



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/204,227	03/11/2014	Matthew T. Vanderpool	C0001885.USU2/ LG10126.L33	3177
27581	7590	09/27/2019	EXAMINER	
Medtronic, Inc. (CVG) 8200 Coral Sea Street NE. MS: MVC22 MINNEAPOLIS, MN 55112			OU, JING RUI	
			ART UNIT	PAPER NUMBER
			3771	
			NOTIFICATION DATE	DELIVERY MODE
			09/27/2019	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

rs.patents.five@medtronic.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MATTHEW T. VANDERPOOL, MICHAEL R. KLARDIE, and
KRIS A. PETERSON

Appeal 2019-000380
Application 14/204,227
Technology Center 3700

Before CHARLES N. GREENHUT, JEREMY M. PLENZLER, and
BRANDON J. WARNER, *Administrative Patent Judges*.

PLENZLER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1, 18–21, 23, 25–42, and 44–46.² Final Act. 1.

We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Medtronic, Inc. Appeal Br. 3.

² Claims 2–17, 22, 24, and 43 are cancelled. Final Act. 2.

THE CLAIMED SUBJECT MATTER

Claims 1, 18, 33, and 45 are independent. Claims 19–21, 23, 25–32, 34–42, 44, and 46 depend from claim 18, 33, or 45. Claim 1 is reproduced below.

1. An implantation tool comprising:
 - a one-piece tool body comprising:
 - a channel section having a longitudinally extending recess having a distal opening; and
 - a tunneler fixedly located at a distal end of the channel section and extending from the distal opening of the recess, the tunneler being configured for blunt dissection of subcutaneous tissue; and
 - a plunger fitting within at least a portion of the recess, wherein a distal end of the plunger is configured to push a proximal end of an implant through the recess and out of the distal opening.

REJECTIONS

References	Basis	Claims
N/A	§ 112, ¶ 1	1, 18–21, 23, 25–42, and 44
Bardy ³	§ 102(b)	1, 18–21, 23, 25–27, 33–39, 42, and 44–46
Grayzel ⁴	§ 102(b)	1, 18–22, 25–27, 42, and 45
Bardy and Michelson ⁵	§ 103(a)	28 and 29
Bardy and Anderson ⁶	§ 103(a)	40
Bardy, Anderson, and Matsutani ⁷	§ 103(a)	41

OPINION

Written Description

The Examiner finds that there is insufficient written description support for the “one-piece” feature recited in the claims. Final Act. 2–3. Appellant responds, citing to Figures 5A and 6D, for example, as evidence that Appellant was in possession of the “one-piece” feature at the time the Application was filed. Appeal Br. 32–36. Appellant has the better position.

Figures 5A and 6D are reproduced below.

³ US 2010/0331868 A1, published Dec. 30, 2010.

⁴ US 2008/0154298 A1, published June 26, 2008.

⁵ US 2004/0249388 A1, published Dec. 9, 2004.

⁶ US 2009/0036917 A1, published Feb. 5, 2009.

⁷ US 2007/0179515 A1, published Aug. 2, 2007.

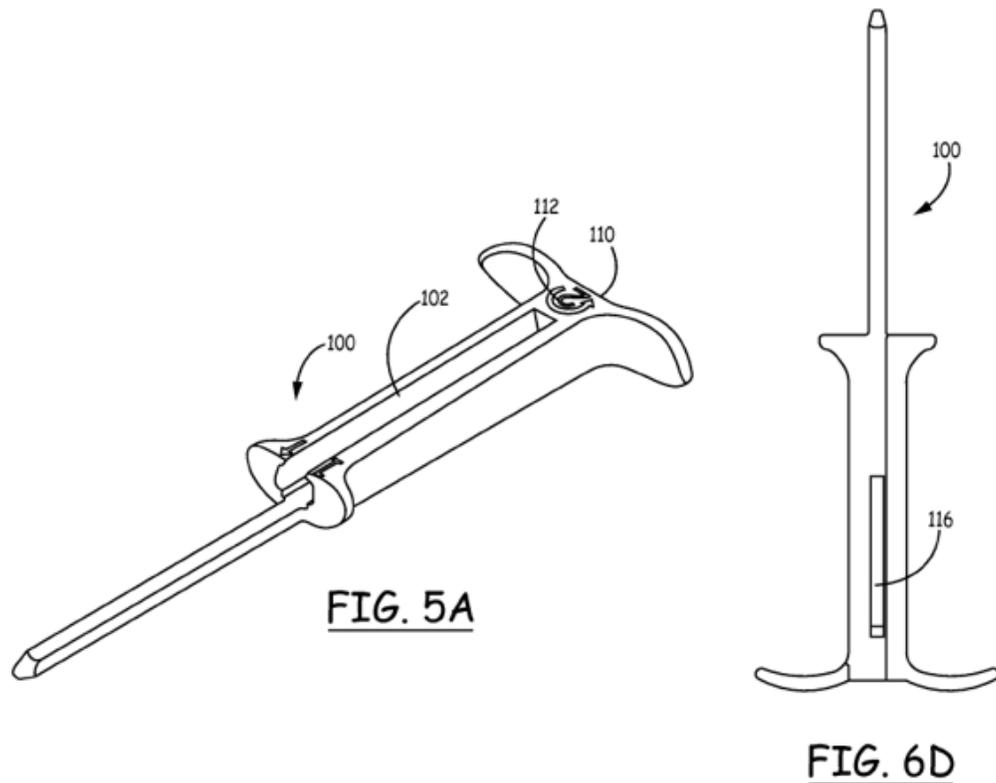


Figure 5A is a “perspective view[] of the tool handle” (Spec. ¶ 16) and Figure 6D is a “bottom . . . view[] . . . of the tool handle” (*id.* ¶ 17). Although the Examiner states that “[t]he drawings alone are not sufficient to support that limitation,” there is no further explanation provided as to why the drawings are insufficient. Final Act. 3; *see also* Ans. 2. Figure 5A, for example, depicts the tunneler as part of the channel section.

Without more detail from the Examiner, we agree with Appellant that there is insufficient basis to sustain the Examiner’s decision to reject the claims for lack of written description support.

Bardy Grounds

Each claim requires a “tunneler being configured for blunt dissection of subcutaneous tissue.” With respect to the rejection of claim 1, the Examiner finds that “Bardy discloses . . . a tunneler (protruded portion

shown in Figures 10B or 10C with 81 or 91) fixedly located at a distal end of the channel section and extending from the distal opening of the recess.”

Final Act. 4. The Examiner finds that “the tunneler is fully capable to be for blunt dissection of subcutaneous tissue.” *Id.* (citing Bardy ¶ 121). With respect to the cited portion of Bardy, the Examiner explains that “paragraph [0121] states that ‘the cutting edge 81 can be shaped into a rounded or curved edge, which can also progressively enlarge an implantation site, but without initial piercing.’” *Id.* The Examiner further explains that “as shown in Figure 10C, the cutting edge 91 is upward curved or angled and the bottom of it appears to be rounded which could be used for blunt dissection of the subcutaneous tissue if needed.” *Id.* The Examiner explains that “although the tunneler or the protruded section shown in Figure 10B has cutting edges, . . . the top and/or the bottom surfaces appear to be flat which can be used for blunt dissection.” *Id.* The Examiner relies on the same finding for the other rejections based on Bardy. *See id.* at 5, 9, 16, 18, 19.

Appellant disputes the Examiner’s determination that Bardy discloses a tunneler *configured for* blunt dissection. *See* Appeal Br. 7–12. Although Appellant disagrees that the claim language “configured to” only requires a tunneler *capable of* blunt dissection (*id.* at 11), Appellant contends that “[c]utting edges 81 and 91 of Bardy are incapable of performing blunt dissection, because they are instead configured for ‘cutting’—the very opposite of blunt dissection” (*id.* at 8). In response to the Examiner’s explanation of Bardy’s paragraph [0121], Appellant contends that “the fact that cutting edge 81 can be shaped into a rounded or curved edge does not preclude cutting edge 81 from being sharp, and the shape of a sharp cutting edge does not negate the fact that a sharp cutting edge is not configured for

blunt dissection” because “[a] cutting edge which is configured to ‘progressively enlarge [an] implantation site’ is still a sharp cutting edge and is not configured for blunt dissection.” *Id.* Appellant contends that, regardless of whether Bardy’s tunneler can have a rounded or curved edge that does not provide initial piercing, it still has a cutting edge and “a cutting edge, as disclosed by Bardy, is simply incapable of blunt dissection.” *Id.* at 10. Appellant has the better position.

Even if we accept the Examiner’s interpretation of the claims (i.e., that “configured for blunt dissection” only requires “capable of blunt dissection”), the findings relied on by the Examiner fail to establish sufficiently that Bardy’s tunneler with “cutting edge 81” or “cutting edge 91” is “configured for blunt dissection.” There is no dispute that “blunt dissection” does not involve cutting. The Examiner provides no persuasive reason for us to believe that a “cutting edge” is capable of blunt dissection without cutting.⁸ The fact that “the cutting edge 81 can be shaped into a rounded or curved edge, which can also progressively enlarge an implantation site, but without initial piercing” (Bardy ¶ 121), does not mean that the *cutting edge* does not *cut* the implantation site. For at least these reasons, the Examiner has failed to establish sufficiently that “cutting edge 81” or “cutting edge 91” in Bardy are “configured for blunt dissection.”⁹

⁸ Because the Examiner has failed to establish even mere capability, we need not reach whether “configured for blunt dissection” requires something more than mere capability, as Appellant contends. Appeal Br. 11.

⁹ The Examiner’s rejection does not rely on or address the additional disclosure in paragraph [0121] of Bardy that “dissecting tools could be used in addition to or in lieu of the progressive cutting edges, such as a flat or shaped dissecting tool.”

Accordingly, we do not sustain the Examiner's decision to reject claims 1, 18–21, 23, 25–29, 33–42, and 44–46 based on Bardy or the combination of Bardy with other references.

Grayzel Ground

Appellant presents arguments with respect to claim 1 (Appeal Br. 18–23), and relies on those arguments for the patentability of claims 18–21, 25–27, 42, and 45 (*id.* at 23–24). Appellant only disputes the Examiner's finding that “a single finger 130 [of Grayzel's tool] anticipat[es] the ‘one-piece tool body’ of independent claim 1” (*id.* at 18–20) and the Examiner's finding that “the singular tapered cylindrical passage 152 of the dissector/retractor tool of Grayzel anticipates the channel section of claim 1” (*id.* at 20–23).

The Examiner finds that arm 110 with finger 130 of Grayzel's dissector tool 100 corresponds to the recited “one-piece tool body” and end 134 of finger 130 corresponds to the recited “tunneler . . . configured for blunt dissection of subcutaneous tissue.” Final Act. 11.

Appellant does not dispute that Grayzel's dissector tool 100 is “configured for blunt dissection,” or that arm 110 (including end 134) is a one-piece tool body.¹⁰ Rather, Appellant contends that Grayzel's dissector tool 100 requires two arms 110, 120 with fingers 130, 132, respectively for blunt dissection. *See* Appeal Br. 20 (“[B]oth finger 130 and finger 132 must be used in order to perform blunt dissection according to the disclosure of Grayzel. Therefore, Grayzel does not disclose or suggest ‘[a]n implantation

¹⁰ The Appeal Brief indicates that “Appellant does not acquiesce” that “a single finger 130 . . . anticipat[es] the ‘one-piece tool body,’” but does not provide any argument on this issue. Appeal Br. 20.

tool comprising: a one-piece tool body comprising: [] a tunneler[], the tunneler being configured for blunt dissection of subcutaneous tissue.”).

Appellant’s contention is not persuasive. Claim 1 includes the transitional phrase “comprising” (i.e., “[a]n implantation tool comprising”). Although the implantation tool of claim 1 requires “a one-piece tool body” and “a plunger,” it is not limited to those elements. As acknowledged by Appellant, Grayzel’s dissection tool 100 is “configured for blunt dissection.” Appeal Br. 20. That tool 100 uses both arms 110, 120 for blunt dissection does not mean that each of those arms is not “configured for blunt dissection.” Because claim 1 does not preclude an additional element (e.g., Grayzel’s arm 120) used in combination with the “one-piece tool body” (Grayzel’s arm 110, which includes end 134), we are not apprised of error in the Examiner’s finding.

The Examiner finds that Grayzel discloses “a channel section having a longitudinally extending recess (152, Fig. 2) having a distal opening (the opening of 152 at the distal end of 152, Fig. 2).” Final Act. 12.

Appellant contends that Grayzel does not disclose “a channel section having a longitudinally extending recess having a distal opening” in a “one-piece tool body” because “the conduits and obturator of Grayzel are placed in the cylindrical passage formed by both fingers of the dissector/retractor tool.” Appeal Br. 21. Appellant contends that “to the extent in which the singular tapered cylindrical passage 152 of the dissector/retractor tool of Grayzel anticipates the channel section of claim 1, which Appellant does not acquiesce, tapered cylindrical passage 152 is not open at its distal end.” *Id.* Appellant further contends that “[i]n order for the dissector/retractor tool to perform its function of pushing the implant through the recess, the conduits

and the obturator must fit in the channel formed by both fingers.” *Id.*
Appellant explains that “the distal end of the tapered cylindrical passage is not open; on the contrary, the distal end of the tapered cylindrical passage does not form any sort of opening.” *Id.* at 22.

Appellant’s contentions are not persuasive. Claim 1 recites that the “one-piece tool body” includes “a channel section having a longitudinally extending recess having a distal opening” and that “a distal end of the plunger is configured to push a proximal end of an implant through the recess and out of the distal opening.” There is no dispute that Grayzel’s passage 152 forms a “recess.” Grayzel’s passage 152 is “a channel section having a longitudinally extending recess,” as recited in claim 1. Appellant’s main dispute appears to be that the end of Grayzel’s passage 152 is not like that shown in Appellant’s Figures. Although repeatedly stating that “tapered cylindrical passage 152 is not open at its distal end,” Appellant fails to identify and particular structure missing from Grayzel’s passage 152 needed to form an “opening” at its “distal end.” Nor does the claim recite any particular structure required. The “distal opening” limitation is met by Grayzel’s passage 152 because the end of that passage is “open” (i.e., unobstructed).

Accordingly, we are not apprised of error in the rejection of claims 1, 18–22, 25–27, 42, and 45 based on Grayzel.

CONCLUSION

In summary:

Claims Rejected	Basis	Affirmed	Reversed
1, 18–21, 23, 25–42, and 44	§ 112, ¶ 1 Written Description		1, 18–21, 23, 25–42, and 44
1, 18–21, 23, 25–27, 33–39, 42, and 44–46	§ 102(b) Bardy		1, 18–21, 23, 25–27, 33–39, 42, and 44–46
1, 18–22, 25–27, 42, and 45	§ 102(b) Grayzel	1, 18–22, 25–27, 42, and 45	
28 and 29	§ 103(a) Bardy and Michelson		28 and 29
40	§ 103(a) Bardy and Anderson		40
41	§ 103(a) Bardy, Anderson, and Matsutani		41
Overall Outcome		1, 18–22, 25–27, 42, and 45	23, 28–41, 44, and 46

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-IN-PART