

1 *Eli Lilly and Co.*, 119 F.3d 1559, 1566, 43 USPQ2d 1398, 1404 (Fed. Cir. 1997),
2 *cert. denied*, 523 U.S. 1089 (1998)(citing *Vas-Cath Inc. v. Mahurkar*, 935 F.2d
3 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991)). To fulfill the written
4 description requirement, a patent specification must describe an invention and do
5 so in sufficient detail that one skilled in the art can clearly conclude that “the
6 inventor invented the claimed invention.” *Id.* (citing *Lockwood v. Am. Airlines,*
7 *Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997) and *In re Gosteli*, 872
8 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (“[T]he description
9 must clearly allow persons of ordinary skill in the art to recognize that [the
10 inventor] invented what is claimed.”)). Thus, an applicant complies with the
11 written description requirement “by describing the invention, with all its claimed
12 limitations, not that which makes it obvious,” and by using “such descriptive
13 means as words, structures, figures, diagrams, formulas, etc., that set forth the
14 claimed invention.” *Id.* (citing *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966).

15 It is important to note that “[t]he invention is, for purposes of the ‘written
16 description’ inquiry, *whatever is now claimed.*” *Vas-Cath*, 935 F.2d at 1564, 19
17 USPQ2d at 1117.

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FINDINGS OF FACT

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The relevant portion of Appellant’s Specification reads as follows:

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Fluid flow connection means, for example one or more apertures, may be provided in the integrally formed wall means that separates the interior of balloon segment 236 and one or more of the adjacent, external lumens 242, 244 and 246. In this embodiment, instead of having coaxial inner sleeve 234, fluid may be supplied to balloon segment 236 through sleeve 232 and withdrawn through an externally extending adjacent, external lumen such as lumen 242. As seen in Fig. 4, external, adjacent lumen 242 can be formed so as to run

1 the entire length of sleeve 232, including balloon segment 236 and
2 conical ends 238 and 240. Thus, in still another embodiment of this
3 invention, an apparatus similar to that shown in Fig. 4 but having two
4 perimetrical lumens like lumen 242 running the entire length of
5 sleeve 232 could be used to deliver heat transfer fluid to a body
6 location distal of balloon segment 236. The flow of heat transfer
7 fluid, in through one of said perimetrical lumens and out through the
8 other, would not be significantly interrupted even during dilatation of
9 balloon segment 236. Similarly, and for other applications, external,
10 adjacent lumen 244 can be formed so as to run from one end of the
11 middle or working section of balloon 236 to the other. Similarly,
12 external, adjacent lumen 246 can be formed so as to begin and end
13 within the working section of balloon 236. By proper selection of the
14 forming wires, external, adjacent lumens can be created of the same or
15 different diameters, of uniform or non-uniform cross-section, and of
16 circular or other cross-sectional shape, as desired for particular
17 applications. Employing a similar preparation technique, a heat
18 transfer balloon dilatation catheter apparatus can be prepared as
19 shown in Fig. 6 wherein an external, adjacent lumen 252 runs in a
20 helical pattern around the outside wall of balloon 236. Helical lumen
21 252 may comprise, in one embodiment, a plurality of pinholes 254
22 along its length to precisely deliver medication or other fluids to select
23 body locations.

24 (Specification 23:9-24:9).

25 This passage would have conveyed to those skilled in the art that an external
26 adjacent lumen as described and illustrated in Figures 4 and 5 could optionally be
27 provided on the exterior surface of balloon 236 in a helical pattern. The
28 Specification plainly conveys that the pinhole embodiment of Figure 6 is merely
29 “one embodiment” of the external, adjacent lumen of helical shape. Accordingly, it
30 is our finding that Appellant’s disclosure would have conveyed to those of
31 ordinary skill possession of the subject matter of claims 74 and 75.

CONCLUSION

The decision of the Examiner is reversed.

REVERSED

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