

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ANTHONY C. ALIBERTO, SCOTT M. EVANS
and WILLIAM J. WORTHEN

Appeal No. 2003-1655
Application No. 09/800,706

ON BRIEF

Before COHEN, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 31 to 34, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a catheter. A copy of the dependent claims under appeal is set forth in the appendix to the appellants' brief. Claim 31, the only independent claim on appeal, reads as follows:

A catheter, comprising:
an elongate body having a first infusion lumen and a second infusion lumen each extending through the elongate body, a distal end, and an exterior surface;
a first cooling balloon through which a heat exchange fluid may circulate, the first cooling balloon being distally located on the catheter and having a size and configuration such that blood may flow around and past the first cooling balloon when operatively disposed in a patient's blood vessel;
a first infusion port on the elongate body distal to the first cooling balloon, the first infusion port establishing a pathway for fluid communication between the exterior surface and the first infusion lumen; and
a second infusion port on the elongate body proximal to the first cooling balloon, the second infusion port establishing a pathway for fluid communication between the exterior surface and the second infusion lumen.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Burton et al. (Burton)	5,496,271	March 5, 1996
Afzal	6,210,365	April 3, 2001

Claims 31 to 34 stand rejected under 35 U.S.C. § 103 as being unpatentable over Burton in view of Afzal.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 15, mailed July 30, 2002) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 14, filed May 2, 2002) and reply brief (Paper No. 16, filed September 3, 2002) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 31 to 34 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention.

See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998).

In the rejection before us in this appeal (answer, pp. 3-4), the examiner (1) ascertained that Burton taught all the claimed subject matter of claim 31 "except for having a port proximal to the distal balloon;" and (2) concluded that "[o]ne of ordinary skill in the art would have found it obvious to include a port between the balloons of Burton as taught by Afzal in order to allow therapeutic agents to be introduced between the balloons."

The appellants argue that there is no motivation or suggestion in the applied prior art for one skilled in the art to have modified Burton to arrive at the claimed subject matter. We agree.

Burton's invention is directed to an apparatus and method for treatment of conditions in which it is desired to simultaneously hyperthermally treat diseased target tissue in a patient and dilate a lumen of a patient which is compressed and/or obstructed by the diseased target tissue and/or surrounding tissue. The apparatus generally includes a catheter for insertion into a lumen of the patient, such as in the prostatic urethra; an antenna for applying microwave or radio frequency energy to the selected target tissue to produce hyperthermal effects therein, thereby causing therapeutic alteration of the selected target tissue cells; a dilation balloon for simultaneously dilating the lumen of the patient and for compressing tissue to restrict blood flow to said tissue, thereby reducing the heat sink effect of blood-supplied tissue absorbing heat energy applied thereto, enabling both greater uniformity of heating in selected target diseased tissue and a reduction in the amount of power required to supply an effective level of energy to the selected target diseased tissue; and a fixation balloon for securing the apparatus during treatment. The apparatus and method are particularly adapted to the treatment of diseases of the prostate, such as benign prostatic hypertrophy, prostatitis and prostatic cancer, as well as in the treatment of certain tumors of the esophagus and the gastro-intestinal tract.

Afzal's invention relates to catheters used to return oxygenated blood from a cardiopulmonary bypass machine to a patient during cardiac surgery. More

specifically, Afzal's invention relates to a perfusion catheter, and methods of use, that enable the catheter to be intraoperatively placed in the aorta using a sutureless arteriotomy seal.

As set forth above, teachings of references can be combined only if there is some motivation, suggestion or incentive to do so. Here, the applied prior art contains none. That is, there is no motivation or suggestion in the applied prior art for one skilled in the art at the time the invention was made to have modified Burton to have a port proximal to Burton's distal balloon (i.e., dilation balloon 18). The disparate teachings of the applied prior art¹ and the manner in which they are proposed to be combined indicate, in our view, that the examiner has engaged in an impermissible hindsight reconstruction of the appellants' invention using the claims as a template to selectively piece together isolated disclosures in the prior art.²

For the reasons set forth above, the decision of the examiner to reject claims 31 to 34 under 35 U.S.C. § 103 is reversed.

¹ Burton and Afzal are directed to very different types of catheters so much so that it would not have been obvious at the time the invention was made to a person of ordinary skill in the art to have applied the teachings of Afzal's catheter to the catheter of Burton.

² The use of hindsight knowledge derived from the appellants' own disclosure to support an obviousness rejection under 35 U.S.C. § 103 is impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

CONCLUSION

To summarize, the decision of the examiner to reject claims 31 to 34 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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