

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. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL H. BURMEISTER, RICHARD E. CAPPETTA, STEVEN S.
HACKETT and PAUL SLAIKEU

Appeal No. 1999-1959
Application No. 08/881,586

ON BRIEF

Before COHEN, NASE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 28-39, which are all of the claims pending in this application.

BACKGROUND

The appellants' invention relates to intravascular guide wires. A copy of the claims under appeal is set forth in the

appendix to the appellants' brief.

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

De Toledo	WO 91/00051	Jan. 10, 1991
(International patent publication)		

Miyano	407,965	Jan. 16, 1991
(European patent application)		

The following rejections are before us for review.

Claims 28-39 stand rejected under the judicially created doctrine of double patenting based on U.S. Patent No. 5,452,726.

Claims 28-39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over De Toledo in view of Miyano.¹

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 24) for the examiner's complete reasoning in support of the rejections and to the brief and reply brief (Paper Nos. 23 and 25) for

¹ Although the final rejection (page 2) indicated that claims 32 and 38 were rejected on the basis of De Toledo alone, it is apparent from appellants' brief (page 12) that appellants understood the rejection of claims 32 and 38 to be based on De Toledo in view of Miyano. The examiner confirmed appellants' understanding on this point on page 4 of the answer.

the appellants' arguments thereagainst.

OPINION

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

Appellants do not contest the examiner's rejection of claims 28-39 under the judicially created doctrine of double patenting and have indicated that they will file a terminal disclaimer when the pending claims are found allowable over the cited prior art (brief, page 13). Accordingly, we summarily sustain the examiner's rejection.

Turning now to the examiner's rejection of claims 28-39 under 35 U.S.C. § 103(a), we note that appellants' brief (page 8) states that claims 28-39 stand or fall together. Therefore, in accordance with 37 CFR § 1.192(c)(7), we shall decide this appeal on the basis of claim 28, with claims 29-39 standing or falling therewith.

De Toledo discloses a guide wire comprising a core (wires 17, 18 joined together at coupling sleeve 24). A radiopaque,

platinum coil 19 is fitted over the distal end portion 21 of the wire 18. The core wire and platinum coil are enclosed in a sleeve 32, 34 of plastic material. The sleeve surrounding the De Toledo core wire comprises two sleeves 32, 34 having a coupling sleeve between their opposed ends. The examiner and appellants agree that De Toledo discloses a guide wire as recited in claim 28 with the exception of the radiopaque material being incorporated within the distal jacket portion.

Miyano teaches two alternatives for providing a guide wire having a core enclosed within a plastic layer with X-ray contrast characteristics. The first alternative is to fix a member made of radiopaque material to the front terminal of the distal portion 2b of the core 2 (Figure 1). The second alternative (Figure 2) is to mix pulverized X-ray contrast material with the polymer material forming the base of a layer 4 surrounding the core. Miyano points out that, as a result of the invention disclosed therein,

the position of the overall body of the guide wire can be easily confirmed under the X-ray contrast. In particular, the position of the front portion of the guide wire can be easily confirmed [page 7].

In light of the teachings of Miyano, the examiner contends that it would have been obvious to one of ordinary

skill in the art at the time of appellants' invention "to replace the radiopaque coil of De Toledo with a plastic impregnated radiopaque segment in the device of De Toledo in order to simplify the manufacturing process" (answer, page 4).

Appellants (brief, pages 9-11) argue that Miyano discloses two ways to provide radiopacity to a guide wire, one of which, like that of De Toledo, involves providing a radiopaque member at the distal end of the core wire and the other of which involves covering the entire length of a core 2 with a layer 4 having contrast characteristics. Thus, according to appellants, to make the distal tip of the guide wire more radiopaque than the proximal portion thereof, Miyano teaches one to fix a radiopaque member to the distal tip of the core. Appellants contend that neither De Toledo nor Miyano provides any teaching or suggestion for providing a distal plastic jacket portion that has enhanced radiopaque properties relative to the proximal jacket portion, as recited in the claims.

We appreciate that Miyano discloses, as the second alternative, providing a plastic layer having radiopaque materials mixed therein such that "the position of the overall body of the guide wire 1 introduced into the blood vessel can

be easily confirmed" (page 3). This language suggests that the plastic layer 4 is provided with radiopaque material over its entire length. However, we also observe that Miyano stresses that the significance of the radiopaque material is that the position of the front portion of the guide wire can easily be confirmed.

Miyano evidences that a radiopaque member at the distal end of a core of a guide wire and the incorporation of radiopaque

material in the plastic layer covering the core were recognized in the art at the time of the present invention as interchangeable alternatives for permitting the confirmation of the position of the front portion of the guide wire using X-ray techniques, the same objective taught by De Toledo. Thus, from our perspective, the incorporation of radiopaque material in the sleeve 32 of De Toledo would have been obvious to one skilled in the art as an alternate equivalent to the platinum of coil 19 for permitting the distal end of the De Toledo guide wire to be confirmed using X-ray techniques, in light of the teachings of Miyano. Further, one skilled in the art would have appreciated that it would be unnecessary to

also provide radiopaque material in the proximal sleeve 34 of De Toledo in order to achieve the objective of permitting confirmation of the distal portion of the guide wire.² Thus, in our view, one skilled in the art, in the interest of economy, would have been led by the teachings of Miyano to incorporate pulverized radiopaque material in only the sleeve 32 of De Toledo.

In that appellants' claim 28 does not require that the proximal and distal jacket portions abut one another, we consider the sleeves 32, 34, joined by coupling sleeve 24, to be a "plastic jacket," as recited in claim 28, with the sleeve 32 responding to the distal jacket portion and the sleeve 34 responding to the proximal jacket portion. The provision of radiopaque material only in the sleeve 32 would enhance the radiopaque properties of the sleeve 32 relative to the sleeve 34, as also required in claim 28.

For the foregoing reasons, we agree with the examiner's

² While there must be some suggestion or motivation for one of ordinary skill in the art to combine the teachings of references, it is not necessary that such be found within the four corners of the references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Further, in an obviousness assessment, skill is presumed on the part of the artisan, rather than the lack thereof. In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

ultimate determination that the subject matter of claim 28 would have been suggested by the combined teachings of De Toledo and Miyano. Thus, we shall sustain the examiner's rejection of claim 28, as well as claims 29-39 which fall therewith, under 35 U.S.C. § 103. However, in that our rationale for sustaining the rejection differs from that articulated by the examiner, we denominate our affirmance of the obviousness rejection as a new ground of rejection pursuant to 37 CFR § 1.196(b) in order to give appellants an opportunity to respond thereto.

CONCLUSION

To summarize, the decision of the examiner to reject claims 28-39 under the judicially created doctrine of double patenting and under 35 U.S.C. § 103 is affirmed. Our affirmance of the examiner's obviousness rejection is denominated a new ground of rejection under 37 CFR § 1.196(b) for the reasons discussed supra.

In addition to affirming the examiner's rejection of one

or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or

145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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

AFFIRMED; 37 CFR § 1.196(b)

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JENNIFER D. BAHR)	
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