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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOHN WARDLE
and ANDREW T. SCHIEBER

Appeal 2015-002504
Application 12/833,852
Technology Center 3700

Before STEFAN STAICOVICI, JAMES P. CALVE, and
WILLIAM A. CAPP, *Administrative Patent Judges*.

CALVE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the final rejection of claims 1–9 and 26–34. *See* Appeal Br. 14. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

CLAIMED SUBJECT MATTER

Claims 1, 26, and 30 are independent. Claim 1 is reproduced below.

1. An ocular implant delivery system, comprising:
 - a housing;
 - a cannula coupled to the housing, the cannula sized and configured for insertion into Schlemm's canal of a human eye;
 - a delivery mechanism disposed on the housing, the delivery mechanism configured to advance and retract an ocular implant within the cannula; and
 - an orientation mechanism disposed on the housing, the orientation mechanism configured to control rotation of the cannula with respect to the housing, the orientation mechanism being further configured to maintain an orientation of the ocular implant with respect to the cannula when the cannula is rotated.

REJECTIONS¹

Claims 1–9 and 26–29 are rejected under 35 U.S.C. § 103(a) as unpatentable over De Juan, Jr. (US 2007/0191863 A1, pub. Aug. 16, 2007) (“De Juan”), McIntyre (US 2006/0178674 A1, pub. Aug. 10, 2006), and Lynch (US 2003/0236484 A1, pub. Dec. 25, 2003).

Claims 30–34 are rejected under 35 U.S.C. § 103(a) as unpatentable over De Juan, McIntyre, Lynch, and Cartledge (US 2005/0149114 A1, pub. July 7, 2005).

¹ The Examiner withdrew the rejection of claims 26–34 under 35 U.S.C. § 112, second paragraph, for indefiniteness. *See* Ans. 2.

ANALYSIS

Claims 1–9 and 26–29 as unpatentable over De Juan, McIntyre, Lynch

The Examiner found that De Juan teaches an ocular implant delivery system comprising a housing (handle component 515), a cannula (advancing structure 530), a delivery mechanism (knob 550) disposed on the housing and configured to advance and retract ocular implant 105 within the cannula as recited in independent claims 1 and 26. Final Act. 6, 10. The Examiner found that De Juan does not teach an orientation mechanism on the housing, but McIntyre teaches a surgical device having a housing (handle 12) with an orientation mechanism (nosecone 16) configured to control the rotation of a cannula (tubular guide shaft 20). *Id.* at 7, 10. The Examiner relied on Lynch to teach the deploying of stents and shunts in Schlemm’s canal. *Id.* at 7, 11.

Appellants argue that De Juan’s cannula and delivery mechanism are not configured “to advance and retract an ocular implant within the cannula” as recited in claims 1 and 26. Appeal Br. 5, 9. Appellants also argue that De Juan’s element 530, which the Examiner equates to a cannula, is a push tube that pushes implant 105 off of applier 525, either by moving push tube 530 distally while applier 525 is held stationary, or by withdrawing applier 525 while holding push tube 530 stationary. *Id.* Appellants argue that implant 105 is mounted on applier 525 and is never inside of push tube 530. *Id.* Appellants further argue that if implant 105 fit inside of push tube 530, then push tube 530 could not perform its function of pushing implant 105 off of applier 525, as De Juan discloses. *Id.* Appellants also argue that De Juan cannot retract the implant and thus lacks a cannula and delivery mechanism configured to advance and retract an ocular implant within the cannula. *Id.* at 5–6. We agree.

The Examiner's finding that De Juan teaches a cannula and delivery mechanism configured to advance and retract an ocular implant within the cannula is not supported by a preponderance of evidence. De Juan teaches that the cannula (advancing structure 530) is configured to allow applicator 525 to advance and retract in advancing structure 530 as shown in Figures 6C–6G. De Juan teaches that applicator 525 is sized to fit through the lumen in the ocular implant (shunt 105) so shunt 105 is mounted on applicator 525. De Juan ¶ 110. Shunt 105 is not advanced or retracted by knob 550 *inside* advancing structure 530, which the Examiner found to be the claimed cannula. Instead, advancing structure 530 moves distally relative to applicator 525 and pushes shunt 105 along applicator 525 to the patient's eye. Alternatively, applicator 525 can be withdrawn into advancing structure 530 and remove shunt 105 from applicator 525 as advancing structure 530 holds shunt 105 in a fixed location in the eye. *Id.* ¶¶ 111, 114.

In both cases, shunt 105 does not advance or retract within advancing structure 530 (the cannula), as claimed. Instead, advancing structure 530 *abuts* shunt 105 when shunt 105 is mounted on applicator 525, and advancing structure 530 removes shunt 105 from applicator 525. *Id.* ¶ 121, Figs. 6E–6G. Thus, De Juan does not teach a device configured to advance or retract an ocular implant *within* a cannula, as the Examiner found. *See* Ans. 2.

De Juan's disclosure that a shunt can be placed inside a sheath during delivery (De Juan ¶ 109) does not teach that shunt 105 is disposed *inside* of advancing structure 530 (or a cannula), as the Examiner found. *See* Ans. 3. This embodiment does not teach a device configured to retract a sheathed shunt inside a cannula, as claimed, or a device that advances and retracts a sheathed shunt within a cannula, as claimed. Reply Br. 3.

Nor has the Examiner made sufficient findings to show that De Juan is configured to retract an ocular implant (shunt 105). *See* Final Act. 6, 10. Paragraph 97 of De Juan does not support such a finding by the Examiner. Ans. 3. De Juan teaches that shunt 105 can be anchored to eye tissue after being implanted by attaching hairs to shunt 105 and the eye tissue. De Juan ¶ 97. This teaching does not support the Examiner's finding that shunt 105 can be retracted within the delivery device, as claimed, however.

Thus, we do not sustain the rejection of claims 1–9 and 26–29.

Claims 30–34 as unpatentable over De Juan, McIntyre, Lynch, Cartledge

Independent claim 30 recites an ocular implant and delivery system having a cannula coupled to a housing, an ocular implant disposed in the cannula, and a delivery mechanism that advances and retracts the implant in the cannula. Appeal Br. 17 (Claims App.). The Examiner relied on De Juan to teach these features, McIntyre to teach an orientation mechanism, and Lynch to teach deployment of shunts in Schlemm's canal. Final Act. 12–13. The Examiner relied on Cartledge to teach keyed connections between a catheter and other coaxial components of a delivery device. *Id.* at 13–14.

We agree with Appellants that De Juan and the other references do not teach or suggest an ocular implant disposed to advance and retract within a cannula as recited in claim 30. Appeal Br. 12. Cartledge's coaxial keyed connection does not overcome these deficiencies, either. *See id.* at 13.

Thus, we do not sustain the rejection of claims 30–34.

DECISION

We reverse the rejection of claims 1–9 and 26–34.

REVERSED