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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEPHEN T. EPSTEIN and JOHN J. SINISI

Appeal 2019-004621
Application 15/230,231
Technology Center 3700

Before MICHAEL C. ASTORINO, PHILIP J. HOFFMANN, and
BRUCE T. WIEDER, *Administrative Patent Judges*.

HOFFMANN, *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 1–17. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

According to Appellant, “the . . . invention relates to defibrillation paddles that are used during minimally invasive procedures wherein the

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 the inventors, Stephen J. Epstein and John J. Sinisi. Appeal Br. 2.

defibrillation paddle is brought into direct contact with the tissue of the heart.” Spec. 1, ll. 7–11. Claims 1 and 9 are the independent claims on appeal. Below, we reproduce claim 1 as illustrative of the appealed claims:

1. A defibrillator assembly, comprising:

a control unit having a first terminal wire and a second terminal wire, wherein said control unit creates an electrical bias between said first terminal wire and said second terminal wire;

a conductive pad that is electrically interconnected with said control unit by said first terminal wire;

a paddle having a dielectric handle, a paddle head, and an elongated shaft, wherein said paddle head has a conductive surface thereon;

wherein said elongated shaft joins said handle to said paddle head, said elongated shaft having a conductive core protected by external insulation, wherein said conductive core is connected to said second terminal wire within said handle; and

a pivot connection that joins said elongated shaft to said paddle head and enables said paddle head to move through a range of different orientations with respect to said elongated shaft, wherein said pivot connection creates an electrical interconnection between said conductive core of said elongated shaft and said conductive surface of said paddle head.

REJECTIONS AND PRIOR ART

The Examiner rejects the claims as follows:

- I. Claims 1, 4, 8–10, 13, and 17 under 35 U.S.C. § 102(a)(1) as anticipated by Epstein et al. (US 8,452,393 B1, iss. May 28, 2013) (“Epstein”);
- II. Claims 2, 3, 11, and 12 under 35 U.S.C. § 103 as unpatentable over Epstein and Jones (US 2,985,172, iss. May 23, 1961); and

- III. Claims 5–7 and 14–16 under 35 U.S.C. § 103 as unpatentable over Epstein and Roy et al. (US 6,156,060, iss. Dec. 5, 2000) (“Roy”).

ANALYSIS

Rejection I—Anticipation rejection of independent claims 1 and 9, and dependent claims 4, 8, 10, 13, and 17

As set forth above, independent claim 1 recites, in relevant part, “a pivot connection that joins said elongated shaft to said paddle head . . . , wherein said pivot connection creates an electrical interconnection between said conductive core of said elongated shaft and said conductive surface of said paddle head.” Appeal Br., Claims App. (emphases added). Appellant and the Examiner disagree as to whether in Epstein spring 40 (the claimed “pivot”) creates an electrical interconnection between flexible neck 24’s terminal wire 48 (the claimed elongated shaft’s “conductive core”) and paddle head 26’s conductive contact surface 22 (the claimed paddle head’s “conductive surface”). *See, e.g.*, Answer 5–7; Appeal Br. 7–9. Based on our review of the record, we do not sustain the Examiner’s anticipation rejection of claim 1. Specifically, the Examiner does not support adequately that Epstein’s spring 40 *creates* an electrical connection.

First, we note that a relevant dictionary definition of “create” is “to bring into existence.” From <https://www.merriam-webster.com/dictionary/create>, last accessed Jan. 22, 2020. This definition is consistent with Appellant’s Specification and drawings, which do not describe or show that an electrical connection exists between the elongated shaft’s conductive core and the paddle head’s conductive surface in the absence of the pivot. *See generally* Spec.

With respect to Epstein, Epstein refers to “terminal wire 48” only one time (Epstein col. 3, ll. 49–52), and does not illustrate terminal wire 48 in any figure (*see generally id.*). Epstein’s single sentence describing terminal wire 48 states: “The terminal wire 48 that provides electricity to the conductive contact surface 22 extends through the handle 28 and through the center of the spring 40 in the flexible neck 24.” *Id.* at col. 3, ll. 49–52 (bold omitted). There is nothing in this portion of Epstein describing that spring 40 *creates* (i.e., brings into existence) an electrical connection—rather, the electrical connection is provided by (unshown) terminal wire 48’s presumed connection to paddle head 26’s conductive contact surface 22, when terminal wire 48 passes through spring 40’s center. *See id.* Figs. 2, 3. Consequently, it appears that the electrical connection between terminal wire 48 and paddle head 26 would exist even if Epstein’s device omits spring 40.

Based on the foregoing, we do not sustain the Examiner’s anticipation rejection of claim 1. Further, we do not sustain the anticipation rejection of independent claim 9, which includes a similar recitation as that discussed above. Still further, we do not sustain the Examiner’s anticipation rejection of claims 4, 8, 10, 13, and 17 that depend from the independent claims.

Rejections II and III—Obviousness rejections of dependent claims 2, 3, 5–7, 11, 12, and 14–16

The Examiner does not rely on either Jones or Roy to disclose anything that would remedy the above-discussed deficiency in the anticipation rejection of independent claims 1 and 9. Thus, we do not sustain the Examiner’s obviousness rejections of claims 2, 3, 5–7, 11, 12, and 14–16 that depend from claims 1 and 9.

CONCLUSION

We REVERSE the Examiner's anticipation and obviousness rejections of claims 1–17.

In summary:

Claims Rejected	35 U.S.C. §	Basis/Reference(s)	Affirmed	Reversed
1, 4, 8–10, 13, 17	102(a)(1)	Epstein		1, 4, 8–10, 13, 17
2, 3, 11, 12	103	Epstein, Jones		2, 3, 11, 12
5–7, 14–16	103	Epstein, Roy		5–7, 14–16
Overall Outcome:				1–17

REVERSED