

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERALD R. HELLER
and
WAYNE MAREIRO

Appeal No. 2002-1916
Application 09/332,772

HEARD: March 11, 2003

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

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 10 through 18, 21 and 22, all of the claims remaining in this application. Claims 1 through 9, 19 and 20 have been canceled.

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Appellants' invention relates to a catheter system or kit including at least one conversion dilator for use with a dilatation catheter, and more particularly to an adapter or plurality of adapters for converting a dilatation catheter having a lumen of a given internal diameter to use with smaller size guidewires. Independent claims 10 and 21 are representative of the subject matter on appeal and a copy of those claims can be found in the Appendix to appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Fuqua	4,710,181	Dec. 1, 1987
Osborn	5,409,495	Apr. 25, 1995
Donadio, III et al. (Donadio)	5,741,429	Apr. 21, 1998
Loeffler	5,891,154	Apr. 6, 1999

Claims 10 through 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Donadio.

Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Donadio.

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Claims 15 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Donadio in view of Loeffler or Osborn.

Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Donadio in view of Loeffler or Osborn as applied above, and further in view of Fuqua.

Claims 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Donadio.

Rather than reiterate the examiner's full commentary concerning the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we make reference to the examiner's answer (Paper No. 18, mailed April 9, 2002) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 17, filed January 29, 2002) and reply brief (Paper No. 21, filed June 4, 2002) for the arguments thereagainst.

OPINION

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

As a preliminary matter, we note that on page 6 of the brief appellants have indicated that claims 10 through 18 form one patentably distinct group, while claims 21 and 22 form a second patentably distinct group. Appellants then state that the arguments presented "will only address the rejections of independent claims 10 and 21." Accordingly, we will treat claims 10 and 21 in our discussions below and consider claims 11 through 18 and claim 22 as standing or falling with their respective independent claim.

Looking first to the examiner's rejection of claims 10 through 14 under 35 U.S.C. § 102(b), we agree with the examiner that Donadio discloses, in Figures 12 and 13, a catheter system comprising a catheter member (20) including a lumen defining an

internal diameter of sufficient size to accommodate a dilator or adapter (93) which is optionally positionable within the lumen of the catheter member (20). The adapter has an external diameter substantially equal to the internal diameter of the lumen of the catheter member (col. 16, lines 35-37), and the adapter (93) further includes a lumen defining an internal diameter for directly fittingly accommodating a relatively small diameter guidewire (95). Like the examiner, we are of the view that the lumen of the catheter member (20) in Donadio is of sufficient internal diameter so as to accommodate a first guidewire of a size larger than the size of the guidewire (95) accommodated by the dilator/adapter (93), and that this is all that the language of appellants' claim 10 on appeal requires, because the first and second guidewires are not recited as positive elements of the claimed system.

With regard to the optional positioning of the adapter (93) in the lumen of catheter member (20) in Donadio, we note that the patent indicates (col. 3, lines 5-7) that after placement of the catheter member (20) in a blood vessel the

guidewire and dilator (93) are removed so that catheters or other medical devices can then be passed through the lumen of the catheter member (20) into the desired vessel. Thus, the adapter (93) need not be positioned within the lumen of catheter member (20) at all times and the user clearly has the option of removing it or not when appropriate. We are also of the view that a further guidewire of a size on the order of the outside diameter of adapter (93) or smaller would reasonably fall within the bounds of "other medical devices" to be passed through the catheter member (20) and into the blood vessel as mentioned in Donadio (col. 3, lines 5-7).

Contrary to appellants' arguments in their brief (pages 8-9) and reply brief (page 3), we consider that Donadio clearly discloses a catheter member (20) having a lumen which is capable of accommodating a first guidewire having an external diameter of a given size and also guidewires of different diameters, wherein the guidewire diameters may fall within a range slightly smaller than the outer diameter of adapter (93) to just larger than the outer diameter of the guidewire (95).

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The mere fact that Donadio does not expressly disclose use of the lumen in catheter member (20) for receiving a guidewire having a larger diameter than guidewire (95) seen in Figures 12 and 13 of that patent does not mean that the lumen in catheter member (20) is not capable of such use. Thus, it is our determination that the catheter system seen in Donadio Figures 12 and 13 is fully responsive to that set forth in claim 10 on appeal and fully capable of the functional aspects set forth in that claim.

Since we have determined that the teachings which would have been fairly derived from Donadio anticipate the subject matter of claim 10 on appeal, we will sustain the examiner's rejection of that claim under 35 U.S.C. § 102(b). It follows from appellants' grouping of the claims on page 6 of the brief that claims 11 through 18 will fall with claim 10, and that the examiner's various rejections of claims 11 through 18 under 35 U.S.C. § 102(b) and § 103(a) will also be sustained.

With regard to the examiner's rejection of claims 21 and 22 under 35 U.S.C. § 103(a) based on Donadio, we observe that

independent claim 21 is directed to a catheter system including a kit of parts for use with a plurality of guidewires having different diameters and, in addition to a catheter having a lumen of a given internal diameter, also includes

a plurality of adapters, each of said plurality of adapters including an external diameter substantially equal to said internal diameter of said lumen of said catheter for individual exclusive positioning in said lumen of said catheter, each of said plurality of adapters further including a lumen defining mutually distinct internal diameters for uniquely fitting one of said plurality of guidewires.

According to the examiner (answer, page 6), although Donadio does not disclose a plurality of adapters, it is common knowledge in the prior art to insert a plurality of different devices through a catheter in order to perform surgery and those skilled in the art would recognize that such different devices have different diameters. Apparently based on that knowledge, the examiner then reaches the conclusions that

[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the number of adapters used in order to customize it to the patient's blood vessels (i.e. veins, arteries, capillaries). Further it would have been construed as a mere duplication of adapters performing the same function.

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Further, it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. ***St. Regia Paper Co. v. Bemis Co.***, 193 USPQ 8.

Like appellants, we find no basis in the teachings of Donadio or otherwise articulated by the examiner that would have rendered obvious the catheter kit set forth in appellants' claims 21 and 22 on appeal. In that regard, we agree with appellants' points as set forth on pages 9-11 of their brief and we adopt them as our own. The examiner has clearly engaged in a prohibited hindsight reconstruction of appellants' claimed catheter kit based on appellants' own teachings and disclosure. Accordingly, the examiner's rejection of claims 21 and 22 under 35 U.S.C. § 103(a) will not be sustained.

To summarize, the examiner's rejection of claims 10 through 14 under 35 U.S.C. § 102(b) as being anticipated by Donadio has been sustained; as have the rejections of claims 15 through 18 under 35 U.S.C. § 103(a) based on Donadio alone or in combination with Loeffler, Osborn or Fuqua. The examiner's

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rejection of claims 21 and 22 based on Donadio has not been sustained.

The decision of the examiner is accordingly affirmed-in-part.

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

AFFIRMED-IN-PART

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JOHN P. McQUADE)	
Administrative Patent Judge)	

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