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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JASON VAN SCIVER, GREG TEABY, PHIL FOREMAN, and
MANISH GADA

Appeal 2012-011728
Application 12/748,271¹
Technology Center 1700

Before CHUNG K. PAK, MARK NAGUMO, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 11–19.² We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

¹ The Real Party in Interest is Abbott Cardiovascular Systems Inc. Br. 1.

² Claims 10 and 13, which were included in the final rejection, have been cancelled (Br. 12, 21).

Claims 11 and 16 are illustrative of the claimed subject matter
(emphasis added):

11. A method of depositing a substance on a stent, comprising:
positioning the stent on a mandrel for supporting the stent, the
mandrel comprising an elongated body for insertion into a longitudinal bore
of the stent, *the body comprising carbide*;
depositing a substance on the stent; and
imaging the stent or the substance being deposited, wherein *the stent
is light-colored and the elongated body is dark-colored or black*.

16. A method of depositing a substance on a stent, comprising:
positioning the stent on a mandrel for supporting the stent, the
mandrel comprising an elongated body for insertion into a longitudinal bore
of the stent;
depositing a substance on the stent; and
controlling the depositing of the substance on the stent *based on a
contrast in color between the stent and the elongated body*.

Independent claims 12, 14, and 15 each recite a similar method to
claim 11, and each requiring “the body comprising carbide” (Br. Claims
App’x).

The Examiner maintains, and Appellants appeal, the following
rejections:

- (a) claims 11, 12, 14, and 15 under 35 U.S.C. 103(a) as being
unpatentable over Teichman (US 2006/0073265 A1, published Apr.
6, 2006) in view of Hopkins (US 5,131,253, issued July 21, 1992);
and
- (b) claims 16–19 under 35 U.S.C. 102(b) as being anticipated by or, in
the alternative, under 35 U.S.C. 103(a) as being obvious over
Teichman.

ANALYSIS

We have thoroughly reviewed each of Appellants' arguments for patentability. We are constrained to reverse the Examiner's anticipation rejection of claim 16 (as well its dependent claims 17–19), since, as pointed out by Appellants, Teichmann discusses a color contrast between the stent and a balloon catheter and does not explicitly mention “a contrast in color between the stent and the elongated body” of a mandrel as recited in claim 16 on appeal (Br. 24). *See, e.g., Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008) (A reference must disclose all of the limitations arranged or combined in the same way as recited in the claim in order to anticipate under 35 U.S.C. § 102).

However, we are in agreement with the Examiner that the claimed subject matter of representative claim 16 is unpatentable under § 103(a) in view of the applied prior art. Likewise, a preponderance of the evidence supports the Examiner's conclusion that the subject matter of the remaining claims is unpatentable under § 103(a) in view of the applied prior art. Accordingly, we sustain each of the Examiner's § 103 rejections for essentially the reasons set forth in the Answer.

We add the following primarily for emphasis.

In assessing whether a claim to a combination of prior art elements/steps would have been obvious, the question to be asked is whether the improvement of the claim is more than the predictable use of prior art elements or steps according to their established functions. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). “[T]he analysis need not seek out precise teachings directed to the specific subject matter of the challenged

claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 418.

It is also well established that in evaluating references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826 (CCPA 1968).

We first address claim 11, since Appellants’ first argument is that there would have been no reason to combine “the [carbide] mandrel of Hopkins into the device of Teichman” because, e.g., Hopkins is directed to extrusion of metals (Br. 14–16). Appellants further argue that Hopkins is non-analogous art (Br. 18). These arguments are not persuasive for the reasons set out by the Examiner (Ans. 6, 7). As the Examiner points out, Hopkins uses a carbide material for its stability at high processing temperatures and wear resistance properties over time, and one of ordinary skill in the art would have been led to choose such a material for the mandrel of Teichman in order to obtain similar advantages (*id.*).

Appellants have not provided persuasive technical reasoning or credible evidence why one of ordinary skill in the art would not have, using no more than ordinary creativity, predictably used a conventional carbide material for a mandrel as exemplified in Hopkins for the supporting mandrel of the prior art process stent coating process of Teichman, for the same/similar advantages as discussed by Appellants to achieve a dimensionally stable mandrel (*e.g.*, Ans. 6–8; Br. *generally*). *See KSR*, 550 U.S. at 421 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”).

Appellants' also argue that Teichman does not teach the claimed contrasting colors of a stent and an elongated mandrel body. This argument is not persuasive of error in the obviousness rejection, since Teichman teaches the advantages of using a contrasting color of the stent on the balloon for edge analysis so as to improve the coating process (Br. 18, 19; Teichman ¶ [0080]). As pointed out by the Examiner, Teichman also teaches that "the bare stent" may be coated while it is "mounted directly on a mandrel," i.e., without a balloon (Teichmann e.g., ¶ [137]). One of ordinary skill in the art would have readily appreciated from the overall teachings of Teichman that providing a color contrast between the stent and mandrel would have been advantageous for the same reasons as providing a color contrast between the stent and the balloon.

Appellants further argue that Teichmann does not teach "controlling the depositing" of the substance "based on a contrast in color" as recited in claim 16 (e.g., Br. 24) (*see also* similar limitations in each of independent claims 11, 12, 14). This argument is not persuasive, since it is axiomatic that "the PTO must give claims their broadest reasonable construction consistent with the specification Therefore, we look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation." *In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007). "[A]s applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee." *Id.*

Appellants do not however provide any evidence as to limit the plain meaning of the claim language, and do not point to any specific definition of the claim language "controlling the depositing . . . based on a color contrast"

(Spec. *generally*; Br. *generally*). Indeed, Appellants' Specification merely states that "[p]referably, the mandrel has a color that *facilitates imaging* of a mounted stent" (Spec. 7:16; emphasis added).

Accordingly, the Examiner's determination that Teichman's de facto controlling of the substance deposition based on the edge analysis which is based on the color contrast (in order to deposit the substance only on the stent) encompasses the claim language is reasonable.

To the extent that any other limitations are argued, we affirm for the reasons set out by the Examiner and above.

Therefore, we affirm each of the Examiner's obviousness rejections of all the claims on appeal.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136.

ORDER
AFFIRMED

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