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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* GERA STROMMER, UZI EICHLER, and
LIAT SCHWARTZ

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Appeal 2015-002911[1,2]
Application 11/329,824
Technology Center 3700

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Before ANTON W. FETTING, PHILIP J. HOFFMANN, and
BRADLEY B. BAYAT, *Administrative Patent Judges*.

HOFFMANN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 14, 15, and 17–25. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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[1] Our decision references Appellants' Specification ("Spec.," filed Jan. 10, 2006), Appeal Brief ("Appeal Br.," filed Aug. 25, 2014), and Reply Brief ("Reply Br.," filed Jan. 16, 2015), as well as the Examiner's Answer ("Answer," mailed Nov. 19, 2014).

[2] Appellants indicates that Mediguide Ltd. is the real party in interest. Appeal Br. 1.

According to Appellants, the invention is directed "to methods and systems for replacing a malfunctioning heart valve." Spec. 1, ll. 8–9. Claim 14 is the only independent claim on appeal. *See* Appeal Br., Claims App. We reproduce claim 14, below, as representative of the appealed claims.

> 14. System for positioning an artificial heart valve at the anatomic position of a malfunctioning heart valve of a heart of a patient, the system comprising:
>
> a valve fixation device, for fixing said artificial heart valve at said anatomic position;
>
> a valve replacement catheter, said valve replacement catheter bearing said artificial heart valve and said valve fixation device, at the tip of said valve replacement catheter, said valve replacement catheter being employed for fixing in place said artificial heart valve;
>
> a first medical positioning system (MPS) sensor located at the tip of said valve replacement catheter;
>
> an MPS coupled with said first MPS sensor, for determining the current position of said tip of said valve replacement catheter in an MPS coordinate system, according to an output of said first MPS sensor;
>
> a processor coupled with said MPS, said processor being configured to determine a trajectory along which said valve replacement catheter will move by acquiring position readings of a second MPS sensor disposed in a mapping catheter and coupled to said MPS; and
>
> a first user interface, coupled with said processor, for receiving a marking input from a user, independent of said trajectory and respective of said anatomic position, said marking input comprising at least position information indicative of said anatomic position and a marking information indicating that the user has affirmatively designated the position information as indicative of said anatomic position;

> said processor determining said anatomic position in said MPS coordinate system, according to said marking input;
>
> said processor constantly determining said current position, while said valve replacement catheter is moving along said trajectory toward said anatomic position;
>
> said processor producing an indication via said first user interface, when said processor determines that said current position substantially matches said anatomic position.

*Id.*

## REJECTIONS AND PRIOR ART

The Examiner rejects claims 14, 15, 17–21, 23, and 24 under 35 U.S.C. § 102(e) as anticipated by Strommer (US 2002/0049375 A1, pub. Apr. 25, 2002).

The Examiner rejects claim 22 under 35 U.S.C. § 103(a) as unpatentable over Strommer and Sobe (US 2004/0097804 A1, pub. May 20, 2004).

The Examiner rejects claim 25 under 35 U.S.C. § 103(a) as unpatentable over Strommer and Verard (US 2010/0210938 A1, pub. Aug. 19, 2010).

*See* Answer 2–6.

## ANALYSIS

In the rejection of independent claim 14, the Examiner indicates that "the recitation 'an artificial heart valve' has not been given patentable weight because the recitation occurs in the preamble, the artificial heart valve is not positively cited[,] only a valve fixation device such as a stent. A preamble is generally not accorded any patentable weight." Answer 6.

Further, the Examiner determines that "Strommer teaches a system comprising of a valve fixation device." *Id.* at 7. Claim 14, however, recites a heart valve in the body of the claim—viz. "a valve replacement catheter . . . bearing said artificial heart valve." Appeal Br., Claims App. Thus, inasmuch as claim 14 requires a heart valve, and the Examiner does not establish that Strommer teaches a heart valve, but instead that "the valve fixation device of Strommer is *fully capable of being used with* an artificial heart valve" (Answer 7) (emphasis added), we do not sustain the rejection of claim 14 or of claims 15, 17–21, 23, and 24 that depend from claim 14 and are rejected as anticipated by Strommer. *See, e.g.*, Appeal Br. 4–5; *see also* Reply Br. 2–3.

Notwithstanding the above, Appellants further argue that the Examiner's rejection of claim 14 is erroneous because Strommer does not recite "a first user interface, coupled with said processor, for receiving a marking input from a user, independent of said trajectory" of the valve replacement catheter. *See id.* at 5–8. In the rejection of claim 14, the Examiner finds that "Strommer discloses that the user can move marks 116, 118, 120 together *along the length of the trajectory* 114 (paragraph [0078])," which is in direct opposition to the claim limitation. Answer 3 (square brackets in original).

In the Response to Arguments section of the Answer, the Examiner reiterates this finding (*see* Answer 7), but also finds that "Strommer teaches . . . a first user interface coupled to the processor for receiving a marking input 116, 118, 120 from a user independent of said trajectory 114 (as seen in Figures 1A-2A and paragraphs [0076-0078])" (*id.*) (square brackets original). This is based on the Examiner's additional findings that

"Strommer . . . teaches two different sessions, an imaging session and a planning session" (*id.*), and that because "the trajectory is obtained [during the imaging session that is] prior to and independent of the planning session, wherein the user designates markings on the trajectory" (*id.* at 7–8), the marking inputs are received independent of the trajectory as required by claim 14. We agree with Appellants, however, that because in the imaging session Strommer's markings are based on the trajectory of the valve replacement catheter, Strommer teaches receiving a marking input dependent on a trajectory of a catheter, contrary to the requirements of claim 14. *See* Reply Br. 3.

Inasmuch as the Examiner does not rely on either secondary reference to remedy all of the deficiencies in the rejection of claim 14, we do not sustain either obviousness rejection of claim 22 or claim 25 that depends from claim 14.

## DECISION

We REVERSE the Examiner's anticipation and obviousness rejections of claims 14, 15, and 17–25.

## REVERSED