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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARTIN T. GERBER and MICHAEL D. BAUDINO

Appeal 2018-005961[1]
Application 14/331,283[2]
Technology Center 3700

Before BRADLEY B. BAYAT, TARA L. HUTCHINGS, and ROBERT J. SILVERMAN, *Administrative Patent Judges*.

BAYAT, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1–8, which are all the pending claims in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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[1] Our Decision references Appellants' Appeal Brief ("App. Br.," filed Nov. 13, 2017), Reply Brief ("Reply Br.," filed Apr. 13, 2018), the Examiner's Answer ("Ans.," mailed Feb. 15, 2017), and the Final Office Action ("Final Action," mailed June 13, 2017).

[2] Appellants identify "Medtronic, Inc." as the real party in interest. App. Br. 2.

STATEMENT OF THE CASE

Sole independent claim 1

Appellants' claimed invention is directed to a system "for introducing implantable medical leads into patients, particularly leads having distal fixation elements." Spec. 1:10–11. Claim 1 recites:

1. A system comprising:

an introducer including a body member having a proximal end and a distal end, wherein the body member defines a lumen extending from the proximal end to the distal end;

an implantable medical lead configured to be inserted in the lumen of the introducer, the lead having a proximal end and a distal end and including a fixation element and an electrode array, wherein the fixation element is between the electrode array and the distal end of the lead; and

an elongate member configured to be inserted in the lumen of the introducer, the elongate member having a conductive element adjacent a non-conductive distal end portion that extends from a distal end of the elongate member a distance equal to a distance from the distal end of the lead to a predetermined location of the electrode array.

App. Br. 11, Claims Appendix.

Rejections

Claims 1–4 and 7 are rejected under 35 U.S.C. § 103(a) as unpatentable over Bonde (US 2008/0269716 A1, pub. Oct. 30, 2008).

Claims 5 and 6 are rejected under 35 U.S.C. § 103(a) as unpatentable over Bonde and Gerber (US 2008/0132979 A1, pub. June 5, 2008).

Claim 8 is rejected under 35 U.S.C. § 103(a) as unpatentable over Bonde and Tronnes (US 2010/0228328 A1, pub. Sept. 9, 2010).

ANALYSIS

In rejecting independent claim 1, the Examiner finds Bonde discloses all the recited elements of the claim except "Bonde fails to specifically disclose the non-conductive distal end portion of the elongate member extending a distance equal to a distance from the distal end of the lead to a predetermine[d] location of the electrode array." Final Act. 5. According to the Examiner,

> it would have been obvious to one of ordinary skill in the art at the time of the invention was made to try extending the non-conductive distal portion a distance, of Bonde, equal to a distance from a distal end of a lead to a predetermined location of one or more electrodes of an electrode array, to provide nothing more than predictable results of coordinating the non-conductive distal end portion of a lead and an elongate member, such that when the elongate member determines a treatment location by providing a test stimulation with a conductive element of the elongate member, the one or more electrodes of the electrode array of the lead will be implanted at the same location to stimulate the same tissue, thereof.

Id. at 6. The Examiner maintains that Bonde's disclosure "at paragraph [0038] which specifically discloses placing the conductive element on needle 18 such that it is '*displaced some distance from the tip 22*'" renders the missing feature obvious. Ans. 3.

Appellants argue that the Examiner's rejection relies on impermissible hindsight because

> one of skill in the art would not have reached a conclusion that an elongate member as recited in the present claims should have a conductive element adjacent a non-conductive distal end portion that extends from a distal end of the elongate member a distance equal to a distance from the distal end of the lead to a predetermined location of the electrode array.

App. Br. 7. According to Appellants, "nothing in Bonde would lead one to extend the non-conductive distal portion a distance equal to a distance from a distal end of a lead to a predetermined location of one or more electrodes of the array as suggested by the Examiner." *Id.* at 8. In particular, Appellants argue

> [n]othing in Bonde teaches or suggests that 'near the distal tip' of the electrode could or should mean a distance from the distal tip equal to a distance from a distal end of a lead to a predetermined location of one or more electrodes of the lead, as recited in the present application.

Id. at 9.

We are persuaded by Appellants' arguments.

"Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." *Para-Ordnance Mfg. v. SGS Importers Int'l*, 73 F.3d 1085, 1087 (Fed. Cir. 1995) (citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 1553 (Fed. Cir. 1983)). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (citing *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984)). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *Fritch*, 972 F.2 at 1266 (citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991)).

We agree with Appellants that the Examiner has not adequately explained why it would have been obvious to modify Bonde to "try extending the non-conductive distal portion [of needle 18] a distance" equal to a distance from the distal end of the lead to a predetermined location of

the electrode array, as required by claim 1. Although the Examiner found that Bonde teaches placing the conductive element some distance from the tip or distal end of needle 18, this teaching by itself is not sufficient reason to modify Bonde. The Examiner does not provide an adequate reason as to why it would have been obvious to modify Bonde to extend the non-conductive distal portion of needle 18 a distance equal to a distance from the distal end of the lead to a predetermined location of the electrode array. In other words, the Examiner has not shown how Bonde's disclosure of electrode 20 being some distance from the distal end of needle 18 suggests a relationship between the lead and the needle. Rather, the Examiner's rationale for the modification, i.e., to coordinate the non-conductive distal end portion of a lead and an elongate member, such that when the elongate member determines a treatment location by providing a test stimulation with a conductive element of the elongate member, the one or more electrodes of the electrode array of the lead will be implanted at the same location to stimulate the same tissue, appears to be a restatement of Appellants' stated advantage. Aside from referring to the same reasoning Appellants' Specification provides for aligning the lead and elongate member, the Examiner has not provided rational underpinnings for modifying Bonde. Based on the record presented, the Examiner's rationale for modifying Bonde to provide a non-conductive distal end portion coordinated with the lead appears to be based on impermissible hindsight.

Accordingly, we do not sustain the rejection of independent claim 1 as obvious over Bonde, including dependent claims 2–4 and 7. The Examiner's additional findings and determinations with respect to dependent claims 5, 6, and 8, including the Examiner's reliance on Gerber and Tronnes,

does not remedy the above-discussed deficiency in the rejection of independent claim 1. As such, we do not sustain the rejections of claims 5, 6, and 8 for the same reasons as claim 1.

DECISION

The Examiner's decision to reject claims 1–8 is reversed.

REVERSED