

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte MATTHEW A. HOWARD, MARK MAYBERG, SEAN GRADY,  
ROGERS C. RITTER and GEORGE T. GILLIES

---

Appeal No. 96-0022  
Application 08/096,214<sup>1</sup>

---

ON BRIEF

---

ABRAMS, FRANKFORT and CRAWFORD, Administrative Patent Judges.

CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection  
of claims 39, 42, 43 and 44. Claims 1-38 have been canceled,

---

<sup>1</sup> Application for patent filed July 19, 1993. According to appellants, this application is a continuation of Application 07/904,032 filed June 25, 1992, now abandoned, which is a division of Application 07/463,340 filed January 10, 1990, now Patent No. 5,125,888.

Appeal No. 96-0022  
Application 08/096,214

claims 53-70 have been withdrawn from consideration. Claims 40, 41 and 45-52 stand objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form.

The appellants' invention is a drug delivery apparatus which according to the specification is utilized to deliver treatment to a specific location of a body (Specification at page 1). The drug delivery apparatus includes a carrier means for carrying a treatment to a specific location of the body. The carrier means in one embodiment is disclosed as an implant sheath device with a semi-permeable membrane filled with treatment placed inside the implant sheath (Specification at page 3). A leading magnet is releasably connected to the carrier means by a connection means (Specification at page 4). The specification discloses that the leading magnet is manipulated by a magnetic field external to the body so as to move through the body to the specific location in the body to be treated (Specification page 4-5). When the carrier means is in the location needing treatment the connection means releases the magnet so that the magnet can be directed out of the body (Specification, pages 4 and 8). Appellants' specification teaches that the connection means is a heat-sensitive polymer which when inductively heated

Appeal No. 96-0022  
Application 08/096,214

melts thereby disconnecting the magnet from the carrier means  
(Specification, pages 14 and 18).

Independent claim 39 is representative of the subject  
matter on appeal and reads as follows:

39. A drug delivery apparatus comprising:

- a) a magnetic means for inserting in a body part;
- b) a carrier means for carrying a treatment to a  
specific location in the body part; and
- c) a connection means for releasably connecting the  
carrier means to the magnetic means and for disengaging the  
carrier means from the magnetic means.

#### THE REFERENCES

The following reference was relied on by the examiner:

Diefenbach	2,589,349	March 18, 1952
------------	-----------	----------------

#### THE REJECTIONS

Claims 43 stands rejected under 35 U.S.C. § 112, second  
paragraph.

Claim 39 stands rejected under 35 U.S.C. § 102(b) as  
being anticipated by Diefenbach.

Claims 42-44 stand rejected under 35 U.S.C. § 103 as  
being obvious over Diefenbach.

Rather than reiterate the entire arguments of the  
appellants and the examiner in support of their respective

Appeal No. 96-0022  
Application 08/096,214

positions, reference is made to appellants' brief (Paper No. 29) and appellants' reply brief (Paper No. 31).

#### OPINION

In reaching our conclusions on the issues raised in this appeal, we have carefully considered appellants' specification and claims, the applied reference, and the respective viewpoints advanced by the appellants and the examiner. These considerations lead us to make the determinations which follow.

With regard to the examiner's rejection of claim 43 under 35 U.S.C. § 112, second paragraph, we initially note that the purpose of the requirement stated in the second paragraph of 35 U.S.C. § 112 is to provide those who would endeavor, in future enterprise, to approach the area as circumscribed by the claims of a patent, with the adequate notice demanded by due process of law, so that they may more readily and adequately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). The inquiry as stated in In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971) is:

Appeal No. 96-0022  
Application 08/096,214

... whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity.... [t]he definiteness of the language employed must be analyzed--not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art.

In the instant case, the examiner is of the opinion that the recitation "like a torpedo" in claim 43 is indefinite since a torpedo can assume a variety of shapes. In regard to the appellants argument that a torpedo is defined in Websters Third New International Dictionary to be shaped like a cigar, the examiner states that cigars can also assume a variety of shapes. The examiner also states that it is not readily apparent that element 61 is shaped like a torpedo or like a cigar in Figures 9-11 and that the term torpedo is never used to describe magnet 61 in the specification.

We do not agree with the examiner. Contrary to the assertion of the examiner, the specification at page 4 discloses that the magnetic means has a torpedo-like shape. In our view, this disclosure along with the depiction of magnetic means 61 in Figure 11 provide adequate notice of the shape of the magnetic means to those who would endeavor, in future enterprise to

Appeal No. 96-0022  
Application 08/096,214

approach the area circumscribed by claim 43. We will not sustain the examiner's rejection of claim 43 under 35 U.S.C. § 112, second paragraph.

Turning now to the examiner's anticipation rejection of claim 39, we find that Diefenbach discloses a magnetic key case which includes a magnet 15 attached to a container 7 with a sliding cover 11. The container holds a key 8. The examiner considers the magnet 15 to be a "magnetic means for inserting in a body part", the sliding cover 11 to be a "carrier means for carrying a treatment to a specific location in the body part" and the container 7 to be a "connection means for releasably connecting the carrier means to the magnetic means."

The examiner argues that the language "drug delivering apparatus" is a statement of intended use and that the case 11 disclosed in Diefenbach is capable of carrying a treatment (See Examiner's Answer at page 4). The examiner also argues that a body can include a myriad of possibilities such as a car (Final Rejection at page 5). However, we, as well as the examiner, are charged with interpreting the recitations in claim 39 consistent with the specification which is clearly directed to a drug delivering apparatus for carrying treatment to a specific location in the body of an animal such as a human being. As

Appeal No. 96-0022  
Application 08/096,214

such, we are at a complete loss to understand the basis of the examiner's anticipation rejection. Diefenbach simply does not disclose a drug delivering apparatus. We will not sustain the examiner's rejection of claim 39 under 35 U.S.C. § 102(b) as anticipated by Diefenbach.

In addition, we will not sustain the examiner's rejection under 35 U.S.C. § 103 of claims 42-44, which are dependent of claim 39 because we find absolutely no teaching or suggestion in Diefenbach of a drug delivering apparatus which includes a carrier means for carrying a treatment to a specific location in a body part.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
	)	
	)	)
CHARLES E. FRANKFORT	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
MURRIEL E. CRAWFORD	)	
Administrative Patent Judge	)	

Appeal No. 96-0022  
Application 08/096,214

James C. Wray  
1493 Chain Bridge Road  
Suite 300  
McLean, VA 22101