

**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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

*Ex parte* JAN VODA

---

Appeal No. 1998-2830  
Application No. 08/558,006<sup>1</sup>

---

ON BRIEF

---

Before ABRAMS, McQUADE and GONZALES, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

**DECISION ON APPEAL**

---

<sup>1</sup> Application for patent filed November 13, 1995. According to appellant, this application is a continuation of Application No. 08/190,149 filed February 4, 1994, now abandoned; which is a national stage application of PCT/US93/04031 filed April 29, 1993; which is a continuation-in-part of Application No. 07/877,288 filed May 1, 1991, now U.S. Patent No. 5,306,263 issued April 26, 1994.

Appeal No. 1998-2830  
Application No. 08/558,006

This is an appeal from the decision of the examiner finally rejecting claims 11-16, which constitute all of the claims remaining of record in the application.

The appellant's invention is directed to a catheter. The subject matter before us on appeal is illustrated by reference to claim 11, which reads as follows:

11. A catheter comprising:

an elongate catheter body having a proximal end and a distal end and having a central lumen from the proximal end to the distal end adapted to slidably receive a therapeutic catheter;

a soft tip fixedly attached to the elongate catheter body adapted to removably lodge in the ostium of the right coronary artery; and

the elongate catheter body being bendably formed near the distal end to impinge against the opposite wall of the aorta along a line wherein the line is proximal of the ostium of the coronary artery.

The reference relied upon by the examiner to support the final rejection is:

European Patent Application    0 277 366 A1                    Aug. 10, 1988  
(EPO '366)

Appeal No. 1998-2830  
Application No. 08/558,006

Claims 11-16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by EPO '366.

The rejection is explained in the Examiner's Answer, and the opposing viewpoints of the appellant are set forth in the Brief.

We reverse the rejection and remand the application to the examiner, as explained below.

#### OPINION

Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See, for example, *In re Paulsen*, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994).

Independent claim 11 requires, *inter alia*, that there be an elongate catheter body to which is attached a tip "adapted to removably lodge in the ostium of the right coronary artery," with the catheter body being bendably formed near the distal end "to impinge against the opposite wall of the aorta along a line . . . proximal of the ostium of the [right]

Appeal No. 1998-2830  
Application No. 08/558,006

coronary artery." Contrary to the view of the examiner, it is our opinion that this recitation constitutes functional limitations upon the claimed structure that cannot be ignored as being directed to intended use.

EPO '366 discloses a catheter formed into "the conventional J-shape" (column 3, line 52). Insofar as the coronary arteries are concerned, the disclosed shape would appear to limit the use of this catheter to removable lodging in the left coronary artery only, and we find no explanation in the disclosure that would indicate otherwise. This being the case, the reference does not anticipate the structure recited in claim 11, which requires that the catheter be capable of lodging in the ostium of the right coronary artery while impinging against the opposite wall of the aorta.

The rejection therefore cannot be sustained.

**REMAND TO THE EXAMINER**

Beginning on page 5 of the specification, the appellant discusses the "Arani-type Double Loop" guide catheter, which is shown in the drawings in Figures 2A, 2B and 2C. As is evident from Figure 2B, the Arani catheter is adapted to

Appeal No. 1998-2830  
Application No. 08/558,006

removably lodge in the ostium of the right coronary artery while impinging against the opposite wall of the aorta. From our perspective, this reference is relevant to the patentability of independent claim 11 and at least some of the other claims on appeal.

Therefore, pursuant to Section 1211 of the Manual of Patent Examining Procedure, this application is remanded to the examiner for consideration of the Arani catheter as disclosed in the appellant's specification and other prior art that might be considered relevant in addition thereto.

Appeal No. 1998-2830  
Application No. 08/558,006

**SUMMARY**

The rejection is not sustained.

The decision of the examiner is reversed.

The application is remanded to the examiner.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal.

**REVERSED AND REMANDED**

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JOHN P. McQUADE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JOHN F. GONZALES	)	
Administrative Patent Judge	)	

bae

Appeal No. 1998-2830  
Application No. 08/558,006

Glenn M. Seager  
Crompton, Seager & Tufte, LLC  
331 Second Avenue South  
Suite 895  
Minneapolis, MN 55401-2246