

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. 43

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PANNAYIOTIS J. ASIMACOPOULOS

Appeal No. 1999-2790
Application No. 08/794,530

ON BRIEF

Before FRANKFORT, PATE, and MCQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 5 through 10, 12 and 13, which are all of the claims remaining in this application. Claims 2 through 4 and 11 have been canceled.

Appeal No. 1999-2790
Application No. 08/794,530

Appellant's invention relates to a stent assembly that includes a stent that can be inserted into a desired destination within a lumen of a hollow organ or other tubular part of the body of an animal, including a human, and then expanded to a desired size, locked in place for a designated period of time, unlocked, contracted in size and then removed. In addition, appellant's invention addresses a method for supporting hollow organs or tubular parts of an animal's body by utilizing the stent assembly described above. Independent claims 1 and 10 are respectively representative of the subject matter on appeal and a copy of those claims may be found in the Appendix to appellant's brief.

The prior art references of record relied upon by the examiner are:

Kreamer 1988	4,740,207	Apr. 26,
Wall Nov. 30, 1993 filed Dec. 8, 1987)	5,266,073	(effectively

Claims 1, 5 through 10, 12 and 13 stand rejected under 35 U.S.C. § 102(e) as anticipated by Wall.

Appeal No. 1999-2790
Application No. 08/794,530

Claims 1 and 5 through 9 additionally stand rejected under 35 U.S.C. § 103 as being unpatentable over Wall in view of Kreamer.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we refer to the examiner's answer (Paper No. 42, mailed March 29, 1999) and to appellant's brief (Paper No. 41, filed February 25, 1999) for a full exposition thereof.

OPINION

Having carefully reviewed the anticipation and obviousness issues raised in this appeal in light of the record before us, we have come to the conclusion that the examiner's rejections of the appealed claims under 35 U.S.C. § 102(b) and 35 U.S.C. § 103 will not be sustained. Our reasoning in support of these determinations follows.

Regarding the examiner's rejection of claims 1, 5 through 10, 12 and 13 under 35 U.S.C. § 102(e) based on Wall, appellant has invoked 35 U.S.C. § 112, sixth paragraph, by

Appeal No. 1999-2790
Application No. 08/794,530

arguing (brief, pages 4-6) that Wall does not disclose, teach or suggest the "shaped profile means" as claimed by appellant in independent claim 1 and the claims which depend therefrom, or the steps of "positively causing," "positively preventing reengagement," and "positively releasing" as set forth in the method claims on appeal. In response, the examiner has urged (answer, pages 3-5) that it is the curved, rounded, blunt shape of the extreme end (at 29) of Wall in combination with the bias of the first and second arms therein which cause the first longitudinal edge (at 30) to pass over the top of the second longitudinal edge (at 29). The examiner has further explained the details of his position in the paragraph bridging pages 4 and 5 of the answer.

Appellant asserts (brief, pages 5-6) that the examiner has engaged in mere speculation in stating that the rounded ends of the arms seen in Wall Figure 4 have anything to do with the reversal of the radial positions of the arms therein. More particularly, appellant has pointed out that Wall does not teach or suggest that the ends (29, 30) of the opposing

Appeal No. 1999-2790
Application No. 08/794,530

arms ever touch one another and thus slide over one another when the expanding mechanism is released and the stent is reduced in diameter. In that regard, appellant has pointed to Wall, column 3, lines 36-45, wherein the patentee indicates that the ends (29, 30) of the stent are so biased that, when the stent is expanded so far that the ends (29) and (30) are released from engagement, the end (29) will move inwardly and the end (30) will move outwardly, so that on subsequent release of the stent, the ends (29) and (30) have exchanged places so that the hook means (28) cannot now engage.

Appellant concludes from this disclosure that Wall teaches and discloses that only the bias of the arms causes them to reverse their radial positions, and that there is nothing in Wall to teach or suggest the "shaped profile means" of independent claim 1 for positively causing the first and second locking means to slide over one another and for positively preventing reengagement thereof. Likewise, appellant concludes that the Wall patent provides no teaching or suggestion regarding the steps of "positively causing said first locking means to slide over said second locking means to

Appeal No. 1999-2790
Application No. 08/794,530

positively prevent reengagement thereof...," as in method claim 10 and the claims which depend therefrom.

Like appellant, it is our opinion that the examiner's position lacks any reasonable support in the applied Wall reference and is based on speculation and conjecture on the examiner's part. While it is possible that the scenario set forth by the examiner on pages 4 and 5 of the answer may occur during removal of Wall's stent from its position in a lumen of the body, we note that it is well settled that inherency may not be established by probabilities or possibilities, but must instead be "the natural result flowing from the operation as taught." See In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). In the present case, the disclosure of Wall does not provide an adequate factual basis to establish that the natural result flowing from following the teachings of that reference would be a stent including shaped profile means like that disclosed and claimed by appellant which inevitably functions in the recited manner.

Appeal No. 1999-2790
Application No. 08/794,530

Since all the limitations of appellant's independent claims 1 and 10 are not found in Wall, either expressly or under principles of inherency, it follows that the examiner's rejection of claim 1 (and claims 5 through 9 which depend therefrom) and of method claim 10 (and claims 12 and 13 which depend therefrom) under 35 U.S.C. § 102(e) relying on Wall will not be sustained.

As for the examiner's rejection of claims 1 and 5 through 9 on appeal under 35 U.S.C. § 103 based on Wall and Kreamer, we share appellant's view as expressed on pages 7 through 10 of the brief, that the examiner has again engaged in rank speculation concerning the teachings of Wall and Kreamer, and that the examiner's position amounts to nothing more than an attempted hindsight reconstruction of the claimed invention through picking and choosing isolated and unrelated elements from the prior art references. Accordingly, we will not sustain the examiner's rejection of claims 1 and 5 through 9 on appeal under 35 U.S.C. § 103.

Appeal No. 1999-2790
Application No. 08/794,530

Appeal No. 1999-2790
Application No. 08/794,530

In summary: the decision of the examiner to reject claims 1, 5 through 10, 12 and 13 under 35 U.S.C. § 102(e) based on Wall is reversed, as is the examiner's decision to reject claims 1 and 5 through 9 under 35 U.S.C. § 103 based on Wall and Kreamer.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
WILLIAM F. PATE, III)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
JOHN P. MCQUADE)	
Administrative Patent Judge)	

Appeal No. 1999-2790
Application No. 08/794,530

WILLIAM E. SHULL
13322 GOLDEN VALLEY
CYPRESS, TX 77429

Shereece

Appeal No. 1999-2790
Application No. 08/794,530

APJ FRANKFORT

APJ KEYBOARD()

APJ KEYBOARD()

REVERSED

Prepared: July 3, 2001