UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDY E. DENISON

Appeal 2009-004110
Application 10/158,362
Technology Center 3700

Decided: January 19, 2010

Before: WILLIAM F. PATE III, JOHN C. KERINS and
STEVEN D.A. MCCARTHY, *Administrative Patent Judges*.

PATE III, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a rejection of claims 1-26, 51-54 and 56-63. App. Br. 3. We have jurisdiction under 35 U.S.C. § 6(b).

The claims are directed to a longitudinally flexible stent for implanting in a body lumen and the method of making such a stent. Claim 1, reproduced below, is illustrative of the claimed subject matter:

> 1. A longitudinally flexible stent for implanting in a body lumen and expandable from a contracted condition to an expanded condition, comprising:
>
> a plurality of adjacent cylindrical elements, each cylindrical element having a circumference extending about a longitudinal stent axis and being substantially independently expandable in the radial direction;
>
> wherein the plurality of adjacent cylindrical elements are arranged in alignment along the longitudinal stent axis and form a generally serpentine wave pattern transverse to the longitudinal axis and each cylindrical element has a plurality of alternating valley portions and peak portions, the valley portions including alternating double-curved portions and Y-shaped portions, and the peak portions including alternating, inverted double-curved portions and inverted Y-shaped portions; and
>
> a plurality of interconnecting members extending between the adjacent cylindrical elements and connecting the adjacent cylindrical elements to one another, interconnecting members being connected to the alternating double-curved portions to connect a cylindrical element to the Y-shaped portion of an adjacent cylindrical element, and interconnecting members being connected to the alternating, inverted double-curved portion to connect a cylindrical element to the alternating, inverted Y-shaped portion of an adjacent cylindrical element.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Berry	WO 99/15108	Apr. 1, 1999

Claims 1, 4, 5, 8-21, 23-26, 51-54, 56-60, 62 and 63 stand rejected under 35 U.S.C. § 102(b) as being anticipated or in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Berry. Ans. 3.

Claims 2, 3, 6, 7, 22 and 61 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Berry. Ans. 4.

OPINION

The disputed claim limitation in this appeal, appearing in each of independent claims 1, 51 and 57, requires "valley portions including alternating double-curved portions and Y-shaped portions, and [] peak portions including alternating, inverted double-curved portions and inverted Y-shaped portions." The Examiner identifies the "double-curved portion[]" in the Berry reference as "a portion of the longitudinally extending member on top of the W, but not a portion of the longitudinally extending member on the bottom of the W." Ans. 7. The Examiner identifies the "Y-shaped portion[]" as "a portion of the longitudinally extending member on the bottom of the Y, but not a portion of the longitudinally extending member on the top of the Y." Ans. 7. Appellant contends that this interpretation is unreasonable because "the Examiner's position requires the viewer to first visualize one shape and then completely disregard portions of that shape in order to visualize a second, distinctive shape." Appellant contends the claims instead require "[c]omplete and distinct structural shapes depicting both the double-curved shape and Y-shape." App. Br. 12; Reply Br 7.

A determination of anticipation, as well as obviousness, involves two steps. First is construing the claim, a question of law, followed by, in the case of anticipation or obviousness, a comparison of the construed claim to

the prior art. This comparison process involves fact-finding. *Key Pharmaceuticals v. Hercon Labs. Corp.*, 161 F.3d 709, 714 (Fed. Cir. 1998) (citations omitted). "[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification." *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). The ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1319 (Fed. Cir. 2005) (en banc).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. The key to supporting any prima facie conclusion of obviousness under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Court *in KSR International Co. v. Teleflex Inc*., 550 U.S. 398, 418 (2007) noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re*

Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006), cited with approval in *KSR*, 550 U.S. at 418.

Initially we note that it is not reasonable to rely on the same structure depicted at the interconnection of Berry's stent segments to meet both of the limitations requiring a "double-curved shaped portion" and a "Y-shaped portion." Berry fig. 23; Ans. Appendix. *See e.g. Lantech, Inc. v. Keip Machine Co.*, 32 F.3d 542 (Fed. Cir. 1994)(in infringement context, a single conveyor held to not meet claim element requiring at least two conveyors); *In re Robertson*, 169 F.3d 743 (Fed. Cir. 1999)(claim requiring three separate means not anticipated by structure containing two means where one of the two means was argued to meet two of the three claimed means). Instead, the Examiner contends that "the structure which the examiner has identified as the double curved portion is not identical to the structure identified as the Y-shaped portion." Ans. 7. However, that "structure" identified by the Examiner results only from an arbitrary delineation of Berry's structure, made in order to meet the claim limitations. Even giving the claims their broadest reasonable interpretation, one of ordinary skill in the art would not have understood the claim terms requiring "double-curved portions" and "Y-shaped portions" to include the arbitrary portions of Berry defined only by the Examiner.

Since in finding a lack of novelty the Examiner relied upon an unreasonable interpretation of the claims, the rejection of claims 1, 4, 5, 8-21, 23-26, 51-54, 56-60, 62 and 63 as being anticipated by Berry cannot be sustained. The Examiner's rationale for concluding that, in the alternative, the subject matter of these claims would have been obvious over Berry does not correct the erroneous claim construction. Ans. 3-4. Accordingly, the

rejection of these claims, along with dependent claims 2, 3, 6, 7, 22 and 61 as being unpatentable over Berry also cannot be sustained.

DECISION

For the above reasons, the Examiner's rejections of claims 1-26, 51-54 and 56-63 are reversed.

REVERSED

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