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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* ROBERT C. FARNAN

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Appeal 2020-002229  
Application 13/489,250  
Technology Center 3700

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Before PHILIP J. HOFFMANN, BRADLEY B. BAYAT, and  
TARA L. HUTCHINGS, *Administrative Patent Judges*.

BAYAT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Robert C. Farnan (Appellant)<sup>1</sup> appeals under 35 U.S.C. § 134(a) from the Examiner’s decision to reject claims 1–3, 5, 6, 8–15, and 21–27, which constitute all the claims pending in the application.<sup>2</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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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 identifies “Koninklijke Philips N.V.” as the real party in interest. Appeal Br. 2.

<sup>2</sup> Claims 4, 7, and 16–20 are canceled. *Id.*, Claims App.

### CLAIMED SUBJECT MATTER

To understand the claimed invention, claim 1 is reproduced below and illustrative of the subject matter on appeal. *See* Appeal Br. Claims Appendix (emphasis added).

1. A system for performing angioplasty, said system comprising:
  - a catheter shaft having a distal end and an inflatable balloon disposed adjacent the distal end, wherein the inflatable balloon comprises a working length; and
  - an expandable constraining structure disposed over the inflatable balloon, wherein the expandable constraining structure comprises a plurality of axial struts and at least one ring, wherein each of the axial struts comprise a central portion, wherein the ring is disposed over the working length of the inflatable balloon and intersects the central portions of the axial struts, said expandable constraining structure having a non-expanded configuration and an expanded configuration, wherein the non-expanded configuration comprises the expandable constraining structure lying closely over the inflatable balloon prior to inflation of the inflatable balloon, wherein the expanded configuration comprises the expandable constraining structure being smaller than an unconstrained size of the expandable balloon upon inflation of the inflatable balloon so that the expandable constraining structure restrains the inflatable balloon along a plurality of crossing channel lines and *portions of the inflatable balloon protrude through openings in the expandable constraining structure.*

## REJECTION

Claims 1–3, 5, 6, 8–15, and 21–27 are rejected under 35 U.S.C. § 112 (Pre-AIA), first paragraph, as failing to comply with the written description requirement.

## OPINION

The purpose of the written description requirement is to convey with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991). The written description requirement prevents an applicant from claiming subject matter that was not adequately described in the specification as filed. New or amended claims that introduce elements or limitations that are not supported by the as-filed disclosure violate the written-description requirement. *See, e.g., In re Lukach*, 442 F.2d 967, 968–69 (CCPA 1971).

In rejecting claims 1–3, 5, 6, 8–15, and 21–27 under 35 U.S.C. § 112, first paragraph, the Examiner finds that the original disclosure fails to provide adequate written description support for independent claims 1, 13, and 22. Final Act. 5. In particular, the Examiner finds the Specification does not sufficiently support the amended limitation “portions of the inflatable balloon protrude through openings in the expandable constraining structure,” as recited in independent claims 1, 13, and 22. *Id.* According to the Examiner, “there is nothing in the original disclosure that shows or describes that portions of the inflatable balloon protrude through openings in the expandable constraining structure.” *Id.*

Appellant disagrees and asserts that one having ordinary skill in the art would recognize, upon *viewing* Figure 5, that portions of the inflatable

balloon protrude through openings in the expandable constraining structure, as an inherent function of the device in the originally-filed Application.

Appeal Br. 5–9. In support of inherency, Appellant relies on a Declaration by Mr. Jefferey Bleam, which states, in part, “that ‘upon inflating the balloon 1 within the non-deployable stent as shown Fig. 5 of the `119 Patent,<sup>[3]</sup> the structure 2 *necessarily result[s]* in constraining the balloon along a plurality of crossing channel lines while the balloon protrudes through the openings between the rings 7 and the struts 5.’” *Id.* at 10 (quoting Bleam Declaration ¶ 11, filed November 21, 2016).

The Examiner considers Mr. Bleam’s Declaration, but maintains that there is insufficient evidence to overcome the rejection. *See* Ans. 4–6.

To determine whether the written-description requirement is met, we consider “whether the disclosure of the [earlier] application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of that earlier filing date.” *Hologic, Inc. v. Smith & Nephew, Inc.*, 884 F.3d 1357, 1361 (Fed. Cir. 2018) (bracketed material in original quote) (quotes and citation omitted).

We agree with the Examiner that the disclosure of the originally-filed application does not support the amended claim limitation “portions of the inflatable balloon protrude through openings in the expandable constraining structure.” We have viewed Figure 5 of the `119 Patent, which is a drawing of the non-deployable stent associated with an angioplasty balloon, but we find nothing that suggests to an artisan when the balloon is inflated it

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<sup>3</sup> U.S. 7,691,119 issued April 6, 2010, to which the present application claims priority (“`119 Patent”).

protrudes through the openings between the rings 7 and the struts 5.

Appellant does not directly cite to any portion of the original disclosure for written-description support, but instead relies on attorney argument and a supporting declaration.

We have considered the supporting Declaration of Mr. Blead, but the information provided therein does not convince us that the original disclosure provides the necessary support to satisfy the written-description requirement for the limitation at issue. Mr. Blead's Declaration does not affirmatively state that by viewing Figure 5 of the '119 Patent, a person of ordinary skill in the art would understand that the inventors were in possession of the amended limitation at the time of filing. And contrary to Appellant's contention, Mr. Blead's Declaration does not state that "one having ordinary skill in the art *observing* Fig. 5 of the *Specification* would know an inflatable balloon that is inflated to a pressure disclosed in the *Specification* would protrude through openings in the constraining structure." Appeal Br. 9.

The statement upon which Appellant relies as supporting the doctrine of inherent disclosure<sup>4</sup> is not attributed to Mr. Blead and his understanding of what would be encompassed by the disclosure in Figure 5 of the '119 Patent. Instead, that statement is attributed to the results of an evaluation from a prototype model created with modifications to the design from Figure

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<sup>4</sup> Under the doctrine of inherent disclosure an amendment that recites a property inherent in a device or material described in the original specification does not introduce prohibited new matter. *In re Reynolds*, 443 F.2d 384 (CCPA 1971); *In re Smythe*, 480 F.2d 1376 (CCPA 1973); *Yeda Research & Dev. Co. v. Abbott GmbH*, 837 F.3d 1341 (Fed. Cir. 2016)).

6 of the '119 Patent. *See* Bleam Declaration ¶¶ 6–11. That statement in full provides: “The *outcome of this evaluation demonstrated* that upon inflating the balloon 1 within the non-deployable stent as shown Fig. 5 of the '119 Patent, the structure 2 necessarily result [sic] in constraining the balloon along a plurality of crossing channel lines while the balloon protrudes through the openings between the rings 7 and the struts 5.” Bleam Declaration ¶ 11 (emphasis added). Not only is that evaluation modified from the original disclosure, but it is unclear how an evaluation that entails many variables, which were altered from the relied-upon written description, demonstrates to an artisan an inherent property of the device. Further, the Declaration was signed by Mr. Bleam on October 26, 2016, and the original application lists a filing date of 2003. The Declaration does not indicate whether the statements comprise Mr. Bleam’s personal understanding as of 2016, or whether the statements support what a person of ordinary skill in the art would have understood as of the time of filing, more than a decade earlier.

We are not persuaded that Appellant’s amended claim limitation recites a function inherent in the device of the originally-filed application, because the extrinsic evidence does not make clear that the functional limitation is necessarily present and would be recognized by persons of ordinary skill at the time of filing. We have fully considered Mr. Bleam’s Declaration as part of the record before us, but the preponderance of the evidence weighs in favor of the Examiner’s position that the disclosure of the earlier application does not reasonably convey to those skilled in the art that Appellant had possession of the claimed subject matter as of that earlier

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filing date. Accordingly, we sustain the rejection of claims 1–3, 5, 6, 8–15, and 21–27 as failing to comply with the written description requirement.

### CONCLUSION

The Examiner’s rejection under 35 U.S.C. § 112, first paragraph, is affirmed.

| <b>Claims Rejected</b> | <b>35 U.S.C. §</b>   | <b>Reference(s)/Basis</b> | <b>Affirmed</b>        | <b>Reversed</b> |
|------------------------|----------------------|---------------------------|------------------------|-----------------|
| 1–3, 5, 6, 8–15, 21–27 | 112, first paragraph | Written Description       | 1–3, 5, 6, 8–15, 21–27 |                 |

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

**AFFIRMED**