

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 28

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte DAVID K. SWANSON, THOMAS BOURNE and SIDNEY D. FLEISCHMAN

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Appeal No. 2001-1621  
Application No. 09/111,308

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ON BRIEF

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Before ABRAMS, FRANKFORT, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 50 to 60, which are all of the claims pending in this application.<sup>1</sup>

We REVERSE.

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<sup>1</sup> Claim 50 was amended subsequent to the final rejection.

### BACKGROUND

The appellants' invention relates to systems and methods for ablating myocardial tissue for the treatment of cardiac conditions (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

Claims 50 to 60 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,263,493<sup>2</sup> to Avitall.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the final rejection (Paper No. 15, mailed March 22, 2000) and the answer (Paper No. 22, mailed October 25, 2000) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 21, filed September 11, 2000) and reply brief (Paper No. 23, filed December 18, 2000) for the appellants' arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellants and the examiner. As a consequence

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<sup>2</sup> Issued November 23, 1993.

of our review, we will not sustain the anticipation rejection of claims 50 to 60 for the following reasons.

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgirk v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)) (internal citations omitted):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Thus, a prior art reference may anticipate when the claim limitation or limitations not expressly found in that reference are nonetheless inherent in it. See In re Oelrich, 666 F.2d at 581, 212 USPQ at 326; Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 630, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates. See In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986).

Claim 50, the only independent claim on appeal, reads as follows:

A device for creating a lesion in body tissue, comprising:  
a catheter body including a curved region defining an arc of at least about 180 degrees; and  
at least two spaced electrodes on the curved region of the catheter body separated by an arc of at least about 180 degrees and adapted to face each other across an area of tissue with no portions of the catheter body or other electrodes therebetween;  
wherein the respective sizes and spacing of the at least two electrodes, and the size and curvature of the curved region, is such that a substantially continuous lesion will be formed across the area of tissue between the electrodes in response to simultaneous transmission of energy from each of the electrodes into the tissue area to an indifferent electrode.

Avitall's invention is directed to the use of a deflectable, preferably size and shape adjustable, electrode array loop catheter which allows the operator to rapidly map heart chambers and including the tricuspid annulus and ablate the desired tissue using the same mapping electrode in the array that is positioned on or near the site that should be ablated. Figures 1A-2E show one embodiment of the electrode array loop having a series of spaced tubular noble metal electrodes shown in part at 36 on either half of the elliptical loop. Avitall teaches (column 5, lines 16-17) that the electrodes 36 are preferably made of platinum tubing 2 mm thick and 4 mm long. Avitall further teaches (column 3, lines 56-59; claims 12 and 20) that "[i]n one arrangement, each electrode back side is shaved or flattened to permit the majority of the exposed surface to be in contact with the tissue and not with the blood." Figures 6A-6D show a second

embodiment of the electrode array loop having spaced electrodes in the form of tubular segments as shown at 136.

In the anticipation rejection before us in this appeal (final rejection, p. 2), the examiner appears to rely on the embodiment shown in Avitall's Figures 6A-6D as the basis for this rejection.

In our view, claim 50 is not anticipated by Avitall for the following reasons. First, the embodiment of the electrode array loop shown in Figures 1A-2E of Avitall lacks electrodes adapted to face each other across an area of tissue with no portions of the catheter body or other electrodes therebetween as recited in claim 50. Second, the embodiment of the electrode array loop shown in Figures 6A-6D of Avitall lacks sufficient details to determine whether or not any of the pairs of electrodes separated by an arc of at least about 180 degrees and facing each other across an area of tissue with no portions of the catheter body or other electrodes therebetween are sized and spaced such that a substantially continuous lesion will be formed across the area of tissue between the electrodes in response to simultaneous transmission of energy from each of the electrodes into the tissue area to an indifferent electrode as recited in claim 50. In that regard, the embodiment of the electrode array loop shown in Figures 6A-6D

of Avitall does not teach or disclose the actual diameter of the tubular electrodes 136<sup>3</sup> or the actual spacing between electrodes that are separated by an arc of at least about 180 degrees and facing each other across an area of tissue with no portions of the catheter body or other electrodes therebetween. Without such teachings, it is our view that the teachings of Avitall are insufficient to establish that the electrode array loop shown in Figures 6A-6D of Avitall inherently meets the claim limitation that a pair of electrodes separated by an arc of at least about 180 degrees and facing each other across an area of tissue with no portions of the catheter body or other electrodes therebetween are sized and spaced such that a substantially continuous lesion will be formed across the area of tissue between the electrodes in response to simultaneous transmission of energy from each of the electrodes into the tissue area to an indifferent electrode. While this may be possible, this is not sufficient for an anticipation rejection.

For the reasons set forth above, the decision of the examiner to reject claim 50, and claims 51 to 60 dependent thereon, under 35 U.S.C. § 102(b) is reversed.

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<sup>3</sup> While the teachings of Avitall may be sufficient to determine the diameter of electrodes 36 in the embodiment shown in Figures 1A-2E, the teachings of Avitall are not sufficient to determine the diameter of electrodes 136 in the embodiment shown in Figures 6A-6D. It is impermissible under 35 U.S.C. § 102 to infer that the diameters or other dimensions of electrodes 136 or equal to the diameters or other dimensions of electrodes 36 unless specifically taught by Avitall.

CONCLUSION

To summarize, the decision of the examiner to reject claims 50 to 60 under 35 U.S.C. § 102(b) is reversed.

REVERSED

NEAL E. ABRAMS  
Administrative Patent Judge

CHARLES E. FRANKFORT  
Administrative Patent Judge

JEFFREY V. NASE  
Administrative Patent Judge

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