



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/243,381	09/12/2002	Jerry Brightbill	P1071 US	5209
28390	7590	02/20/2013	EXAMINER	
MEDTRONIC VASCULAR, INC. IP LEGAL DEPARTMENT 3576 UNOCAL PLACE SANTA ROSA, CA 95403			GRAY, PHILLIP A	
			ART UNIT	PAPER NUMBER
			3767	
			NOTIFICATION DATE	DELIVERY MODE
			02/20/2013	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

rs.vasciplegal@medtronic.com
medtronic_cv_docketing@cardinal-ip.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JERRY BRIGHTBILL

Appeal 2010-007058
Application 10/243,381
Technology Center 3700

Before STEFAN STAICOVICI, MICHELLE R. OSINSKI, and
BRADFORD E. KILE, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Jerry Brightbill (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision finally rejecting claims 1, 11, 31, and 32 under 35 U.S.C. § 103(a) as unpatentable over Ju (US 5,725,513, iss. Mar. 10, 1998) and Pourrezaei (US 5,685,961, iss. Nov. 11, 1997) and over Pourrezaei and Ju¹. Claims 3-10, 12-27, 29, and 30 have been withdrawn and claims 2 and 28 have been canceled. We have jurisdiction over this appeal under 35 U.S.C. § 6.

THE INVENTION

Appellant's invention relates to a "reinforced catheter [10] having a non-filamentous, seamless metal tube [25] interposed between a polymeric hollow core [20] and a polymeric outer jacket [30]." Spec. 2, para. [0006]; Spec. 3, para. [0015]; and fig. 1.

Claim 1 is illustrative of the claimed invention and reads as follows:

1. A reinforced catheter having proximal and distal ends, the catheter comprising:
 - an elongate, flexible, polymeric, hollow tubular core extending between the proximal and distal ends of the catheter;
 - the core having an outer surface with a tubular, seamless, metallized layer formed directly and adherent thereon of between 0.0005 and 0.002 inches thickness to define a reinforcement layer to enhance the ability of the catheter to transmit controllably to the distal end rotation applied to the proximal end; the reinforcement layer extending from the catheter proximal end to the catheter distal end and

¹ The rejection of claims 1 and 32 under 35 U.S.C. § 112, second paragraph, for being indefinite, has been withdrawn by the Examiner. Ans. 3.

a flexible, polymeric jacket surrounding and fully covering the reinforcement layer and extending from the catheter proximal end to the catheter distal end.

SUMMARY OF DECISION

We REVERSE.

ANALYSIS

The obviousness rejection based upon Ju and Pourrezaei

The Examiner found that Ju discloses a reinforced catheter 12 having a proximal end and a distal end and including a polymeric core 28, a tubular reinforcement layer 30 or 38, and a flexible polymer jacket 32. Ans. 3 and 6; *see also* Ju, col. 4, l. 66 through col. 5, l. 4 and fig. 6. The Examiner further found that, “Ju does not explicitly disclose the tubular metal reinforcement layer electroplated or electroless plated or sputter coated or vapor deposited.” Ans. 5. Thus, the Examiner turned to the teachings of Pourrezaei to describe “a metal reinforcement layer [that is] electroplated/sputter coated/electroless plated onto a polymeric core of a catheter.” *Id.* (citing to Pourrezaei, col. 3, l. 46 through col. 4, l. 32; col. 12, l. 48 through col. 13, l. 17; and col. 16, ll. 32-55). The Examiner concluded that “it would [have been] obvious to one of ordinary skill in the art at the time of the invention to modify the device of Ju with the teachings of Pourrezaei in order to reinforce the catheter by filling in the cracks and to help fight infection/rejection.” *Id.*

Appellant argues that, “[t]here is no evidence to support the posited combination of Pourrezaei and Ju.” Br. 6. According to Appellant, “[t]here is no demonstrated reason for selecting what is necessarily an externally

exposed film of Pourrezaei and incorporating it into an internal, concealed feature of another catheter where the film would be unable to perform its intended function of resisting infection.” *Id.* In other words, Appellant contends that the Examiner has not provided a rational underpinning for the reasoning underlying the rejection of claims 1, 11, 31, and 32.

In response, the Examiner notes that:

[T]he Pourrezaei reference is not being used to teach the metal reinforcement layer but rather teaching "electroplated or electroless plated or sputter coated or vapor deposited" this metal layer (metal reinforcement layer taught in Ju). Examiner is using Pourrezaei to teach a method of applying the layer and Ju to teach the metal reinforcement layer in the first place.

Ans. 14.

Without an articulated rationale based on rational underpinning for modifying the reference as proposed, the Examiner's rejection appears to be the result of hindsight analysis. *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (*cited with approval in KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007)) ("rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness").

With respect to the Examiner's first stated reasoning to combine the teachings of Ju and Pourrezaei, *i.e.*, "reinforce the catheter by filling in the cracks," we note that the Examiner has not provided any findings that Ju recognized a problem with cracking of its tubular reinforcement layer 30 or 38. Thus, because Ju does not have a cracking problem of its tubular reinforcement layer 30 or 38, we find the Examiner's rejection insufficient

to explain what in the prior art would have prompted a person having ordinary skill in the art to electroplate/sputter coat/electroless plate Ju's internal tubular reinforcement layer 30 or 38 "in order to reinforce the catheter by filling in the cracks," as the Examiner proposes.

Regarding the Examiner's second stated reasoning to combine the teachings of Ju and Pourrezaei, *i.e.*, "reinforce the catheter . . . to help fight infection/rejection," we note that Pourrezaei specifically discloses that electroplating/sputter coating/electroless plating a metallic tubular reinforcement layer on the exterior of a catheter inhibits or kills microbes "in a region immediately adjacent to the catheter surface." Pourrezaei, col. 5, ll. 35-36; col. 6, ll. 8-14; and fig. 1. As such, we agree with Appellant that in order for the catheter of Ju as modified by Pourrezaei to be able to "fight infection/rejection," as the Examiner proposes, the electroplated/sputter coated/electroless plated tubular reinforcement layer 30 or 38 would have to be positioned on the exterior of the catheter and not between a polymeric core and a polymeric jacket. *See* Br. 6. Hence, we find the Examiner's rejection insufficient to explain what in the prior art would have prompted a person having ordinary skill in the art to electroplate/sputter coat/electroless plate Ju's internal tubular reinforcement layer 30 or 38.

In conclusion, the Examiner does not provide any support for the allegation that electroplating, sputter coating or electroless plating, as taught by Pourrezaei, of Ju's internal tubular reinforcement layer 30 or 38, would "reinforce the catheter by filling in the cracks and . . . help fight infection/rejection." Thus, absent hindsight, we fail to see why one having ordinary skill in the art would have been led by the teachings of Pourrezaei to modify the catheter of Ju in the manner claimed. As such, we cannot

sustain the rejection of claims 1, 11, 31, and 32 under § 103(a) as unpatentable over Ju and Pourrezaei.

The obviousness rejection based upon Pourrezaei and Ju

The Examiner found that Pourrezaei discloses all the limitations of independent claims 1, 31, and 32 with the exception of a “flexible polymeric jacket surrounding the reinforcement layer.” Ans. 9. The Examiner further found that “[t]he Ju reference teaches a polymeric flexible jacket around a metal layer.” *Id.* The Examiner concluded that, “it would be obvious to one of ordinary skill in the art at the time of the invention to modify the device of Pourrezaei with the teachings of Ju in order to provide a desired thickness and ‘feel.’” *Id.* (citing to Ju, col. 5, ll. 3-29).

Appellant argues that if “a polymeric jacket were added to Pourrezaei to cover the film, Pourrezaei would lose its anti-bacterial function and would be inoperative for its intended purpose.” Br. 6.

It is well settled that where the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, the proposed modification would not have been obvious. *See Tec Air, Inc. v. Denso Mfg. Mich., Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999); *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984). “A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). In this case, Pourrezaei specifically discloses that having a metallic layer on the outer surface of a catheter when placed in contact with the interdermal layer

(dermis 22, adventitia 24) inhibits or kills microbes “in a region immediately adjacent to the catheter surface.” Pourrezaei, col. 5, ll. 35-36; col. 6, ll. 8-14; and fig. 1. Thus, the catheter of Pourrezaei functions by having the external metallic layer come into contact with body tissue. As such, the function of the metallic reinforcement layer of Pourrezaei would have discouraged a person of ordinary skill in the art from providing the external polymeric jacket of Ju. Accordingly, the modification proposed by the Examiner of providing the external polymeric jacket of Ju to the metallic reinforcement layer of Pourrezaei’s catheter would not have been obvious to the person of ordinary skill in the art.

Thus, for the foregoing reasons, we cannot sustain the rejection of independent claims 1, 31, and 32, and dependent claim 11, under 35 U.S.C. § 103(a) as unpatentable over Pourrezaei and Ju.

SUMMARY

The Examiner’s decision to reject claims 1, 11, 31, and 32 is reversed.

REVERSED

hh