



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.
15/091,402	04/05/2016	Csaba Truckai	48428-704.301	1059
21971	7590	11/15/2019	EXAMINER	
WILSON, SONSINI, GOODRICH & ROSATI 650 PAGE MILL ROAD PALO ALTO, CA 94304-1050			BEHRINGER, LUTHER G	
			ART UNIT	PAPER NUMBER
			3793	
			NOTIFICATION DATE	DELIVERY MODE
			11/15/2019	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):

patentdocket@wsgr.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CSABA TRUCKAI and BENEDEK ORCZY-TIMKO

Appeal 2019-001767
Application 15/091,402
Technology Center 3700

BEFORE PHILLIP J. KAUFFMAN, JEREMY M. PLENZLER, and
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

PLENZLER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–16, 18–20, and 22–27. Claim 17 has been withdrawn from consideration. Claims 21 and 28–30 are cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as Cirrus Technologies Ltd. Appeal Br. 3.

CLAIMED SUBJECT MATTER

Claim 1 is independent, with claims 2–16, 18–20, and 22–27 depending from claim 1. Claim 1 is reproduced below:

1. An electrosurgical device comprising:
 - an elongate shaft having an axis and a window in a distal portion thereof;
 - a wire-like electrode having an axially aligned centerline and an axially aligned spine radially offset from the centerline; and
 - a motor operatively connected to the centerline of the wire-like electrode to rotationally oscillate the spine of the wire-like electrode in an arc back and forth between opposing sides of the window to abut the opposing sides at the end of each arc to cut tissue received in the window.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Germain	US 2013/0296847 A1	Nov. 7, 2013
Crow	US 5,662,647	Sept. 2, 1997
Robertson	US 2011/0196401 A1	Aug. 11, 2011
Goble	US 2004/0102770 A1	May 27, 2004

REJECTIONS

1. Claims 1–4, 8–15, 18–20, and 22–27 are rejected under 35 U.S.C. § 103 as being unpatentable over Germain and Crow. Final Act. 3.
2. Claims 5–7 are rejected under 35 U.S.C. § 103 as being unpatentable over Germain, Crow, and Robertson. Final Act. 8.
3. Claim 16 is rejected under 35 U.S.C. § 103 as being unpatentable over Germain, Crow, and Goble. Final Act. 9.

OPINION

The Examiner finds that Germain teaches the majority of elements recited in claim 1, “but fails to disclose the wire-like electrode having an axially aligned centerline and an axially aligned spine radially offset from the centerline.” Final Act. 3. The Examiner finds that “Crow teaches the wire-like electrode, 60/62, having an axially aligned centerline, 30, and an axially aligned spine radially offset from the centerline,” and proposes modifying Germain’s teachings accordingly. *Id.* at 4 (emphasis omitted). Although the Examiner finds that Germain teaches the recited motor, generally, the Examiner determines, without further explanation, that

[t]he phrase “to rotationally oscillate the spine of the wire-like electrode in an arc back and forth between opposing sides of the window to abut the opposing sides at the end of each arc to cut tissue received in the window” is considered a statement of intended use and fails to impart further structural elements to the claim.

Id. The Examiner finds that “[t]he device of Germain in view of Crow is considered capable of performing as claimed.” *Id.*

Appellant contends that “the language imparts clear structure, e.g. as illustrated in Figs 12A and 12B” (i.e., it defines the configuration of the motor, albeit in functional terms). Appeal Br. 9. Appellant further contends Germain does not disclose an electrode that oscillates within a window and which abuts the opposing sides of the window at each end of the oscillary arc to cut tissue. *Id.* at 8. Appellant’s argument is persuasive.

The claim requires a device that causes the electrode to “abut the opposing sides [of the window] at the end of each arc.” The dispositive issue before us is whether the electrode in Germain abuts the opposing sides of its window. The dispute focuses on the meaning of the term “abut.”

The Examiner cites a dictionary definition of the verb “abut,” which defines “abut” as “to be adjacent to; border on; end at.” Ans. 3 (citing Dictionary.com). According to the Examiner, Germain’s tissue-cutting device satisfies the quoted limitation when “abut” is defined in this manner. *Id.*

In response, Appellant cites an alternative definition of the verb “abut,” namely, “to cause to touch or lean for support.” Reply Br. 2 (citing <https://www.merriam-webster.com/dictionary/abut>). Unlike the definition proposed by the Examiner, the definition proposed by Appellant is consistent with Appellant’s Specification. *See* Spec. ¶ 55, Fig. 12A. Based on the record before us, we determine that the broadest reasonable interpretation of the phrase “to abut the opposing sides at the end of each arc,” as used in claim 1, requires that the wire-like electrode touches or leans on the opposing sides at the end of each arc of rotation.

The Examiner makes no finding that Germain’s device abuts its window, as required under the correct interpretation of that term. Rather, the Examiner’s rejection requires that “abut” merely requires “adjacent.” *See* Ans. 2 (“As the term ‘abutting’ is a broad term, encompassing being adjacent, the rotation of the electrode 725 of Germain is considered to ‘abut’ the window.”).

The Examiner’s reliance on Crow in the rejection of claim 1 does not remedy the deficiency in the teachings of Germain noted above. Therefore, we do not sustain the rejection of claims 1–4, 8–15, 18–20, and 22–27 under 35 U.S.C. § 103 as being unpatentable over Germain and Crow.

Robertson and Goble, as applied to claims 5–7 and 16, respectively, also fail to remedy the deficiency in the teachings of Germain. Therefore, we do not sustain the rejection of claims 5–7 under 35 U.S.C. § 103 as

Appeal 2019-001767

Application 15/091,402

unpatentable over Germain, Crow, and Robertson; or the rejection of claim 16 under 35 U.S.C. § 103 as unpatentable over Germain, Crow, and Goble.

CONCLUSION

The Examiner's rejections are reversed.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1-4, 8-15, 18-20, 22-27	103	Germain, Crow		1-4, 8-15, 18-20, 22-27
5-7	103	Germain, Crow, Robertson		5-7
16	103	Germain, Crow, Goble		16
Overall Outcome				1-16, 18-20, 22-27

REVERSED