

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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LOUIS G. ELLIS
and ANDREW J. DUSBABEK

Appeal No. 1999-0512
Application No. 08/701,979

ON BRIEF

Before COHEN, FRANKFORT, and McQUADE, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 11, 20, and 39. Claims 12 through 19, 21 through 38, and 40 through 44 stand withdrawn pursuant to 37 C.F.R. § 1.142(b). These claims constitute all of the claims in the application.

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Appellants' invention pertains to an assembly for delivery and deployment of an inflation expandable stent and to a method for delivering and deploying a stent using the specified assembly. A basic understanding of the invention can be derived from a reading of exemplary claims 1 and 39, copies of which appear in the APPENDIX to the main brief (Paper No. 16).

As evidence of obviousness, the examiner has applied the documents listed below:

Ryan et al. 1992 (Ryan)	5,108,416	Apr. 28,
Susawa et al. 1997 (Susawa) 1994)	5,591,222	Jan. 7, (filed Mar. 28,

The following rejections are before us for review.

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Claims 1 through 5, 7 through 9, 20, and 39 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ryan.

Claims 10 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ryan.

Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Ryan in view of Susawa.

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The full text of the examiner's rejections and response to the argument presented by appellants appears in the answer (Paper No. 18), while the complete statement of appellants' argument can be found in the main and reply briefs (Paper Nos. 16 and 19).

In the main brief (page 6), appellants indicate that claims 1 through 5, 7, 9, 20, and 39 stand or fall together, that claim 8 stands or falls alone, that claim 10 stands or falls alone, that claim 11 stands or falls alone, and that claim 6 stands or falls alone. Pursuant to 37 C.F.R. § 1.192(c)(7), as to the grouping of claims 1 through 5, 7, 9, 20, and 39, we select claim 1 for review, with the remaining claims standing or falling therewith. Accordingly, we focus our attention exclusively upon claims 1, 8, 10, 11 and 6, infra.

OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered

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appellants' specification and claims,¹ the applied teachings,² and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Claim 1

We affirm the rejection of claim 1 under 35 U.S.C. § 102(b). It follows that we likewise affirm the rejection of claims 2 through 5, 7, 9, 20, and 39 since these claims stand or fall with claim 1. Our reasoning follows.

¹ In claim 1, line 10, "distal" should apparently be --proximal--, in light of the underlying disclosure. This matter is addressed in a remand to the examiner, infra.

² In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); and RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). However, the law of anticipation does not require that the reference teach specifically what an appellant has disclosed and is claiming but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Claim 1 is drawn to an assembly for delivery and deployment of an inflation expandable stent comprising, inter alia, a catheter, an annular collar, an expandable balloon mounted over the collar, a stent, the collar abutting the

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stent as a stop, a cup having a first end portion restraining the stent at its proximal end portion, and the cup and collar cooperatively constructed and arranged to restrain the stent distal and proximal end portions in a stent reduced condition and to release the stent proximal end portion from the cup end portion in a balloon expanded state.

Based upon the clear and unambiguous overall disclosure of Ryan, we share the examiner's point of view that the assembly set forth in claim 1 is anticipated thereby. In particular, we note that Ryan expressly teaches (column 12, lines 3 through 10) the combination of interior (Fig. 15) and exterior (Fig. 7A) end caps, anticipating appellants' claimed collar and cup, respectively.

As explained below, the argument advanced by appellants does not convince us that the rejection is unsound.

In the main brief (page 7), it is asserted that the interior end cap of Ryan is incapable of retaining the stent in position and acting as a stop (page 7) and is expected to

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be incapable of retaining a stent in position (page 8). An argument of counsel, of course, is not evidence. See In re De Blauwe, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984). Under the present circumstances, more than attorney argument in a brief is required since the Ryan patent itself (column 5, lines 39 through 44) expressly indicates that the stent is "retained in position" by end caps 26, 28 which "receive and capture" the proximal and distal ends of the stent and "prevent axial displacement" of the stent as the delivery system and the stent are guided through the patient. Ryan further points out (column 6, lines 35 through 39) that the end caps 26, 28 (Fig. 7A) serve to "prevent axial movement of the stent toward either the proximal or distal end of the delivery catheter." As to end caps 102, 104 (forming shoulders 106, 108) located under the balloon, they can be made of a flexible, polymeric material and include at least one slit and yet still, as patentee Ryan indicates, "hold the stent in place as the delivery catheter is guided to a selected location." (column 12, lines 12 through 65). In a concluding paragraph of the patent (column 12, lines 23 through 25) Ryan emphasizes that a stent is "securely

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retained" until it is navigated to a desired location. From the above, it is abundantly clear to us that one skilled in this art would readily appreciate that the end caps of Ryan serve as stops. It is also quite apparent to this panel of the board that the inclusion of a weakening means on the end caps of Ryan for assisting retraction and release of the stent (column 6, lines 63 through 65) does not detract from the stent movement prevention function of the end caps during delivery of the stent through the patient. Of course, this same viewpoint is also clearly applicable to the inclusion of a slit as the particular weakening means. It is worthy of noting that the argument advanced in the main brief seems to be rebutted by appellants' own teaching that a cup can be formed with areas of weakness, be elastomeric, and may accordion or buckle, and apparently still be able to retain a stent on the catheter in its reduced condition during maneuvering to its deployment site (specification, pages 7 and 10).

Claim 8

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We reverse the rejection of claim 8 under 35 U.S.C.
§ 102(b).

Claim 8, dependent from claim 1, requires that the collar
be formed as a single³ member with the catheter.

We share appellants' point of view (main brief, pages 8
through 10 and reply brief, pages 2 and 3) that the Ryan
document does not teach an end cap (collar) formed as a single
member with the catheter, as now claimed.⁴ Contrary to the
examiner's viewpoint, it is apparent to us that one skilled in
this art would simply not consider an end cap bonded to a
catheter, as disclosed by Ryan, as a teaching of an end cap
(collar) and catheter being formed as a single (one part)
member. It is for this reason that the rejection of claim 8
must be reversed.

³ The word "single" has been defined as consisting of or
having only one part. Webster's New Collegiate Dictionary, G.
& C. Merriam Company, Springfield, Massachusetts, 1979.

⁴ It is worthy of noting that appellants' own
specification (page 2) reveals the knowledge in the art, when
the present invention was made, of forming ring members
integral with a catheter.

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Claim 10

We affirm the rejection of claim 10 under 35 U.S.C. § 103.

Claim 10, dependent from claim 1, specifies that the collar is axially positioned exterior to the stent at the stent distal end portion opposite the stent proximal end portion retained by the cup.

The thrust of appellants' argument (main brief, page 10) as to claim 10 is based upon the recitation in parent claim 1 of the collar serving as a stop, and the assertion that Ryan does not address an end cap or collar that serves as a stop. We previously focused upon this same argument relative to claim 1, supra, and found it nonpersuasive. The argument now reiterated still fails to convince us that our earlier reasoning was in error. Thus, we sustain the rejection of claim 10.

Claim 11

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We reverse the rejection of claim 11 under 35 U.S.C. §
103.

Claim 11, dependent from claim 10, requires that the
collar be formed as a single member with the catheter

We incorporate herein our discussion relative to claim 8,
supra, the rejection of which we did not sustain. As we see
it, the Ryan teaching of bonding an end cap to a catheter, by
itself, would not, in our opinion, have been suggestive to one
having ordinary skill in the art of forming an end cap
(collar) as a single (one part) member with a catheter, as now
claimed. We do note again, however, the disclosure in
appellants' application as referenced in footnote 4. above.

Claim 6

We reverse the rejection of claim 6 under 35 U.S.C. §
103.

Claim 6, dependent from claim 1, sets forth that the cup is rigid. More specifically, it is clear to us that what claim 6 covers is a rigid cup at a proximal end portion of a catheter acting in conjunction with a collar at a catheter distal end portion, in the assembly of claim 1.

The Ryan document teaches a resilient end cap at a proximal end of a catheter acting in conjunction with a "stiff" tubular sheath (column 10, lines 9 through 15; Fig. 14). This stiff tubular sheath is connected to a slidable hub 94 such that in use the sheath moves towards a Y-fitting 22 and is withdrawn from the distal end of the catheter thereby exposing the stent. The Ryan patent also discloses the use of this stiff tubular sheath with two resilient distally and proximally located end caps (column 10, lines 51 through 55). Thus, it appears to us that Ryan alone would not have been suggestive of a stiff (rigid) sheath as an alternative to a flexible, proximally located end cap.

The patent to Susawa, additionally relied upon by the examiner, teaches a silicone tube, without any indication as to whether it is a rigid tube or not. Thus, from our

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perspective this document does not fairly teach or suggest a rigid cup since it is clearly speculative as to whether the silicone tube in this particular instance is rigid.⁵

Since the proffered evidence would not have been suggestive of the subject matter of claim 6, the rejection thereof must be reversed.

REMAND TO THE EXAMINER

This application is remanded to the examiner to address the matters specified below and to take action deemed appropriate.

1. As pointed out in footnote No. 1, in claim 1, line 10, "distal" should apparently be --proximal--, in light of the underlying disclosure.

⁵ Of interest is the Savin et al. patent (U.S. Patent No. 4,950,227) referenced by appellants on page 2 of the present application and cited in appellants' Information Disclosure Statement of December 30, 1996 (Paper No. 4). The Savin et al. patent teaches non-rigid silicone sleeves 18, 20 that expand and contract (Figs. 1 and 2).

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2. In the matter of the patentability of claims 8 and 11, the examiner should consider the collective teachings of the Ryan reference (the alternative of a bonded end cap and catheter) and U.S. Patent No. 4,733,665 to Palmaz, the latter patent being referenced by appellants on page 2 of this application and cited in appellants' Information Disclosure Statement of December 30, 1996 (Paper No. 4). We draw the examiner's attention to Palmaz's teaching of the alternative of retaining ring members 86 integral (formed as a single member) with a catheter 83 (Fig. 3), a teaching acknowledged by appellants in their specification (page 2).

In summary, this panel of the board has:

affirmed the rejection of claims 1 through 5, 7, 9, 20, and 39 under 35 U.S.C. § 102(b) as being anticipated by Ryan, but reversed the rejection of claim 8 on this same ground;

affirmed the rejection of claim 10 under 35 U.S.C. § 103 as being unpatentable over Ryan, but reversed the rejection of claim 11 on this same ground; and

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reversed the rejection of claim 6 under 35 U.S.C. § 103 as being unpatentable over Ryan in view of Susawa.

Additionally, we have remanded the application to the examiner to consider the matters discussed above.

The decision of the examiner is affirmed-in-part.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a remand to the examiner for further action. 37 CFR § 1.196(e) provides that

Whenever a decision of the Board of Patent Appeals and Interferences includes or allows a remand, that decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

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The effective date of the affirmance is deferred until conclusion of the proceedings before the examiner unless, as a mere incident to the limited proceedings, the affirmed rejection is overcome. If the proceedings before the examiner does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejections, including any timely request for rehearing thereof.

This application, by virtue of its "special" status, requires an immediate action, M.P.E.P. § 708.01(D) (Seventh Edition, Rev. 1, February 2000).

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART and REMANDED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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Administrative Patent Judge)	

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