

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte YIANNAKIS P. YIANNI

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Appeal No. 1999-2816  
Application No. 08/064,052

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ON BRIEF<sup>1</sup>

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Before WINTERS, ADAMS and GRIMES, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 77, 79-81, 83-86, 88 and 89. We note the examiner's indication (Answer<sup>2</sup>, page 2) that claim 87 is allowable. Claims 78 and 82 are free from rejection, however, the examiner has objected to these claims as dependent upon a rejected base claim.

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<sup>1</sup> Pursuant to appellant's request (Paper No. 34, received February 23, 1998) an oral hearing for this appeal was scheduled for February 19, 2002. Appellant, however, subsequently waived (Paper No. 37, received December 6, 2001) the request for oral hearing. Accordingly, we considered this appeal on Brief.

<sup>2</sup> Paper No. 32, mailed December 22, 1997.

Claim 77 is illustrative of the subject matter on appeal and is reproduced below:

77. A process for increasing the lubricity and reducing the thrombogenicity of a body tissue contacting surface of a single-use disposable device in which a portion of the surface of the device which is inserted into the body and contacts body tissue is subjected to the steps of:
- a) coating of the portion with a solution of a fatty acid diester of phosphatidyl choline in an organic solvent; and
  - b) removing the organic solvent to form a coating of the fatty acid diester of phosphatidyl choline physically adsorbed and retained on the portion by hydrophobic interaction,
- whereby the lubricity of the portion is increased and the thrombogenicity of the portion is decreased compared to an uncoated device.

The reference relied upon by the examiner is:

Bird et al. (Bird) "Material Thrombelastography: an Assessment of Phosphoryl Choline Compounds as Models for Biomaterials," Thrombosis Research, Vol. 51, pp. 471-483 (1988)

#### GROUND OF REJECTION

Claims 77, 79-81, 83-86, 88 and 89 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bird.

We reverse.

#### DISCUSSION

According to the examiner (Answer, page 4) Bird teaches "coating a piston and cuvette with a solution ... of dipalmitoylphosphatidylcholine in ethanol and evaporating to dryness under a stream of nitrogen." The examiner notes

(id.) that “[t]he materials come in contact with blood during testing [and that] ‘a remarkable reduction in thrombogenicity’ is demonstrated by compounds containing a phosphatidylcholine group.” The examiner finds (Answer, page 5) that Bird “suggests the use of the phosphatidyl choline [sic] material as a biomaterial to be used in a device which would be implanted in the body (note, e.g. the suggestion of benefits for grafts in an arterial tree, p. 481, second full paragraph).” From this the examiner concludes (Answer, page 4) “[b]ecause the prior art uses one of the materials specifically named in the present claims to coat a surface, it is the examiner’s position that the lubricity of the surface which is coated is increased and the thrombogenicity of the surface which is coated is decreased.”

In response, appellant argues inter alia (Brief<sup>3</sup>, page 6) “the lubricity of the coated components in Bird is not disclosed ... [therefore,] a skilled person, seeking a way of improving the lubricity of single-use disposable items which are to be inserted into the body ... would not be led to consider the teachings of Bird as relevant.”

In response, the examiner argues (Answer, page 6) “that the benefits of reduced thrombogenicity, alone, would have motivated one of ordinary skill in the art at the time of the invention to apply a coating of the phosphatidylcholine material to a surface of a device where reduced thrombogenicity was desired.”

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<sup>3</sup> Paper No. 28, received July 21, 1997.

The examiner finds (Answer, bridging sentence, pages 6-7) that increased “lubricity is inherent in the use of the materials disclosed in the prior art.” In this regard, we note that while Bird was originally applied<sup>4</sup> in a rejection under 35 U.S.C. § 102(b) during the prosecution of this application, the rejection before us for review is not based upon anticipation, but is instead one of obviousness under 35 U.S.C. § 103. Therefore, to the extent that the examiner may find “increased lubricity” inherent in Bird, we remind the examiner as set forth in In re Spormann, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966) “[t]hat which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.”

Besides failing to mention “lubricity,” Bird differs from the claimed invention in not teaching “a single-use disposable device in which a portion of the surface of the device ... is inserted into the body and contacts body tissue....” While appellant’s specification does disclose, at page 12, “cuvettes” as “[t]ypical blood contacting devices,” the limitations set forth in the claims circumscribe a subset of the devices listed in the specification. In our opinion, a person of ordinary skill in the art would appreciate that a cuvette would typically not be considered a device that would be inserted into the body. In this regard, we note that the examiner has not provided evidence to the contrary. Instead, the examiner finds (Answer, page 5) that “Bird also suggests the use of the phosphatidyl choline [sic] material as a biomaterial to be used in a device which would be implanted in the body (note, e.g. the suggestion of benefits for grafts in

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<sup>4</sup> Paper No. 8, mailed June 27, 1994, at page 4, paragraph no. 5.

an arterial tree, p. 481, second full paragraph).” In our opinion, the examiner’s interpretation of this section of Bird, is incomplete. In the second full paragraph of page 481, Bird teaches:

The low platelet activation seen with DPPC is important because platelet activation is thought to be the primary event initiating thrombosis of grafts in the arterial tree. That this benefit is also seen with DAPC, a polymer containing PC, has exciting implications for the development of new biomaterials, and further work is planned.

The examiner is reminded that “[t]he consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art.” In re Dow Chemical Co. 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). In our opinion, this section of Bird does not provide a person of ordinary skill in the art with a reasonable expectation of success. Instead, Bird merely suggests a direction for further research. This however, is not the standard of obviousness under 35 U.S.C. § 103. See In re O’Farrell, 853 F.2d 894, 904, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988).

Instead, a “prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.” In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)). On this record, as appellant points out, the prior art does not suggest the claimed subject matter.

Specifically, Bird does not address the increased lubricity component of the claimed invention nor does Bird teach a single-use disposable device in the context of the claimed invention.

To make up for these deficiencies in Bird, the examiner simply concludes that the invention would have been obvious, with no factual evidence other than appellant's disclosure and declaration to support her position. This however, is not sufficient to meet the examiner's burden<sup>5</sup> of establishing a prima facie case of obviousness. "The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis." In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967).

On this record, it is our opinion that the examiner has fallen victim to the insidious effect of hindsight syndrome wherein that which only the inventor taught is used against its teacher. Cf. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

Accordingly, we reverse the rejection of claims 77, 79-81, 83-86, 88 and 89 under 35 U.S.C. § 103 as being unpatentable over Bird.

REVERSED

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<sup>5</sup> In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

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