

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 41

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte A. LANE KEITH, GARY G. MASSENGALE,
JOHN T. RIDDLE and RONALD B. ROTH

Appeal No. 2002-0396
Application No. 08/331,280

ON BRIEF

Before KIMLIN, OWENS, and PAWLIKOWSKI, Administrative Patent Judges.

OWENS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1, 4-9 and 11-18. Claims 2, 3, 10, 24 and 34-42, which are all of the other claims in the application, stand allowable.

THE INVENTION

Appeal No. 2002-0396
Application No. 08/331,280

1. A microtube having a relatively stiffer proximal end and a relatively more flexible distal end comprising:

an inner cured resin layer;

a braid layer over the inner cured resin layer;

an outer cured resin layer over and encasing the braid layer;

wherein the braid layer is woven in a weave having relatively fewer picks per inch at the proximate end and relatively more picks per inch at the distal end.

9. A microtube having a proximate end and a distal end and an inner layer and an outer layer comprising:

an inner cured resin layer extending from the proximate end of the microtube to a point intermediate the proximate end and the distal end of the microtube;

a braid layer over the inner cured resin layer from the proximate end to the intermediate point, said braid layer constituting the inner layer from the intermediate point to the distal end of the microtube; and

an outer cured resin layer over and encasing the braid layer.

11. A microtube having a tube wall with an outer surface and an inner lumen connecting a proximal end and a distal end, said tube wall comprising at least two adjacent layers and wherein the cross section of the inner lumen at the proximate end is of relatively greater area than the cross section of the inner lumen at the distal end.

Appeal No. 2002-0396
Application No. 08/331,280

THE REJECTIONS

The claims stand rejected as follows: claims 1 and 4-8 under 35 U.S.C. § 102(e) as anticipated by Pray, and claims 9 and 11-18 under 35 U.S.C. § 103 as obvious over Pray in view of Sepetka.

OPINION

We reverse the aforementioned rejections. We need to address only the independent claims, i.e., claims 1, 9 and 11.

Rejection of claim 1

The appellants concede that if Pray is available as a reference under 35 U.S.C. § 102(e), it anticipates the microtube claimed in the appellants' claim 1 (reply brief, page 1). The appellants state that the appellants and the examiner appear to be in agreement that, with respect to the appellants' claim 1, Pray has an effective filing date of April 9, 1993, which is the first filing date of a Pray application containing a disclosure of a braid layer having fewer picks per inch at the proximal end than at the distal end (brief, page 9). The appellants argue that the second supplemental declaration under 37 CFR § 1.131

Appeal No. 2002-0396
Application No. 08/331,280

The examiner argues that the declaration fails to overcome Pray because to do so the declaration needs to show not just a braid having a variable pick count, but a braid having fewer picks per inch at the proximal end than at the distal end, since this is what is recited in the appellants' claim 1 (answer, page 6).

The examiner's argument is that the declaration must show written descriptive support for the claimed invention under 35 U.S.C. § 112, first paragraph. A showing under 37 CFR § 131, however, does not have to show adequate support for the claimed invention under 35 U.S.C. § 112. See *In re Clarke*, 356 F.2d 987, 991, 148 USPQ 665, 669 (CCPA 1966); *In re Hostettler*, 356 F.2d 562, 565, 148 USPQ 514, 516 (CCPA 1966). All that is required of a Rule 131 declaration is that it must show possession, before the effective date of the reference, of subject matter which at least would have rendered obvious to one of ordinary skill in the art so much of the claimed invention as the reference shows. See *In re Rainer*, 390 F.2d 771, 774, 156 USPQ 334, 336 (CCPA 1968);

Appeal No. 2002-0396
Application No. 08/331,280

Pray discloses a microtube having a relatively stiffer proximal end and a relatively more flexible distal end, comprising an inner cured resin layer (24), a braid layer (52) over the inner cured resin layer, and an outer cured resin layer (54) over and encasing the braid layer, wherein the braid layer is woven in a weave having relatively fewer picks per inch at the proximate end and relatively more picks per inch at the distal end (col. 2, lines 31-34; col. 3, lines 22-30; col. 3, line 66 - col. 4, line 37; col. 10, lines 13-14).

The second supplemental declaration under 37 CFR § 1.131 shows that, no later than November 1992, the appellants were in possession of a microtube having an inner cured resin layer, a braid layer over the inner cured resin layer, and an outer cured resin layer over and encasing the braid layer, wherein the braid pick count varies over the length of the catheter to provide increased flexibility from the proximal end to the distal end (declaration exhibits D, E, F, G, H, J, K, L, N and O).

The declaration exhibits do not show fewer picks per inch at

Appeal No. 2002-0396
Application No. 08/331,280

vary the pick count such that the desired flexibility increase from the proximal end to the distal end is obtained.

The second supplemental declaration under 37 CFR § 1.131, therefore, shows possession of subject matter which at least would have rendered obvious to one of ordinary skill in the art so much of the claimed invention as Pray shows. Hence, the declaration has removed Pray as a reference.

Rejection of claim 9

The appellants' claim 9 does not include any variation in picks per inch such as that recited in claim 1. The appellants do not argue that Pray is unavailable as a reference for the disclosures therein relied upon by the examiner regarding claim 9.

The appellants' claim 9 requires an inner cured resin layer having over it a braid layer extending from the proximal end of the microtube to an intermediate point, and requires that from the intermediate point to the distal end of the microtube, the braid layer is the inner layer.

Appeal No. 2002-0396
Application No. 08/331,280

skill in the art to end Pray's inner tube at an intermediate point to provide this benefit (answer, pages 4-5).

Sepetka discloses a microtube having an outer tube, three inner tube sections which increase in flexibility from the proximal end to the distal end, and a fourth section at the distal end which has no inner tube and is the most flexible of the four sections (col. 2, lines 21-23 and 57-65; col. 3, lines 65-67; figure 2).

Pray's outer tube comprises, as the proximal section, a composite polyimide-encased stainless steel braid tube and, as the distal section, a polyethylene tube having no stainless steel braid (col. 3, lines 27-30 and 61-65; col. 5, lines 24-25 and 43). The composite polyimide-encased stainless steel braid tube which comprises the proximal section provides enhanced pushability (col. 3, lines 63). One of ordinary skill in the art would not have been led by the applied prior art to remove the inner polyimide layer at an intermediate point because doing so would make the proximal section more flexible, thereby reducing

Appeal No. 2002-0396
Application No. 08/331,280

embodiment there is, inside the outer tube, a polyethylene inner tube which necks down in the direction from the proximal end to the distal end (col. 3, lines 23-26). Even if this tube were removed at some intermediate point, however, the microtube claimed in the appellants' claim 9 would not be obtained because there is no braid layer in Pray's distal section.

The examiner, therefore, has not carried the burden of establishing a *prima facie* case of obviousness of the microtube claimed in the appellants' claim 9.

Rejection of claim 11

The appellants' claim 11 requires a tube wall comprising at least two adjacent layers and having an outer surface and an inner lumen, the cross section of the inner lumen being larger at the proximal end than at the distal end.

The examiner argues that "Sepetka shows a tube which tapers from one end to the other and which also comprises more than one layer wherein the layers are adjacent to each other" (answer, page 7). The appellants' claim 11, however, requires that the

Appeal No. 2002-0396
Application No. 08/331,280

outer wall preferably is of substantially constant diameter along the three sections which have an inner tube (col. 3, lines 59-61). The examiner has not pointed out a disclosure in Sepetka of an outer wall having an inner lumen which decreases in diameter or cross section from the proximal end to the distal end.

The examiner argues that Pray discloses an inner tube having an inner diameter which is larger at the proximal end than at the distal end (answer, page 7). The appellants' claim 11, however, requires that the inner lumen of the outer wall has a larger cross section at the proximal end than at the distal end. The inner tube referred to by the examiner (tube 24, figure 1) is not part of the outer wall (col. 3, line 5).

Hence, the examiner has not carried the burden of establishing a *prima facie* case of obviousness of the microtube claimed in the appellants' claim 11.



Appeal No. 2002-0396
Application No. 08/331,280

DECISION

The rejections of claims 1 and 4-8 under 35 U.S.C. § 102(e) as anticipated by Pray, and claims 9 and 11-18 under 35 U.S.C. § 103 as obvious over Pray in view of Sepetka, are reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
TERRY J. OWENS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
BEVERLY A. PAWLIKOWSKI)	
Administrative Patent Judge)	

Douglas T. Johnson, Esq.
MILLER & MARTIN
1000 Volunteer Building
832 Georgia Avenue
Chattanooga, TN 37402-2289