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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JONATHAN W. SAPIENZA, PAUL D. RICHARD,  
RAMIRO CABRERA, and STEPHEN R. PAUL

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Appeal 2019-003867  
Application 14/829,771  
Technology Center 3700

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Before EDWARD A. BROWN, BENJAMIN D. M. WOOD, and  
MICHAEL J. FITZPATRICK, *Administrative Patent Judges*.

WOOD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner's decision to reject claims 1 and 3–13, 15, and 17. *See* Final Act. 1. Claims 2, 14, 16, and 18–20 are canceled. Appeal Br. 16–20 (Claims App.). We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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<sup>1</sup> “Appellant” refers to the applicant as defined by 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Covidien LP. Appeal Br. 1.

### CLAIMED SUBJECT MATTER

The claims are directed to a cleaning apparatus for surgical instruments. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. An apparatus for cleaning a surgical instrument, comprising:
  - an elongate member having a first end and a second end, the second end being configured for disposal within a cavity of the surgical instrument, the elongate member defining: a longitudinal channel;
  - and a plurality of apertures extending transversely through the elongate member and communicating with the longitudinal channel, the plurality of apertures being configured to direct fluid toward the first end of the elongate member;
  - wherein the first end of the elongate member is configured to be coupled to a source of fluid, wherein the longitudinal channel is configured to allow passage of fluid to the plurality of apertures.

### REFERENCES

Name	Reference	Date
Milliman	US 7,364,060 B2	Apr. 29, 2008
Savage	US 7,686,800 B2	Mar. 30, 2010
Miller	US 2008/0221580 A1	Sep. 11, 2008
Simmoteit	DE 102010008745 A1	Aug. 25, 2011

### REJECTIONS

Claims Rejected	35 U.S.C. §	Reference(s)/Basis
1, 3-7	103	Simmoteit and Savage
1, 3-7	103	Simmoteit, Savage, and Milliman
8	103	Simmoteit, Savage, Milliman, and Miller
9, 15, 17	103	Simmoteit, Milliman, and Miller

Claims Rejected	35 U.S.C. §	Reference(s)/Basis
10–13	103	Simmoteit, Milliman, Miller, and Savage

## OPINION

*A. Claims 1 and 3–7—Rejected as Unpatentable over Simmoteit and Savage, or Alternatively, as Unpatentable over Simmoteit, Savage, and Milliman*

For independent claim 1, the Examiner finds that Simmoteit teaches the apparatus substantially as claimed, including the claimed elongate member having a longitudinal channel with a plurality of apertures extending transversely through the elongate member and communicating with the channel, except that Simmoteit does not disclose that “the plurality of apertures are configured to direct fluid toward the first end of the elongate member.” Final Act. 2–3 (citing Simmoteit, Fig. 1a). The Examiner further finds that Savage teaches that it was known to provide an elongate member of an analogous apparatus with a plurality of apertures extending transversely through the elongate member such that the apertures are configured to direct fluid to the first end of the elongate member. *Id.* at 3 (citing Savage, 7:22–37, Figs. 1–3). The Examiner determines that it would have been obvious to one of ordinary skill in the art to angle Simmoteit’s apertures and properly space them along Simmoteit’s elongate member, as taught by Savage, “because doing so would substantially reduce or all-together prevent a recoil, whipping motion or excessive movement of the second end (right end of 2 in Figure 1a of Simmoteit) of the elongate member during cleaning of the surgical instrument.” *Id.* at 3–4.

Among other arguments, Appellant challenges the Examiner’s reason to combine Simmoteit and Savage. According to Appellant, “recoil,

whipping motion or excessive movement of the second end . . . of the elongate member during cleaning’ is not a problem sought to be addressed by the present application or Simmoteit, nor is it a problem known to present itself during cleaning of surgical instruments.” Appeal Br. 9.

The Examiner responds that “the fluid flow out of apertures 24 and opening 23 of Simmoteit have a tendency to cause apparatus 10 to move,” and thus modifying Simmoteit’s device as proposed “will provide the benefit of substantially reducing or all-together preventing a recoil, whipping motion or excessive movement of the second end (right end of 2 in Figures 1a of Simmoteit) of the elongate member 2 during cleaning of the surgical instrument.” Ans. 4–5.

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). We agree with Appellant that the Examiner has failed to articulate reasoning with a rational underpinning sufficient to support the conclusion of obviousness. The Examiner has not provided any evidence or persuasive argument that recoil, whipping motion, or excessive movement was a known problem with medical-instrument cleaning devices. Nor did the Examiner explain why one of ordinary skill in the art would have considered the problem addressed by Savage—the management of fluid forces resulting from using small diameter catheters to inject high volumes of fluid associated with ventricular angiography (Savage, 3:3–9)—relevant to Simmoteit’s medical-instrument cleaning device. The premise on which the Examiner’s reason to combine is

based, that fluid flow out of apertures 24 and opening 23 of Simmoteit “have a tendency to cause apparatus 10 to move,” is not supported by evidence, and, in any event, the Examiner has not established that one of ordinary skill in the art would have appreciated that the proposed modification would have had any effect on that movement in Simmoteit’s device. Because we are not persuaded that one of ordinary skill in the art would have had a reason to combine Simmoteit and Savage in the proposed manner, we decline to sustain the Examiner’s rejection of claim 1, and its dependent claims 3–7, as unpatentable over Simmoteit and Savage.

The Examiner alternatively relies on Milliman to teach a surgical instrument to the extent that “it can be argued that the instrument (12) of Simmoteit is not a surgical instrument.” Final Act. 4 (citing Milliman, Figs. 1, 6, 34–38; Simmoteit, Fig. 1a). Milliman is not relied on to cure the deficiency noted above with respect to the combination of Simmoteit and Savage. Accordingly we also do not sustain the Examiner’s rejection of claims 1 and 3–7 as unpatentable over Simmoteit, Savage, and Milliman.

*B. Claim 8—Rejected as Unpatentable over  
Simmoteit, Savage, Milliman, and Miller*

Claim 8 indirectly depends from claim 1. Appeal Br. 17 (claims app.). The Examiner relies on the combination of Simmoteit and Savage to teach claim 1’s limitations. Final Act. 5. Because we are not persuaded that one of ordinary skill in the art would have combined Simmoteit and Savage as the Examiner contends, we likewise are not persuaded that claim 8 is unpatentable over Simmoteit, Savage, Milliman, and Miller.

*C. Claims 9, 15, and 17—Rejected as Unpatentable  
over Simmoteit, Milliman, and Miller*

Independent claim 9 differs from independent claim 1 primarily in that it requires the cleaning device to be configured such that the distal end of the elongate member is oriented away from, rather than disposed within, the longitudinal cavity of the surgical instrument, so that the elongate member can protect a trocar mounted to the distal end of the surgical instrument. *See* Appeal Br. 16–18. The Examiner finds that one of ordinary skill in the art would have substituted Simmoteit’s instrument 12 for Milliman’s instrument “to achieve the predictable result of cleaning [Milliman’s] surgical instrument using the apparatus (10) of Simmoteit.” Final Act. 8 (citing Milliman, Figs. 6, 34–38; Simmoteit ¶¶ 1, 7, 18, 35, Fig. 1a). The Examiner acknowledges, however, that the combination of Simmoteit and Milliman does not teach, *inter alia*,

[T]he cap has a mating part configured to be coupled to the distal end of the surgical instrument such that upon coupling the mating part to the distal end of the surgical instrument, the second end of the elongate member is disposed distally of the distal end of the surgical instrument and encloses a trocar extending distally from the distal end of the surgical instrument.

*Id.* The Examiner therefore relies on Miller to teach the above limitation.

According to the Examiner:

Miller teaches an analogous apparatus . . . comprising: an elongate member (210) having a first end (left end of 210 in Figure 4A) and a second end (right end of 210 in Figure 4A), and a cap (200 in Figure 4A) supported on the first end . . . configured to be coupled to a distal end (right end of 180 in Figure 4A) of a surgical instrument (180 in Figure 4A) such that upon coupling the mating part (208) to the distal end (right end of 180 in Figure 4A) of the surgical instrument (180), the

second end (right end of 210 in Figure 4A) of the elongate member (210) is disposed distally of the distal end (right end of 180 in Figure 4A) of the surgical instrument (180) and encloses a trocar (220) extending distally from the distal end (right end of 180 in Figure 4A) of the surgical instrument (180).

*Id.* at 9 (citing Miller ¶ 69, Fig. 4A). The Examiner determines that it would have been obvious to one of ordinary skill in the art to configure Simmoteit's cleaning instrument so that it can be coupled to the distal end of Milliman's surgical instrument such that the second end of the elongate member is disposed distally of the distal end of the surgical instrument to enclose Milliman's trocar to "protect[] the trocar extending from the surgical instrument." *Id.* at 9–10.

Appellant responds that "one of ordinary skill in the art would have no reason to combine Miller with Simmoteit and Milliman in the manner suggested" by the Examiner. Appeal Br. 13. According to Appellant,

there is no teaching, motivation, or suggestion in Miller or Simmoteit to make the rinsing device 10 of Simmoteit reversible so that it is both "configured for disposal within the longitudinal cavity of the surgical instrument" and "configured to be coupled to the distal end of the surgical instrument" as recited in claim 9.

The Examiner responds that the motivation to combine the teachings of Simmoteit, Milliman, and Miller as proposed "is derived from the general knowledge of one of ordinary skill in the art." Ans. 7.

We do not sustain this rejection. We agree with Appellant that the Examiner's stated reason for combining the teachings of Simmoteit, Milliman, and Miller is not supported by a rational underpinning. Although the Examiner reasonably determined that one of ordinary skill in the art would have used Simmoteit's cleaning apparatus to clean Milliman's



surgical instrument, Miller would not have motivated one of ordinary skill in the art to dispose Simmoteit's device on Milliman's instrument in a way that renders it unable to do so.

To use Simmoteit's device to clean Milliman's surgical instrument, as the Examiner proposes, the asserted second end of the device's elongate member is disposed within the surgical instrument's longitudinal cavity. Simmoteit ¶ 35, Fig. 1a. Claim 9, however, requires the cleaning device to be mounted on the surgical instrument such that the second end of the elongate member is disposed distally of the distal end of the surgical instrument, i.e., the elongate member is facing away from, rather than inserted into, the instrument's longitudinal cavity, rendering Simmoteit's device unable to fulfill its cleaning function (but instead fulfilling a different function: protecting a trocar). While the structure in Miller that the Examiner contends corresponds to the claimed elongate member is arguably oriented as the claim requires—i.e., hub 200 and outer penetrator 210 are disposed over inner penetrator 220 (Miller, Fig. 4A)—that structure is an intraosseous needle set designed to penetrate bone marrow; there is no teaching in Miller that outer penetrator 210 is designed to protect inner penetrator 220. In short, the only teaching to use a cleaning device as a device to protect a trocar is found in the Specification, not the prior art. *See Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317, 1320 (Fed. Cir. 2004) (holding that using an inventor's disclosure to defeat the patentability of the inventor's claims is “the essence of hindsight”) (internal quotation marks and citations omitted).

Because we are not persuaded that one of ordinary skill in the art would have combined Simmoteit, Milliman, and Miller to achieve all of the

limitations of claim 9, we do not sustain the Examiner's rejection of claim 9, and its dependent claims 15 and 17, as unpatentable over Simmoteit, Milliman, and Miller.

*D. Claims 10–13—Rejected as Unpatentable  
over Simmoteit, Milliman, Miller, and Savage*

Claims 10–13 ultimately depend from claim 9. Appeal Br. 18–19 (Claims App.). The Examiner relies on the combination of Simmoteit, Milliman, and Miller to teach the limitations of claim 9. Final Act. 11. Because we are not persuaded that one of ordinary skill in the art would have combined Simmoteit, Milliman, and Miller in the manner that the Examiner proposes, we likewise are not persuaded that claims 10–13 are unpatentable over Simmoteit, Milliman, Miller, and Savage.

CONCLUSION

The Examiner's rejections are reversed.

DECISION SUMMARY

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 3-7	103	Simmoteit, Savage		1, 3-7
1, 3-7	103	Simmoteit, Savage, Milliman		1, 3-7
8	103	Simmoteit, Savage, Milliman, Miller		8
9, 15, 17	103	Simmoteit, Milliman, Miller		9, 15, 17
10-13	103	Simmoteit, Milliman, Miller, Savage		10-13
<b>Overall Outcome</b>				1, 3-13, 15, 17

REVERSED