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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ISAAC OSTROVSKY

Appeal 2011-009091
Application 11/289,981
Technology Center 3700

Before DONALD E. ADAMS, LORA M. GREEN, and
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-9 and 16-21.¹ We have jurisdiction under 35 U.S.C. § 6(b).

¹ Claim 15 is also pending, but stands objected to as being dependent upon a rejected base claim (Ans. 5).

STATEMENT OF THE CASE

Claim 1 is the only independent claim on appeal, and reads as follows:

1. An imaging catheter having distal and proximal ends and a lumen, comprising:
 - a coaxial cable comprising a center wire, an outer shield, and a distal end;
 - an imaging transducer assembly located within the lumen of a distal portion of the catheter, the imaging transducer assembly including an imaging transducer; and
 - a sensor adapted to communicate with a medical positioning system, wherein the sensor and the imaging transducer are each electrically coupled, in a parallel electrical configuration with respect to each other, to the center wire and the outer shield at the distal end of the coaxial cable.

The following grounds of rejection are before us for review:

Claims 1-9 and 16-21² stand rejected under 35 U.S.C. § 103(a) as being rendered obvious by the combination of Ben-Haim³ and Sieben⁴(Ans. 4).

We reverse.

ANALYSIS

The Examiner finds that Ben Hain “discloses an imaging catheter for use in intracardiac drug delivery including an imaging element at the distal end” (Ans. 4). The Examiner notes that Ben-Haim “fails to disclose the use of a coaxial cable for running the system in parallel with the sensor” (*id.*).

² The statement of rejection refers to claims 1-14 and 16-23, but claims 22 and 23 appear to have been cancelled (App. Br. 5).

³ Haim et al., US 6,309,370 B1, issued Oct. 30, 2001.

⁴ Sieben., US 6,309,370 B1, issued Oct. 30, 2001.

The Examiner finds that Sieben “teaches the use of a coaxial cabling (col. 12, lines 25-29, fig. 43), wherein the sensor and the imaging transducer are electrically coupled in a parallel configuration (col. 43, lines 52-60)” (*id.*). The Examiner concludes that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to have included the connection components of Sieben with the system of Ben-Haim et al for the purpose of providing the best signal and clearest diagnostic image possible with very little loss or distortion from noise or crosstalk” (*id.* at 5).

Appellants argue that “Sieben does not teach or suggest a sensor adapted to communicate with a medical positioning system and an imaging transducer in a parallel electrical configuration with respect to the sensor as recited in claim 1” (App. Br. 10). Appellants assert that the “CCD arrays of Siben are not ‘adapted to communicate with a medical positioning system’ as recited in claim 1,” but are “used to receive the signals from the ultrasound transducer as explained at Col. 42, line 57 to Col 43, line 38” (*id.*). Appellants thus assert that the CCD arrays do not correspond to the claimed sensor and any teaching regarding them is irrelevant to the invention of claim 1 (*id.*).

We agree with Appellants that the Examiner has failed to set forth a prima facie case of obviousness. “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.” *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, 417-18 (2007).

Here, the Examiner points to two disparate teachings in the Sieben reference, but does not explain how the coaxial cable relates to the CCD array relates to the coaxial cabling, or how the teaching of the CCD array by Sieben relates to “a sensor adapted to communicate with a medical positioning system, wherein the sensor and the imaging transducer are each electrically coupled, in a parallel electrical configuration with respect to each other, to the center wire and the outer shield at the distal end of the coaxial cable,” as required by claim 1. The rejection is thus too cursory to pass the *Kahn* test, and it is thus reversed.

REVERSED

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