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SHAY GLENN LLP 2755 CAMPUS DRIVE SUITE 210 SAN MATEO, CA 94403			SCHALL, MATTHEW WAYNE	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte EDWARD MCNAMARA, DAVID CELERMAJER,
STEPHEN FORCUCCI,
and HIROATSU SUGIMOTO¹

Appeal 2018-006548
Application 13/471,419
Technology Center 3700

Before: JOSEPH A. FISCHETTI, BIBHU R. MOHANTY, and
KENNETH G. SCHOPFER, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 of the Final rejection of claims 1–15 which are all the claims pending in the application.

We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies Corvia Medical, Inc. as the real party in interest (Appeal Br. 2).

CLAIMED SUBJECT MATTER

The Appellant's claimed invention is directed to devices for treating heart failure in interatrial pressure vents, shunts and the like (Spec., para 2). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A device for implanting in an opening is a septal wall in a heart of a patient, the device comprising:
 - a core segment defining a passage through which fluid can flow after implantation of the device, the passage comprising a diameter larger than about 5 mm, the flow being from one side of the septal wall to another side of the septal wall, the core segment having a first diameter when deployed;
 - a first annular flange contiguous with the core segment;
 - and
 - a second annular flange contiguous with the core segment, wherein the device is collapsible, enabling the core segment to have a second diameter less than the first diameter thereby enabling percutaneous delivery of the device to the heart of the patient,
 - and
 - wherein the core segment comprises a non-braided substantially open mesh.

THE REJECTIONS

The following rejection is before us for review:

1. Claims 1–10 are rejected under 35 U.S.C. § 103(a) as unpatentable over Berg (Berg et al., US 6,712,836 B1; iss. Mar. 30, 2004, hereinafter “Berg”).
2. Claims 11–15 are rejected under 35 U.S.C. § 103(a) as unpatentable over Berg and Melsheimer (US 2007/0043431 A1; pub. Feb. 22, 2007).

FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence.²

ANALYSIS

Rejection under 35 U.S.C. § 103(a)

The Appellant argues that the rejection of claim 1 under 35 U.S.C. § 103(a) is improper because Berg discloses “apparatuses and methods for *preventing the flow of body fluids* through apertures in body cavity walls” (App. Br. 3). The Appellant has stated that in contrast the current claim includes a limitation for:

a core segment *defining a passage through which fluid can flow after implantation of the device*, the passage comprising a diameter larger than about 5 mm, the flow being from one side of the septal wall to another side of the septal wall, the core segment having a first diameter when deployed.

(App. Br. 2) (emphasis added). The Appellant argues that the rejection is improper because: Berg does not disclose or suggest the aperture to have a diameter of about 5mm; Berg does not disclose a device including a passage in which fluid can flow after implantation; and that modifying Berg to include a passage in which fluid can flow after implantation of the device renders Berg inoperable for its intended purpose (App. Br. 2–8; *see also* Reply Br. 2–4).

² *See Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

In contrast, the Examiner has determined that the rejection of record is proper (Final Act. 2, 3; *see also* Ans. 2, 3).

We agree with the Appellant. *In KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) the Supreme Court at *KSR*, 550 U.S. at 418 noted that in an obviousness analysis that “[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” In this case, the rejection before us lacks articulated reasoning with rational underpinning to support a legal conclusion of obviousness without impermissible hindsight. The disclosure of the device of Berg is essentially for closing fluid flow in a passage after implantation while in contrast the claim at issue is directed to “defining a passage through which fluid can flow after implantation” (Appeal Br. 2). The rejection also requires a modification in changing of the dimension of the passage to 5mm. Here, the cited modifications taken together lack articulated reasoning with rational underpinnings without impermissible hindsight and the rejection of claim 1 and its dependent claims 2–10 is not sustained.

With regard to claims 11–15, the Melsheimer reference fails to correct the deficiency of the rejection of the base claim and the rejection of these claims as well. Accordingly, the rejection of claims 11–15 is not sustained as well.

CONCLUSIONS OF LAW

We conclude that the Appellant has shown that the Examiner erred in rejecting claims 1–10 under 35 U.S.C. § 103(a) as unpatentable over Berg.

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We conclude that the Appellant has shown that the Examiner erred in rejecting claims 11–15 under 35 U.S.C. § 103(a) as unpatentable over Berg and Melsheimer.

DECISION

The Examiner’s rejection of claims 1–15 is reversed.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–10	103(a)	Berg		1–10
11–15	103(a)	Berg and Melsheimer		11–15
Overall Outcome				1–15

REVERSED