UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex Parte Sorenson *et al.*

Appeal No. 2006-1844
Application No. 10/080,292

ON BRIEF

Before PATE, SCHAFER and NAGUMO, Administrative Patent Judges.

PATE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-12 and 14-24. Claim 13 stands objected to as containing allowable subject matter but depending from a rejected based claim. These are the only claims in the application.

The claimed invention is directed to a medical infusion device which has a discharge portion that can dispense a substantially uniform cylindrical pool of treatment fluids at a treatment site in a patient.

Claims 17, reproduced below, is further illustrative of the claimed subject matter.

17. An infusion device, comprising:

a tubular element having a proximal end and a distal end;

a wall defining an elongate lumen between said proximal and distal ends;

a proximal connection port at said proximal end; and

a discharge portion adjacent to said distal end, said discharge portion being configured and arranged to dispense treatment fluids in a substantially uniform cylindrical pool at a treatment site in a patient.

THE REFERENCES

The references of record relied upon by the examiner as evidence of anticipation and obviousness are:

Verreet et al.(Verreet)	5,156,597	Oct. 20, 1992
Bolger et al.(Bolger)	5,437,290	Aug. 01, 1995
Saadat et al.(Saadat)	5,954,714	Sept. 21, 1999
Henalla	6,071,230	June 6, 2000
Donadio	6,107,004	Aug. 22, 2000
Cragg	6,315,789	Nov. 13, 2001
Sirimanne	6,488,662	Dec. 3, 2002

THE REJECTIONS

Claims 1-9, 11, 12, 14 and 16-20 stand rejected under 35 U.S.C. § 102 as anticipated by Verreet.

Claims 1-11, 12, 14 and 16-20 stand rejected under 35 U.S.C. § 102 as anticipated by Sirimanne.

Claims 1, 6 and 16-17 stand rejected under 35 U.S.C. § 102 as anticipated by Donadio.

Claim 15 stands rejected under 35 U.S.C. § 103 as unpatentable over Verreet in view of Bolger or Saadat or Henalla.

Claim 21 stands rejected under 35 U.S.C. § 103 as unpatentable over Verreet in view of Cragg.

Claims 22-24 stand rejected under 35 U.S.C. § 103 as unpatentable over Verreet in view of Cragg and further in view of Bolger, Saadat or Henalla.

OPINION

The following are our findings of fact as to the scope and content of the prior art and the differences between the prior art and the claimed subject matter.

Verreet discloses a transcutaneous implant catheter designed for more or less permanent implacement as a peritoneal dialysis catheter. The device is a medical infusion assembly with a tubular element having a proximal end 13 and a distal end at disk 14. A wall 10, 11, 12 defines an elongate lumen between the proximal and distal ends. A discharge portion is adjacent the distal end. The discharge portion has a plurality of perforations 16. We infer from the drawings (Figures 1 and 3) that the perforations, while offset from one another longitudinally, are spaced equidistant in a row around the circumference of the tube 10. Thus, Verreet discloses a catheter having many

discharge portions each composed of one circumferential row of equidistant ports. Since the pressure drop at any one discrete row or discharge portion should be the same, we infer that Verreet discloses many radially extending treatment zones of substantially cylindrical shape. While the pressure drop experienced by the various discharge portions is not the same, this is not required by the independent claim 17.

The disclosure of Donadio is directed to methods of making catheters and stents and the catheters and stents made thereby. The examiner directs our attention to Figures 6-10 where the distal ends of catheters are shown. Taking Figure 9 as an example, several circumferential rows of rectangular perforations 52 are shown. Since each circumferential row of perforations 52 experiences the same pressure drop or "head", each circumferential row comprises a discharge portion wherein the dispensed fluids form a substantially uniform cylindrical pool.

Siramanne discloses a percutaneous catheter assembly with a catheter housing 12 and a dilator 20 intended for long term use of several days. The catheter housing is of a size to receive the dilator. Both elements have proximal and distil ends and a set of perforations 36 and 70 respectively. The perforations are located so that the

dilator perforations 70 align with the perforations 36 on the catheter when both are in place so that radiopaque fluid may be injected as the catheter and dilator are placed in the patient. It is not clear whether the ports 36 and 72 are in more than one side of the periphery of the dilator and catheter.

With respect to independent claim 1, we have carefully considered the examiner's argument that the expression "being structured and arranged for substantially uniform discharge of therapeutic fluids therethrough" is [merely] an intended use. The examiner cites *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967). *Casey* is generally cited for the proposition that the manner or method in which an article is used is not germane to the patentability of the article itself. In this case however, it is not the use of the article that is called into play by the above-quoted expression. The phrase plainly refers to the structure and arrangement of the perforations and thus has structural significance.

Secondly, even if this expression could be held to be directed to a manner of use, the examiner, by her own admission, would bear the burden of showing "that the structure[s] provided by the reference[s] possessed the capabilities requisite to meet the terms of the claims."

Casey at 370 F.2d 579, 152 USPQ at 238. The appellants have provided argument and reasoning as to why Verreet, Donadio and Siramanne could not provide these capabilities. Since the examiner has not rebutted appellants' arguments with any additional arguments or evidence, we can not sustain the examiner's rejections of independent claim 1 which is based on these capabilities being found in the prior art.

Accordingly, the rejections of independent claim 1 and the claims dependent thereon under both section 102 and section 103 are reversed.

On the other hand, as outlined above, both Verreet and Donadio disclose multiple discharge portions. Each discharge portion is comprised of a circumferential row of perforations, with each perforation of a discrete row, in use, at the same hydrodynamic head as the other perforations of the same row. Since all perforations of each row are at the same head, each row generates a substantially uniform cylindrical pool of treatment fluid. The claims are silent as to the linear extent of the cylindrical pool or the treatment site. The claims do not exclude a plurality of discharge portions. Thus Verreet and Donadio anticipate claim 17, and Verreet anticipates claim 18. The rejections of these claims under section 102 based on Verreet and Donadio are affirmed.

With respect to claims 19 and 20 we note appellants' argument on page 5 of the supplemental brief that Verreet cannot teach the size limitations claimed in claims 19 and 20. We concur. We reverse the section 102 rejection of claims 19 and 20 based on the Verreet patent.

We note that the rejections of claims 21, 22 and 23 under section 103 are not argued on page 9 of the supplemental brief apart from a limitation of the independent claim 17 from which they depend. Thus claim 21 falls with claim 17 as unpatentable over Verreet in view of Cragg, and claims 22 and 23 fall with claim 17 as unpatentable over Verreet in view of Cragg and any of Bolger, Saadat, or Henalla.

Finally, with respect to claim 24 we agree that none of the applied prior art appears to disclose a patient-operated device in combination with a delivery system. Indeed, the examiner has not so indicated. Accordingly, the rejection of claim 24 under section 103 is reversed.

SUMMARY

All rejections of claims 1-12 and 14-16 are reversed.

The rejections of claims 17-20 under section 102 as anticipated by Siramanne are reversed.

The rejection of claim 17 under section 102 as anticipated by Donadio is affirmed.

The rejection of claims 17 and 18 under section 102 as anticipated by Verreet is affirmed.

The rejection of claims 19 and 20 under section 102 as anticipated by Verreet is reversed.

The rejection of claim 21 under section 103 as unpatentable over Verreet in view Cragg is affirmed.

The rejection of claims 22 and 23 under section 103 as unpatentable over Verreet in view Cragg and any of Bolger, Saadat, or Henalla is affirmed.

The rejection of claim 24 under section 103 as unpatentable over Verreet in view of Cragg is reversed.

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

AFFIRMED-IN-PART

WILLIAM F. PATE, III Administrative Patent Judge	)	
RICHARD E. SCHAFER Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
MARK NAGUMO Administrative Patent Judge	)	

WFP/lp

TRASK BRITT
P.O. BOX 2550
SALT LAKE CITY UT 84110