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3576 Unocal Place
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EXAMINER

BACHMAN, LINDSEY MICHELE

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SCOTT E. JAHNS, JAMES R. KEOGH, PAUL A. PIGNATO,
CHRISTOPHER P. OLIG, KAREN P. MONTPETIT,
CYNTHIA T. CLAGUE, RAYMOND W. USHER,
PHILIP J. HAARSTAD, and GARY W. GUENST

Appeal 2014-007103
Application 12/688,219
Technology Center 3700

Before LYNNE H. BROWNE, JILL D. HILL, and ERIC C. JESCHKE,
Administrative Patent Judges.

HILL, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Scott E. Jahns et al. (“Appellants”) appeal under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1–13 and 17–24, 27–30, 34, and 35.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Claims 14–16, 25, 26, and 31–33 have been canceled. Appeal Br. (Claims App.).

CLAIMED SUBJECT MATTER

Independent claims 1, 19, and 27 are pending. Independent claim 1, reproduced below, illustrates the subject matter on appeal. The disputed limitation is italicized.

1. A device for creating an opening in a first blood vessel and for sealing the opening in the first blood vessel while an anastomosis is created between the first blood vessel and a second blood vessel, the device comprising:

a cutting mechanism for creating the opening in the first blood vessel, the cutting mechanism including a plurality of cutting elements each including a proximal tip and a distal tip and an elongate electrode extending substantially from the proximal tip to the distal tip, wherein the cutting mechanism includes a closed configuration for creating the opening in the first blood vessel and an opened configuration, wherein *the electrode is configured to cut the opening by piercing the first blood vessel and then moving from the closed position to the opened position*;

a seal for sealing the opening in the first blood vessel wherein the seal is attached to a tether independent of the cutting mechanism and configured to facilitate removal of the seal during or after anastomosis;

a tool body pivotably coupled to the cutting mechanism, the tool body comprising a distal end having a distal opening and a proximal end having a proximal opening, the cutting mechanism attached to the distal end of the tool body such that elongate electrodes extend distally from the distal end of the tool body, and such that the proximal tips of the plurality of cutting elements are pivotably coupled to the distal end of the tool body, wherein distal tips of the cutting elements are urged together in the closed configuration and the distal tips are pivotably spaced-apart laterally in the open configuration; and

the tool body having an inner lumen extending between the distal opening and the proximal opening for delivering the seal through the tool body and into the opening in the first blood vessel when the cutting mechanism is in the opened configuration, and wherein the seal is moveable distally and proximally with respect to the cutting mechanism.

Appeal Br. 13 (Claims App.).

REJECTIONS

I. Claims 1–6, 8–13 and 17 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Golden (US 6,695,859 B1, iss. Feb. 24, 2004), Manhes (US 7,131,985 B1; iss. Nov. 7, 2006), and Burbank (US 6,689,071 B2; iss. Feb. 10, 2004). Ans. 2.

II. Claims 19, 20, 22, 24, 27, 29, 30, 34, 35 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Golden and Manhes. Ans. 4.

III. Claim 7 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Golden, Manhes, Burbank, and Fortune (US 2004/0215231 A1; pub. Oct. 28, 2004). Ans. 7.

IV. Claims 21 and 28 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Golden, Manhes, and Fortune. Ans. 8.

V. Claim 18 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Golden, Manhes, Burbank, and Diaz (US 5,690,674; iss. Nov. 25, 1997). Ans. 8.

VI. Claim 23 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Golden, Manhes, and Brinkerhoff (US 5,366,478; iss. Nov. 22, 1994). Ans. 8.

ANALYSIS

The dispositive issue in this case is whether the prior art teaches or suggests an electrode or cutting surfaces that are configured to cut an opening in a first blood vessel by piercing the first blood vessel and then moving from the closed position to the opened position. Although separate headings are provided in the Appeal Brief, Appellants make the same argument to support patentability of all pending claims.

The Examiner finds that Manhes discloses cutting surfaces 11, 12 configured to cut an opening by piercing and then moving from the closed position to the opened position. Final Act. 3.

Appellants argue that this finding is in error because Manhes discloses opening its longitudinal sections 11, 12 only after cutting has occurred, the longitudinal sections 11, 12 bearing against an inner surface of the abdominal wall rather than furthering the cutting process. Appeal Br. 8; Manhes 3:25–51.

The Examiner responds that the claim has not been interpreted to require that “the process of cutting occurs while the cutting mechanism moves from the closed position to the open position.” Ans. 10. According to the Examiner, the recitation of “configured to cut the opening by piercing the first blood vessel and then moving from the closed position to the open position” does not require that cutting occurs while the electrode (or cutting surface) is moved from the closed to the open position, but rather that the electrode cuts the vessel and, afterward, moves from a closed position to an opened position. *Id.* The Examiner contends that this interpretation is supported by Appellants’ Specification, which states that Appellants’ cutting

mechanism 140 advances in a closed configuration through vessel wall V and then opens into a delivery configuration allowing seal 710 to move into vessel V. *Id.*; Spec. Figs. 29–31 and ¶ 141 (referring to “a closed cutting configuration” and “an open delivery configuration”).

Appellants argue that the Examiner’s interpretation of the claim language is unreasonable because it ignores an entire claim element. Reply Br. 23. According to Appellants, the Specification supports their position that the claim requires the electrode (or cutting surfaces) be configured to cut an opening by piercing the first blood vessel and by moving from a closed position to an opened position. *Id.* (citing Spec. ¶ 141). The cited language from the Specification includes the following:

Seal 710 is advanced or pushed through lumen 136 of tool body 135, through cutting electrode 140 and into vessel V (see FIG. 31). Power may be provided to cutting electrode 140 at any time while seal 710 is advanced through lumen 136 of tool body 135, through cutting electrode 140 and into vessel V. Cutting mechanism 140 is coupled to the proximal end of tool body 135 [allowing] cutting mechanism 140 to change from a closed cutting configuration to an open delivery configuration.

Spec. ¶ 141.

The Examiner has the better argument. Paragraph 141 of Appellants’ Specification supports the Examiner’s claim interpretation. Although opening of the cutting configuration is discussed, the Specification fails to refer to such opening as causing cutting. Instead, the Specification supports the Examiner’s position that the electrode (or cutting surfaces) moves to the opened position *after* the vessel opening is cut. We therefore sustain Rejections I–VI.

DECISION

We AFFIRM the rejection of claims 1–6, 8–13 and 17 under 35 U.S.C. § 103(a) as unpatentable over Golden, Manhes, and Burbank.

We AFFIRM the rejection of claims 19, 20, 22, 24, 27, 29, 30, 34, 35 under 35 U.S.C. § 103(a) as unpatentable over Golden and Manhes.

We AFFIRM the rejection of claim 7 under 35 U.S.C. § 103(a) as unpatentable over Golden, Manhes, Burbank, and Fortune.

We AFFIRM the rejection of claims 21 and 28 under 35 U.S.C. § 103(a) as unpatentable over Golden, Manhes, and Fortune.

We AFFIRM the rejection of claim 18 under 35 U.S.C. § 103(a) as unpatentable over Golden, Manhes, Burbank, and Diaz.

We AFFIRM the rejection of claim 23 under 35 U.S.C. § 103(a) as unpatentable over Golden, Manhes, and Brinkerhoff.

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

AFFIRMED