

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GLENN W. LAUB

Appeal No. 96-0877
Application 08/123,639¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, and
ABRAMS and NASE, 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. No other claims are pending in the application.

¹ Application for patent filed September 17, 1993.

Appeal No. 96-0877
Application 08/123,639

Appellant's claimed invention relates to an implantable prosthetic heart valve assembly having a leaflet (12) and an oscillator (13) (i.e., a vibratory device) for imparting vibratory energy to the leaflet.

A copy of the appealed claims is appended to appellant's brief.

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

Carey et al. (Carey)	5,052,934	Oct. 1,
1991		

The grounds of rejection are as follows:

1. Claims 1 through 9 stand rejected under the first paragraph of 35 U.S.C. § 112.

Appeal No. 96-0877
Application 08/123,639

2. Claims 2, 3 and 9 stand rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as his invention.

3. Claims 1 through 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Carey.

Considering first the rejection under the first paragraph of § 112, the examiner states that "the specification, as originally filed, does not provide support for the invention as is now claimed" (final office action, Paper No. 4, page 2). In addition, he states that "[t]he specification also fails to provide an adequate written description of the invention and fails to adequately teach how to make and/or use the invention" (final office action, Paper No. 4, page 2).

As we understand the examiner's position as quoted supra and as set forth in greater detail in the final office action (Paper No. 4), he concludes that the appealed claims are based

Appeal No. 96-0877
Application 08/123,639

on a specification which does not satisfy both the description and enablement requirements in the first paragraph of § 112. However, because these requirements are separate and distinct and involve different tests, they cannot be considered as a common or single rejection as the examiner has done here. See In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984). We shall therefore treat this rejection as two separate grounds of rejection of the appealed claims, one under the description requirement in the first paragraph of § 112, and the other under the enablement requirement in the first paragraph of § 112.

With apparent regard to the description requirement, the examiner takes the position that "[t]he specification does not provide support for 'an implantable prosthetic heart having at least one leaflet and valve as claim 1 now states?' (final office action, Paper No. 4, page 2). Appellant does not take issue with the examiner's position and instead states on page 7 of the main brief that the present wording of claim 1 contains an error which occurred in rewriting the claim in amended form in amendment A (Paper No. 3).

Appeal No. 96-0877
Application 08/123,639

We agree that there is no descriptive support in appellant's specification as filed for "[a]n implantable prosthetic heart" in its entirety. Instead, the specification as filed merely discloses a prosthetic component for the heart, namely a prosthetic heart valve. We will therefore sustain the rejection of claim 1 and claims 2, 3, 8/1 and 9, which depend from claim 1, based on the description requirement in the first paragraph of § 112.

Unlike claim 1, claim 4, the only other independent claim on appeal, does not call for a prosthetic heart as such and, instead, is directed to the prosthetic heart valve itself. We will therefore reverse the rejection of claims 4 through 7 and 8/4 based on the description requirement in the first paragraph of § 112.

With regard to the enablement requirement in the first paragraph of § 112, the test is whether an applicant's disclosure, considering the level of ordinary skill in the art

Appeal No. 96-0877
Application 08/123,639

as of the date of the applicant's application, would have enabled a person of such skill to make and use the claimed invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982).

In the present case, one of ordinary skill in the art would have recognized that the vibrations produced by the vibratory device 13 are transmitted through the valve housing 11 to the leaflet 12 itself. Furthermore, given the specialized level of skill in this art, one of ordinary skill in the art would have known how to attach or connect the vibratory device 13 to the valve housing to impart the desired vibrations to the leaflet without undue experimentation, notwithstanding the lack of detail in appellant's specification. Accordingly, we cannot sustain the rejection of claims 1 through 9 based on the enablement requirement in the first paragraph of § 112.

With regard to the rejection of claims 2, 3 and 9 under the second paragraph of § 112, appellant does not contend that the examiner erred in holding that these claims are

Appeal No. 96-0877
Application 08/123,639

indefinite. Instead, on page 7 of the main brief, appellant concedes the correctness of the examiner's position that, in substance, there is no antecedent basis in claim 1 for "[a]n implantable prosthetic heart valve" as recited in claims 2, 3 and 9. Accordingly, we will sustain the rejection of claims 2, 3 and 9 under the second paragraph of § 112.

With regard to the § 103 rejection, the examiner has made the finding that the ultrasonic transducers 124 and 126 in Carey's device must impart vibratory energy to the prosthetic heart valve member 120 because it lies in the path of the ultrasonic vibrations traveling to the elastomeric measurement windows 138 and 140. The only arguments traversing this rejection are as follows:

There is no teaching or suggestion that ultrasonic transducers 124 and 126 provide vibratory energy to the heart valve 120 or valve 108. To the contrary, ultrasonic energy is generated to measure flow characteristics of the blood-mimicking fluid. There is no suggestion for positioning transducers 124 or 126 on the prosthetic valve housing or is in any way

Appeal No. 96-0877
Application 08/123,639

impart vibratory energy to the leaflets of the valve. In short, Casey [sic, Carey], et al. is simply not relevant or suggestive of the present invention. [brief, pages 8-9]

Admittedly, Carey does not expressly teach that the transducers 124 and 126 impart vibratory energy to the prosthetic heart valve member 120. However, it is not necessary that Carey explicitly disclose that the transducers 124 and 126 will impart vibratory energy to valve member 120. Instead, it is sufficient that Carey's transducers are inherently capable of performing in the manner claimed. See In re Hallman, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981), In re Ludtke, 441 F.2d 660, 664, 169 USPQ 563, 566 (CCPA 1971) and In re Yanush, 477 F.2d 958, 959, 177 USPQ 705, 706 (CCPA 1973).

In the present case, claim 1 does not require the valve to actually be vibrated by the vibratory energy. Instead, this claim merely requires that vibratory energy be applied to the valve. In Carey's apparatus, it is reasonable to believe that the ultrasonic vibrations produced by transducers 124 and 126

Appeal No. 96-0877
Application 08/123,639

will necessarily and, thus, inherently be imparted to the valve member 120 because the valve member lies in the path of the ultrasonic vibrations traveling towards window 140. Since appellant has not shown that Carey's transducers are not inherently capable of performing in the manner broadly claimed in claim 1, we will sustain the § 103 rejection of claim 1. We will also sustain the § 103 rejection of dependent claims 2, 3, 8/1 and 9 because the patentability of these claims has not been argued separately of claim 1. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987) and In re Burckel, 592 F.2d 1175, 1178-79, 201 USPQ 67, 70 (CCPA 1979).

Unlike claim 1, claim 4 requires the oscillator to perform the function of oscillating (i.e., vibrating) the leaflet. In Carey's apparatus, there is no evidence to indicate that the ultrasonic vibrations produced by transducers 124 and 126 are of sufficient strength to necessarily perform this function. As stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981), inherency may not be established by possibilities or probabilities. Accordingly, we must reverse the § 103 rejection of claims 4

Appeal No. 96-0877
Application 08/123,639

through 7 and 8/4.

In summary:

1. The rejection of claims 1, 2, 3, 8/1 and 9 based on the description requirement in the first paragraph of § 112 is affirmed.

2. The rejection of claims 4 through 7 and 8/4 based on the description requirement in the first paragraph of § 112 is reversed.

3. The rejection of claims 1 through 9 based on the enablement requirement in the first paragraph of § 112 is reversed.

4. The rejection of claims 2, 3 and 9 under the second paragraph of § 112 is affirmed.

5. The rejection of claims 1, 2, 3, 8/1 and 9 under § 103

Appeal No. 96-0877
Application 08/123,639

is affirmed.

6. The rejection of claims 4 through 7 and 8/4 under §
103 is reversed.

The examiner's decision rejecting the appealed claims 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

)
HARRISON E. McCANDLISH, Senior))
Administrative Patent Judge))
))
))
) BOARD OF PATENT)
NEAL E. ABRAMS))
Administrative Patent Judge) APPEALS AND)
))

