

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. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM J. DRASLER, ROBERT G. DUTCHER,
MARK L. JENSON, JOSEPH M. THIELEN
and EMMANUIL L. PROTONOTARIOS

Appeal No. 1999-1964
Application No. 08/349,665

ON BRIEF

Before ABRAMS, STAAB, and BAHR, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 37-57, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellants' invention relates to a method for breaking apart and removing thrombus or other tissue from a body vessel or cavity. An understanding of the invention can be derived from a reading of exemplary claim 37, which appears in the appendix to the Brief.

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

Kensey	4,790,813	Dec. 13, 1988
Neracher	5,135,482	Aug 4, 1992 (filed Jun. 8, 1989)

Claims 37, 38 and 41-57 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kensey.

Claims 39-45 and 48-50 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Neracher.

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. 25) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 23) and Reply Brief (Paper No. 27) for 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.

The Rejection Based Upon Kensey

Independent claims 37 and 38 and dependent claims 41-57 stand rejected as being anticipated¹ by Kensey under 35 U.S.C. § 102(b). Kensey discloses an apparatus for removing deposits from arteries and the like. With reference particularly to Figures 2 and 5, the Kensey apparatus comprises a tubular member provided with a pressurized liquid supply passage 30 and a return passage 32. At the distal end of the tubular member is a cutting wheel 58 that is caused to rotate by the action of pressurized fluid emanating from passage 30, which wheel cuts plaque from the inside of the vessel as it rotates. Owing to the orientation of passages in the cutting wheel

¹Anticipation 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) and *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). Anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference. See *Verdegaal Brothers Inc. v. Union Oil Co. of California*, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987). Nor does anticipation require that the reference teach what the applicant is claiming, but only that the claim on appeal "read on" something disclosed in the reference, *i.e.*, all limitations of the claim are found in the reference. See *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984).

and in support head 36, pressurized fluid passes through turbine blades 76 to turn the cutting wheel, and then is caused to reverse its direction, at which point its flow through holes 78 induces return flow to the proximal end of the device, acting as an axial flow pump, whereby

[t]he return flow will serve to aspirate the particles of plaque being cut away by the rotating cutting head 58, and the pressure differential created by application of positive pressure through the annular passageway 30 will also serve to pull the plaque 20 into a cutting position in the path of cutting blades 70 (column 5, lines 45-50, emphasis added).

Kensey states that “[if necessary, negative pressure can be applied at the proximal end” of the return tube (column 5, lines 43-45; emphasis added), which indicates that providing suction to the proximal end of the return tube is an option. It therefore is clear that the fluid jets emanating from the end of the tubular member, on their own, “attract” the thrombus toward the tubular member, as is required by claim 37, and “help drive” the thrombus toward the tubular member, as required by claim 38. Since these claims are cast in “comprising” format, it matters not that the Kensey device and method incorporate other elements and steps.²

The only argument advanced by the appellants with regard to the rejection of claims 37 and 38 is that the fluid jets in Kensey simply cause the cutter to rotate and do

²It is well settled the use of the term "comprising" in a claim opens the claim to inclusion of elements or steps other than those recited in the claim. In re Hunter, 288 F.2d 930, 932, 129 USPQ 225, 226 (CCPA 1961).

not attract or help thrombus toward the cutter (Brief, page 6; Reply Brief, page 3). In view of the explicit teachings of Kensey set forth in the preceding paragraph, we find this argument not to be persuasive.

We therefore conclude that the methods recited in claims 37 and 38 are anticipated by Kensey, and the rejection will be sustained. Since the appellants have not argued the merits of claims 41-47 and 49-57, which are dependent from both independent claims, they are grouped with claims 37 and 38, and fall therewith.

However, we reach the opposite conclusion with regard to claim 48, which also depends from claims 37 and 38. Claim 48 recites the steps of connecting the second (discharge) passage to a metering device “which controls the rate of flow of fluid and thrombus or other material in said second passage,” and “metering the removal of thrombus or other material . . . at a rate less than the rate which would result without metering” (emphasis added). No such teaching is disclosed in Kensey. If an auxiliary device is to be used in the discharge passage, Kensey teaches that it will apply negative pressure, which is the antithesis of the steps recited in claim 48. The rejection of claim 48 as being anticipated by Kensey is not sustained.

The Rejection Based Upon Neracher

This rejection under 35 U.S.C. § 102(e) is directed to independent claims 39 and 40 and dependent claims 41-45 and 48-50. Neracher discloses a device and method

for removing organic deposits obstructing a vessel which comprises, with reference to Figure 4, a first passage 11 for supplying fluid to a nozzle 22 from which emanates a fluid jet that “strikes deposit B and destroys it, dismantles it, or disintegrates it,” after which the liquid is evacuated together with the deposit matter by a pump (column 2, lines 49-57). The fluid is supplied at supersonic speed under a pressure of 6×10^7 Pa (column 1, lines 23-24, which is much greater than the 1000 psi required by claim 40.

The only argument advanced by the appellants in opposition to the examiner’s conclusion is that the Neracher system utilizes two telescoping tubular members which can move independently of one another, whereas “[a]pplicants’ device employs a singular tubular member with a first and second passage” (Brief, page 7; Reply Brief, page 5). We agree with the examiner, however, that the claim reads on the assembled Neracher apparatus, and that the claimed method is performed by Neracher.

We therefore will sustain the rejection of claims 39 and 40, as well as this rejection of dependent claims 41-46, 49 and 50, which depend from both independent claims, and with regard to which the separate patentability was not argued.

As was the case with the Kensey rejection, the subject matter recited in dependent claim 48 is not disclosed or taught by Neracher, and we therefore will not sustain the rejection of claim 48 as being anticipated by Neracher.

CONCLUSION

The rejection of claims 37, 38, 41-47 and 49-57 as being anticipated by Kensey is sustained.

The rejection of claim 48 as being anticipated by Kensey is not sustained.

The rejection of claims 39-45, 49 and 50 as being anticipated by Neracher is sustained.

The rejection of claim 48 as being anticipated by Neracher is not sustained.

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

NEAL E. ABRAMS
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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