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TAROLLI, SUNDHEIM, COVELL & TUMMINO L.L.P. 1300 EAST NINTH STREET, SUITE 1700 CLEVELAND, OH 44114			NGUYEN, HUONG Q	
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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* DAVID R. WHITTAKER, RYAN S. KLATTE,  
SHAWN D. ELLIS, and JASON T. MIKULSKI

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Appeal 2018-001610  
Application 13/157,627  
Technology Center 3700

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Before: JEREMY M. PLENZLER, LISA M. GUIJT, and  
BRENT M. DOUGAL, *Administrative Patent Judges*.

DOUGAL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134 from a final rejection of claims 1–29 and 31–33. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm in part.

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<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real parties in interest as The Cleveland Clinic Foundation, Windcrest LLC, and Parker-Hannifin Corporation. Appeal Br. 3.

### CLAIMED SUBJECT MATTER

The claims are directed to a guidewire control device. Claims 1, 29, and 31–33 are independent. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A controller for manually controlling a guidewire, the controller comprising:
  - a housing comprising a passage for receiving the guidewire;
  - a gripper that is actuatable to grasp the guidewire in the passage; and
  - a cap connected to the housing by threads, the cap being rotatable relative to the housing so that the threads actuate the gripper, the housing comprising an element in addition to the threads for maintaining the cap in a receiving position, the cap when in the receiving position placing the controller in a condition in which the guidewire can be moved into and out of the passage.

### REFERENCES

The prior art relied upon by the Examiner is:

Wright	US 4,034,882	July 12, 1977
Carlson	US 4,157,674	June 12, 1979
Holman	US 5,224,939	July 6, 1993
Nash	US 2004/0133185 A1	July 8, 2004
Whittaker	US 7,615,032 B2	Nov. 10, 2009
Fisher	US 2010/0234897 A1	Sept. 16, 2010
von Malmborg	US 8,038,628 B2	Oct. 18, 2011

## REJECTIONS

Claims 1–5 and 16–22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Whittaker and von Malmborg.

The remaining claims are rejected under the same grounds, but further in view of Carlson (claims 14, 15, 29), Nash (claims 23–28), Wright (claims 6–13, 31, 32), and Holman and Fisher (claim 33).

## OPINION

### *Claims 1–28*

Independent claim 1 includes a “housing comprising an element . . . for maintaining the cap in a receiving position, the cap when in the receiving position placing the controller in a condition in which the guidewire can be moved into and out of the passage.” Appellant and the Examiner dispute whether Whittaker and von Malmborg suggest this claim element. *See* App. Br. 16–19; Ans. 3–4. However, neither the Examiner nor Appellant offer any construction for this limitation. *See Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003) (“The first step in both [anticipation and obviousness] analyses is a proper construction of the claims.”).

Claim 1 does not recite any particular structure associated with the “element” that performs the function of “maintaining the cap in a receiving position.” Based on the record before us, we determine that “element” is a

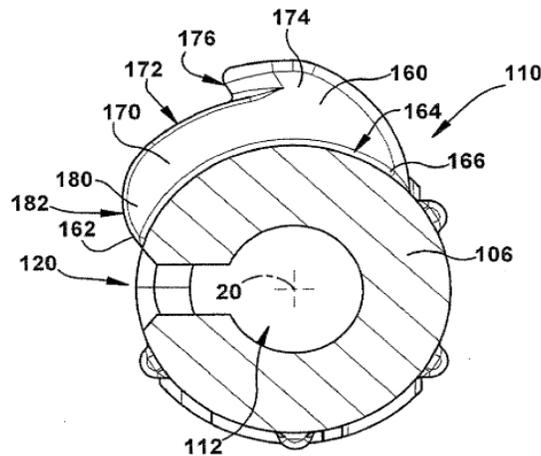
means-plus-function term, subject to 35 U.S.C. § 112, ¶ 6.<sup>2,3</sup> The standard for determining whether a limitation is a means-plus-function term is not based merely on the presence of the word “means,” but, rather, “is [based on] whether the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure.” *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1349 (Fed. Cir. 2015) (internal citation omitted). Appellant does not contend that “element” is understood as the name for any particular structure. Although there is a presumption that a limitation lacking the word “means” is not subject to § 112, ¶ 6, that presumption is overcome when it is “demonstrate[d] that the claim term fails to ‘recite sufficiently definite structure’ or else recites ‘function without reciting sufficient structure for performing that function.’” *Id.* Claim 1 recites function (i.e., “maintaining the cap in a receiving position”) “without reciting sufficient structure for performing that function.” In fact, claim 1 does not recite *any* structure, other than an “element,” for performing that function.

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<sup>2</sup> 35 U.S.C. § 112, ¶ 6 (“An *element* in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.”) (emphasis added).

<sup>3</sup> It has long been recognized that § 112, ¶ 6 applies during patent examination. *See In re Donaldson Co., Inc.*, 16 F.3d 1189, 1194–95 (Fed. Cir. 1994) (en banc) (When 35 U.S.C. § 112, ¶ 6 applies, “the ‘broadest reasonable interpretation’ that an examiner may give means-plus-function language is that statutorily mandated in paragraph six.”). Invoking § 112, ¶ 6 *sua sponte* at the Board is nothing new. *See, e.g., Ex parte Lakkala*, 108 USPQ2d 1392 (PTAB 2013) (informative); *Ex parte Erol*, 107 USPQ2d 1963 (PTAB 2013) (informative); *Ex parte Smith*, 108 USPQ2d 1198 (PTAB 2013) (informative).

A means-plus-function limitation “shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” 35 U.S.C. § 112, ¶ 6. The Specification describes a multi-function element 160 on the housing 100 that interacts with a tab 260 on the cap “to maintain the controller in desired conditions,” such as a “receiving position.” Spec. ¶¶ 51, 52. The element 160 is described with reference to Figure 7, reproduced below.



**Fig. 7**

Figure 7 above, shows a cross-section of the housing.

The Specification describes the element 160 as follows:

Adjacent the threaded portion 150, the housing 100 includes a multi-function element 160 that projects outward from the central portion 106 of the housing away from the axis 20. Fig. 7 illustrates the element 160 in detail. The element 160 has a curved contour, merging at a first end 162 with the surface 164 of the central portion 106 adjacent the primary receiving portion 130 of the slot 120. An opposite second end 166 of the element 160 also terminates and merges with the outer surface 164, although at a larger or steeper angle than that at which the first end 162 merges.

The element 160 includes a first portion 170 that projects outward from the housing 100 and has an outward facing

surface 172. The element 160 also includes a second portion 174, adjacent the first portion 170, that also projects outward from the housing 100. The second portion 174 projects further outward from the housing 100 than the first portion 170 and therefore has a height, as viewed in Fig. 7, that is greater than the height of the first portion. The second portion 174 has a lateral surface 176 formed where the element 160 transitions from the first portion 170 to the second portion 174. The lateral surface 176 of the second portion 174 extends transverse to the outward facing surface 172 of the first portion 170. The element 160 further includes a third portion 180 that is formed in the area of the first end portion 162 where the element merges with the outer surface 164. The third portion 180 includes a surface 182 that extends transverse to and merges with the outer surface 164.

*Id.* at ¶¶ 36–37.

As the Specification does not describe any other feature for maintaining the cap in a receiving position, we construe “an element . . . for maintaining the cap in a receiving position” in claim 1 as requiring the structure discussed above or its equivalents.

The Examiner’s rejection does not explain how the references meet the limitations associated with “an element . . . for maintaining the cap in a receiving position” under the construction noted above. Furthermore, review of the rejection does not reveal how the portions of Whittaker and von Malmberg cited by the Examiner disclose or teach the recited “maintaining the cap in a receiving position” limitations required by that term. Indeed, the Examiner was not applying that construction when making these rejections. For this reason, we do not sustain the rejection of claim 1, or the rejections of the claims which depend therefrom.

*Claim 29*

Independent claim 29 includes “threads of at least one of the housing and cap having asymmetrical flank angles.” Appellant argues that flank angles are defined as “the angle made by the flank of a screw thread with a line perpendicular to the axis of the screw.” Appeal Br. 28 (quoting <http://encyclopedia2.thefreedictionary.com/flank+angle>). Appellant also points to Figure 6 and the related discussion in the Specification concerning flank angles as being consistent with this definition. *Id.* Appellant argues that Carlson does not teach or suggest asymmetrical flank angles. *Id.* at 27.

Rather than focus on the flanks of the *threads*, the Examiner points to “[t]he space between ring 14 and the first thread.” Final Act. 6 (“The flank angle has been defined to include the entire spacing between each thread/ring.”). The Examiner further finds that the claim “does not require the flank angles to be associated with threads of a screw.” Ans. 6. However, we disagree as the claim specifically links the flank angles with the threads. Further, the claim specifically requires a screw-like connection between the cap and the housing (“cap having a threaded connection with the housing.”). The Examiner does not sufficiently address Appellant’s dictionary definition or support from the Specification.

The Examiner also takes an alternative position that because the angle between the threads and the shaft in ring 14 is different than the angle of threads 15, asymmetrical flank angles are present. Ans. 6. This reasoning also misunderstands the definition of flank angles. *See* Appeal Br. 28–29. As the Examiner has not shown that Carlson teaches asymmetrical flank angles or provided a sufficient reason to modifying Whittaker and von

Malmborg to provide asymmetrical flank angles, we do not sustain the rejection of claim 29.<sup>4</sup>

*Claims 31–33*

Appellant generally alleges that none of the cited references teaches or suggests the claimed invention of independent claims 31–33. Appeal Br. 31–33. However, none of independent claims 31–33 include the same limitations as independent claims 1 and 29 discussed above. Further, the Examiner’s rejections of independent claims 31–33 involve art that is not part of the rejections of independent claims 1 and 29. For these reasons, Appellant’s mere allegation of patentability without addressing the rejections does not inform us of error in the rejections. *See* 37 C.F.R. § 41.37(c)(1)(iv) (Arguments presented in an appeal must address the grounds of rejection set forth by the Examiner.).

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
1–5, 16–22	103(a)	Whittaker, von Malmborg		1–5, 16–22
14, 15, 29	103(a)	Whittaker, von Malmborg, Carlson		14, 15, 29
23–28	103(a)	Whittaker, von Malmborg, Nash		23–28
6–13, 31, 32	103(a)	Whittaker, von Malmborg, Wright	31, 32	6–13
33	103(a)	Whittaker, von Malmborg, Holman, Fisher	33	
<b>Overall Outcome</b>			31–33	1–29

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<sup>4</sup> We take no position concerning what flank angles are shown by threads 14 and 15 in Carlson.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED IN PART