

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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRADLEY LINDEN, DONALD F. PALME, II,
PAUL J. BUSCEMI and THOMAS J. HOLMAN

Appeal No. 1999-2789
Application No. 08/805,633

ON BRIEF

Before ABRAMS, FRANKFORT, and GONZALES, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 94, 95, 104 and 140. Claims 96, 97, 102, 103, 105 through 113, 130 and 131, the only other claims still pending in this application, stand allowed.¹

¹ It does not appear that the numbering of the claims in this application is in accordance with the requirements of 37 CFR

§ 1.126. We leave it to appellants and the examiner to treat this issue in any further prosecution of the application. For purposes of this appeal, we will refer to the claims on appeal

(continued...)

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Appellants' invention relates to a method for permanently closing a septal defect in a body, such as in the human heart. Independent claim 140 is representative of the subject matter on appeal and a copy of that claim, as reproduced from the Appendix to appellants' brief, is appended to this decision.

The sole prior art reference of record relied upon by the examiner is:

Kamiya et al. (Kamiya)	5,192,301	Mar. 9,
		1993

Claims 94, 95, 104 and 140 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kamiya.

¹(...continued)
by their current numbers. In addition, we note that notwithstanding the examiner's apparent verification of the continuing data information on the face of the file, it does not appear that this application is a division of S.N. 08/323,824, filed 10/17/94 as the filewrapper currently shows. It would seem that the correct information is that the present application is a division of S.N. 08/383,824, filed 02/06/95. This issue should likewise be addressed by the examiner and appellants during any further prosecution.

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Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejection, we refer to the examiner's answer (Paper No. 15, mailed February 11, 1999) and to appellants' brief (Paper No. 14, filed November 23, 1998) and reply brief (Paper No. 16, filed March 19, 1999) for a full exposition thereof.

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OPINION

At the outset, we observe that appellants, on page 6 of their brief, have indicated that claims 94, 95, 104 and 140 stand or fall together. Thus, in accordance with 37 CFR § 1.192(c)(7), we have selected claim 140 as being representative of appellants' claim grouping and will decide this appeal on the basis of that claim alone.

Having carefully reviewed the anticipation issue raised in this appeal in light of the record before us, we have come to the conclusion that the examiner's rejection of the appealed claims under 35 U.S.C. § 102(b) will be sustained. Our reasoning in support of this determination follows.

Representative claim 140 sets forth a method for permanently closing a septal defect in a body, which method comprises the steps of: introducing a septal defect closure device into a body and advancing the device to an area of a septal defect; orienting the septal defect closure device within the septal defect; and curing or hardening the septal defect closure device *in situ*; whereby the septal defect

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closure device remains, permanently plugging the defect. On page 8 of their brief, appellants urge that the temperature dependent change of shape of the shape memory polymer of Kamiya is not curing, and that Kamiya "makes no disclosure, suggestion or teaching of curing and hardening a plug of polymeric material in situ," as set forth in the claims on appeal.

Like the examiner, we note that Kamiya discloses (col. 3, lines 41-48 and col. 7, lines 34-60) an article and method for permanently closing a septal defect in a body. In pertinent part, that disclosure indicates that subsequent to the time the septal defect closure device or closing plug is recovered to its original shape within the septal defect (i.e., undergoes its shape memory transition), it is cooled by the body temperature and "loses its rubbery flexibility and is fixed to the body as a hard member having high strength" (col. 3, lines 45-48) or "becomes gradually a hard material that fits well to the defect" (col. 7, lines 58-60). Thus, it appears clear that the closing plug in this embodiment of

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Kamiya is hardened *in situ* and is to remain in place permanently closing the defect.

An anticipation under 35 U.S.C. § 102(b) is established when a single prior art reference discloses, either expressly or under principles of inherency, each and every element or limitation of a claimed invention. See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). However, we observe that the law of anticipation does not require that the reference teach what the appellant has disclosed but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983). Since representative claim 140 on appeal uses the alternative language "curing or hardening" (emphasis ours), it is our conclusion that appellants' claim 140 on appeal is clearly readable on the method in Kamiya, at least as to the embodiment of Kamiya where the closing plug is formed of a shape memory polymeric

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material designed to have a shape memory recovery temperature that is higher than body temperature and wherein the plug, subsequent to recovering its original shape, hardens from a rubbery state to a hard member or material having a high strength.

Regardless of whether or not Kamiya teaches "curing," a point not factually or technically well developed by either the examiner or appellants, we find that it clearly does teach a method involving hardening of the defect closure device or closing plug *in situ* so as to allow permanent plugging of the defect, and consequently anticipates appellants' claim 140 on appeal. Appellants' argument (brief, page 8) that Kamiya does not disclose or teach "curing and hardening a plug" (emphasis ours), is of no moment, since this is not what is required by claim 140 on appeal. Moreover, we observe that there is no requirement in claim 140 on appeal that the hardening of the plug must take place as a result of a chemical change in the plug, as appears to be urged by appellants on page 9 of their brief.

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Having considered the evidence provided by the teachings in Kamiya and the arguments of appellants and the examiner, for the reasons stated above, we will sustain the examiner's rejection of appellants' representative claim 140 under 35 U.S.C. § 102(b). Given appellants' grouping of the claims (brief, page 6), we also sustain the standing § 102(b) rejection of independent claim 94 and claims 95 and 104 which depend therefrom, since those claims fall with independent claim 140.

In summary: the decision of the examiner to reject claims 94, 95, 104 and 140 under 35 U.S.C. § 102(b) based on Kamiya is affirmed.

No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

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NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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Claim

140. A method for permanently closing a septal defect in a body, which comprises the steps of:

introducing a septal defect closure device into a body and advancing the septal defect closure device to an area of a septal defect;

orienting the septal defect closure device within the septal defect; and

curing or hardening the septal defect closure device *in situ*;

whereby the septal defect closure device remains, permanently plugging the defect.

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APJ FRANKFORT

APJ GONZALES

APJ ABRAMS

AFFIRMED

Prepared: September 24, 2001