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Paper No. 10
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ETHICON ENDO-SURGERY, INC.,
Petitioner,

v.

COVIDIEN AG,
Patent Owner.

Case IPR2015-01275
Patent 8,241,284 B2

Before JAMES A. TARTAL, ZHENYU YANG, and JAMES A. WORTH, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* YANG.

Opinion Concurring filed by *Administrative Patent Judge* WORTH.

Opinion Dissenting filed by *Administrative Patent Judge* TARTAL.

YANG, *Administrative Patent Judge.*

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

INTRODUCTION

Ethicon Endo-Surgery, Inc. ("Petitioner") filed a Petition for an *inter partes* review of claims 1–18 of U.S. Patent No. 8,241,284 B2 ("the '284 patent," Ex. 1001). Paper 1 ("Pet."). Covidien AG ("Patent Owner") timely filed a corrected Preliminary Response. Paper 9 ("Prelim. Resp."). We have jurisdiction under 35 U.S.C. § 314.

For the reasons provided below, we determine Petitioner has not established a reasonable likelihood that it would prevail in showing the unpatentability of at least one challenged claim. *See* 35 U.S.C. § 314(a). Therefore, we deny the Petition for an *inter partes* review.

The '284 Patent

The '284 patent relates to an endoscopic bipolar electrosurgical forceps for clamping, sealing and/or dividing tissue. Ex. 1001, 3:40–42. The forceps includes an elongated shaft having opposing jaw members. *Id.* at 3:42–43. At least one non-conductive and spaced-apart stop member is disposed on an inner-facing surface of at least one of the jaw members and is positioned to control the gap distance between the opposing jaw members when the tissue is held therebetween. *Id.* at 3:50–54. A longitudinally reciprocating knife severs the tissue proximate the sealing site once an effective seal is formed. *Id.* at 3:54–56.

Illustrative Claim

Claims 1 and 12 are independent claims. Claim 1 is illustrative. It is reproduced below:

> 1. An endoscopic bipolar forceps, comprising:
> an elongated shaft having opposing jaw members at a distal end thereof, the jaw members including a length and a periphery and movable relative to one another from a first position wherein the jaw members are disposed in spaced relation relative to one another to a second position wherein the jaw members cooperate to grasp tissue therebetween, the jaw members each including respective flat seal surfaces extending along a respective length thereof and adaptable to connect to a source of electrical energy such that the jaw members are capable of conducting energy through tissue held therebetween to effect a tissue seal;
> a plurality of non-conductive stop members disposed along the length of at least one of the seal surfaces of at least one of the jaw members such that the plurality of non-conductive stop members are disposed along the same plane on the seal surface with respect to one another, the non-conductive stop members configured to maintain a uniform distance between the jaw members along the length thereof; and a knife disposed in operative communication with at least one of the jaw members and translatable to sever tissue disposed between jaw members.

Asserted Ground of Unpatentability

Petitioner asserts the following grounds of unpatentability:

Claim(s)	Basis	References
1–11	§ 103	Fox[1] and Eggers '142[2]
11	§ 103	Fox, Eggers '142, and Slater[3]
1–18	§ 103	Eggers '471,[4] Wales,[5] Fox, and Eggers '142
11	§ 103	Eggers '471, Wales, Fox, Eggers '142, and Slater
12–18	§ 103	Schulze,[6] Fox, and Eggers '142

In support of its patentability challenge, Petitioner relies on the Declaration of David C. Yates. Ex. 1004.

ANALYSIS

Claim Construction

In an *inter partes* review, we interpret a claim term in an unexpired patent according to its broadest reasonable construction in light of the specification of the patent in which it appears. 37 C.F.R. § 42.100(b); *In re*

[1] Fox et al., U.S. Patent No. 5,674,220, issued October 7, 1997 (Ex. 1006, "Fox").
[2] Eggers et al., U.S. Patent No. 5,891,142, issued April 6, 1999 (Ex. 1007, "Eggers '142").
[3] Slater et al., U.S. Patent No. 5,396,900, issued March 14, 1995 (Ex. 1011, "Slater").
[4] Phillip E. Eggers, U.S. Patent No. 5,330,471, issued July 19, 1994 (Ex. 1009, "Eggers '471").
[5] Kenneth S. Wales, U.S. Patent No. 5,800,449, issued September 1, 1998 (Ex. 1008, "Wales")
[6] Schulze et al., U.S. Patent No. 5,599,350, issued February 4, 1997 (Ex. 1012, "Schulze")

Cuozzo Speed Techs., LLC, 793 F.3d 1268, 1279 (Fed. Cir. 2015). Under that standard, and absent any special definitions, we assign claim terms their ordinary and customary meaning, as would be understood by one of ordinary skill in the art at the time of the invention, in the context of the entire patent disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

Petitioner proposes claim constructions for "jaw members movable with respect to the elongated shaft" and "drive rod assembly." Pet. 8–11. Claim terms need only be construed to the extent necessary to resolve the controversy. *Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011). For purposes of this Decision, we determine that it is unnecessary to construe those two terms expressly.

Central to our Decision, however, is the construction of "a uniform distance between the jaw members along the length thereof," a limitation required by all challenged claims. Both the Specification and the challenged claims of the '284 patent require this distance when tissue is held between the jaw members. Indeed, the Specification discloses that the stop members are "positioned to control the gap distance between the opposing jaw members when the tissue is held therebetween." Ex. 1001, 3:50–54; *see also id.* at Abstract (stating the same), 5:3–6 (stating the same). In addition, claim 15 recites "[a]n endoscopic bipolar forceps according to claim 12 wherein the jaw members and the non-conductive stop members are configured *such that the distance between the jaw members when tissue is held therebetween* is between about 0.002 inches and about 0.003 inches." *Id.* at 15:21–16:3. Thus, we conclude that the challenged claims require "a

uniform distance between the jaw members" when tissue is held between the opposing jaw members.

In the dissent's view, our construction is not the broadest reasonable because it includes the requirement of "when tissue is held between the opposing jaw members." *See* Dissent 1–3. According to the dissent, we should "apply the ordinary and customary meaning of the term[] recited in the claims without express construction." *Id.* at 3. We disagree.

First, the dissent ignores that a claim term, in general, should be given its ordinary and customary meaning, not in a vacuum, but rather, in the context of the patent in which the term appears. *Translogic Tech.*, 504 F.3d at 1257. Merely stating that we apply the ordinary and customary meaning, in this instance, does not clarify the issue.

Second, the dissent is correct in its understanding of the law; that is, when construing claim terms, we shall not read into a claim a limitation from an embodiment, if that limitation is not present in the claim itself. *Bayer AG v. Biovail Corp.*, 279 F. 3d 1340, 1348 (Fed. Cir. 2002). The dissent, however, is mistaken in its understanding of the facts of this case; that is, the requirement of "when tissue is held therebetween" is not from a specific embodiment, but rather, from the abstract and summary of the invention. *See* Ex. 1001, Abstract, 3:40–54 (summary of the forceps of the "present disclosure"), 4:65–5:6 (summary of the method of the "present disclosure"). Indeed, the '284 patent explains that the stop members are "designed to control the gap distance between opposing jaw members and enhance the manipulation and gripping of tissue during the sealing and dividing process." *Id.* at 1:23–26. When a patent "describes the features of

the 'present invention' as a whole, this description limits the scope of the invention." *Verizon Service Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1308 (Fed. Cir. 2007).

Referring to Figure 5 of the '284, the dissent states that "[j]aw members 22 and 24 are not parallel to each other at all times." Dissent 2. The dissent is correct because Figure 5 shows the forceps "in open configuration." *See* Ex. 1001, 5:29–30, 5:33–36. Indeed, both claims 1 and 12, the only two independent claims, recite two positions of the jaw members: "a first position wherein the jaw members are disposed in spaced relation relative to one another" and "a second position wherein the jaw members cooperate to grasp tissue therebetween." Ex. 1001, 13:54–57, 14:55–59. The dissent, however, would require the "uniform distance" not at either of the explicitly stated position, but rather, "some other position, such as when fully closed," in the absence of any tissue. *See* Dissent 2. The dissent does not explain how Figure 5, showing the forceps in the first position, supports its opinion. We decline to join the dissent's unreasonably broad construction. *See Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015) ("Even under the broadest reasonable interpretation, the Board's construction cannot be divorced from the specification and the record evidence.") (quotation marks omitted).

The challenged claims also require "a uniform distance between the jaw members *along the length thereof*." The '284 patent discloses that the stop members control the "overall gap distance" between the jaw members. Ex. 1001, 4:59–63. As a result, the uniform distance between the jaw members must be maintained along the entire length thereof. Our

understanding is confirmed by the plain and ordinary meaning of "uniform," which means "[n]ot changing in form or character; remaining the same in all cases and at all times." *See* http://www.oxforddictionaries.com/us/definition/american_english/uniform. *See also* http://www.merriam-webster.com/dictionary/uniform (defining "uniform" as "having always the same form, manner, or degree: not varying or variable").

Accordingly, we construe "a uniform distance between the jaw members along the length thereof" to mean that, when tissue is held between the opposing jaw members (i.e., "the jaw members cooperate to grasp tissue therebetween," as recited in both independent claims), the distance between the jaw members is the same along the entire length thereof.

35 U.S.C. § 325(d)

Patent Owner asks us to deny the Petition under 35 U.S.C. § 325(d), arguing that all but one references relied on in the Petition were considered during prosecution. Prelim. Resp. 9–12. The statute allows, but does not require, the Director to deny a petition if "the same or substantially the same prior art or arguments previously were presented to the Office." 35 U.S.C. § 325(d). We decline to exercise our discretion to deny the Petition under § 325(d).

Obviousness over Fox and Eggers '142

Petitioner asserts that claims 1–11 would have been obvious over the combination of Fox and Eggers '142. Pet. 11–32. Based on the current

record, we determine Petitioner has not established a reasonable likelihood that it would prevail in this assertion.

Petitioner asserts that one of ordinary skill in the art would have been motivated to combine the teachings of Fox and Eggers '142. *Id.* at 14–18. Petitioner also refers to the prior art for teaching each and every limitation of claims 1–11. *Id.* at 18–32. Assuming, without deciding, that Petitioner has provided sufficient rationale for combining the prior art, we nevertheless agree with Patent Owner that the combination does not teach "non-conductive stop members configured to maintain a uniform distance between the jaw members along the length thereof," as all challenged claims require. *See* Prelim. Resp. 14–26.

Fox teaches a bipolar endoscopic clamping, coagulation and cutting device. Ex. 1006, 2:62–65. The device includes an end effector with jaw members arranged to grasp tissue therebetween. *Id.* at 4:46–52. Each jaw member includes an electrode. *Id.* According to Fox, "[w]here necessary, shorting may be prevented by, for example, including an island of insulation on the grasping surface 27 or 36 of either electrode 21 or 22 to establish an insulative gap between the conductive surfaces." *Id.* at 4:25–29. In addition, Fox states that "[t]issue stop **418** is positioned within closure tube **420**." *Id.* at 4:38–39.

Eggers '142 teaches surgical forceps with oppositely disposed tissue grasping surfaces at the tip regions of corresponding tines. Ex. 1007, Abstract. "These forceps employ electrically insulative spacer regions or assemblies in conjunction with the mutually inwardly facing electrically conductive tissue grasping surfaces of the two movable tines of the

instruments." *Id.* at 3:46–50. The spacer arrangement serves to space the tissue grasping surfaces apart when the tines are in a substantially closed orientation. *Id.* at 3:50–52.

Petitioner argues that the "island of insulation" in Fox is a non-conductive stop member, and "is provided to 'establish an insulative gap' and to prevent shorting." Pet. 21, 23 (citing Ex. 1006, 4:25–29). According to Petitioner, because "this is the same purpose as the stop members of the '284 patent . . . Fox's disclosed stop members create a uniform desired gap distance the same way as the '284 Patent." *Id.* at 23. We are not persuaded.

First, Fox does not disclose "stop members." At most, it teaches a single "island of insulation." Second, as Patent Owner points out, Fox provides no information about the "shape, position, length and/or orientation" of the "island of insulation." Prelim. Resp. 17. It is unclear how the purpose of establishing an insulative gap would result in the gap being uniform along the entire length of the jaw members, where there is only one island of unknown size and location.

The dissent points to claim 2 of the '284 patent, which recites "at least two non-conductive stop members . . . that extend different heights." *See* Dissent 3 (citing Ex. 1001, 14:7–11). Despite couching it as a claim construction issue,[7] the dissent concludes that claim 2 shows that "[t]he '284 patent, therefore, provides that a configuration consisting of a single stop member of a particular height (of unknown size and location), i.e. an 'island

[7] The dissent states that we "disregard[] the language of claim 2 in construing claim terms" without explaining how claim 2 would inform our claim construction. *See* Dissent 3.

of insulation,' is sufficient to maintain a uniform distance between the jaw members." *Id.* at 2–3. We disagree.

Under the statute, an *inter partes* review may be instituted only if "*the information presented in the petition* . . . and any response filed [thereto] shows that there is a reasonable likelihood that the petitioner would prevail" in the unpatentability challenge. 35 U.S.C. § 314(a) (emphasis added). In the Petition, Petitioner does not rely on claim 2 of the '284 patent to support, as the dissent insists, a uniform distance between the jaw members. To the contrary, when discussing claim 2,

> Petitioner submits that this claim limitation is (a) not supported by the disclosure of the '284 Patent and (b) at odds with the requirement of claim 1 (and PO's arguments during prosecution) that "the non-conductive stop members [are] configured to maintain a uniform distance between the jaw members along the length thereof." Providing stop members of different heights as required by this claim *necessarily results in a non-uniform distance between jaw members*.

Pet. 26 (emphasis added). As a result, the information presented in the Petition does not show a reasonable likelihood that Petitioner would prevail, based on claim 2 of the '284 patent, that an "island of insulation" of unknown size and location, is sufficient to maintain a uniform distance between the jaw members. We decline to join the dissent in reforming the Petition and rely on an argument Petitioner specifically disclaimed.

Petitioner also asserts that Fox teaches the uniform distance limitation because it is a "parallel closure device," whose jaws are parallel to each other as they close. Pet. 23. As support, Petitioner cites to Figures 1 and 2 of Fox and paragraph 38 of the Yates Declaration. Figures 1 and 2,

however, represent the cross-section views of an end effector. Ex. 1006, 3:21–24. In other words, it only shows the distal end of the two jaw members and does not support Petitioner's contention of parallel jaws. In his Declaration, Mr. Yates simply states, without any support or explanation, that "since the tube closure mechanism of Fox results in parallel closure of the jaws, the presence of a single island sets a uniform gap along the entire length of the jaws in Fox." Ex. 1004 ¶ 38. We decline to accord such a conclusory statement much weight. And even if we were to consider his testimony, we would not be persuaded. Indeed, nowhere does Mr. Yates analyze the gap when tissue is held between the jaws.[8] Parallel closure of the jaws in the absence of tissue held therebetween does not satisfy the limitation of "uniform distance between the jaw members along the length thereof," as properly construed.

Petitioner next contends that the electrically insulative spacer regions 124a–124f and 126a–126f in Figures 8–10 of Eggers '142, "evenly spaced apart longitudinally along a grasping length L_G," are examples of the non-conductive stop members (21–22 (citing Ex. 1007, 9:33–36, 9:40–42)). According to Petitioner, the "particular arrangement of [the] insulative spacers in Eggers '142 also provides for the claimed 'uniform distance

[8] According to the dissent, "at this stage of the proceeding, prior to any deposition testimony, we do not know whether Petitioner's expert analyzed this or not." Dissent 5. An analysis not explained in the declaration, regardless of whether it was actually performed or not, cannot support a Petition. 35 U.S.C. § 314(a).

between the jaw members.'" *Id.* at 23. Figure 8 of Eggers '142 is reproduced below:

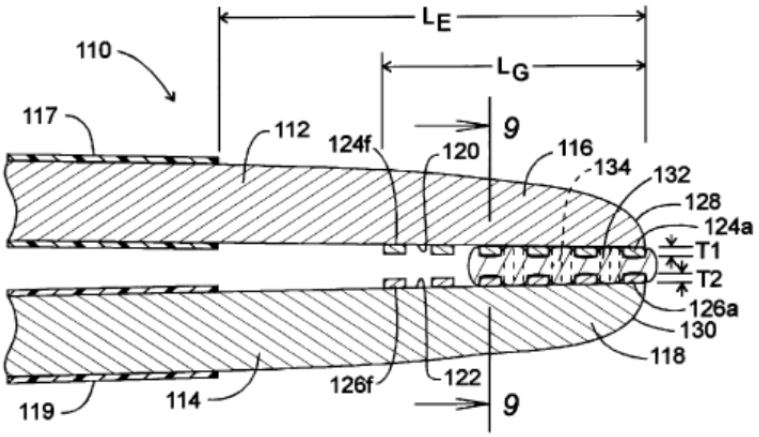

Figure 8 is a partial sectional view of an embodiment of forceps according to Eggers '142. Ex. 1007, 4:61–62. It shows strips 124a–124f having a uniform thickness T1, and 126a–126f having a thickness T2. *Id.* at 9:40–41, 9:49–50. The strips "are aligned for movement into mutual contact when in a closed orientation." Ex. 1007, 9:66–10:1.

A partial sectional view of the forceps of Figure 8 with a full closure orientation is shown in Figure 11, reproduced below. Ex. 1007, 5:1–2.

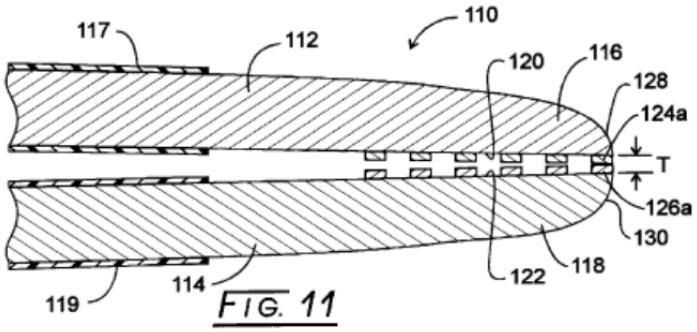

FIG. 11

Figure 11 shows "strips or insulated regions 124a and 126a having been moved into mutual contacting relationship." *Id.* at 10:47–49. According to Eggers '142, "[u]pon further pressure being made by the user,

then the remaining strips progressively come into contact." *Id.* at 10:54–56. At this position, the total spacing between the grasping surfaces, represented as T in Figure 11, is the sum of the thickness T1 and T2. *Id.* at 10:57–60. Petitioner contends, and the dissent agrees, that spacing T is uniform along the length because the T1 and T2 are constant. Pet. 24; Dissent, 4–5. We are not persuaded.

First, as explained above, we construe "a uniform distance between the jaw members along the length thereof" to mean that, *when the tissue is held between the opposing jaw members,* the distance between the jaw members is the same along the entire length thereof. *See supra* at 7. Spacing T in Figure 11, however, represents the distance between the two grasping surfaces without any tissue. *See* Ex. 1007, Fig. 11; *see also id.* at 10:47–50 (stating that Figure 11 shows strips 124a and 126a in mutual contacting relationship "without the presence of tissue interposed therebetween"). As a result, constant spacing T is not the same as "a uniform distance between the jaw members along the length thereof," as construed above.

Second, Eggers '142 teaches that in Figures 8 and 11, the tines are bowed "at **112** and **114** toward each other from a location rearwardly positioned from tip regions **116** and **118**." *Id.* at 10:50–52. This bowed arrangement is better illustrated in Figure 14, reproduced below:

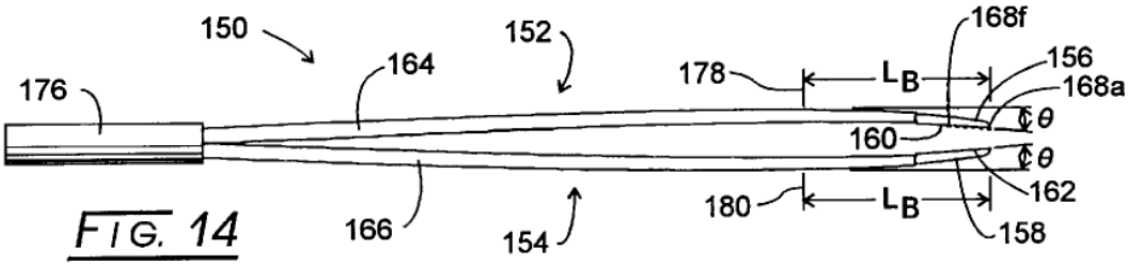

FIG. 14

Figure 14 is a plan view of the forceps according to Eggers '142. Ex. 1007, 5:3–5, 5:11–12. The only difference between this embodiment and the one illustrated in Figures 8–11 is that the former has insulative spacers on one grasping surface, while the latter has insulative spacers on both grasping surfaces. *Id.* at 9:34–36, 11:49–51, 13:22–23; *compare id.* at Figs. 8, 9, *with id.* at Figs. 12, 13.

Contrary to the dissent's assertion, our analysis is based not on our own interpretation, but on the prior art description. *See* Dissent 5. Indeed, Eggers '142 teaches that both tines 152 and 154 in Figure 14—which, as explained above, has the same configuration as Figure 8—are bent mutually inwardly from bend points 178 and 180. *Id.* at 13:32–34. Points 178 and 180 are located a distance, L_B, rearwardly from the tips 156 and 158. *Id.* at 13:34–36. The bends or bowing is at an angle θ with respect to the longitudinal extent of tines 152 and 154. *Id.* at 13:36–39. Given this configuration, we agree with Patent Owner that because the tines in Eggers '142 are bowed along the length thereof, the insulative spacers do not "maintain a uniform distance between the jaw members along the length thereof," as required by the challenged claims. *See* Prelim. Resp. 23–25. Indeed, Figure 8 depicts tines 112 and 114 as grasping tissue 132. *See*

Ex. 1007, 9:59–60. It shows that the distance between the tines (or the grasping surfaces) is not uniform along the length thereof. *See id.* at Fig. 8.

In sum, Petitioner does not point to sufficient evidence or present persuasive argument to show that either Fox or Eggers '142 teaches "non-conductive stop members configured to maintain a uniform distance between the jaw members along the length thereof," as all challenged claims require. As a result, we deny the Petition regarding the obviousness challenge of claims 1–11 over Fox and Eggers '142.

Other Asserted Obviousness Grounds

Petitioner further argues that (1) claim 11 would have been obvious over Fox, Eggers '142, and Slater; (2) claims 1–18 would have been obvious over Eggers '471, Wales, Fox, and Eggers '142; (3) claim 11 would have been obvious over Eggers '471, Wales, Fox, Eggers '142, and Slater; and (4) claims 12–18 would have been obvious over Schulze, Fox, and Eggers '142. Pet. 32–60. As Patent Owner points out, Petitioner does not rely on any additional prior art for teaching "non-conductive stop members configured to maintain a uniform distance between the jaw members along the length thereof," the limitation required by all challenged claims. *See* Prelim. Resp. 27; *see also* Pet. 41–42 (relying on Fox and Eggers '142 for teaching the limitation). We, therefore, deny the rest of the Petition for the same reason as explained above.

CONCLUSION

For the foregoing reasons, the information presented in the Petition and accompanying evidence do not establish a reasonable likelihood that Petitioner would prevail in showing the unpatentability of any one of claims 1–18 of the ’284 patent.

ORDER

Accordingly, it is

ORDERED that Petitioner’s request for an *inter partes* review of claims 1–18 of the ’284 patent is *denied*.

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JAMES A. WORTH, *Administrative Patent Judge, concurring.*

I join the result and reasoning of the majority opinion. I write separately to discuss an additional reason to conclude that the Petition does not establish a reasonable likelihood of success. For each of the proposed grounds, Petitioner contends that it would have been obvious to combine Fox and Eggers '142, alone or in further combination with additional references. I would find that the Petition fails to explain why the proposed combination of references would have been obvious, i.e., the Petition does not articulate a sufficient reason why a person of ordinary skill would have combined the references in the manner proposed. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

Petitioner contends that "[a] person of skill in the art would have been motivated to incorporate the spacer regions of Eggers '142 into the end effector illustrated in Fig. 5 of Fox as Fox's disclosed islands of insulation to provide the benefits described in Eggers '142 in the Fox endoscopic bipolar forceps." Pet. 14 (citing Ex. 1004 (Yates Decl.) ¶¶ 83–89).

However, Patent Owner argues that such generalized motivation is insufficient to establish obviousness. Prelim. Resp. 28–29 (citing *Cisco Sys. Inc. v. C-Cation Techs., LLC*, IPR2014-00454, slip op. at 13–15 (PTAB Aug. 29, 2014) (Paper No. 12)). Indeed, Petitioner and Petitioner's Declarant pre-emptively attempt to address some of the concerns raised by Patent Owner in the Preliminary Response. I address the issues as follows.

First, Patent Owner disputes that the teaching in Eggers '142 of insulative spaces is applicable to non-tweezer bipolar electrosurgical instruments, as Petitioner contends. Prelim. Resp. 28–29; Pet. 15; Ex. 1004 ¶¶ 55–58. Mr. Yates avers that Eggers '142 refers in the Background of the

Specification to other patents that relate to non-tweezer bipolar instruments. To the extent that this is a question of whether the patents relate to the same field of invention, I am persuaded by Petitioner that Eggers '142 and Fox relate to the same field of invention as the '284 patent.

However, Patent Owner argues that Petitioner still provides an insufficient explanation as to why a person of ordinary skill would have sought to improve, in particular, Fox's "island of insulation," with the insulative spaces of Eggers '142. Prelim. Resp. 28–29.

Petitioner's rationale for the particular combination is based, *inter alia*, on the general similarity of structures. Pet. 16–18. Petitioner asserts that electrodes 216 and [217] of Fox include tissue grasping teeth 206 and 208 (Ex. 1006, 5:36–37) and that Eggers '142's spacers achieve grasping using "a roughened or tooth-like surface" (Ex. 1007, 3:1–3, 15:41–45, Figs. 20–21). Pet. 17. Although Petitioner argues that the structures are directed to a similar purpose, I am not persuaded that Petitioner has sufficiently established that this would be a case of simple substitution of one structure for another. *See KSR*, 550 U.S. at 416. Petitioner's Declarant does not rely on any additional persuasive evidence for the conclusion of substitutability. Ex. 1004 ¶¶ 89–90. Petitioner's Declarant explains the proposed combination:

> For example, incorporating the embodiment of Figs. 17 and 18 of Eggers '142 into Fox would result in the square/circular spacers being arranged on either side of the knife channel of Fox, with the knife channel being positioned where the middle row of spacers (212b in Fig. 17 or 226b in Fig. 18) is in Eggers '142. This arrangement replicates the teeth illustrated in Fig. 7 of Fox, albeit with Eggers '142's insulative spacers (for

> example, having a circular shape as in Fig. 18) dimensioned as in Eggers '142 as opposed to Fox's grasping teeth.

Id. I would determine that the Petition and Petitioner's Declarant do not provide sufficient evidence that this would have constituted the simple substitution of one piece for another for purposes of establishing the obviousness of a combination to a person of ordinary skill.

Petitioner also contends that "Fox provides an express motivation to look to references like Eggers '142 in discussing an 'island of insulation' to establish an insulative gap." Pet. 15 (citing Ex. 1006, 4:25-29; Ex. 1004 ¶ 84). In this regard, Fox states that "[w]here necessary, shorting may be prevented by, for example, including an island of insulation on the grasping surface 27 or 36 of either electrode 21 or 22 to establish an insulative gap between the conductive surfaces." Ex. 1006, 4:25–29. Thus, Petitioner's Declarant proffers that a person of ordinary skill would have looked to improve Fox's island of insulation as an insulative gap. Ex. 1004 ¶ 84.

In context, however, Fox discloses immediately thereafter: "However, the grasped tissue will generally prevent shorting of the electrodes during treatment and, once the tissue is treated it may not be necessary or desirable to prevent the electrodes from shorting." Ex. 1006, 4:29–32. Although this additional disclosure of Fox does not necessarily teach away from the use of Fox's "island of insulation" as an insulative gap, Fox does explain that it "may not be desirable" to use an island of insulation to prevent shorting. Therefore, I am persuaded by Patent Owner that this disclosure from Fox, on its own, is not sufficient to establish the obviousness

of a modification thereof, e.g., in combination with Eggers ’142. *See* Prelim. Resp. 29.

The Petition finally looks to the Specification of the subject patent itself:

> *Fox* discloses that its “island of insulation” is provided to “establish an insulative gap” and to prevent shorting. (Ex. 1006 at 4:25–29). This is the same purpose as the stop members of the ‘284 Patent:
>
> > [T]o achieve a **desired spacing** between the electrically conductive surfaces 35 of the respective jaw members 22 and 24, (**i.e., gap distance**) and apply a desired force to seal the tissue 150, at least one jaw member 22 and/or 24 includes at least one stop member, e.g., 50a, which limits the movement of the two opposing jaw members 22 and 24 relative to one another.
>
> (*Id*. at 10:52–58). *Fox’s* disclosed stop members create a uniform desired gap distance the same way as the ‘284 Patent.

Pet. 23. However, the Petition’s reliance on the Specification of the ’284 patent represents impermissible hindsight. I, therefore, conclude that the Petition fails to articulate a sufficient reason for the proposed combination of references. 37 C.F.R. § 42.104(b). The other proposed grounds similarly fail to articulate a rationale for obviousness.

JAMES A. TARTAL, *Administrative Patent Judge, dissenting.*

In my opinion, in choosing to deny institution of *inter partes* review in this proceeding, the Board loses sight of the standard which we are compelled to apply, and instead reaches issues best resolved in a final written decision based on a record fully developed through the trial process. Because I find that the information presented in the Petition and the Preliminary Response shows that there is a reasonable likelihood Petitioner would prevail, I respectfully dissent.

Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted "unless . . . the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." Thus, we need not resolve in an institution decision contested issues when Petitioner provides sufficient evidence to show a reasonable likelihood of prevailing.

First, the majority opinion finds central to its decision the determination that "a uniform distance between the jaw members along the length thereof" means "when tissue is held between the opposing jaw members (. . .), the distance between the jaw members is the same along the entire length thereof." Majority Opinion (Maj. Op.), 5–8. The claim, however, contains no limitation corresponding to the presence or absence of tissue and it is unreasonable to suggest that an apparatus falls within the scope of a claim only when it is holding tissue. Moreover, particular features appearing in the written description should not be read into the claim if the claim language is broader. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993); *see also Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 992 (Fed. Cir. 1999) ("[J]ust as the preferred

embodiment itself does not limit claim terms, mere inferences drawn from the description of an embodiment of the invention cannot serve to limit claim terms, as they are insufficient to require a narrower definition of a disputed term.") (internal citations omitted). I find insufficient the premise that because the '284 patent "discloses that the stop members are 'positioned to control the gap distance between the opposing jaw members when the tissue is held therebetween,'" a limitation should be imported into the claim to require a uniform distance "when tissue is held between the opposing jaws," as opposed to a uniform distance with the jaws in some other position, such as when fully closed or in a grasping position. *See* Maj. Op. at 5–6, quoting Ex. 1001, 3:50–54.

Figure 5 of the '284 patent is reproduced below.

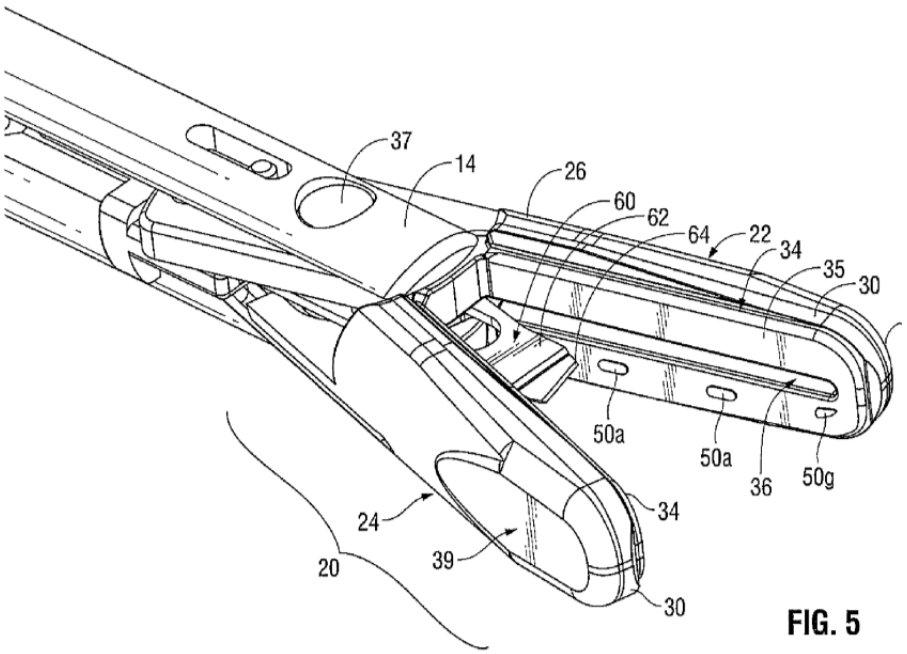

FIG. 5

Figure 5 shows an embodiment of the endoscopic bipolar forceps, as claimed, including first jaw member 22, second jaw member 24, and pivot 37. Ex. 1001, 5:49–50, 22–29. Jaw members 22 and 24 are not parallel to each other at all times. Thus, the construction adopted by the majority suggests that, depending upon the thickness and uniformity of the tissue being grasped, the same set of jaw members may or may not fall within the scope of the claims. For example, if it is a particularly thick piece of tissue being grasped by the jaw members as they pivot about pivot 37, according to the construction adopted by the majority, because the jaw members remain not parallel, and therefore not at a "uniform distance," the apparatus falls outside of the claims. If, however, the same apparatus is used to grasp thinner tissue such that the jaw members pivot into a parallel position, the apparatus would then be within the scope of the claim. I disagree such a construction is the broadest reasonable. I would instead apply the ordinary and customary meaning of the terms recited in the claims without express construction at this stage of the proceeding and without importation of elements disclosed in the specification of the '284 patent.

Next, the majority opinion concludes that Fox fails to disclose "stop members," because it discloses only an "island of insulation," and that it is unclear how only one island of unknown size and location could be configured to maintain a uniform distance between the jaw members along the length thereof. Maj. Op. at 10. Claim 2 of the '284 patent, however, requires only two "non-conductive stop members … that extend different heights." Ex. 1001, 14:7–11. The '284 patent, therefore, provides that a configuration consisting of a single stop member of a particular height (of

unknown size and location), i.e. an "island of insulation," is sufficient to maintain a uniform distance between the jaw members. The majority opinion, however, takes the unconventional approach of disregarding the language of claim 2 in construing claim terms, and instead suggests that it is constrained by the arguments made by Petitioner in the Petition. Maj. Op. at 11. In my view, it is improper to adopt a claim construction that is not reasonable merely because it comports with an argument made (or not made) by a party.

The majority opinion also finds insufficient support for Petitioner's contention that Fox teaches the uniform distance limitation. I disagree. According to the majority, Petitioner's expert failed to "analyze the gap when tissue is held between the jaws." *Id*. at 11–12. Even assuming such a feature should have been considered based on the majority's claim construction, at this stage of the proceeding, prior to any deposition testimony, we do not know whether Petitioner's expert analyzed this or not. Moreover, there is evidence that supports Petitioner's contention that Fox teaches the uniform distance limitation, principally an expert declaration stating that "the tube closure mechanism of Fox results in parallel closure of the jaws." Ex. 1004, ¶ 38. Rather than decline to accord the opinion of Petitioner's expert "much weight," as the majority insists because it is "conclusory," for purposes of an institution decision I find the expert's testimony in this proceeding to be sufficient support to demonstrate a reasonable likelihood Petitioner would prevail, which is all that we need resolve at this stage of the proceeding.

Finally, the majority opinion determines that because "the tines in Eggers '142 are bowed along the length thereof, the insulative spacers do not 'maintain a uniform distance between the jaw members along the length thereof,' as required by the challenged claims." Maj. Op. at 14–15. Contrary to the Majority's conclusion, Eggers '142 expressly discloses an "electrically insulative spacer assembly [] positioned on and supported from at least one of the tissue grasping surfaces to space the tissue contacting surfaces apart an optimized distance, T, when the tines are in a substantially closed orientation." Ex. 1007 at Abstract, 3:40–52. Because the majority's determination concerning Eggers '142 is premised on a construction of "uniform distance" as requiring tissue between the jaw members, I disagree. The majority opinion further neglects to consider whether "substantially closed" includes closed with tissue between the tines. The majority opinion is further premised on its own interpretation of Figure 8 of Eggers '142 as showing a distance between tines that is not uniform along the length thereof, rather than the text of Eggers '142. Maj. Op. 15. It is not readily apparent how the majority reached this conclusion, unsupported by an expert's testimony. At a minimum, a proper determination of what Eggers '142 discloses to one of ordinary skill in the art would best be made with the benefit of testimony introduced through a full trial.

With regard to a motivation to combine Fox and Eggers, the Petition explains:

> Moreover, Fox provides an express motivation to look to references like Eggers '142 in discussing an "island of insulation" to establish an insulative gap. (Ex. 1006 at 4:25-29; Ex. 1004 at ¶ 84). Fox notes that such an island of insulation

> can be positioned on either electrode in a bipolar forceps device to prevent shorting or arcing during treatment. (*Id*.). A person of skill would have been motivated, in view of this disclosure, to look to other references that disclose using similar insulative materials on similar tools for additional details on how the islands of insulation could be dimensioned, formed, and applied. (Ex. 1004 at ¶¶ 84-85).
>
> Accordingly, a person of skill in the art would have incorporated Eggers '42's teaching of dimensions (*see* Ex. 1007 at 10:46-11:24), material for (*id*. at 11:25-27) and arrangement of stop members on the sealing surfaces (*see, e.g.*, *id*. at 9:2-23, Figs. 8, 10-13, 15, 17-18), and mechanisms for affixing stop members (*see, e.g., id*. at 11:25-45) to provide Fox's islands of insulation. (Ex. 1004 at ¶¶ 84-85).

Pet. 15–16. That Fox may also suggest that it "may not be desirable" to use an island of insulation to prevent shorting does not demonstrate a "teaching away," or that Petitioner has failed to provide a sufficient rationale in support of the asserted combination to show a reasonable likelihood of prevailing. Thus, for purposes of a decision to institute, I am persuaded that Petitioner articulates a sufficient reason why a person of ordinary skill would have combined the references in the manner proposed. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).