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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEPHEN C. PORTER,
LIKE QUE, and
TRI D. TRAN

Appeal 2014-008500
Application 12/462,663
Technology Center 3700

Before MICHAEL L. HOELTER, ANNETTE R. REIMERS, and
JEFFREY A. STEPHENS, *Administrative Patent Judges*.

HOELTER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is a decision on appeal, under 35 U.S.C. § 134(a), from a final rejection of claims 1, 2, 8, and 12–18. App. Br. 4. Claims 3–7, 9–11, and 19–23 are canceled. App. Br. 4. We have jurisdiction under 35 U.S.C. § 6(b). We REVERSE.

THE CLAIMED SUBJECT MATTER

The disclosed subject matter relates to “vaso-occlusive devices having a non-random, textured outer surface.” Spec. ¶ 2. Independent claim 1 is

the sole independent claim and is illustrative of the claims on appeal. Claim 1 is reproduced below:

1. An occlusive device having an outer surface, the outer surface comprising a continuous, non-randomly textured material defining raised and depressed regions, wherein the raised regions are arranged in a repeating manner about at least a portion of such outer surface and are separated from neighboring raised regions by a uniform axial distance and a uniform radial distance, wherein the raised regions are gradually concave and taper to a rounded point projecting away from the surface.

REFERENCES RELIED ON BY THE EXAMINER

Nikolchev	US 2004/0211429 A1	Oct. 28, 2004
Callister	US 2005/0209633 A1	Sept. 22, 2005

THE REJECTIONS ON APPEAL

Claims 1, 8, and 13 are rejected under 35 U.S.C. § 102(b) as anticipated by Callister.

Claims 2, 12, and 14–17 are rejected under 35 U.S.C. § 103(a) as obvious over Callister and Nikolchev.

Claim 18 is rejected under 35 U.S.C. § 103(a) as obvious over Callister.

ANALYSIS

The rejection of claims 1, 8, and 13 as anticipated by Callister

Sole independent claim 1 is directed to an outer surface with raised and depressed regions forming (a) a “non-randomly textured material;” (b) “wherein the raised regions are arranged in a repeating manner;” and,

(c) wherein neighboring raised regions are separated “by a uniform axial distance and a uniform radial distance.”

The Examiner relies on Figure 18 of Callister for disclosing these limitations. Final Act. 2–3. Appellants contend the rejection is “*defective in view of the Examiner’s reliance on drawings within Callister that are not to scale.*” App. Br. 9. The Examiner replies that such reliance is permissible as per MPEP § 2125 which states “[d]rawings and pictures can anticipate claims if they clearly show the structure which is claimed,” and “[w]hen the reference is a utility patent, it does not matter that the feature shown is unintended or unexplained in the specification.” Ans. 4–5. The question, thus, is whether Figure 18 of Callister “clearly shows” the limitations above.

Regarding the limitation “non-randomly textured material,” Appellants’ Specification provides both a definition of “non-random” as well as an example of what it is not. *See* Spec. ¶ 34. This paragraph states, “[n]on-random’ *includes any ordered or semi-ordered structure that provides texture to the outer surface.*” Spec. ¶ 34 (emphasis added). It also states, “[t]hus, unlike randomly textured devices, such as sandblasted devices (see, U.S. Patent No. 6,953,468), the devices described herein have a non-random texture on the outer surface.” Spec. ¶ 34. In effect, then, the claim term “non-randomly,” as broadly understood, “includes” ordered and semi-ordered structure, but it is not so broad as to encompass sandblasted texture.

Appellants do not identify where this line of demarcation between non-random and sandblasted texture can be drawn. Nevertheless, Appellants are not asserting that Callister’s Figure 18 discloses a sandblasted texture (and hence fails to disclose a “non-randomly textured” surface). Instead,

Appellants are asserting that the Examiner is relying on Callister's Figure 18 and that this reliance is improper because this figure is not said to be "*to scale*." App. Br. 9. In other words, there is no dispute that the texture disclosed in Callister's Figure 18 (i.e., the interplay between tubular component 92 and raised particles 93, 94) is something much different from a sandblasted texture. *See e.g.*, Spec. ¶ 34 (and more particularly Appellants reference to U.S. Patent No. 6,953,468 on what is a sandblasted texture). As such, Appellants do not dispute, and hence are not persuasive in their argument that, the Examiner erred in finding that Callister's Figure 18 "clearly shows 'non-randomly textured material defining raised and depressed regions.'"¹ Ans. 5.

Regarding the limitation "wherein the raised regions are arranged in a repeating manner," the Examiner simply states that they are so arranged (Final Act. 2), but does not indicate which of the particles 93, 94 depicted in Callister's Figure 18 form this repeating pattern, or whether the whole spatial arrangement shown therein is repeated. The Examiner (as well as Callister) is silent on this point. *See, e.g.*, Ans. 5; Callister ¶¶ 55, 56. Accordingly, it is not known where such a repeating pattern is "clearly shown" in Callister's Figure 18, and as such, the Examiner has not established a prima facie case of anticipation with respect to this limitation.²

¹ The Examiner also contends "that the recitation of how the texturing is distributed is a product-by-process limitation." Ans. 5. However, we instead agree with Appellants' analysis that "[t]he phrase 'non-randomly textured material' clearly refers to a physical feature." Reply Br. 2.

² "In the prosecution of a patent, the initial burden falls on the PTO [examiner] to set forth the basis for any rejection." *Hyatt v. Dudas*, 492 F.3d 1365, 1369–70 (Fed. Cir. 2007).

Regarding the limitation of neighboring raised regions being separated “by a uniform axial distance and a uniform radial distance,” the Examiner provides an annotation of Callister’s Figure 18 indicating where this is illustrated. Ans. 5. The claim term “uniform” is not defined in Appellants’ Specification but it is understood to refer to a plurality of like distances that do not vary.³ *See also* Spec. ¶¶ 39 (“uniform cross-section”), 47. Although the Examiner’s annotation of Callister’s Figure 18 identifies “axial” and “radial” distances (Ans. 5), there is no indication that these are “uniform” distances, or that the axial and radial distances between adjacent particles 93 and 94 do not vary. As such, the Examiner fails to identify where Callister’s Figure 18 “clearly shows” “uniform” distances. Accordingly, the Examiner has not established a prima facie case of anticipation with respect to this limitation.

Based on the record presented, and our analysis above, the Examiner has not established by a preponderance of the evidence that Callister anticipates independent claim 1. We reverse the Examiner’s rejection of claim 1 and dependent claims 8 and 13.

The rejection of (a) claims 2, 12, and 14–17 as obvious over Callister and Nikolchev and, (b) claim 18 as obvious over Callister

The Examiner’s rejections of these dependent claims relies on Callister for disclosing the limitations discussed above. Final Act. 3–5. Nikolchev is not relied on to cure this defect, nor is it cured by relying on Callister for obviousness purposes. We do not sustain the Examiner’s rejections of these claims.

³ *See* <http://www.merriam-webster.com/dictionary/uniform>.

Appeal 2014-008500
Application 12/462,663

DECISION

The Examiner's rejections of claims 1, 2, 8, and 12–18 are reversed.

REVERSED