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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO. Includes details for application 11/591,447, inventor Martin T. Gerber, and examiner D ABREU, MICHAEL JOSEPH.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARTIN T. GERBER

Appeal 2011-008920
Application 11/591,447
Technology Center 3700

Before LORA M. GREEN, FRANCISCO C. PRATS, and
ERICA A. FRANKLIN, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant requests reconsideration of the Decision on Appeal entered October 31, 2012, which reversed the Examiner's anticipation and obviousness rejections and entered a New Ground of rejection, pursuant to 37 C.F.R. § 41.50(b). We have considered the arguments presented, but deny the requested relief.

BACKGROUND

Appellant's claims are directed to an implanted elongated member comprising a balloon fixation element "composed at least in part of a biocompatible degradable material," a system including an elongated member comprising such a balloon fixation element, and a method comprising inserting into a patient an elongated member including such a balloon fixation element. (*See, e.g.*, Claims 1, 14, and 21.) The Examiner rejected the claims as anticipated and obvious. We reversed the Examiner's rejections and entered a New Ground of rejection. (Decision 6-8.)

Appellant requests rehearing, alleging:

Appellant believes the Board overlooked Appellant's arguments that a skilled artisan would have recognized that it would be undesirable to construct the balloons 2002, 2004 disclosed by Karicherla at least in part of a degradable material because when the balloons are filled with a fluid and implanted within the patient's heart, degradation of the degradable material could lead to the release of the fluid into the patient's heart or bloodstream, which would be undesirable.

(Reh. Req. 3-4.)

ANALYSIS

We have carefully reviewed Appellant's arguments presented in the Request for Rehearing, but do not find them convincing. In particular, the Decision addresses the argument that Appellant asserts was overlooked. In the Decision, we stated, in part:

The amount or duration of time over which the material degrades is not specified, or otherwise limited in either Karicherla or the instant Specification. Thus, a skilled artisan may select a biodegradable material that requires a degradation time that would extend beyond the length of time that the balloon fixation element would be used in and removed from a patient, such that any

potential harmful effects of the degradation *in vivo* may be avoided.

(Decision 8.) Appellant acknowledges this statement in the Request for Rehearing. (Reh. Req. 4.)

To the extent Appellant asserts that the Board misapprehended their argument (Reh. Req. 5) we remain unpersuaded. Appellant's arguments presume that forming Karicherla's balloon attachment structure from a degradable material would lead to adverse effects. (*See id.* at 3-4.) However, Appellant has not pointed to any evidence in the record supporting this presumption. As discussed in the Decision, "the *amount* or *duration of time* over which the material degrades is not specified, or otherwise limited in either Karicherla or the instant Specification." (Decision 8)(Emphasis added). In other words, there is no teaching or requirement that the amount or timing of degradable material used would result in the material degrading to the extent of adversely releasing fluid within the heart, as alleged by Appellant.

Appellant further challenges the Decision by asserting that "such a justification appears to negate the reason disclosed by Karicherla for using a biodegradable material, and evidences the use of hindsight reconstruction of independent claim 1." (Reh. Req. 4.) As discussed in the Decision, Karicherla disclosed that "[i]n some embodiments the attachment structure may be constructed of a biodegradable material that degrades over time." (Decision 5, FF-4.) While Karicherla provided an exemplary case where such use may be used, i.e., "where it may be necessary to remove the lead sometime in the future," this disclosure does not suggest that this is the only case wherein a biodegradable material may be beneficial. In other words, a

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skilled artisan would have understood Karicherla's disclosure as a teaching that a biodegradable material may be used in the construction of its balloon structures in *any* case wherein it is desirable to have a structure that "degrades over time." (*See* Decision 7-8.) Such use of a biodegradable material was suggested by the reference and not the result of hindsight reconstruction.

CONCLUSION OF LAW

We have considered Appellant's request, but find no point of law or fact which we overlooked or misapprehended in arriving at our decision.

SUMMARY

We deny the requested relief.

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

DENIED

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