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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KARL WEST

Appeal 2018-008152
Application 14/749,677
Technology Center 3700

Before MICHELLE R. OSINSKI, BRANDON J. WARNER, and
NATHAN A. ENGELS, *Administrative Patent Judges*.

WARNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Cleveland Clinic Foundation (“Appellant”)¹ appeals under 35 U.S.C. § 134(a) from the Examiner’s decision rejecting claims 1–19, which are all the pending claims. Appeal Br. 3. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

¹ The Cleveland Clinic Foundation is the applicant, as provided in 37 C.F.R. § 1.46, and is identified as the real party in interest. Appeal Br. 3.

CLAIMED SUBJECT MATTER

Appellant's disclosed invention "relates to an apparatus and method for tracking a position of a medical device and, more particularly, to a method and apparatus for tracking a position of a medical device relative to a target site of a patient lumen." Spec. ¶ 2. Claims 1 and 15 are independent. Claim 1, reproduced below with emphasis added, is illustrative of the subject matter on appeal.

1. A method of tracking a position of a medical device relative to a target site of a patient lumen, the method comprising:

providing a trackable guidewire, the guidewire having longitudinally spaced proximal and distal guidewire ends separated by a guidewire body, the guidewire including a plurality of longitudinally spaced position sensors configured to provide signals corresponding to a three-dimensional position in space to an outside communication device, the guidewire including at least one retention mechanism for maintaining a medical device in a predetermined retention position longitudinally along the guidewire body, and the guidewire including at least one stop structure in a predetermined stop position longitudinally along the guidewire body;

placing the medical device in the retention position;

maintaining the medical device in the retention position via the retention mechanism;

placing the distal guidewire end into the patient lumen;

advancing the distal guidewire end and at least a portion of the guidewire body through at least a portion of the patient lumen;

determining a three-dimensional position of at least one position sensor in a coordinate system of an associated tracking system; and

determining a relative position of the at least one sensor with respect to geometry of the patient lumen.

EVIDENCE

The Examiner relied on the following evidence in rejecting the claims on appeal:

| | | |
|-----------|--------------------|---------------|
| Ahmed | US 2006/0074318 A1 | Apr. 6, 2006 |
| Markowitz | US 8,208,991 B2 | June 26, 2012 |
| Vanney | US 2013/0296692 A1 | Nov. 7, 2013 |

REJECTIONS

The following rejections are before us for review:

- I. Claims 1, 4–6, and 15–18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Vanney and Ahmed. Final Act. 5–7.
- II. Claims 2, 3, 7–14, and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Vanney, Ahmed, and Markowitz. *Id.* at 7–9.

ANALYSIS

Independent claim 1 recites a method of tracking a position of a medical device that involves “providing a trackable guidewire,” with “*the guidewire including at least one retention mechanism* for maintaining a medical device in a predetermined retention position longitudinally along the guidewire body,” as well as “*the guidewire including at least one stop structure* in a predetermined stop position longitudinally along the guidewire body.” Appeal Br. 25, Claims App. (emphasis added). Similarly, independent claim 15 recites an apparatus of a trackable guidewire itself, which comprises or includes “*at least one retention mechanism* which selectively maintains a separate medical device in a predetermined retention position longitudinally along the guidewire body,” as well as “*at least one*

stop structure in a predetermined stop position longitudinally along the guidewire body.” *Id.* at 30, Claims App. (emphasis added). In other words, from the plain language of the claim recitations, the disputed elements of the retention mechanism and the stop structure are *components of the guidewire itself* as recited.

In rejecting the claims, for both Rejections I and II, the Examiner relies on Ahmed for teaching these disputed elements. Final Act. 5–6, 7. From a review of the disclosure of Ahmed, we agree with Appellant that these identified elements (retainer 203 and stop tab 216) are “part of connector 200,” rather than being “part of the guidewire itself as claimed.” Appeal Br. 15 (underlining omitted); *see also* Ahmed, Figs. 12–16, ¶¶ 69, 75).

Although the Examiner asserts that “[t]he claim does not preclude either the retention mechanism or the stop tab from being separate [from] the guidewire” itself, such an interpretation is contrary to the plain language of the claims, as discussed above. Ans. 10; *see id.* at 9–10. To the extent that the Examiner is merely indicating that the claim does not require the retention mechanism and the stop tab to be formed integrally as a one-piece structure with the guidewire, the Examiner has not adequately explained how Ahmed teaches a retention mechanism and a stop tab that are “separate structure . . . of the guidewire.” Ans. 10 (emphasis added). Stated another way, although Ahmed may disclose these disputed elements, it does not disclose them as being part of the guidewire itself (rather, they are part of Ahmed’s separate connector element).

In short, we agree with Appellant that the Examiner errs in applying an unreasonably broad claim construction that disregards the requirement that these disputed elements are part of the guidewire itself. *See* Appeal Br. 15–18, 20. Because of this erroneous claim construction, the Examiner has not established factual findings, or provided any explanatory analysis, as to how Ahmed would disclose or suggest the disputed elements being part of the guidewire itself, as required by the claims.

For Rejection II, the Examiner relies on Markowitz for teaching additional claimed features, but not to cure the above-noted deficiency in the Examiner’s findings based upon the improper claim construction.

Accordingly, based on the error in claim construction that pervades the prior art rejections, we do not sustain them.

DECISION

We REVERSE the Examiner’s decision rejecting claims 1, 4–6, and 15–18 under 35 U.S.C. § 103 as being unpatentable over Vanney and Ahmed.

We REVERSE the Examiner’s decision rejecting claims 2, 3, 7–14, and 19 under 35 U.S.C. § 103 as being unpatentable over Vanney, Ahmed, and Markowitz.

CONCLUSION

In summary:

| Claims Rejected | Basis | Affirmed | Reversed |
|------------------------|--|-----------------|-----------------------|
| 1, 4–6, and 15–18 | 35 U.S.C. § 103 Vanney and Ahmed | | 1, 4–6, and 15–18 |
| 2, 3, 7–14, and 19 | 35 U.S.C. § 103 Vanney, Ahmed, and Markowitz | | 2, 3, 7–14, and 19 |
| Overall Outcome | | | 1–19 |

REVERSED