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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------|------------------|
| 15/232,074 | 08/09/2016 | ANTHONY B. ROSS | 356023.USU1 (203-10652) | 6333 |
| 90039 | 7590 | 09/28/2020 | EXAMINER | |
| Covidien LP Attn: IP Legal 5920 Longbow Drive Mail Stop A36 Boulder, CO 80301-3299 | | | CLARK, RYAN T | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3794 | |
| | | | NOTIFICATION DATE | DELIVERY MODE |
| | | | 09/28/2020 | ELECTRONIC |

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANTHONY B. ROSS, WILLIAM H. NAU JR.,
ARLEN K. WARD, DUANE E. KERR,
WILLIAM ROSS WHITNEY, and CASSANDRA LATIMER

Appeal 2020-001290
Application 15/232,074
Technology Center 3700

Before PHILLIP J. KAUFFMAN, ANNETTE R. REIMERS, and
TARA L. HUTCHINGS, *Administrative Patent Judges*.

KAUFFMAN, *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, 2, 4–8, 10, 12–14, and 19–22.² Final Act. 3–7. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

The claims are directed to an electrosurgical instrument including a cooling assembly associated with jaw members of the instrument. Spec. ¶ 2. Claims 1 and 8 are independent. Claim 1 is reproduced below.

1. A cooling assembly for use with an electrosurgical instrument, the cooling assembly comprising:
 - a body, at least a portion of an inner perimeter of the body configured for selective engagement with a jaw member of the electrosurgical instrument; and
 - a cavity defined within the body and entirely bounded by the body, the cavity configured to contain a fluid therein capable of providing at least one of cooling or thermal insulation to areas laterally adjacent the jaw member.

REJECTIONS³

I. Claims 1, 2, 4, 6–8, 10, 12–14, 19, and 22 are rejected under 35 U.S.C. § 102(a)(1) as anticipated by Chowaniec.⁴ Final Act. 3–4.

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 Covidien LP, the ultimate parent of which is Medtronic, plc. Appeal Br. 1.

² The claims currently at issue in this appeal may be found at pages 2–4 of an Amendment dated October 7, 2019. In particular, the Amendment dated October 7, 2019, cancelled claims 3 and 11, which appear in the Claims Appendix of the Appeal Brief.

³ In the Final Office Action, the Examiner rejected claim 13 under 35 U.S.C. § 112(b) as indefinite. Final Act. 2–3. The Examiner withdrew this rejection in an Advisory Action mailed May 8, 2019.

⁴ Chowaniec (US 2014/0166720 A1, published June 19, 2014).

II. Claims 1 and 8 are rejected under 35 U.S.C. § 103 as unpatentable over Chapman⁵ and Chowaniec. Final Act. 4–6.

III. Claim 5 is rejected under 35 U.S.C. § 103 as unpatentable over Chowaniec and Pappone.⁶ Final Act. 6.

III. Claims 20 and 21 are rejected under 35 U.S.C. § 103 as unpatentable over Chowaniec. Final Act. 6–7.

ANALYSIS

Each of the rejections relies on Chowaniec for disclosing a cavity as claimed, and Appellant’s sole argument is that Chowaniec does not disclose a cavity as claimed.⁷ *See* Appeal Br. 6–7; Reply Br. 2–3. Consequently, this appeal turn on that issue.

The “cavity” of independent claim 1: contains fluid, is defined within the body of the instrument, and is “entirely bounded” by that body.⁸

Appellant contends that Chowaniec’s cavity is not “entirely bounded” as claimed because the cavity necessarily includes an opening that is a passage for fluid so that it is inflatable. Appeal Br. 6–7; Reply Br. 2–3; *see also* Final Act 3–4 (finding that Chowaniec’s inflatable bladder 516 corresponds to a cavity as claimed). Appellant’s argument is premised on

⁵ Chapman (US 7,147,638 B2, issued Dec. 12, 2006).

⁶ Pappone (US 2007/0038056 A1, published Feb. 15, 2007).

⁷ With regard to the obviousness rejections, Appellant contends the additional reference(s) does not cure the deficiency of Chowaniec. *See* Appeal Br. 7–8.

⁸ Independent claim 1 is representative for purposes of this rejection. 37 C.F.R. § 41.37(c)(1)(iv) (2018). Although Appellant mentions both independent claim 1 and independent claim 8, Appellant draws no distinction between the scope of these claims. Appeal Br. 6–7.

the claim interpretation that “entirely bounded” as claimed precludes an opening that is a passage for fluid. In support of that interpretation, Appellant points out that Figure 7 of the Specification depicts a U-shaped cavity having no openings. Appeal Br. 5. For the reasons that follow, we disagree with Appellant’s claim construction.

Claim 1 does not explicitly state that the claimed cavity has no openings. The Specification, outside of the claims, does not use the term “entirely bounded.”

Claim 3 depends from independent claim 1 and adds the limitation that the fluid is actively cooled.⁹ This suggests that independent claim 1 is broad enough to encompass the instrument being actively cooled. *See Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 910 (Fed. Cir. 2004) (“[W]here the limitation that is sought to be ‘read into’ an independent claim already appears in a dependent claim, the doctrine of claim differentiation is at its strongest.”); *see also* Ans. 4–5 (addressing claim 3).

The Examiner finds, and Appellant does not dispute, that active cooling involves applying energy to a system so that the device is cooled and may be accomplished, for example, by the device having an opening to permit fluid to be pumped into the cavity. *See* Advisory Action, mailed Nov. 20, 2019; Appeal Br. 5 (acknowledging that claim 1 is depicted in Figures 7 and 8); Ans. 4 (pointing out Appellant’s acknowledgment); Ans. 5 (citing Spec. ¶¶ 31, 45, 47). Indeed, the cited paragraphs of the

⁹ Although Appellant has cancelled dependent claim 3, Appellant concedes that the cancellation of claim 3 “does not affect the scope of any other pending claim in the appeal proceeding.” Amendment dated Oct. 7, 2019, at 5.

Specification describe that the cooling assembly may include a port into the cavity to enable entry of fluid. *See also* Spec. ¶ 32 (discussing the use of a fluid conduit to deploy the cooling assembly and to supply a cooling fluid); *id.* ¶ 35 (explaining that the reservoirs or cavities of the cooling assembly are in fluid communication with the fluid conduit to facilitate deployment). In sum, active cooling, such as recited in claim 3, can involve a port into the cavity to permit fluid flow. Because claim 1 is sufficiently broad to encompass active cooling assemblies, it encompasses cooling assemblies having bodies with openings communicating with cavities defined within the bodies. In light of this, we determine that a cavity, as called for in independent claim 1, does not preclude an opening to permit filling and draining of that cavity.

For these reasons, Appellant's argument that Chowaniec does not disclose a cavity as claimed is not commensurate in scope with independent claim 1. Given this is Appellant's only argument, Appellant has not demonstrated how the rejection of claim 1 is in error. That determination is dispositive of each of the rejections.

CONCLUSION

In summary:

| Claims Rejected | 35 U.S.C. § | Reference(s)/Basis | Affirmed | Reversed |
|---------------------------------|--------------------|---------------------------|---------------------------------|-----------------|
| 1, 2, 4, 6–8, 10, 12–14, 19, 22 | 102(a)(1) | Chowaniec | 1, 2, 4, 6–8, 10, 12–14, 19, 22 | |
| 1, 8 | 103 | Chapman, Chowaniec | 1, 8 | |
| 5 | 103 | Chowaniec, Pappone | 5 | |
| 20, 21 | 103 | Chowaniec | 20, 21 | |
| Overall Outcome | | | 1, 2, 4–8, 10, 12–14, 19–22 | |

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED