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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MICHAEL J. LEONARD and BINH T. NGUYEN

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Appeal 2011-003731  
Application 11/957,237  
Technology Center 3700

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Before DONALD E. ADAMS, DEMETRA J. MILLS, and ERIC GRIMES,  
*Administrative Patent Judges.*

ADAMS, *Administrative Patent Judge.*

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134 involves claims 1-18 (App. Br. 3; Ans. 2). We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

The claims are directed to a catheter for delivering an agent to an inner surface of a patient's body lumen wall (claims 1-13) and a method of performing a medical procedure (claims 14-18). Claim 1 is representative and is reproduced in the Claims Appendix of Appellants' Brief.

Claims 1, 12, and 14 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Saadat.<sup>1</sup>

Claims 1-10, 12, 14-16, and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Saadat and Valencia.<sup>2</sup>

Claims 11 and 17 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Saadat, Valencia, and Barbut.<sup>3</sup>

Claim 13 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Saadat, Valencia, and Machold.<sup>4</sup>

We affirm.

*Anticipation:*

ISSUE

Should the rejection under 35 U.S.C. § 102(e) be summarily affirmed by the Board?

ANALYSIS

“If a ground of rejection stated by the examiner is not addressed in the appellant’s brief, that ground of rejection will be summarily sustained by the Board.” Manual of Patent Examining Procedure § 1205.02 (Rev. 8, July 2010). Appellants do not address the rejection under 35 U.S.C. § 102(e), therefore it is summarily affirmed.

CONCLUSION OF LAW

The rejection of claims 1, 12, and 14 under 35 U.S.C. § 102(e) is summarily affirmed.

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<sup>1</sup> Saadat et al., US 2008/0015569 A1, published January 17, 2008.

<sup>2</sup> Valencia et al., US 2006/0030814 A1, published February 9, 2006.

<sup>3</sup> Barbut et al., US 6,592,546 B1, issued July 15, 2003.

<sup>4</sup> Machold et al., US 5,611,775, issued March 18, 1997.

*Obviousness:*

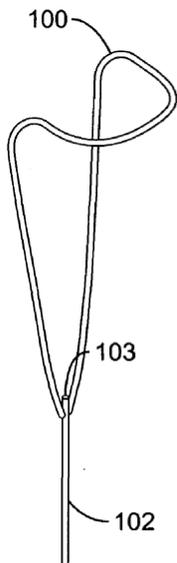
ISSUE

Does the preponderance of evidence on this record support a conclusion of obviousness?

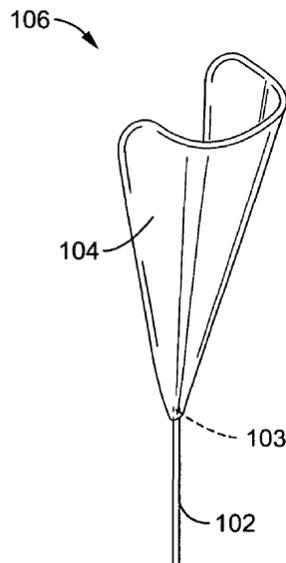
FACTUAL FINDINGS (FF)

FF 1. Examiner finds that Saadat suggests all elements of Appellants' claim 1 with the exception of "a frame fixedly mounted to the distal shaft and secured to the membrane" (Ans. 5).

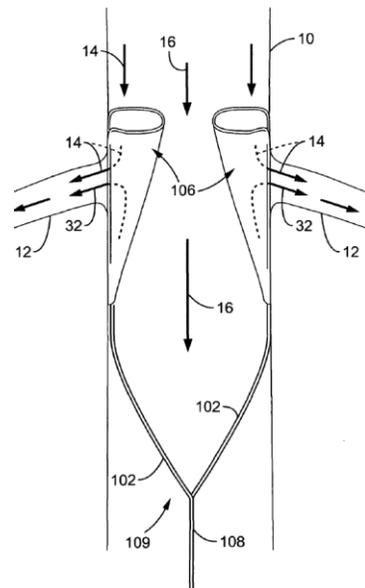
FF 2. Valencia's Figures 9-11 are reproduced below:



**FIG. 9**



**FIG. 10**



**FIG. 11**

"In [Valencia's] **FIG. 9**, a metal frame **100** is shaped in a scallop shape by making an arc loop and bending it 90 degrees. The ends of frame **100** are formed into a 'V' shape. Agent delivery tube **102** with agent delivery port **103** is coupled to frame **100** at the wire ends" (Valencia 13: ¶ [0158]).

Valencia's "**FIG. 10** illustrates a fabric covering **104** fastened over frame **100** to form a semi conical scallop assembly **106**.... Because fabric **104** is supported by frame **100**, it maintains a predictable shape during use" (*id.* at

¶ [0159]). “In [Valencia’s] **FIG. 11**, two scallop assemblies **106** as shown in **FIG. 10**, with concave surfaces facing outward, are connected by a center tube **108** in fluid communication with agent delivery tubes **102** and agent delivery ports **103** ... to form a bifurcated scallop assembly **109**” (*id.* at ¶ [0160]).

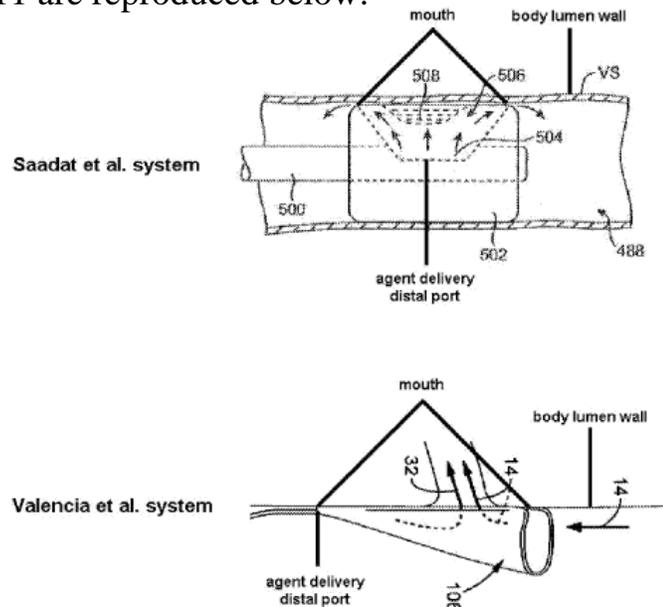
FF 3. Examiner finds that Valencia suggests

[A] frame 100 (Fig 11) fixedly mounted to a distal shaft section 102 (Fig 11; Para 158) ... having ... a radially expandable body section 100c ... between the proximal and distal ends of the frame and a *funnel shaped membrane* 104 (Fig 10) secured to the body section of the frame (Para 159) so that a mouth 104a ... radially expands with the frame away from the shaft ... for the purpose of supporting the membrane and maintaining a predictable shape during use.

(Ans. 5.)

FF 4. Examiner’s annotations of Saadat’s Figure 46A and a portion of Valencia’s Figure 11 are reproduced below:

**Fig E**



Examiner’s annotation illustrates that Valencia’s “frame is similar in construction to the membrane of Saadat ... as both have agent delivery distal

ports ... that open to deliver fluid to a mouth ... which opens from a collapsed configuration ... to an expanded configuration wherein the mouth engages a body lumen wall” (*id.* at 22-23).

FF 5. Examiner finds that the combination of Saadat and Valencia fails to suggest a “frame possessing a plurality of struts” and relies on Barbut to make up for this deficiency (*id.* at 14-15).

FF 6. Examiner finds that the combination of Saadat and Valencia fails to suggest a “shaft compris[ing] an outer and an inner tubular member” and relies on Machold to make up for this deficiency (*id.* at 16).

#### ANALYSIS

Based on the combination of Saadat and Valencia, Examiner concludes that, at the time Appellants’ invention was made, it would have been *prima facie* obvious to “modify Saadat ... to include a frame, as taught by Valencia ... for the purpose of supporting the membrane and maintaining a predictable shape during use” (Ans. 5). Examiner explains that Valencia “is not used to teach a funnel-shaped membrane or a chamber since these structures are provided by ... Saadat,” but instead, Valencia is relied upon to suggest “that one of ordinary skill in the art at the time the invention was made would have combined the frame of Valencia ... with the structure of Saadat ... for the purpose of supporting the membrane and providing a predictable shape to the membrane during use” (*id.* at 20; *see also id.* at 21).

Appellants contend that Valencia’s “scallop assemblies ... do not form a funnel” (App. Br. 14; *see* FF 2). In this regard, Appellants contend that

While the Examiner asserts that ... Saadat ... describes a balloon structure that already provides ..., (a) a **funnel**-shaped membrane, (b) an inner surface of the membrane which defines

a **chamber**, (c) the longitudinal axis of the funnel shaped member being **substantially perpendicular** to the axis of the shaft, and (d) the **entire** mouth of the funnel shaped membrane being capable of engaging a body lumen wall, it is unclear why one skilled in the art would be motivated ... to combine such balloon structure with a frame structure, as disclosed in ... Valencia ... that is incapable of providing **any** of such features.

(*Id.* at 14-15.) We are not persuaded for the reasons set forth by Examiner (FF 3-4). In sum, the combination suggests placing Valencia's frame in Saadat's device in an orientation wherein the mouth of Valencia's frame aligns with the mouth of Saadat's device so as to provide support to Saadat's membrane (*see* FF 4). Therefore, notwithstanding Appellants' contentions to the contrary, a person of ordinary skill in this art, at the time of Appellants' claimed invention, would have recognized that the combination of Valencia's frame with Saadat's device would facilitate rather than impede all of the features outlined by Appellants above (*see* FF 3-4). Therefore, we are not persuaded by Appellants' contention that "Examiner has simply selected references which show various components recited in the claims and has combined them without consideration as to whether a functioning system would be created" (App. Br. 16).

Having found no deficiency in the combination of Saadat and Valencia, we are not persuaded by Appellants' contention that Barbut and Machold fail to make up for the deficiencies in the combination of Saadat and Valencia (App. Br. 16-17).

#### CONCLUSION OF LAW

The preponderance of evidence on this record supports a conclusion of obviousness. The rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over the combination of Saadat and Valencia is affirmed.

Appeal 2011-003731  
Application 11/957,237

Claims 2-10, 12, 14-16, and 18 are not separately argued and fall together with claim 1. The rejection of claim 11 under 35 U.S.C. § 103(a) as unpatentable over the combination of Saadat, Valencia, and Barbut is affirmed. Claim 17 is not separately argued and falls together with claim 11. The rejection of claim 13 under 35 U.S.C. § 103(a) as unpatentable over the combination of Saadat, Valencia, and Machold is affirmed.

**TIME PERIOD FOR RESPONSE**

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

**AFFIRMED**

cdc