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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAIMEEN KAPADIA

Appeal 2020-001755
Application 15/102,178
Technology Center 3700

Before MICHAEL C. ASTORINO, CYNTHIA L. MURPHY, and
KENNETH G. SCHOPFER, *Administrative Patent Judges*.

ASTORINO, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), the Appellant¹ appeals from the Examiner's decision to reject claims 1–16. 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. The Appellant states that “[t]he real party in interest is the assignee of this patent application, Covidien LP” and “[t]he ultimate parent of Covidien LP is Medtronic, plc.” Appeal Br. 2.

STATEMENT OF THE CASE

Claimed Subject Matter

The Appellant’s invention “relates to a single surgical device having jaw members that both clamp and cut tissue depending on the direction in which the jaw members are moved.” Spec. ¶ 7; *see id.* ¶ 2. Claims 1 and 13 are the independent claims on appeal. Appeal Br., Claims Appendix.

Claim 1, reproduced below, is illustrative of the claimed subject matter.

1. A surgical device, comprising:
 - a body portion defining a longitudinal axis; and
 - an end effector disposed adjacent a distal end of the body portion, the end effector including a first jaw member and a second jaw member, wherein at least one jaw member is pivotable with respect to the other jaw member between open and approximated positions along a first plane, wherein each jaw member is independently movable with respect to the other jaw member between a first position where the jaw members are aligned with the longitudinal axis and a second position where at least one jaw member is disposed at an angle with respect to the longitudinal axis and with respect to the first plane, and wherein the at least one jaw member is movable along a second plane through an angle greater than 90 degrees relative to the longitudinal axis and the other jaw member, the second plane transverse to the first plane.

Id.

References

The prior art relied upon by the Examiner is:

Name	Reference	Date
Moreyra	US 6,969,385 B2	Nov. 29, 2005
Frecker et al. (“Frecker”)	US 2007/0179525 A1	Aug. 2, 2007
Surti	US 2010/0168787 A1	July 1, 2010

Rejections

Claims 1–7 are rejected under 35 U.S.C. § 103 as unpatentable over Frecker in view of Surti.

Claims 8–16 are rejected under 35 U.S.C. § 103 as unpatentable over Frecker in view of Surti, as applied to claim 1, and further in view of Moreyra.

ANALYSIS

Independent claim 1 requires a surgical device including an end effector having first and second jaw members, where at least one jaw member is pivotable with respect to the other jaw member along first and second planes. *See* Appeal Br., Claims App. Claim 1 recites, “wherein the at least one jaw member is movable along a second plane through an angle greater than 90 degrees relative to the longitudinal axis and the other jaw member.” *Id.* Independent claim 13 includes a similar recitation. *Id.*

The Examiner relies on Frecker to disclose substantially all of the claimed subject matter of claim 1. Final Act. 2–3 (citing Frecker ¶ 186, Figs. 17a–c). The Examiner finds Frecker fails to teach “that each jaw member is movable through an angle greater than 90 degrees as claimed.” *Id.* at 3. To remedy this deficiency, the Examiner turns to Surti’s teaching. *Id.* The Examiner finds that “Surti teach[es] that it is desirable for surgical forceps to have each jaw member movable along a plane through an angle greater than 90 degrees relative to the longitudinal axis of the forceps and each[]other in order to better grasp larger amounts of tissue.” *Id.* (citing Surti ¶ 28). The Examiner concludes:

It would have been obvious to one of ordinary skill in the art[,] . . . in view of Surti, to have constructed the jaw members

of Frecker . . . to move along the second plane through an angle greater than 90 degrees relative to each[]other and the longitudinal axis in order to better grasp larger amounts of tissue.

Id.

The Appellant points out the Frecker’s multi-functional end effector, “which is actuatable through various slots, pins, and cables to achieve pivoting and various articulations, operates completely different from a device such as the device of Surti, which merely clamps by an axial driven gear mechanism.” Appeal Br. 7–8. The Appellant argues that the Examiner’s rejection is conclusory and lacks rational underpinning because “the Examiner has not provided any evidence or explanation of how such uses or mechanisms could be modified to provide an angle greater than 90 degrees.” Reply Br. 3; *see* Appeal Br. 4. The Appellant’s argument is persuasive.

The Appellant identifies that the structures that actuate Frecker’s multi-functional end effector and Surti’s pivot jaws are different types of actuators. And, the Appellant submits that the Examiner fails to adequately explain how the structures of Frecker’s actuators, i.e., slots, pins, cables, etc., would have been able to be modified by the teachings of Surti’s actuator, i.e., axial driven gear mechanism, such that the modified structure(s) would have been able to move at least one jaw member of Frecker through an angle greater than 90 degrees. To this, the Examiner responds “[i]t is asserted that the jaws of Frecker . . . *could be modified to open at least as wide as 90 degrees relative to the longitudinal axis*” and “[i]t is further noted that Frecker . . . envision[s] a wide variety of uses for their invention . . . and a number of dissimilar mechanisms for

opening/closing the jaws.” Ans. 4 (emphasis added) (citing Frecker ¶¶ 227–228, 232); *see id.* at 3. The foregoing response suggests that the Examiner relies too broadly on the teachings of the references and fails to explain, on the record and with adequate technical details, how Surti’s teachings would have been applied to the structures of Frecker’s actuator mechanisms to result in the disputed limitation of claim 1.

Thus, we do not sustain the Examiner’s rejection of independent claim 1 and dependent claims 2–7. Additionally, we note that the Examiner fails to rely on Moreyra in any manner that would remedy the deficiency in the Examiner’s rejection as discussed above. Thus, we do not sustain the Examiner’s rejection of claims 8–12, which depend from claim 1, or independent claim 13 and claims 14–16, which depend from claim 13.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	References/Basis	Affirmed	Reversed
1–7	103	Frecker, Surti		1–7
8–16	103	Frecker, Surti, Moreyra		8–16
Overall Outcome				1–16

REVERSED