

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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KARL-LUTZ LAUTERJUNG

Appeal No. 2003-1502
Application No. 09/365,860

ON BRIEF

Before ABRAMS, FRANKFORT, and NASE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 5
10 and 52, which are all the claims remaining in the application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a device for retaining a prosthesis within a body passage. An understanding of the invention can be derived from a reading of exemplary claim 1, which has been reproduced below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Kwan-Gett	5,151,105	Sep. 29, 1992
Inoue (Inoue '671)	5,676,671	Oct. 14, 1997
Inoue (Inoue '179)	5,976,179	Nov. 2, 1999

Claims 1, 2, 5 and 10 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Inoue '179 or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Inoue '179.

Claim 52 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Inoue '671 or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Inoue '671.

Claims 1 and 2 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kwan-Gett.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 16) for the examiner's complete reasoning in support of the rejections, and

to the Brief (Paper No. 15) and Reply Brief (Paper No. 17) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Representative Claim 1

A device for retaining a prosthesis within a body passage comprising an annular, resilient element, wherein said element is formed by overlapping a plurality of windings of wire radially on top of one another around a common core and connecting the two windings together to form a bundle, said wire being sized to decrease the minimum bending diameter of said element.

The Section 102 Rejection Based Upon Inoue '179

Claim 1 stands rejected as being anticipated¹ by Inoue '179. In arriving at this conclusion, the examiner has taken the position that "the multiple rings [of Inoue '179] are windings of wire to the extent required" (Answer, page 4), which we assume means the examiner considers the rings disclosed in Inoue '179 to constitute "windings." The

¹Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of the claimed invention. See, for example, RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

appellant argues that this is an erroneous conclusion in view of the common definition of “winding” as well as the explanation of the invention in the specification.

There appears to be no dispute that a “winding” is a turn of wire or rope wound around an object, a spiral, for the appellant has so asserted on page 13 of the specification and the examiner has offered such a definition on page 7 of the Answer. The appellant’s specification explains the construction of the clamping rings in a manner that conforms with this definition, for it describes them as being formed by “wrapping a single length of wire around the mandrel” to form a number of coils (page 7). Based upon this evidence, it is our opinion that the designation of a wire as a “winding” in the present case would be interpreted by one of ordinary skill in the art to be a structural limitation requiring that the annular wire ring be formed by winding a wire in a spiral manner about an object such as a core. In this regard, the appellant argues that the broadest reasonable interpretation of a winding does not include a closed ring, which is what he believes is disclosed in Inoue ‘179.

Inoue ‘179 discloses a collapsible prosthesis having, as shown in Figure 36, to which the examiner refers, an “end wire ring” W1 comprising four wire elements W2 bound together. Neither the manner in which the wire elements are manufactured nor details of their construction are explained, other than to state that they preferably are made of nickel-titanium alloy and have sufficient flexibility and strength so there is little danger of them injuring the blood vessel into which the prosthesis is inserted (column

21). The wire elements are not described as being “windings,” nor can it be determined from the drawings that they are anything other than closed annular rings.

We therefore find ourselves in agreement with the appellant that the examiner’s determination that the wire elements disclosed in Inoue ‘179 are “windings” is not supported by the evidence. This being the case, it is our conclusion that Inoue ‘179 does not disclose or teach an annular element formed of “a plurality of windings of wire” and thus does not anticipate the subject matter recited in claim 1 and we therefore will not sustain the rejection. It follows that we also will not sustain the like rejection of claims 2, 5 and 10, which depend from claim 1.

The Section 103 Rejection Based Upon Inoue ‘197

As an alternative, the examiner rejects claims 1, 2, 5 and 10 as being obvious² in view of Inoue ‘179. As we understand this rejection, it is the examiner’s position that if the rings of Inoue ‘179 are not considered to constitute “windings,” one of ordinary skill in the art would have found it obvious to modify the disclosed device by replacing the closed ring wire elements with “windings,” as such are defined above (Answer, page 4).

²The test for obviousness is what the teachings of the applied prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant’s disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

From his remarks, it would appear that the examiner is contending that the two forms of wire ring elements are considered to be equivalents in the art, but no evidence in support of this conclusion has been provided. Nor has the examiner set forth a reason why one of ordinary skill in the art would have been motivated to make the substitution of elements proposed in the rejection.

In the absence of a teaching, suggestion or incentive which would have led one of ordinary skill in the art to make the proposed modification, it is our view that of Inoue '197 fails to establish a prima facie case of obviousness with regard to the subject matter recited in claim 1, and this rejection of claims 1, 2, 5 and 10 cannot be sustained.

The Section 102 Rejection Based Upon Inoue '671

This rejection applies to claim 52, which also requires that the annular resilient element be "formed from a plurality of windings of wire." The examiner has taken the position that this reference teaches the windings "to the extent required," and refers to Figures 2, 16, 18, 19 and 23, as well as column 7, line 40 to column 16, line 49, as providing the basis for this conclusion.³ In our opinion, Inoue '671 fails to anticipate the claimed subject matter for the same reasons expressed above with regard to the Section 102 rejection based upon Inoue '179, and this rejection is not sustained.

³We note in passing that the examiner has not directed us to any specific passages in the text of this reference which might support his position, but merely refers us to five of the thirty-three figures in the drawings, and ten of the twelve columns of the specification that are directed to describing the invention.

The Section 103 Rejection Based Upon Inoue '671

This is an alternative to the rejection of claim 52 under Section 102. The examiner here poses the same reasoning regarding the “windings” as was presented with regard to the Section 103 rejection of claim 1 et al. over Inoue '179, that is, it would have been obvious to modify Inoue '671 by replacing the disclosed wire elements with “windings.” For the reasons expressed above in the discussion of the cited rejection of claim 1, we also will not sustain this rejection of claim 52.

The Section 102 Rejection Based Upon Kwan-Gett

Claims 1 and 2 stand rejected as being anticipated by Kwan-Gett. The examiner has taken the position that the “windings of wire” recited in claim 1 read on Kwan-Gett’s circular stents 18 and 20, which “preferably comprise lengths of thin, flat spring material . . . that are concentrically wound into torsion springs, similar to a watch or clock spring” (column 5, lines 20-24). We do not agree that the Kwan-Gett lengths of flat spring material fall within the definition of “wire,”⁴ and we will not sustain this rejection of claims 1 and 2.

⁴The common applicable definition of “wire “ is metal in the form of a flexible thread or slender rod. Webster’s new Collegiate Dictionary, 1973, page 1345.

CONCLUSION

None of the rejections are sustained.⁵

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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⁵In view of this decision, it is not necessary for us to reach the issue of whether the invention as claimed is supported by the disclosure in the priority documents, which was raised by the examiner on page 6 of the Answer and responded to by the appellant on pages 10-13 of the Brief and pages 1 and 2 of the Reply Brief.

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TIMOTHY N. TROP
TROP, PRUNER, HU & MILES, P.C.
8554 KATY FREEWAY
SUITE 100
HOUSTON, TX 77024