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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KARL-LUTZ LAUTERJUNG

Appeal 2010-011643
Application 11/205,826
Technology Center 3700

Before STEVEN D.A. McCARTHY, STEFAN STAICOVICI, and
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Karl-Lutz Lauterjung (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision finally rejecting claims 37-40 and 52-64. Claims 1-36, 41-51 and 65 have been canceled. We have jurisdiction over this appeal under 35 U.S.C. § 6.

THE INVENTION

Appellant's invention relates to a method for securing a prosthetic device inside a body passage including folding an annular resilient spring along its diametric axis, positioning the folded spring inside a body passage, and allowing the folded ring to resiliently expand against the body passage. Spec. 4, ll. 26-33 and figs. 1 and 2.

Claims 37 and 59 are illustrative of the claimed invention and read as follows:

37. A method for securing a prosthetic device in a body passage comprising:
- folding a resilient, deformable annular ring, having radii, to assume a first configuration having a cross-sectional area smaller than the cross-sectional area of an undeformed ring, said ring comprising a bundle of closely associated, concentric, radially overlapping windings formed of a strand of wire and overlapping in the directions of said radii, the diameter of said bundle of windings corresponding with the diameter of said ring, said ring attached to and coaxial with a free end of a tubular graft;
 - positioning said ring at a desired position within a body passage; and
 - allowing said ring to resiliently deform to a second configuration having a larger cross-sectional area than in said first configuration, but still having a cross-sectional area smaller than that of said undeformed ring.

59. A method comprising:
attaching an annular resilient element to an end of a graft;
folding said attached element along a diametric axis into
a C-shaped configuration overall; and
resiliently engaging an arcuate portion of said C-shaped
element with the interior of a first blood vessel.

THE REJECTIONS

The Examiner relies upon the following as evidence of
unpatentability:

Donaldson	US 2,935,068	May 3, 1960
Giantureo	US 5,035,706	Jul. 30, 1991
Goicoechea	US 5,609,627	Mar. 11, 1997
Lau	US 5,873,906	Feb. 23, 1999

The following rejections are before us for review:

The Examiner rejected claims 54-64 under 35 U.S.C. § 112, second
paragraph, for being indefinite.

The Examiner rejected claims 37, 38, and 40 under 35 U.S.C.
§ 102(e) as anticipated by Goicoechea.

The Examiner rejected claims 54-57, 59, 61, and 62 under 35 U.S.C.
§ 102(b) as anticipated by Donaldson.

The Examiner rejected claims 54-57, 59, 61, and 62 under 35 U.S.C.
§ 103(a) as unpatentable over Donaldson.

The Examiner rejected claims 39 and 53 under 35 U.S.C. § 103(a) as
unpatentable over Goicoechea and Giantureo¹.

¹ In the heading of this rejection the Examiner refers to “Gianturco et al
(US 5,035,706).” Ans. 6. However, the first named inventor of US
5,035,706 is Giantureo. Thus, for the purpose of this appeal, we assume
that the Examiner’s reliance on “Gianturco” was a mere typographical error.

The Examiner rejected claim 52 under 35 U.S.C. § 103(a) as unpatentable over Goicoechea and Lau.

SUMMARY OF DECISION

We REVERSE.

ANALYSIS

The indefiniteness rejection

The Examiner found that “[t]he preambles of these claims are incomplete because they do not set forth the purpose of this method.” Ans. 4. According to the Examiner, “it is unclear what statutory class the invention belongs because the preambles merely state a ‘method’ without any indication as to what the method is to achieve.” *Id.*; see also Ans. 7.

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted). Claims must “particularly point-out and distinctly claim[] the subject matter which the applicant regards as his invention.” 35 U.S.C. § 112, para. 2.

Here, we agree with Appellant that, “[t]here is no requirement that the preamble do anything.” Reply Br. 1. As long as the body of the claim clearly sets forth process steps to achieve a claimed process, the claim is not indefinite for the reasons identified by the Examiner. Since the steps of claims 54-64 clearly define the claimed method, so as to apprise a person of ordinary skill in the art of their scope, we do not agree with the Examiner’s

position that the statutory class to which the invention belongs is unclear. Thus, we shall not sustain the indefiniteness rejection of claims 54-64 under 35 U.S.C. § 112, second paragraph.

The anticipation rejection based upon Goicoechea

Independent claim 37 requires, *inter alia*, an “annular ring, having radii, . . . said ring comprising a bundle of closely associated, concentric, radially overlapping windings formed of a strand of wire and overlapping in the directions of said radii.” App. Br., Claims App’x. The Examiner found that:

[T]he ring is proximal part (12) or portion (52) of Goicoechea, the tubular graft is the fabric (62), and the bundle of concentric overlapping windings is the proximal portion (52); see Figure 2A and 2B as well as column 9, lines 1-12 where the windings overlap at the pins (46) and at the diagonal “seam”; see Figure 2A. The radii can be construed as the radii of the wire or of the bends in the wire.

With regards to the language “radially overlapping”, since the wire overlaps at least along the bends that each have a radius of curvature, the claim language can be construed as being met to the extent that such language can be given patentable weight; see Figure 2A[.]

Ans. 5.

Appellant argues that Goicoechea fails to teach that the windings overlap along the ring’s radii, as called for by independent claim 37. App. Br. 12.

Claims are to be given their broadest reasonable interpretation consistent with the specification, reading claim language in light of the specification as it would be interpreted by one of ordinary skill in the art. *In*

re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364 (Fed. Cir. 2004). Here, we agree with Appellant that when read in light of the Specification, the claimed radii of independent claim 37 represent the radii of the concentric, radially overlapping windings of the annular ring and not the radius of the wire itself or of the curvature along the bends of the wire, as the Examiner proposes. *See* App. Br. 12; *see also* Ans. 5. Goicoechea teaches that in order to construct proximal part 12, wire is wound around pins 47 of mandrel 46 to form a plurality of hoops 20. When one hoop 20a is formed, the point of winding of the wire is displaced longitudinally to form the next successive hoop 20b. Goicoechea, col. 9, ll. 1-16 and figs. 2A and 2B. Thus, we agree with Appellant that the windings of Goicoechea do not radially overlap, but merely abut along the circumference of mandrel 46. Reply Br. 2. Therefore, for the foregoing reasons, we do not sustain the rejection of claims 37, 38, and 40 under 35 U.S.C. § 102(e) as anticipated by Goicoechea.

The anticipation rejection based upon Donaldson

Each of independent claims 54 and 59 requires, *inter alia*, “an annular resilient element.” App. Br., Claims App’x. The Examiner found that tube 95 of Donaldson constitutes the claimed “annular resilient element.” Ans. 5. According to the Examiner, because “[i]t is not clear when an annular structure has a length that no longer qualifies it as a ring, but rather, it would

be considered a tube,” “a tube can be construed as being annular² because it is shaped like or forming a ring.” Ans. 8.

We do not agree with the Examiner’s position that a person having ordinary skill in the art would not be able to differentiate a tube from a ring. *See, e.g.*, Reply Br. 2. Hence, we agree with Appellant that because element 95 of Donaldson is a tube and a tube is not annular, tube 95 of Donaldson does not constitute the claimed “annular resilient element.” App. Br. 12. Moreover, Donaldson specifically teaches element 95 as being a “tube.” Donaldson, col. 6, ll. 8-9 and fig. 3. Thus, because Donaldson does not teach an “an annular resilient element,” we do not sustain the anticipation rejection of claims 54-57, 59, 61, and 62.

The obviousness rejections

The Examiner’s proposed modification of Donaldson does not remedy the deficiencies of Donaldson as described *supra*. Thus, for the foregoing reasons, we do not sustain the rejection of claims 54-57, 59, 61, and 62 under 35 U.S.C. § 103(a) as unpatentable over Donaldson.

Likewise, the addition of either Giantureo or Lau does not remedy the deficiencies of Goicoechea. Therefore, we also do not sustain the rejections under 35 U.S.C. § 103(a) of claims 39 and 53 as unpatentable over Goicoechea and Giantureo and of claim 52 as unpatentable over Goicoechea and Lau.

² An ordinary and customary meaning of the term “annular” that is most consistent with the Specification is “of, relating to, or forming a ring.” MERRIAM WEBSTER’S COLLEGIATE DICTIONARY (10th Ed. 1997).

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SUMMARY

The decision of the Examiner to reject claims 37-40 and 52-64 is reversed.

REVERSED

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