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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte THOMAS E. ALBRECHT,
MARK S. ZEINER, JASON L. HARRIS,
MICHAEL J. STOKES, MARK S. ORTIZ, KEVIN D. FELDER,
MICHELE D'ARCANGELO, and JAMES W. VOEGELE
(APPLICANT: ETHICON ENDO-SURGERY, INC.)

Appeal 2018-005412
Application 13/644,175¹
Technology Center 3700

Before DONALD E. ADAMS, MICHAEL J. FITZPATRICK, and
DAVID COTTA, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This Appeal under 35 U.S.C. § 134(a) involves claims 1, 7, 8, 10–13, and 16–21 (App. Br. 3). Examiner entered a rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a). We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ Appellants identify “Ethicon Endo-Surgery, Inc.” as the real party in interest (Appellants’ May 5, 2017 Appeal Brief (App. Br.) 3).

STATEMENT OF THE CASE

Appellants' disclosure "relates generally to medical apparatuses and methods and more particularly to devices and methods for positioning and anchoring a lining to a hollow body organ, such as a stomach, intestine or gastrointestinal tract" (Spec. 1:10–12). Appellants' claims 1 and 16 are representative and reproduced below:

1. An endoluminal sleeve device for internally lining a section of the GI tract, comprising:

a sleeve configured for deployment inside a duodenum, the sleeve having walls of a flexible material defining a sleeve lumen, a proximal end defining a proximal lumen opening, and a distal end defining a distal lumen opening; and

a ring attached to the proximal end of the sleeve, sized to remain within the stomach and having a circumferential outer surface;

wherein *the circumferential outer surface of the ring is oriented perpendicular to the orientation of the proximal lumen opening of the sleeve.*

(App. Br. 9 (emphasis added).)

16. An endoluminal sleeve device for internally lining a section of the GI tract, comprising:

a sleeve configured for deployment inside a duodenum, the sleeve comprising a proximal end and a distal end; and

a ring attached to the proximal end of the sleeve, the sleeve extending radially outward from the ring.

(*Id.* at 10.)

Grounds of rejection before this Panel for review:

Claims 1, 7, 10–13, 16–19, and 21 stand rejected under 35 U.S.C. § 102(b) as anticipated by Smit.²

Claims 8 and 20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Smit and Levine.³

ANTICIPATION:

ISSUE

Does the preponderance of evidence on this record support Examiner’s finding that Smit teaches Appellants’ claimed invention?

FACTUAL FINDINGS (FF)

FF 1. Smit “relates to medical appliances and more particularly to devices for lining body passages, especially—although not exclusively—to devices for lining portions of the human alimentary canal” (Smit 1:10–13; Final Act.⁴ 3).

² Smit, US 4,315,509, issued Feb. 16, 1982.

³ Levine et al., US 7,608,114 B2, issued Oct. 27, 2009.

⁴ Examiner’s November 25, 2016 Final Office Action.

Final Act. 3 (Smit’s “Figure 10 shows the . . . [anchor sized to remain within the stomach] is crescent-shaped, not ring-shaped”).

FF 3. Smit’s FIG 10 illustrates tethers, or spring sections 238, 240 attached to opposite sides of “contour ring 242 which forms the beginning of the balloon-like tube 228” (Smit 14:14–18 (emphasis omitted); *see also id.* at 17:22–27 (discussing tethers attached to opposite sides of a ring)).

FF 4. Smit’s Figure 12B is reproduced below:

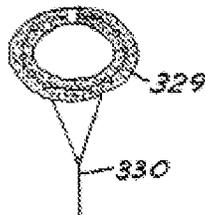


FIG. 12B

Smit’s “FIG. 12B shows an alternative ring shaped anchor means” attached to tethers branching from cord 330 (Smit 3:64–65; *see generally id.* at 16:67–68; *see* Final Act. 3; Ans.⁵ 3).

FF 5. Examiner finds that when Smit’s “ring shaped anchor means” is attached, through a tether (e.g., similar to spring section 220), to the remainder of Smit’s device (e.g., sleeve or tube 228), the ring shaped anchor will necessarily be “oriented perpendicular to the orientation of the proximal lumen [opening of the sleeve] because the ring is attached via two tethers . . . along only one side of the ring which are then connected to [the] tether” (Final Act 3–4; Ans. 3–4).

⁵ Examiner’s March 1, 2018 Answer.

FF 6. Appellants' Figure 17 is reproduced below:

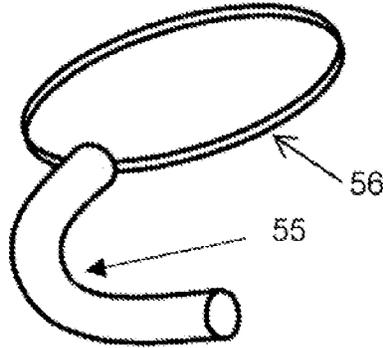


FIG. 17

Appellants' FIG. 17 "illustrates an embodiment of a sleeve attached to an anchoring ring," wherein the sleeve 55 extends radially outward from ring 56 (Spec. 4:6; *see* App. Br. 3–4).

ANALYSIS

Claim 1:

Appellants' independent claim 1, reproduced above, requires, *inter alia*, that "the circumferential outer surface of the ring [shaped anchor means] is oriented perpendicular to the orientation of the proximal lumen opening of the sleeve" (App. Br. 9). Appellants' claims 7 and 10–13 depend directly or indirectly from Appellants' claim 1.

According to Examiner, Smit necessarily teaches that the ring shaped anchor means is "oriented perpendicular to the orientation of the proximal lumen [opening of the sleeve] because the ring is attached via two tethers . . . along only one side of the ring which are then connected to [the] tether" (FF 4–5). We are not persuaded.

Notwithstanding Smit's express disclosure that tethers are attached to opposite sides of a ring structure (*see* FF 3), Examiner finds that Smit

discloses attaching tethers to a single side of Smit's ring shaped anchor (FF 5; *cf.* FF 3–4). According to Examiner, because “the ring is merely an extension of the crescent-shape shown in [Smit's] Figure 12, and as a result, larger in size than the crescent-shaped tether, it makes sense [that] . . . tether 330 is attached at two locations in Figure 12b, instead of one for the crescent-shaped tether shown in Figure 12b” (Ans. 3). Although Examiner's rationale regarding the number of tethers may be true, Examiner's reasoning fails to support Examiner's assertion that multiple tethers will necessarily or inherently be attached to the same side of a ring. *See In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (Inherency “may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”) (citations omitted).

To the contrary, Appellants provide a reasonable interpretation of Smit's FIG. 12b that refutes Examiner's interpretation. Specifically, Appellants contend that “[t]hroughout Smit . . . , the rings are all . . . shown with two points of attachment through a single split tether. The attachment points are shown on the inner diameter of the circular rings and at locations on opposite sides spanning the diameter of the ring” (App. Br. 5; *see* FF 3). Appellants contend that “[t]his attachment scheme is consistent throughout the images in the figures of Smit . . .” (App. Br. 5). Thus, Appellants contend:

Given that [Smit's] Fig. 12b shows a ring in the same perspective view as the rings in Figures 10 and 12 and has a tethering scheme that, although obscured, is consistent . . . with other tethering means shown, the ring in [Smit's] Fig. 12b has an orientation that is parallel to, not perpendicular to the other rings or perpendicular to the proximal lumen of the sleeve, which is in contrast to the requirements of Appellant's claim 1 (App. Br. 6).

We find that the weight of the evidence on this record falls in favor of Appellants.

Claim 16:

Appellants' independent claim 16, reproduced above, requires, *inter alia*, a ring attached to the proximal end of the sleeve, wherein the sleeve extends radially outward from the ring (*see* App. Br. 10; *see also* FF 6). For the same reasons set forth above with respect to Appellants' claim 1, Examiner failed to establish that Smit teaches the endoluminal sleeve device of Appellants' claim 16 (*see* Ans. 5–6).

CONCLUSION

The preponderance of evidence on this record fails to support Examiner's finding that Smit teaches Appellants' claimed invention. The rejection of claims 1, 7, 10–13, 16–19, and 21 under 35 U.S.C. § 102(b) as being anticipated by Smit is reversed.

OBVIOUSNESS:

Does the preponderance of evidence relied upon by Examiner support a conclusion of obviousness?

FACTUAL FINDINGS

FF 7. Examiner relies on Smit as discussed above (*see* Ans. 6; FF 1–5)

FF 8. Examiner finds that Smit “fails to disclose . . . [a] spread ring . . . supported in a deformed wavy shape with longitudinal undulations” and relies upon Levine to disclose a sleeve, intended for deployment in the

duodenum, that comprises a proximal opening having a deformed wavy shape with undulations in the longitudinal direction of the sleeve (Ans. 6).

ANALYSIS

Appellants' claim 8 depends ultimately from Appellants' claim 1 and "further compris[es] at least one elastic spread ring supported by the proximal sleeve end in a deformed wavy shape with undulations in a sleeve longitudinal direction, wherein the spread ring elastically biases the proximal sleeve end in a radially spread configuration while preserving a continuously convex outer contour" (*see* App. Br. 9). Appellants' claim 20 depends ultimately from Appellants' claim 16 and requires that an elastic spread ring, which biases the proximal end of the sleeve in a radially spread configuration, "comprises a spring with longitudinal undulations supported by the proximal end of the sleeve" (*see id.* at 10).

Based on the combination of Smit and Levine, Examiner concludes that, at the time Appellants' invention was made, Appellants' claimed invention would have been *prima facie* "obvious to one of ordinary skill in the art . . . because the particular known technique of providing the proximal end of a bariatric sleeve with undulations in the longitudinal direction of the sleeve was recognized as part of the ordinary capabilities of one skilled in the art" (Final Act. 6). We are not persuaded.

To the contrary, as Appellants explain, Examiner failed to establish that Levine makes up for the deficiencies in Smit discussed above (*see* App. Br. 8).

CONCLUSION

The preponderance of evidence relied upon by Examiner fails to support a conclusion of obviousness. The rejection of claims 8 and 20 under 35 U.S.C. § 103(a) as unpatentable over the combination of Smit and Levine is reversed.

REVERSED