



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,694	09/13/2012	7,691,143 B2	80668-851423	3998

28390 7590 05/05/2016
MEDTRONIC VASCULAR, INC.
IP LEGAL DEPARTMENT
3576 UNOCAL PLACE
SANTA ROSA, CA 95403

EXAMINER

JASTRZAB, JEFFREY R

ART UNIT	PAPER NUMBER
----------	--------------

3993

MAIL DATE	DELIVERY MODE
-----------	---------------

05/05/2016

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EDWARDS LIFESCIENCES CORPORATION
Requester

v.

MEDTRONIC, INC.¹
Patent Owner, Appellant

Appeal 2015-007911
Inter partes Reexamination Control 95/000,694
Patent US 7,691,143 B2²
Technology Center 3900

Before DANIEL S. SONG, MICHAEL L. HOELTER, and
BRETT C. MARTIN, *Administrative Patent Judges*.

SONG, *Administrative Patent Judge*

DECISION ON APPEAL

¹ Medtronic, Inc. is the Patent Owner and the real party in interest (Appeal Brief of Patent Owner (hereinafter “App. Br.”) 1).

² Patent US 7,691,143 B2 (hereinafter “the ’143 patent”) issued April 6, 2010 to Wright et al.

STATEMENT OF THE CASE

Claims 35 and 36 of the '143 patent are the only claims subject to reexamination that remain rejected (Right of Appeal Notice (hereinafter "RAN") PTOL-2066). The Patent Owner appeals under 35 U.S.C. §§ 134(b) and 315 from the Examiner's rejections of claims 35 and 36 (App. Br. 1). In addition to the Appeal Brief and Rebuttal Brief, the Patent Owner also relies on the Declaration of Ryan³ (hereinafter "Ryan Decl."). We have jurisdiction under 35 U.S.C. §§ 134(b) and 315.

We are also informed that the '143 patent was involved in a legal action, the settlement of which resulted in the withdrawal of the Requester in any further participation in the reexamination proceeding and related appeals (Rebuttal Br. (hereinafter "Reb. Br.") 1).

We REVERSE the Examiner's rejections.

The '143 patent is directed to an annuloplasty ring holder and a method for releasing an annuloplasty ring (Abstract; Claims App'x). Claim 35 is independent and claim 36 depends therefrom. Claim 35 reads as follows (Claims App'x):

35. A method of releasing an annuloplasty ring from an annuloplasty ring holder comprising: providing an annuloplasty ring holder having more than one spoke with an upper surface and an annuloplasty ring receiving surface facing opposite the upper surface, an annuloplasty ring removably attached with at least one suture to the annuloplasty ring receiving surface; severing a single suture once thereby fully releasing the annuloplasty ring; and disassociating the annuloplasty ring holder from the annuloplasty ring.

³ Declaration of Timothy R. Ryan, dated Aug. 19, 2013.

The Examiner rejects claims 35 and 36 as follows:

1. Under 35 U.S.C. § 102(b) as anticipated by Cosgrove⁴; and
2. Under 35 U.S.C. § 102(b) as anticipated by Schoon.⁵

ISSUES

The following issues have been raised in the present appeal.

1. Whether the Examiner erred in interpreting the claim term “fully releasing.”
2. Whether the Examiner erred in interpreting the claim term “opposite.”
3. Whether the Examiner erred in rejecting claims 35 and 36 as anticipated by Cosgrove.
4. Whether the Examiner erred in rejecting claims 35 and 36 as anticipated by Schoon.

ANALYSIS

Claim Interpretation: “Fully Releasing”

The Examiner states that because the ’143 patent does not set forth a definition for the limitation “fully releasing,” and because this limitation is not a term of art, its plain and ordinary meaning is applicable (Ans. 10).

Referring to a dictionary, the Examiner states that “‘fully’ is understood to mean ‘completely’ or ‘entirely’ and ‘release’ is understood to mean ‘to set

⁴ U.S. Patent No. 5,350,420 issued Sept. 27, 1994.

⁵ U.S. Patent No. 6,319,280 B1 issued Nov. 20, 2001.

free from restraint’ or ‘to stop holding.’” (Ans. 11, citing www.merriam-webster.com). Based thereon, the Examiner interprets “fully releasing” to mean “completely or entirely setting free or disassociated.” (Ans. 11).

The Patent Owner generally agrees with the Examiner’s articulated construction stating that “fully releasing” means to completely or entirely stop holding (App. Br. 11), but disagrees that the limitation includes “disassociated.” (Reb. Br. 1–2). We understand the Patent Owner’s objection to be based on the inclusion of the term “disassociated,” which is recited in the subsequent step of the claimed methods. While we perceive no significant difference as to the articulated constructions of the Patent Owner and the Examiner, we do agree that the Examiner’s construction is somewhat confusing in that it utilizes a term explicitly recited in a subsequent step in the claims. Thus, we construe “fully releasing” to mean completely or entirely stop holding as advocated by the Patent Owner.

The substantive claim interpretation dispute is directed to what this limitation “fully releasing” means within the context of claim 35. The Examiner states that because the claim specifically recites an additional disassociating step, which is generally described in the Specification of the ’143 patent as “gentle pulling or teasing of the hairpin loops 78,” the claim allows for and requires an additional step “to obtain a complete release of the ring from the holder.” (Ans. 11 citing col. 6, ll. 9–15 and 49–52; *see also* Ans. 10). The Examiner further notes that the Specification of the ’143 patent only mentions “fully releasing” in the context of releasing the ring suture from the ring (Ans. 10). Thus, the Examiner concludes that considering the claim language, a person of ordinary skill in the art “would

have understood that the single suture provides the removable attachment of the ring to the receiving surface.” (RAN 6–7; *see also* App. Br. 12).

The Patent Owner argues that “fully releasing” as recited in claim 35 “means that the holder must ‘completely’ or ‘entirely’ ‘stop holding’ the annuloplasty ring” (App. Br. 11, bolding removed) so that it is the severing of the suture that fully releases the annuloplasty ring (Reb. Br. 4). In support, the Patent Owner argues that “[i]mportantly, ring suture 76 is the only means by which the annuloplasty ring is held to the holder.” (App. Br. 10, citing col. 2, ll. 51–52 (“a single ring suture which is also securely attached to the head is used to secure the ring”). In further support, the Patent Owner (App. Br. 10; *see also* Reb. Br. 2) notes that the Specification of the ’143 patent states:

[r]elease of the annuloplasty ring from the holder is accomplished by using a scalpel in scalpel slot **70**, hence severing the retaining suture **74**, which in turn releases hairpin loops **78**.

(’143 patent, col. 6, ll. 9–12; *see also* col. 2, ll. 54–57).

The Patent Owner also argues that other actions, such as pulling the ring suture from between the ring and the annulus tissue, are part of the “disassociation” step which is distinct from the step of “fully releasing” the annuloplasty ring. (App. Br. 11; *see also* Reb. Br. 2).

While we understand the dispute, we do not find the issue to be dispositive because as discussed *infra*, we agree with the Patent Owner that the prior art fails to anticipate claim 35 regardless of the claim interpretation applied.

Claim Interpretation: “Opposite”

Another claim interpretation issue pertains to the term “opposite” that is recited in the limitation “opposite the upper surface.” The Examiner states that “[t]he term ‘opposite’ is broadly considered to be any direction other than the upper surface.” (Ans. 3). The Patent Owner argues that the Examiner’s interpretation is unreasonably broad, citing to various portions of the Specification of the ’143 patent that describe the annuloplasty ring receiving surface is opposite the upper surface and faces away from the handle (Reb. Br. 4–5, citing col. 3, ll. 50–57; col. 3, l. 64–col. 4, l. 1; col. 4, ll. 3–6; *see also* Figs. 1, 2).

We agree with the Patent Owner. There is no reasonable basis to conclude that the term “opposite” can be read to mean “any direction other than the upper surface.” To the contrary, a person of ordinary skill in the art reading the claims in view of the Specification would understand that the ordinary meaning of the term “opposite” is applicable⁶ so that the annuloplasty ring receiving surface must be positioned across, and at the other end/side of the spokes’ upper surface.

Anticipation by Cosgrove

As noted above, the Examiner concludes a person of ordinary skill in the art “would have understood that the single suture provides the removable attachment of the ring to the receiving surface.” (RAN 6–7; *see also* App.

⁶ The term “opposite” is defined as: “placed in corresponding positions across an intervening, line, space, etc.” (Random House Webster’s College Dictionary (1992); and “set over against something that is at the other end or side of an intervening line or space.” (www.merriam-webster.com).

Br. 12). The Examiner finds that Cosgrove anticipates claim 35 because “Cosgrove severs a single suture 70 to fully release the annuloplasty ring [] and then the annuloplasty ring 10 is disassociated from the annuloplasty ring holder 18.” (Ans. 4; *see also* Ans. 3, 16–17). The Examiner also finds that because “[t]he term ‘opposite’ is broadly considered to be any direction other than the upper surface,” the spokes of the device of Cosgrove have an upper surface and an annuloplasty ring receiving surface opposite thereto (Ans. 3).

In addition to arguments based on the claim construction of “fully releasing” (App. Br. 18), the Patent Owner argues that:

[n]otably, *Cosgrove also fails to meet the Office’s purported interpretation*, that the claim requires “full release of the ring from the receiving surface”. (RAN, p. 10 (emphasis original).) Cosgrove’s ring is not fully released from the ring receiving surface because the ring receiving surface — namely groove 32 — still holds the ring after the suture is severed.

(App. Br. 20).

We generally agree with the Patent Owner. While the suture would be necessary to properly position the holder of Cosgrove together with its annuloplasty ring, it is speculative to find that the annuloplasty ring in the device of Cosgrove would not still be retained in groove/trough 32, which defines the receiving surface upon severing the suture. In this regard, we observe that Cosgrove discloses that “the trough **32** slightly deforms the ring prosthesis **10**” so that “[t]his deformation places a thicker portion of the woven cloth **16** outside of the trough **32**.” (Cosgrove, col. 5, ll. 38–42). This disclosure in Cosgrove indicates that at least a portion of groove 32 is dimensioned slightly smaller than the ring prosthesis to be received therein

so as to at least slightly grip the ring prostheses. Such gripping of the ring prostheses makes the Examiner's finding that the severing of the suture would fully release the annuloplasty ring from the groove/trough somewhat speculative.

We also find persuasive the Patent Owner's argument that:

Cosgrove discloses the type of holder *from which the '143 patent specifically departs and explicitly disparages*. ('143 patent 3:60–4:6; Ryan Decl., ¶ 16.) That is . . . Cosgrove teaches an annuloplasty ring *mounted about a circumferential groove and against circumferential flanges of the holder*. (Ryan Decl., ¶ 16.)

(App. Br. 18).

Construing and applying the claim to encompass a device of the type explicitly disparaged and distinguished in the Specification of the '143 patent is unreasonable. Furthermore, as discussed *supra*, we disagree with the Examiner's construction of the term "opposite," and find that the groove of Cosgrove does not face "opposite the upper surface" as required by claim 35.

Therefore, for the above reasons, we reverse the Examiner's anticipation rejection of claims 35 and 36 based on Cosgrove. Remaining issues of dispute between the Examiner and the Patent Owner with respect to this rejection do not alter our analysis.

Anticipation by Schoon

The Examiner finds that Schoon anticipates claim 35 because it "discloses that annuloplasty ring 50 can be released from holder 10 by severing suture 58," the Examiner further finding that the holder is

disassociated from the annuloplasty ring by tilting or lifting the holder at an angle (Ans. 6, citing Schoon, col. 3, ll. 17–22; *see also* Ans. 15). The Examiner also finds that because “[t]he term ‘opposite’ is broadly considered to be any direction other than the upper surface,” the “[r]ing attachment portion 16 [of Schoon] faces opposite the upper surface of the spokes of the annuloplasty ring holder” as required by the claims (Ans. 7).

In addition to arguments based on the claim construction of “fully releasing” (App. Br. 13–14), the Patent Owner argues that:

[n]otably, *Schoon also fails to meet the Office’s purported interpretation*, that the claim requires “full release of the ring from the receiving surface”. (RAN, p. 10 (emphasis original).) Schoon’s ring is not fully released from the ring receiving surface because the “ring receiving surface” — namely ring attachment portion 16, backing lip 22, and shoulder tab 24 — still holds the ring after the suture is severed.

(App. Br. 17).

We generally agree with the Patent Owner, and find that upon severing of the suture in Schoon, ring attachment portion 16, backing lip 22, and shoulder tab 24 that define the receiving surface would still retain the annuloplasty ring therein. As pointed out by the Patent Owner (App. Br. 16), Schoon specifically states that:

prosthetic ring **50** is securely held to holder **10** at two locations approximately 180° apart by suture **58** extending between holes **42a**, **42b** and between backing lip **22** and shoulder tab **24** (shown in FIG. 5).

(Schoon, col. 3, ll. 10–13).

In view of this explicit teaching in Schoon, we generally agree with the Patent Owner (App. Br. 16) that even after suture 58 is cut, prosthetic

ring 50 would likely not be fully released from the annuloplasty ring receiving surface as required by claim 35. The Examiner's finding to the contrary is speculative. Furthermore, for reasons already discussed *supra*, we also disagree with the Examiner's construction of the term "opposite, and find persuasive the Patent Owner's argument that:

Schoon teaches an annuloplasty ring *mounted about a circumferential groove and against circumferential flanges of the holder. This is the type of holder from which the '143 specifically departs and explicitly disparages.* ('143 patent, 3:60–4:6; Ryan Decl., ¶ 13.)

(App. Br. 14).

Therefore, for the above reasons, we also reverse the Examiner's anticipation rejection of claims 35 and 36 based on Schoon. Remaining issues of dispute between the Examiner and the Patent Owner with respect to this rejection do not alter our analysis.

ORDERS

The Examiner's anticipation rejections of claims 35 and 36 based on Cosgrove or Schoon are REVERSED.

Requests for extensions of time in this *inter partes* reexamination proceeding are governed by 37 C.F.R. § 1.956. In the event neither party files a request for rehearing within the time provided in 37 C.F.R. § 41.79, and this decision becomes final and appealable under 37 C.F.R. § 41.81, a party seeking judicial review must timely serve notice on the Director of the United States Patent and Trademark Office. *See* 37 C.F.R. §§ 90.1 and 1.983.

Appeal 2015-007911
Reexamination Control 95/000,694
Patent US 7,691,143 B2

REVERSED

PATENT OWNER:
MEDTRONIC VASCULAR, INC.
IP LEGAL DEPARTMENT
3576 Unocal Place
Santa Rosa, CA 95403

THIRD PARTY REQUESTER:
KILPATRICK TOWNSEND & STOCKTON LLP
Two Embarcadero Center
Eighth Floor
San Francisco, CA 94111-3834

cdc