

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TODD A. BERG

Appeal No. 96-4138
Application 08/392,609¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge and
COHEN and ABRAMS, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final
rejection of claims 1 through 9 and 14 under 35 U.S.C. § 103. No
other claims are pending in the application.

¹ Application for patent filed February 22, 1995.

Appellant's invention relates to a catheter assembly in which the improvement resides in a lap joint for connecting a catheter segment (22) or catheter apparatus, as it is called in claim 1, to a selected device such as another catheter segment (12) (see Figure 3) or a tip (30) (see Figure 5). The catheter or, more particularly, the catheter apparatus (22) is of the type having inner and outer tubular members and a support member in the form of a braid (15) between the tubular members. The lap joint is made by forming a counterbore (25) in one end of the catheter apparatus and by forming a reduced diametered male portion or member (16) on the selected device for reception in the counterbore.

According to appellant's invention as defined in independent claims 1 and 14, the counterbore has a sufficiently large diameter to effectively remove all of the support member along the length of the counterbore to provide what is called a "flexibility transition area" in the appealed independent claims.² As stated in appellant's specification, this lap joint construction overcomes kinking problems with prior art catheter joints.

² Consistent with appellant's specification, we have interpreted the word "effectively" to mean that the support member is completely removed along the entire length of the counterbore.

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A copy of claim 1, which is representative of the claimed subject matter, is appended to this decision.

The following references are relied upon by the examiner as evidence of obviousness in support of his rejection under 35 U.S.C. § 103:

Tanabe et al. (Tanabe)	4,842,590	Jun. 27, 1989
Macaulay et al. (Macaulay)	5,234,416	Aug. 10, 1993

Claims 1 through 9 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Macaulay in view of Tanabe. The examiner's position is as follows:

Macaulay et al. clearly teach a catheter 10 having an outer tube 22, an inner tube 21 and a support member 5A [sic, 21] mounted there between [sic, therebetween]. The apparatus further includes a joint connecting a catheter tip 16, which is clearly a catheter apparatus, to the catheter 10. The joint includes, as seen in figure 4, a counterbore within the tip and a mating male member on the catheter. Macaulay et al. do not teach, however, a joint within which the counterbore is found in the catheter and the mating male member is found on the tip.

Tanabe et al. clearly teach a catheter 11 connected by a joint to another catheter apparatus, tip 12. The catheter 11 is shown as having an inner tube, an outer tube and a support member there between [sic, therebetween]. The joint includes a counterbore within the catheter and a mating male member on the other catheter apparatus. Therefore, in view of the teachings, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the Macaulay et al. apparatus by forming its joint in the opposite manner, that is, in

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the manner as set forth by Tanabe et al. where the counterbore is within the catheter and the tip includes the mating male member. Further, it is quite clear from [sic, from] the Macaulay et al. reference that the diameter of the counterbore is such that upon placing it within the catheter end, the inner tube and support structure of the catheter would effectively be removed. [final office action, Paper no. 13, pages 2-3]

We have carefully considered the issues raised in this appeal together with the examiner's remarks and appellant's arguments. As a result, we conclude that the rejection of the appealed claims cannot be sustained.

In the present case, the examiner seems to conclude that it would have been obvious to switch the placement of the counterbore and the mating male portion in Macaulay's lap joint simply because it is known to provide the counterbore in a catheter body and the mating male portion on a catheter tip portion as disclosed in Tanabe. However, the question presented under 35 U.S.C. § 103 is not whether such an arrangement is known.

Instead, the question is whether there is some reason or motivation in the prior art that would have led one of ordinary skill in the art to make the proposed modification in Macaulay's catheter assembly. See In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984) (The prior art must provide one of

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ordinary skill in the art with the motivation to make the modification needed to arrive at the claimed invention.). The examiner, however, has offered no reason or motivation to make the needed modification. Moreover, even if it would have been obvious to make such a modification, we find nothing that would

have motivated one of ordinary skill in the art to provide the counterbore in Macaulay's modified catheter body with a diameter equal to or greater than the diameter of the counterbore in the patentee's tip to remove the patentee's supporting braid 21. Furthermore, Tanabe teaches away from eliminating the braid in this manner inasmuch as Tanabe expressly teaches the art to maintain the supporting braid along the length of the counterbore as shown in Figure 2 of the patent drawings.

The examiner's decision rejecting appealed claims 1 through 9 and 14 under § 103 is therefore reversed.

REVERSED

HARRISON E. McCANDLISH)
Senior Administrative Patent Judge)
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IRWIN CHARLES COHEN
Administrative Patent Judge

NEAL E. ABRAMS
Administrative Patent Judge

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