

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MARK L. MATHIS, GREGORY D. NIEMINEN,  
NATHAN ARONSON, and GARRETT BEGET

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Appeal 2006-2249  
Application 10/429,172  
Technology Center 3700

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Decided: May 24, 2007

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Before EDWARD C. KIMLIN, BRADLEY R. GARRIS, and  
CHARLES F. WARREN, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal the final rejection of claims 1-8 under 35 U.S.C. § 134. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

We AFFIRM.

INTRODUCTION

Appellants claim a device for modifying the shape of tissue adjacent to a lumen (Claim 1). Appellants' device includes a proximal anchor (52), a

distal anchor (54) and a support wire or reshaper disposed therebetween (56) (Specification 2). The device is inserted into a lumen, such that the distal anchor (52) and proximal anchor (54) circumferentially engage the lumen to hold the device in place in the lumen (Specification 2). The support wire (56) is urged against the lumen by the distal anchor (52) and proximal anchor (54) to support the tissue adjacent the lumen (Specification 2). Appellants indicate that the device may be used to aid in the closure of a mitral valve in the heart (Specification 2).

Claims 1 and 5 are illustrative:

1. A device for modifying the shape of tissue adjacent to a lumen, the device comprising:

an anchor adapted to be deployed by a catheter to engage the lumen;  
a support extending from the anchor and adapted to engage the lumen;  
and

a recapture mechanism adapted to assist the recapture of at least a portion of the device into the catheter.

5. The device of claim 3 wherein the recapture mechanism comprises a first surface on the anchor and a second surface on the anchor, the slope of the first surface with respect to a longitudinal axis of the anchor being less than the slope of the second surface with respect to the longitudinal axis of the anchor.

The Examiner relies on the following prior art reference as evidence of unpatentability:

Gaber                    WO 01/87180                    Nov. 22, 2001

The rejections as presented by the Examiner are as follows:

1. Claims 5-6 are rejected under 35 U.S.C. § 112, 1st paragraph, as failing to comply with the enablement requirement.
2. Claims 1-8 are rejected under 35 U.S.C. § 102(b) as being unpatentable over Gaber.

We select claims 1 and 5 as the representative claims to discuss in our opinion below.

## OPINION

### 35 U.S.C. § 102(b) REJECTION

Appellants argue that Gaber fails to disclose the following two claim features: (1) Gaber's stent is "adapted to be deployed by a catheter" and (2) "a recapture mechanism adapted to assist the recapture of at least a portion of the device into the catheter" (Br. 8). Appellants contend that Gaber's stent is "specifically designed to be deployed *without* a catheter" (Br. 8). Appellants further contend that Gaber's stent "would not otherwise be compatible with catheter delivery or recapture" (Br. 9).

We are unpersuaded by Appellants' arguments for the reasons discussed below.

As a preliminary matter, we will not consider or rely on the additional references cited by the Examiner in his Answer (i.e., US 6,733,521; US 6,709,425; US 6,629,994) to show that "the type of catheter . . . for which Gaber . . . is adapted . . . and fully capable of use with as [*sic, is*] well known [*sic, known*] in the art of delivering stents to protect the body from the stent" (Answer 6). The disclosures contained in those references are merely

cumulative to Gaber's disclosure of using catheters to deliver stents in his "Background of the Invention" section (Gaber, 1: 10-15).

Additionally, "[w]here a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of rejection." *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). Because the Examiner did not include the US 6,733,521, US 6,709,425, and US 6,629,994 patents in the statement of the rejection, we will not consider them in our patentability analysis of the claims.

We agree with the Examiner's determination that "[s]ince the stent of Gaber collapses laterally to fit through the vasculature, it is fully capable of fitting into a guide catheter likewise sized to fit through the vasculature" (Answer 6-7). Gaber's disclosure that catheters are used to deploy stents into vessels (Gaber 1:10-15) supports the Examiner's determination that Gaber's stent is fully capable of being deployed by a catheter.

As further evidence that a catheter may be used to deploy Gaber's stent, Webster's New World Dictionary defines "catheter" as "a slender tube inserted into a body passage." *Webster's New World Dictionary of the American Language*, "catheter", p. 99 © 1984. Gaber's manipulator tube 49, outer coupler tube 32, and inner coupler tube 30 used to deploy Gaber's stent are a series of nested, slender tubes, thus satisfying Webster's definition of "catheter" (Gaber 7:5-19). Accordingly, we agree with the Examiner that Gaber's disclosure satisfies Appellants' first argued distinction of an anchor "adapted to be deployed by a catheter."

Regarding Appellants' second argued distinction, Gaber discloses that the stent 10 can be reduced and removed from the lumen and patient by

using a hooked wire 55 to engage hole 56 and pulling the hooked wire 55 proximally to collapse the stent 10 (Gaber 8:11-17). From this disclosure, Gaber discloses a “recapture mechanism” as claimed. Regarding the functional recitation that modifies the claim 1 “recapture mechanism” (i.e., “adapted to assist the recapture of at least a portion of the device into the catheter”), Gaber’s disclosure of a “recapture mechanism”, that collapses stent 10 for removal from the vessel, indicates that Gaber’s stent 10 is inherently functionally capable of being recaptured “into a catheter.” *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997). Accordingly, Gaber satisfies Appellants’ second argued distinction.

For the above reasons, we affirm the Examiner’s § 102(b) rejection over Gaber of argued claim 1 and non-argued claims 2-8.

#### 35 U.S.C. § 112, 1<sup>ST</sup> PARAGRAPH LACK OF ENABLEMENT REJECTION

The Examiner contends that claims 5 and 6 lack enablement because the “disclosure provides to [sic too] many variation[s] [for the selection of the ‘first surface’, ‘second surface’ and ‘longitudinal axis of the anchor’ as recited by claims 5 and 6] such that undue experimentation would be necessary to make and use the [claimed] invention” (Answer 5).

We cannot sustain the Examiner’s § 112, 1<sup>st</sup> paragraph, rejection of claims 5 and 6 as lacking enablement.

The Examiner’s rejection is premised on his determination that the language of claims 5 and 6 permits too many variations such that undue experimentation would be required to make or use the invention. However, the Specification, not the claims, discloses what the invention is and how to

practice it. *In re Kamal*, 398 F.2d 867, 871, 158 USPQ 320, 323 (CCPA 1968) *citing In re Grimme*, 274 F.2d 949, 952, 124 USPQ 499, 501 (CCPA 1960) (explaining that a specification need not disclose every possible configuration of a claim term). Moreover, disclosure in a specification sufficient to enable practice of the invention by one skilled in the art, taking into consideration obvious modifications of exemplary embodiments, is all that is required to satisfy the enablement requirement of 35 U.S.C. § 112, 1<sup>st</sup> paragraph. *In re Dinh-Nguyen*, 492 F.2d 856, 858-59, 181 USPQ 46, 48 (CCPA 1974). It is not a function of the claims to specifically exclude possible inoperative or ineffective embodiments that may be encompassed by a claim. *Id.*

Appellants' Specification describes that the "recapture mechanism" has "a first surface on the anchor" (Figure 5, "proximal portion" 145 and 146) and "a second surface on the anchor (Figure 5, "distal portion" 147 and 148) such that the slope of proximal portions 145 and 146 are less than (i.e., more horizontal than) the slope of the distal sections 147 and 148 (Specification 12:19-25). This description enables one of ordinary skill in the art to make or use the subject matter of claims 5 and 6.

Accordingly, we reverse the Examiner's 35 U.S.C. § 112, 1<sup>st</sup> paragraph, rejection of claims 5 and 6.

## DECISION

The Examiner's rejection of claims 1-8 under § 102(b) over Gaber is AFFIRMED.

The Examiner's rejection of claims 5 and 6 as failing to satisfy the enablement requirement of 35 U.S.C. § 112, 1<sup>st</sup> paragraph, is REVERSED.

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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)(2006).

AFFIRMED

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