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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PATRICK W. KELLY

Appeal 2018-005569
Application 13/706,036
Technology Center 3700

Before MICHAEL L. HOELTER, ANNETTE R. REIMERS, and MICHAEL L. WOODS, *Administrative Patent Judges*.

WOODS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Appellant filed a Request for Rehearing on January 20, 2020, ("Request for Rehearing," "Request," or "Req. Reh'g"), under 37 C.F.R. § 41.52, seeking rehearing of our Decision mailed November 19, 2019, ("Decision" or "Dec.").

We grant the Request to the extent that we misapprehended an argument made by Appellant in its Appeal Brief. After reconsidering Appellant's arguments, however, we deny Appellant's Request to change our Decision and affirm the rejection of claims 1–11, 17, and 18 as unpatentable.

ORIGINAL DECISION ON APPEAL

Below is a summary of our original Decision:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–4, 6, 7, 9, 18	103	Piplani, Nunez	1–4, 6, 7, 9, 18	
5, 8, 10, 11	103	Piplani, Nunez, Dehdashtian	5, 8, 10, 11	
17	103	Piplani, Nunez, Ressemann	17	
Overall Outcome			1–11, 17, 18	

Dec. 13.

CLAIMED SUBJECT MATTER

Claim 1 is the sole independent claim on appeal before us. Appeal Br. (Claims App.). We reproduce claim 1, below:

> 1. A debranching stent graft limb comprising:
> a main body stent graft limb with a bifurcation defining a first leg and a second leg,
> wherein the main body stent graft limb has a distal end and a proximal end;
> wherein the main body stent graft limb has a diameter at the proximal end in the range from about 14 mm to about 18 mm;
> wherein the diameter along the length of the main body stent graft limb either tapers outwardly toward the distal end or remains constant;
> wherein the first leg has a diameter ranging from about 8 mm to about 12 mm; wherein the second leg has a diameter ranging from about 6 mm to about 10 mm; and
> wherein the distance from the proximal end of the main body stent graft limb to the distal end of the first leg and the second leg is in the range from about 70 mm to about 90 mm; and

> wherein the diameter of the first leg is about 2 mm greater than the diameter of the second leg;
>
> wherein the length of the first leg and the length of the second leg are each a minimum of about 30 mm; and
>
> wherein the main body stent graft limb comprises a stent structure extending along the length of the main body stent graft limb, wherein the first leg comprises a stent structure extending along the length of the first leg and wherein the second leg comprises a stent structure extending along the length of the second leg.

Id. (emphasis and indentations added for clarity).

APPELLANT'S CONTENTIONS

A rehearing request under 37 C.F.R. § 41.52 has the very specific requirements that the party seeking rehearing allege that the Board misapprehended or overlooked something in rendering the original decision.

Appellant contends that we misapprehended arguments presented in the Appeal Brief filed January 29, 2018 ("Appeal Br."), and in the Reply Brief filed on May 7, 2018 ("Reply Br."). Req. Reh'g 1. In particular, Appellant argues that we "misapprehended and/or overlooked Appellant's arguments and evidence directed to the criticality of the six (6) claimed ranges recited in claim 1 . . . [and] narrowed the criticality argument to a single claimed range." *Id.* at 2.

ANALYSIS

In our Decision, we responded to Appellant's argument that the claimed ranges are critical, and considered the declaration testimony of Appellant's expert, Dr. Kelly. *See* Dec. 7–11. Having reviewed Dr. Kelly's declaration (Appeal Br. (Exh. A), "Declaration" or "Decl."), we found that "Dr. Kelly's testimony is vague and we cannot discern which, if any, of the

claimed ranges is critical and achieves unexpected results." Dec. 9. In light of this confusion, we assumed, apparently incorrectly, that Appellant and Dr. Kelly intended to focus its argument on the one claimed range that the Examiner determined to be obvious, and not explicitly disclosed by Piplani. *See id.* at 7 ("The issue is whether Appellant has shown that the claimed range—wherein the diameter of the first leg is about 2 mm greater than the diameter of the second leg—achieves unexpected results"); *see also* Final Act. 2–5 (finding that Piplani does "not explicitly disclose the diameter of the first leg is about 2 mm greater than the diameter of the second leg" but nevertheless reasoning that the limitation would have been obvious over Nunez, as further evinced by Gordon).

Because we focused Appellant's criticality argument to on one claimed range instead of all six claimed ranges, we grant Appellant's Request to reconsider our Decision.

Having granted Appellant's Request to reconsider our Decision, the issue turns to whether Appellant has shown criticality of the *six claimed ranges* by demonstrating that the *six claimed ranges* achieve unexpected results relative to the prior art ranges.

We find that Appellant has not shown criticality of any or all of the six claimed ranges, and deny Appellant's Request to change our Decision.

"The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. . . . [I]n such a situation, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range." *In re Woodruff*, 919 F.2d

1575, 1578 (Fed. Cir. 1990). Criticality is shown by some noticeable difference in the qualities. *In re Lilienfeld*, 67 F.2d 920, 924 (CCPA 1933).

As similarly explained in our Decision, we are not persuaded that any of the claimed ranges are critical or achieve unexpected results. *See* Dec. 7–11; *see also id.* at 10 ("nothing in the Specification or Declaration leads us to believe that the ranges recited in claim 1 are somehow 'critical' or lead to unexpected results.").

First, Dr. Kelly's testimony lacks adequate factual support, and we give little weight to his unsupported assertions that the claimed ranges are critical. *See Velander v. Garner*, 348 F.3d 1359, 1371 (Fed. Cir. 2003) ("[A]ccord[ing] little weight to broad conclusory statements [in expert testimony before the Board] that it determined were unsupported by corroborating references [was] within the discretion of the trier of fact to give each item of evidence such weight as it feels appropriate"); *see also Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 294 (Fed. Cir. 1985) ("Opinion testimony rendered by experts must be given consideration, and while not controlling, generally is entitled to some weight. Lack of factual support for expert opinion going to factual determinations, however, may render the testimony of little probative value in a validity determination" (citations omitted)); *see also* Dec. 8 (citing *Velander* and *Ashland Oil*).

In particular, Dr. Kelly testifies that "the ranges adapt the debranching stent graft limb to be a modular docking station for other stent grafts and to permit *revision procedures with fewer side effects* than known up-and-over techniques." Decl. ¶ 7 (emphasis added); *see also id., generally*. The testimony, however, fails to show that it is the *claimed ranges* that

unexpectedly result in revision procedures with fewer side effects. In support of his testimony, Dr. Kelly references Exhibits B, C, and D of the Appeal Brief, yet these Exhibits do not support his contention that the ranges are critical. *Id.*; *see also* Appeal Br. (Exhs. B, C, D) ("Exhibits"). These Exhibits depict various stent grafts, but nothing in the Exhibits establishes that the six ranges recited in claim 1 are present in the stent grafts shown, let alone support a finding that stent grafts with the claimed ranges result in revision procedures with fewer side effects. As we found in our Decision, "we accord little weight to Dr. Kelly's declaration and find it insufficient to establish that the ranges of claim 1 exhibit unexpected results." Dec. 9.

Second, we cited Appellant's Specification to further support our finding that the claimed ranges are not critical. *See* Dec. 9–10 (citing Spec. 3–23). Appellant argues that our citation to the unclaimed embodiments of the Specification was in error and not otherwise relevant to the criticality finding. *See* Req. Reh'g 5 ("[The] Board's new argument misapprehends the relevance of Appellant's unclaimed embodiments and this new position is not relevant to the criticality argument."). We disagree. Indeed, Dr. Kelly cites to the general teachings of the Specification in support of his testimony, and our analysis would be incomplete without a thorough review of it. *See, e.g.*, Decl. ¶ 9 ("Based on the foregoing and in view of the teachings of the Specification . . .").

In the present case, we found that the Specification described "*at least twenty four* different embodiments, several of which having multiple sub-embodiments." Dec. 9 (citing Spec. 3–23). We found that the "Specification includes multiple embodiments with ranges that cover a wide spectrum of ranges, and nothing in the Specification or Declaration leads us

to believe that the ranges recited in claim 1 are somehow 'critical' or lead to unexpected results." *Id.* at 9–10. The numerous broad ranges disclosed in the Specification—and the lack of any accompanying description explaining the criticality of these numerous ranges—are relevant, as they discredit Appellant's own criticality argument. *See, e.g.*, *Ex parte Shastry et al.*, No. 2017-003614, 2017 WL 6817003, at *7 (PTAB Dec. 11, 2017) ("Appellants do not establish criticality or unexpected results for the narrow range of peroxide amount claimed, in view of the broader range disclosed in the Specification ¶ 13.").

For the foregoing reasons, Appellant has not shown, either through the Specification, Dr. Kelly's Declaration, or the Exhibits, any noticeable difference in the qualities of the claimed ranges. *See Lilienfeld*, 67 F.2d at 924.

We grant Appellant's Request to the extent that we have considered our Decision in light of the points raised therein. We are not persuaded by Appellant's arguments, however, that any or all of the six ranges recited in claim 1 are critical or achieve unexpected results. As such, we deny Appellant's Request to modify our Decision and affirm the Examiner's rejection of claims 1–11, 17, and 18.

CONCLUSION

SUMMARY OF OUR REHEARING DECISION

Below is a summary of our Rehearing Decision:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Granted	Denied
1–4, 6, 7, 9, 18	103	Piplani, Nunez		1–4, 6, 7, 9, 18
5, 8, 10, 11	103	Piplani, Nunez, Dehdashtian		5, 8, 10, 11
17	103	Piplani, Nunez, Ressemann		17
Overall Outcome				1–11, 17, 18

Below is a summary of the Final Outcome of this appeal:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–4, 6, 7, 9, 18	103	Piplani, Nunez	1–4, 6, 7, 9, 18	
5, 8, 10, 11	103	Piplani, Nunez, Dehdashtian	5, 8, 10, 11	
17	103	Piplani, Nunez, Ressemann	17	
Overall Outcome			1–11, 17, 18	

DENIED