left to lower-right near 113 of Figure 5, which does not include hollow tubular member 105 therein. This is consistent with the disclosure of Cosmescu '125, specifically Figure 5, which depicts element 122 that is labeled "handpiece 122" as that portion of the surgical device without cross-hatching that extends from below reference numeral 105 to reference numeral 114. Thus, although we agree with the Examiner's definition of a handpiece as that portion grasped by a hand, implicit in that definition is the requirement that when the user grasps the apparatus, the user can use the apparatus in its intended manner. Because the Examiner has not adequately established that the user would or could grasp the apparatus in the location suggested by the Examiner and still operate the device as intended, the Examiner has not adequately established that hollow tubular member 105 of Cosmescu '125 extends along an entire length of the handpiece.

Accordingly, we do not sustain the Examiner's rejection of claim 1 and claims 3-6 depending from claim 1 as anticipated by Cosmescu '125.

The Examiner relies on the same findings and reasoning for the rejection of independent claims 8 and 15. *See* Final Act. 2–3. Appellant advances the same arguments for claims 8 and 15. *See* Appeal Br. 9–10. For the same reasons discussed above for claim 1, we also do not sustain the Examiner’s rejection of claims 8 and 15 and of claims 10–13 depending from claim 8 and of claims 16, 18, and 19 depending from claim 15.

*Rejections II and III*

The Examiner does not rely on Cosmescu ’539 and the modification of Cosmescu ’125 in any way that would remedy the deficiency in Rejection (I) discussed above. *See* Final Act. 4–5. Accordingly, we reverse the rejection of claims 2, 9, and 17 as unpatentable over Cosmescu ’125 and Cosmescu ’539, and reverse the rejection of claims 7, 14, and 20 as unpatentable over Cosmescu ’125.

DECISION

I. The Examiner’s decision to reject claims 1, 3–6, 8, 10–13, 15, 16, 18, and 19 as anticipated by Cosmescu ’125 is reversed.

II. The Examiner’s decision to reject claims 2, 9, and 17 as unpatentable over Cosmescu ’125 and Cosmescu ’539 is reversed.

III. The Examiner’s decision to reject claims 7, 14, and 20 as unpatentable over Cosmescu ’125 is reversed.

REVERSED