

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(2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER K. PARK and HENRY NITA

Appeal No. 1999-2800
Application 08/761,659

ON BRIEF

Before CALVERT, STAAB, and MCQUADE, Administrative Patent
Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to
17, all the claims in the application.

The claims on appeal are drawn to a catheter section.
Claim 1, the only independent claim, is illustrative and

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alloy such as nitinol, an outer covering 202 of a polymer such as polyethylene

(col. 10, lines 36 to 50), and an inner liner 204 also of a polymeric material (col. 10, lines 26 to 35). The catheter is disclosed as having a high resistance to kinking, and able to recover in vivo from any kinking that may occur.

On pages 5 and 6 of the answer, the examiner states:

It is well settled in the art that materials such as nitinol are shape memory alloys (SMA's) or super-elastic alloys—depending on which side of the coin you rely upon. As such they are known in the art to be utilized for steerable catheters and such because in a cooled state they maintain one form and in a heated state they maintain another—thereby making them steerable. The device as taught by Samson, specifically the braid and the outer polymeric covering, clearly anticipate a "tubular forming member" . . . having two forms—as settled by the heating process of forming SMA^[2] . . . Samson further teaches a heat softenably [sic] polymeric coating exterior to the forming member. If one were to choose to actuate the braid of Samson it would require enough heat to soften the polymeric coating and form the member into the second form as claimed by the applicant. Because Samson teaches "targeting" certain tissues within the vascular system and the use of SMA's for maneuverability it is clear the device could be utilized in that fashion.

The examiner further states that the 650° to 750°F. heat

² Here the examiner refers to another patent, Hemmer 5,334,168, which will not be considered by us since it was not included in the statement of the rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970).

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treatment disclosed by Samson (at col. 11, lines 43 to 53) is a teaching of "heat treating to impart the desired memory shape and retain the super-elastic qualities" (answer, page 6).

"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). In the present case, claim 1 calls for, inter alia, a catheter section with a tubular forming member having a first form and a second form, whereupon the tubular forming member will self-form to the second form upon heating. We find no disclosure in Samson of such a catheter. While one embodiment of appellants' tubular forming member appears to be essentially the same as Samson's member 206, i.e., a braid made of nitinol, Samson does not disclose that the catheter is so made that the braid 206 would assume a different form if the polymeric covering were heated. The examiner's statement, supra, that superelastic alloys are known in the art for use in steerable catheters because they maintain a different form when heated is not considered relevant to the use of a heat softenable polymeric covering,

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as claimed. Moreover, as disclosed by appellants at page 23, line 17 to page 24, line 21, in making their disclosed catheter section the braid is heat treated on a mandrel having the shape of the second form, and then reformed into the first form, with the polymeric covering being applied to hold it in the first form. No such procedure is disclosed by Samson, but rather, the heat treatment disclosed at col. 11, lines 43 to 53, appears to be used simply to preserve the shape of the braid in one particular form. Certainly there is no disclosure that after the braid has been heated to form it into one form (shape), the

polymeric covering is used to hold the braid in another form (shape).

The examiner also argues on page 7 of the answer:

The applicant [sic] further argues the novelty of the device relies [sic: lies] in the method of making the device. Such is like an intended use argument-if there are no structural limitations to back up such allegations then the device remains unpatentable. The fact remains that if you set the devices [of appellants and of Samson] side by side on a table the applicant [sic] has relied upon no structural limitation overcoming this reference.

We do not find any argument in appellants' brief that the

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novelty of the claimed device lies in the method of making it, but in any event, the examiner's argument to the effect that there are no structural differences between the Samson catheter and the catheter recited in claim 1 is not well taken. Claim 1 recites a particular combination of cooperating structural elements, namely, a catheter section comprising a tubular member which has a second form but is held or maintained by a polymeric covering in a first form until the restraint of the covering is so removed (by heating) that the tubular member can assume its second form. By contrast, Samson discloses a different combination, in that the tubular member (braid) does not have two forms; rather, it is formed into one form, and remains in that form, instead of being held in a different form by the polymeric covering.

Accordingly, since Samson does not disclose all the structure recited in claim 1, the rejection of that claim under § 102(e), as well as of dependent claims 2 to 7, will not be sustained.

The rejection of dependent claims 8 to 17 under § 103(a) will likewise not be sustained, since, as discussed above,

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there are differences between parent claim 1 and Samson, and in light of those differences we find no teaching or suggestion in Samson which would have rendered obvious to one of ordinary skill the subject matter recited in parent claim 1.

Conclusion

The examiner's decision to reject claims 1 to 7 under § 102(e), and claims 8 to 17 under § 103(a), is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
)	
)	BOARD OF PATENT
LAWRENCE J. STAAB)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
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