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SHUMAKER & SIEFFERT, P.A 1625 RADIO DRIVE, SUITE 100 WOODBURY, MN 55125			D ABREU, MICHAEL JOSEPH	
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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* MARTIN T. GERBER

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Appeal 2014-005032  
Application 11/591,448<sup>1</sup>  
Technology Center 3700

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Before STEFAN STAICOVICI, GEORGE R. HOSKINS, and  
ARTHUR M. PESLAK, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Martin T. Gerber (Appellant) appeals under 35 U.S.C. § 134(a) from the Examiner's final decision rejecting claims 1–13, 16–20, 23–26, and 40–43.<sup>2</sup> We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We REVERSE.

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<sup>1</sup> According to Appellant, the real party in interest is Medtronic, Inc. Appeal Br. 3 (filed Dec. 20, 2013).

<sup>2</sup> Claims 14, 15, 21, 22, and 27–39 are canceled. *See* Appellant's Amendment 4–5 (filed Dec. 7, 2010).

## INVENTION

Appellant's invention relates to "[e]lectrical stimulation systems . . . used to deliver electrical stimulation therapy to patients." Spec. ¶ 2.

Claims 1 and 20 are independent. Claim 1 is illustrative of the claimed invention and reads as follows:

1. An implantable elongated member configured to deliver a therapy from a medical device to a target therapy delivery site in a patient, the implantable elongated member comprising:
  - an elongated body extending between a proximal end configured to couple to the medical device and a distal end, wherein the elongated body comprises:
    - a proximal portion including the proximal end;
    - a distal portion including the distal end; and
    - a middle portion located between the proximal portion and the distal portion and adjacent to the proximal portion and distal portion, wherein the proximal portion, the distal portion, and the middle portion have approximately equal lengths;
  - a first fixation element coupled to the proximal portion of the elongated body;
  - a second fixation element coupled to the distal portion of the elongated body; and
  - a third fixation element coupled to the middle portion of the elongated body.

## REJECTIONS

The following rejections are before us for review:

- I. The Examiner rejected claims 1–6, 9–13, 16–20, 23–26, and 40–43 under 35 U.S.C. § 103(a) as being unpatentable over

Swoyer (US 2003/0045919 A1, pub. Mar. 6, 2003) and Mrva (US 2006/0004429 A1, pub. Jan. 5, 2006).<sup>3</sup>

- II. The Examiner rejected claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Swoyer, Mrva, and Tronnes (US 2006/0095078 A1, pub. May 4, 2006).

## ANALYSIS

### *Rejection I*

Each of independent claims 1 and 20 requires, *inter alia*, an “elongated body extending between a proximal end . . . and a distal end . . . [having] a proximal portion . . . [,] a distal portion . . . [,] and a middle portion . . . , wherein the proximal portion, the distal portion, and the middle portion have approximately equal lengths.” *See* Appeal Br. 16, 19 (Claims App.).

The Examiner finds that Swoyer discloses an implantable elongated member having

3 portions - a proximal portion including the proximal end (i.e. Fig. 1 - extending from distal end of #140 to proximal end of #105), a distal portion including the distal end (i.e. Fig. 1 - extending from distal tip to proximal end of #125) and a middle portion located between and adjacent to the proximal portion and distal portion (i.e. Fig. 1 - extending from proximal end of #125 to distal end of #140).

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<sup>3</sup> As claims 9 and 16 are discussed in the body of this rejection, we consider the omission of these claims in the heading of the rejection as an inadvertent typographical error. *See* Final Act. 2, 4 (transmitted June 7, 2013).

Final Act. 3. The Examiner further finds that Mrva discloses an elongated member 12 having fixation elements 76 “coupled to the proximal, distal, and middle portions of the body in order to allow the fixation members to have room to collapse during insertion to prevent undesired contact with tissue while ensuring uniform fixation over the elongated member.” *Id.* (citing Mrva ¶¶ 128–129, Fig. 38). The Examiner concludes that:

It would have been an obvious design choice to one of ordinary skill in the art to modify the device of Swoyer to have tines placed in approximately equal proximal, distal, and middle regions as in Mrva, in order to yield the predictable results of providing tines which distribute the fixation throughout the length of the lead. Additionally, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the tine distribution along length of the proximal, middle, and distal sections of Swoyer to be approximately equal since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

*Id.* at 3–4.

Thus, according to the Examiner, Swoyer discloses “the presence of a proximal, middle, and distal portion with tines coupled to each portion” and “Mrva is simply introduced as a secondary reference to help obviate the placing of tines and fixation elements in ‘approximately equal’ lengths.” Ans. 3 (transmitted Jan. 31, 2014).

Appellant argues that in contrast to the Examiner’s position, Mrva fails to disclose that fixation elements 76 are placed in the proximal, distal, and middle portions of lead 12, but rather are all located in the distal portion of lead 12. *See* Appeal Br. 7. Thus, as Mrva fails to disclose the claimed locations of fixation elements 76, Appellant contends that the Examiner’s

reasoning to modify the implantable elongated member of Swoyer, according to Mrva, namely, “to . . . provid[e] tines which distribute the fixation throughout the length of the lead,” lacks rational underpinnings. *Id.* at 9.

As Mrva discloses a lead 12 having a proximal end including plug 22 and a distal end including electrode 16 (*see* Mrva ¶ 43, Fig. 3), we agree with Appellant that Mrva’s tines 76 are likewise located in the distal portion of lead 12. *See* Reply Br. 6 (citing Mrva, Figs. 34, 38A, 38B). Moreover, as correctly noted by Appellant, in Figure 5B of Mrva, the entire lead 12 is implanted in the patient’s body and electrode 16 is located at the distal tip of lead 12. *Id.* at 7. Appellant is thus correct that Figures 38A and 38B of Mrva “simply show the distal tip of the lead 12.” *Id.* at 6. Hence, as Mrva discloses tines 76 located at the distal end of lead 12, we do not agree with the Examiner’s finding that Mrva discloses fixation elements/tines “coupled to the proximal, distal, and middle portions of the [lead] body.” *See* Final Act. 3. Therefore, because Mrva fails to disclose providing tines at proximal, middle, and distal portions of the body of an implantable elongated member, but rather only at the distal tip of lead 12, the Examiner’s reasoning to modify the device of Swoyer is based on an erroneous interpretation of the disclosure of Mrva. Accordingly, the Examiner’s legal conclusion of obviousness is not supported by facts, and thus, cannot stand. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). We thus agree with Appellant that the Examiner’s reasoning to combine the teachings of Swoyer and Mrva, namely, to “distribute the fixation throughout the length of the lead,” lacks rational underpinnings. *See* Appeal Br. 9.

Furthermore, Appellant is correct in that “[a] particular parameter must first be recognized as a result-effective parameter . . . before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.” Appeal Br. 9. Although we appreciate the Examiner’s finding that Swoyer discloses positioning tines in both proximal and distal sections of lead 15 (*see* Ans. 3 (citing Swoyer ¶ 69)), this does not mean that the lengths of the distal, middle, and proximal portions can be recognized as result-effective variables. Even though each of the distal, middle, and proximal portions of Swoyer’s lead 15 has a certain length, the Examiner has not cited to any portion of Swoyer or other prior art that actually recognizes such lengths as result-effective variables. Moreover, we note that claims 1 and 20 do not require that the distribution of the fixation elements (i.e., tines) along the length of the elongated body of the claimed implantable elongated member be at equal lengths, as the Examiner contends, but rather that the proximal, middle, and distal portions of the body “have approximately equal lengths.”

In conclusion, for the foregoing reasons, we do not sustain the rejection under 35 U.S.C. § 103(a) of claims 1–6, 9–13, 16–20, 23–26, and 40–43 as being unpatentable over Swoyer and Mrva.

*Rejection II*

The Examiner's use of Tronnes's disclosure does not remedy the deficiencies of Swoyer and Mrva as discussed *supra*. See Final Act. 5. Therefore, for the same reasons as discussed above, we also do not sustain the rejection of claims 7 and 8 over the combined teachings of Swoyer, Mrva, and Tronnes.

SUMMARY

The Examiner's decision to reject claims 1–13, 16–20, 23–26, and 40–43 is reversed.

REVERSED