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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* RICHARD K. ELTON

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Appeal 2019-001399  
Application 14/758,617  
Technology Center 3700

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Before CHARLES N. GREENHUT, WILLIAM A. CAPP, and  
MICHAEL L. WOODS, *Administrative Patent Judges*.

CAPP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Clearstream Technologies Limited, and Richard K. Elton (hereinafter collectively “Appellant”)<sup>1</sup> seek our review under 35 U.S.C. § 134(a) of the final rejection of claims 15, 24–29, 36, and 37 under 35 U.S.C. § 102(b) as anticipated by Sullivan (US 7,033,325 B1, iss. Apr. 25, 2006) and claim 35 as unpatentable under 35 U.S.C. § 103(a) over Sullivan and Miraki (US 5,383,890, iss. Jan. 24, 1995). We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE and enter a NEW GROUND OF REJECTION.

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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(a). Appellant C.R. Bard, Inc. as the real party in interest. Appeal Br. 2.

## THE INVENTION

Appellant's invention relates to an apparatus for use in an angioplasty procedure. Spec. 1. Claim 15, reproduced below with emphasis added, is illustrative of the subject matter on appeal.<sup>2</sup>

15. An apparatus for treating a treatment area in the vasculature using a catheter having a balloon including a working surface having a length for engaging the treatment area, comprising:

a guidewire for guiding the balloon to the treatment area, said guidewire including one or more radiopaque markings *corresponding to the length of the working surface of the balloon*, the correspondence being a correspondence in size.

## OPINION

### *NEW GROUND OF REJECTION UNDER 35 U.S.C. § 112(b)*

#### *Claim 15*

The PTO can properly reject a claim as indefinite under 35 U.S.C. § 112(b) if the claim is ambiguous, vague, incoherent, opaque, or otherwise unclear. *In re Packard*, 751 F.3d 1307, 1311 (Fed. Cir. 2014) (*per curiam*). The test for definiteness under 35 U.S.C. § 112, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted). In other words, a claim is indefinite if, after applying the broadest reasonable interpretation in light of the specification, the metes and bounds of a claim are not clear because the claim “contains words or phrases whose meaning is unclear.” *Packard*, 751

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<sup>2</sup> Appellant cancelled claims 1–8 and 11–13 after entry of the Examiner's Final Action. Claims App.

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F.3d at 1322 (approving, for pre-issuance claims, the standard from MPEP § 2173.05(e)); *see also Ex parte McAward*, Case No. 2015-006416, 2017 WL 3669566, at \*5 (PTAB Aug. 25, 2017) (precedential) (adopting the approach for assessing indefiniteness approved by the Federal Circuit in *Packard*).

Section 112 places the burden of precise claim drafting on the applicant. *In re Morris*, 127 F.3d 1048, 1056–57 (Fed. Cir. 1997). During patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed. *See In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989). The patent drafter is in the best position to resolve the ambiguity in the patent claims, and it is highly desirable that patent examiners demand that applicants do so in appropriate circumstances so that the patent can be amended during prosecution rather than attempting to resolve the ambiguity in litigation. *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1255 (Fed. Cir. 2008) (cited with approval in *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 910 (2014)). Rigorous application of the statutory standard to particularly point out and distinctly claim the subject matter regarded to be the invention serve an important public notice function. *See Predicate Logic, Inc. v. Distributive Software, Inc.*, 544 F.3d 1298, 1300 (Fed. Cir. 2008).

Appellant and the Examiner engage in a vigorous debate over the meaning of “*length of the working surface* of the balloon.” Appeal Br. 3–5; Ans. 2–4; Reply Br. 1–3. Appellant initially contends that the length of the working surface is co-extensive with the barrel portion of the balloon and that the Specification “defines” the term as such. Appeal Br. 4. In response,

the Examiner states that the Specification fails to provide a definition of working surface. Ans. 2. In reply, Appellant argues that the Specification defines “working surface” as the surface along the “portion of the balloon” that is used to achieve “the desired treatment effect,” such as contacting plaque. Reply Br. 2. However, in the Reply Brief, Appellant concedes the working surface is merely “typically” coextensive with the barrel section of the balloon. *Id.*

We view the disagreement between Appellant and the Examiner, in large part, as due to the fact that the meaning of the phrase at issue is vague and uncertain when construed in light of the Appellant’s disclosure. There are at least two factors arising from Appellant’s Specification that come to bear when analyzing the definiteness (or lack thereof) of “length of the working surface.” The first factor entails Appellant’s use of the adverb “typically” to modify “co-extensive” with the barrel section. Spec. 4. The second factor entails Appellant’s use of the term “treatment area” as more-or-less synonymous with “working surface.” *Id.* at 3.

One aspect of the disclosure relates to an apparatus for treating a treatment area in the vasculature using a catheter having a balloon. The apparatus comprises a guidewire for guiding the balloon to the treatment area. The guidewire includes one or more radiopaque markings arranged for *corresponding to the treatment area.*

*The one or more radiopaque markings may correspond in size or position to the treatment area.* The guidewire may include at least two radiopaque markings corresponding to the treatment area.

*Id.* at 3 (emphasis added).

We view Appellant’s use of “typically” to modify “co-extensive” as indicating that the working surface may be co-extensive in length with the

barrel section, but that such is not necessarily always the case. *Id.* at 1. Appellant's choice to include the word "typically" is a clear and unambiguous signal to the general public that "working surface" is not to be construed as strictly limited to the length of the barrel.

The second ambiguity factor arises from Appellant's repeated reference to the working surface corresponding to the "treatment area." The length of the "working surface" of the balloon is a structural feature of an apparatus. In contrast, the "treatment area" is peculiar to the individual patient that is receiving the treatment. There is no indication in the Specification that the length of the barrel section of the balloon is necessarily co-extensive with the axial length of arterial plaque stenosis in a patient's vasculature that requires treatment. Indeed, the most reasonable interpretation of Appellant's disclosure is that a balloon of a fixed barrel length could be used to treat stenosis of a variety of lengths in the vasculature.

Claim 15 recites that radiopaque markings correspond to the length of the "working surface" of the balloon. Claims App. In Appellant's Figure 4, radiopaque marking 26a is approximately co-extensive in length to the barrel section of balloon 12. *See* Fig. 4. Figures 8–10 depict alternate embodiment variations where two or more spaced apart markers delineate the respective lengths of working surface "W" and treatment area "A." However, to the extent that the balloon has an axial barrel length of "X" and patent's stenosis or treatment area "A" has an axial length of "Y," it is unclear whether the recited "length of the working surface" is measured with respect to: (1) the balloon; or (2) the patient's treatment area.

After reading Appellant's Specification, a person of ordinary skill in the art attempting to either practice Appellant's invention or design around it would be at loss that determine whether the "length of the working surface" of the balloon is measured in relation to the length of the barrel section of the balloon, or a patient's treatment area, or some other criteria.<sup>3</sup> The claim, therefore, is indefinitely vague as it fails to reasonably notify the public of the metes and bounds of the invention. *Predicate Logic*, 544 F.3d at 1300 (explaining that claim definiteness serves an important public notice function).

In view of the foregoing, we hereby exercise our authority under 37 C.F.R. § 41.50(b) to enter a NEW GROUND OF REJECTION, rejecting claim 15 under 35 U.S.C. § 112(b) for failure to particularly point out and distinctly claim the subject matter which Appellant regards as the invention.

*Claims 24–29, and 35–37*

Claim 24 is an independent claim. Claims App. Claims 25–29 and 35–37 depend, directly or indirectly, therefrom. *Id.* As with claim 15, claim 24 contains a limitation directed to a length of the working surface of balloon. *Id.* Claim 24 is indefinite for the same reasons identified above with respect to claim 15. Claims 25–29 and 35–37 are indefinite by reason of their dependency from an indefinite claim.

We hereby enter a NEW GROUND OF REJECTION, rejecting claims 24–29, and 35–37 under 35 U.S.C. § 112(b) for failure to particularly

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<sup>3</sup> The fact that the barrel section and the treatment area may occasionally and coincidentally be of the same length (as depicted in Figures 7–10) does not, in our opinion, save the claim from being indefinite.

point out and distinctly claim the subject matter which Appellant regards as the invention.

*Anticipation of Claims 15, 24–29, 36, and 37  
by Sullivan*

“[A] claim cannot be both indefinite and anticipated.” *Enzo Biochem, Inc. v. Applera Corp.*, 599 F.3d 1325, 1332 (Fed. Cir. 2010). In view of the new ground of rejection entered herein with respect to the indefiniteness of each of these claims, we pro forma reverse the Examiner’s anticipation ground of rejection.

*Unpatentability of Claim 35  
over Sullivan and Miraki*

In view of the new ground of rejection entered herein with respect to the indefiniteness of claim 35, we pro forma reverse the Examiner’s unpatentability ground of rejection.

DECISION

We hereby enter a NEW GROUND OF REJECTION under 35 U.S.C. § 112(b) with respect to claims 15, 24–29, and 35–37.

We hereby pro forma reverse the Examiner’s prior art rejections of claims 15, 24–29, and 35–37 set forth in the Final Action.

FINALITY OF DECISION

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of

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the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the prosecution will be remanded to the Examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

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).

REVERSED; 37 C.F.R. § 41.50(b)