

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

Appeal No. 95-0423
Application 07/696,859¹

ON BRIEF

Before McCANDLISH, *Senior Administrative Patent Judge*, STAAB
and McQUADE, *Administrative Patent Judges*.

STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-32 and 34-63, all the claims in the application. We *affirm-in-part*.

Appellant's invention pertains to a shunt for use in the

¹ Application for patent filed May 8, 1991.

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body of a patient for establishing communication between a high pressure chamber and a low pressure chamber separated by a membrane (claims 16-31 and 58), the combination of a hole forming device for forming a hole in a membrane and a shunt removably carried by the hole forming means (claims 1-15, 55-57 and 61-63), and a method of providing communication in the body of a patient across a membrane separating high and low pressure chambers (claims 32, 34-54, 59 and 60). A basic understanding of the invention can be derived from a reading of exemplary claim 1, a copy of which is appended to appellant's brief.

The following reference of record is relied upon by the examiner in support of rejections under 35 U.S.C. § 102(e) and 35 U.S.C. § 103:

Ritch et al. (Ritch)	4,968,296	Nov. 6, 1990
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(filed Dec. 20, 1989)

The following rejections are before us for review:

(a) claim 59 stands rejected under 35 U.S.C. § 112, second paragraph, "as being infinite" (answer, page 3);

(b) claims 1-32 and 34-63 stand rejected under 35 U.S.C. § 102(c) "as being abandoned by applicant" (answer, page 4);

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(c) claims 1, 16, 20, 28, 29, 32 and 43-48 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Ritch; and

(d) claims 17-19, 25, 27 and 31 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ritch.²

The rejections are explained on pages 3-5 of the answer.

Appellant's argument is set forth on pages 6-17 of the brief. In addition, appellant relies on declarations submitted May 8, 1991 (Prywes I) and October 12, 1993 (Prywes II).

The 35 U.S.C. § 112, second paragraph, rejection

We shall not sustain the 35 U.S.C. § 112, second paragraph, rejection of claim 59.

The basis of this rejection is the examiner's belief that claim 59 is vague and indefinite because the terminology "the

² The examiner appears to have inadvertently included claim 26 in the statement of this rejection on page 5 of the answer. In this regard, see the statement of the rejection of claims under § 103 based on Ritch as set forth on page 5 of the final rejection and on page 4 of the office action dated May 20, 1993, wherein claim 26 is not listed. See also page 2 of the answer, last two lines, under the heading "Grouping of claims" wherein claim 26 is not listed among the claims rejected under § 103. Accordingly, we have not included claim 26 in our restatement of this rejection.

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intermediary of said shunt" lacks antecedent basis. However, we agree with appellant that "[t]he word 'intermediary' is not used in a structural sense in the claim which would require antecedent support, but as its normal meaning that the therapeutic substance is delivered through the intervention or presence of the shunt" (brief, page 16). Under these circumstances, we are convinced that the artisan would have no trouble understanding the metes and bounds of claim 59, particularly when the claim is read in light of the supporting disclosure.

The 35 U.S.C. § 102(c) rejection

We shall not sustain the 35 U.S.C. § 102(c) rejection of claims 1-32 and 34-63.

This rejection is founded upon the showing of facts in appellant's 37 CFR § 1.131 declaration (Prywes I) submitted concurrently with the filing of the present application.³

According to the examiner,

³ The Prywes I declaration was submitted for the purpose of antedating the Ritch '296 patent presently applied by the examiner against certain appealed claims. The Ritch '296 patent was initially made of record by appellant in an Information Disclosure Statement (Paper No. 2) submitted at the time the present application was filed.

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[t]he facts revealed in the [Prywes I] declaration under 37 C.F.R. 1.131 show a delay of 3 years and 8 months (44 months) from the time of conception to the time of filing of the application in this case. It can be inferred that the application has been abandoned by reason of unexplained delay. [answer, page 4]

The examiner acknowledges that "intent is a consideration in the holding of abandonment and that delay, alone and of itself, is not sufficient for a holding of abandonment" (answer, page 6). Nonetheless, the examiner has taken the position that in this instance the delay is unexplained, and that for this reason "the delay of 44 months in filing the patent application suggest[s] more at an attempt to abandon rather than an attempt not to abandon" (answer, page 6).

Appellant cites *Ex parte Dunne*, 20 USPQ2d 1479, 1480 (BPAI 1991) for the proposition that delay in filing alone is not a sufficient basis from which to infer the requisite intent to abandon under 35 U.S.C. § 102(c). In addition, appellant relies on a declaration (Prywes II) wherein the inventor asserts on page 1 thereof that "[i]n the interval of time between September 12, 1987 and the filing of the application, I intended to maintain my invention and at no time had any intent whatsoever to abandon the same."

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Appellant maintains that the examiner's inference is misplaced and that the examiner appears to misapprehend the correct requirement for abandonment under 35 U.S.C. § 102(c).

The appellant's position is well taken. As stated in *Ex parte Dunne*, 20 USPQ2d at 1480 (BPAI 1991):

Actual abandonment under 35 U.S.C. § 102(c) requires that the inventor *intend* to abandon the invention Such intent to abandon an invention will not be imputed, and every reasonable doubt should be resolved in favor of the inventor. . . . Delay in filing alone is not a sufficient basis from which to infer the requisite intent to abandon under 35 U.S.C. § 102(c).

In the present instance, it is clear that the examiner has failed to make out a *prima facie* case of abandonment within the meaning of 35 U.S.C. § 102(c), particularly when, as set forth in *Dunne*, every reasonable doubt is to be resolved in favor of the inventor.

The 35 U.S.C. § 102(e) and 35 U.S.C. § 103 rejections based on Ritch '296

At the outset, we note appellant's statement on page 10 of the brief that "when the rejection under 35 U.S.C. § 102(c) is withdrawn, Ritch '296 no longer becomes a reference under 35 U.S.C. § 102(e)." Appellant has not explained why this is

so, and no reason for so concluding is apparent to us.

We first take up for consideration the question of whether the Ritch patent should be withdrawn as a reference in light of appellant's declaration under 37 CFR § 1.131 (Prywes I).⁴ For completeness sake, we also consider the declaration submitted in response to the examiner's rejection under 35 U.S.C. § 102(c) (Prywes II) to the extent it relates to this question.

Prywes I states on page 1 that it is submitted "to establish completion of the invention in this application in the United States at a date prior to Dec. 20, 1989, which is the effective date of US Patent 4,968,296 [to Ritch], which is voluntarily cited by applicant in the attached information

⁴ A review of the record reveals that at one point during prosecution, the examiner considered the Prywes I declaration to be "ineffective to overcome the Ritch et al reference as it pertains to claim 1" because appellant was claiming therein the same invention as Ritch, but that said declaration "[was] sufficient to overcome the Ritch et al reference as it pertains to [the remaining] claims" Office Action mailed September 30, 1992 (Paper No. 7), pages 2 and 3. Subsequently, the examiner reversed his position with respect to the appellant's showing of facts, found the Prywes I declaration to be insufficient to establish diligence, and rejected a variety of claims under 35 U.S.C. § 102(e) and 35 U.S.C. § 103 based on the Ritch patent. See the Office Action mailed May 20, 1993 (Paper No. 11).

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disclosure statement." Evidence in the form of reproductions of notebook entries accompany Prywes I in support of the statements made therein.

Prywes II, although not submitted for the purpose of antedating the Ritch patent, is relevant here to the extent it alleges in paragraphs 5 through 8 that appellant engaged in certain activities in the interval of time between the alleged date of conception and the filing of the application. No evidence accompanies Prywes II in support of the statements made therein.

The examiner determined that the Prywes I declaration was sufficient to establish conception of the claimed invention prior to the filing date of the Ritch patent (answer, page 4), but that the declaration is not effective to overcome the reference because "there is no factual evidence demonstrating due diligence between the date of conception and the reduction to practice that occurred by the filing of this application" (answer, page 7).⁵ The examiner does not mention Prywes II in

⁵ The examiner's treatment of appellant's showing of facts is incorrect to the extent it infers that appellant must show diligence all the way from the date of conception to the filing of the present application. As is made clear by 37 CFR

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addressing the question of diligence.

We agree with the examiner that Prywes I establishes conception of the invention prior to the filing date of Ritch. Nevertheless, like the examiner, we find the appellant's showing of facts to be insufficient to remove Ritch as a reference. First, appellant's showing does not establish that the claimed combination, or shunt, ever actually existed⁶, or that the claimed method was ever performed⁷. Accordingly, no actual reduction to practice of the invention, either prior to or after the filing date of Ritch, has been established. Second, as to diligence during the critical period from just prior to the effective date of the Ritch patent to the filing of the application, the only relevant showing in this regard

§ 1.131(b), where an applicant is the first to conceive an invention but the second to reduce it to practice, diligence must be shown from just prior to the effective date of the reference to a subsequent reduction to practice or filing of the application.

⁶ Actual reduction to practice requires at the very least a showing that the apparatus actually existed. *In re Asahi/American Inc.*, 68 F.3d 442, 445, 37 USPQ2d 1204, 1206 (Fed. Cir. 1995).

⁷ "A process is reduced to practice when it is successfully performed." *Corona v. Dovan*, 273 U.S. 692, 1928 Comm'r Pats. 253, 262-63 (1928).

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is found in paragraphs 5 through 8 of Prywes II, wherein certain activities are alleged to have taken place in the interval to time between conception of the invention and the filing of the application. However, as previously noted, no evidence has been provided in support of these allegations. Accordingly, diligence has not been establish. It follows that appellant's showing of facts is insufficient to overcome the Ritch patent. See 37 CFR § 1.131(b).

Turning now to the merits of the rejections based on Ritch, we shall not sustain the rejection of claims 1, 20 and 32 as being anticipated by Ritch.

Claim 1 calls for "fluid control means carried by said shunt means for controlling flow of fluid through the shunt means from the high pressure chamber to the low pressure chamber." Claim 20 contains similar language. Method claim 32 calls for the step of "controlling the flow of fluid through said shunt . . . to regulate rate of fluid flow between said chambers." In attempting to read this claim language on Ritch, the examiner has taken the position that the purpose of the Ritch et al. reference is to

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control fluid flow from the eye so as to permit the treatment of glaucoma. The fluid flow is controlled by the aperture in the shunt, thus this aperture reads as the claimed "fluid flow control means." This flow control means is carried by the shunt means. [answer, pages 7-8]

We cannot accept this position. In accordance with *In re Donaldson Co., Inc.*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994), the means for controlling flow of claims 1 and 20, and the step of controlling flow of claim 32, must be interpreted in accordance with the sixth paragraph of 35 U.S.C. § 112, i.e., "construed to cover the corresponding structure . . . or acts described in the specification and equivalents thereof." Appellant's specification makes clear that the means for and act of controlling flow between the high and low pressure chambers is separate and distinct from the means for and act of merely placing these two chambers in communication via the aperture in the shunt. See page 5, lines 6-15 of appellant's specification, wherein it is stated that according to a broad aspect of the invention hollow shunt means is engaged with the membrane to establish communication between the chambers, and lines 16-24 wherein it is stated that according to a further aspect of the invention the shunt means can carry means for

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controlling flow of fluid through the shunt means. The specification then goes on to disclose structures, i.e., inflatable member 52 in the form of a porous balloon carried by the shunt (see, for example, page 17, lines 2-5) and porous plug 40 inserted into the aperture of the shunt (page 15, line 30 through page 16, line 8) for controlling the rate of flow. In that we do not find any such hollow balloon member or plug or equivalents thereof disclosed in or suggested by Ritch, we conclude that the examiner has not made out a *prima facie* case of anticipation of claims 1, 20 and 32 based on Ritch.

We shall sustain the rejection of claims 16, 28 and 29 as being anticipated by Ritch, since appellant concedes on pages 10-11 that these claims would be properly subject to rejection under 35 U.S.C. § 102(e) by Ritch if Ritch is available as a reference.

We shall not sustain the rejection of claims 17-19, 25, 27 and 31 as being unpatentable over Ritch.

Each of these claims, in one form or another, calls for a tapered portion on the shunt that increases in radial extent from one end of the shunt to the other. In addition, claim 25 calls for the tapered portion to be angled relative to the

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remainder of the body. Although the examiner concedes that Ritch does not disclose these features, he nevertheless concludes that they would have been obvious to one of ordinary skill in the art "as a choice of geometrical design" (answer, page 5).

In short, Ritch does not provide the factual basis necessary to support this conclusion of obviousness. The tapered portions are stated to facilitate entry of the shunt into the hole formed in the membrane (specification, page 15, lines 8-10) and the angled construction is stated to allow the shunt to conform to the curvature of the globe of the eye (specification, page 11, lines 35-37). Accordingly, these features of appellant's invention may not be dismissed as obvious design parameters without supporting evidence.

Compare In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975). Thus, based on the prior art relied upon by the examiner, we cannot sustain the rejection of claims 17-19, 25, 27 and 31 as being unpatentable over Ritch.

We shall sustain the rejection of claim 43 as being anticipated by Ritch.

The only limitation of method claim 43 argued by

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appellant as distinguishing over Ritch is the step of "axially displacing the shunt from the tool into the hole coaxially with the latter." According to appellant, "[t]he method of Ritch '296 is entirely dissimilar as Ritch employs a cam surface 27 to ensure that the shunt will be laterally displaced as it is being ejected" (brief, page 12).

Ritch states that the shunt is "discharged forwardly and laterally" through the opening 22 into the membrane (column 6, line 20). When the claim language "axially displacing the shunt from the tool" is given its broadest reasonable interpretation consistent with the specification (*In re Prater*, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969)), without reading limitations thereinto from the specification (*Sjolund v. Musland*, 847 F.2d 1573, 1582, 6 USPQ2d 2020, 2027 (Fed. Cir. 1988)), the argued claim language does not preclude the kind of compound discharging motion disclosed by Ritch, which motion includes a forward or axial component. As to the requirement that the shunt is displaced "into the hole coaxially with the latter," we consider the words "the latter"

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to be a reference to "the hole" in the membrane, such that the claim language simply requires that the shunt be displaced coaxially into the hole. In that the shunt 21 of Ritch can likewise be said to move coaxially into the hole formed by the cannula in the membrane 18, it is our view that this requirement also does not serve to distinguish over Ritch. Accordingly, as argued, we will sustain the § 102 rejection of claim 43 based on Ritch.

Claims 44 and 46-48, which depend from claim 43, have not been separately argued by appellant. We will therefore also sustain the rejection of these claims as being anticipated by Ritch. See *In re Nielson*, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987).

We shall not sustain the rejection of claim 45 as being anticipated by Ritch.

Claim 45 depends from claim 43 and additionally requires that the axially displacing step of the base claim "is effected in a straight line." Notwithstanding that the shunt of Ritch may translate axially until it reaches the cam surface 27, it cannot be fairly said that the displacing of Ritch's shunt is "effected in a straight line," as called for

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in claim 45.

Summary

The rejection of claim 59 under 35 U.S.C. § 112, second paragraph, is reversed.

The rejection of claims 1-32 and 34-63 under 35 U.S.C. § 102(c) is reversed.

The rejection of claims 1, 16, 20, 28, 29, 32 and 43-48 under 35 U.S.C. § 102(e) as being anticipated by Ritch '296 is reversed as to claims 1, 20, 32 and 45, but is affirmed as to claims 16, 28, 29, 43, 44 and 46-48.

The rejection of claims 17-19, 25, 27 and 31 under 35 U.S.C. § 103 as being unpatentable over Ritch '296 is reversed.

The decision of the examiner is 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

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