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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PIERRE BAILLY and GENEVIÈVE DOUCET

Appeal 2019-002341
Application 14/332,496
Technology Center 3700

Before MURRIEL E. CRAWFORD, PHILIP J. HOFFMANN, and
BRADLEY B. BAYAT, *Administrative Patent Judges*.

BAYAT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ appeals under 35 U.S.C. § 134(a) from the decision rejecting claims 10, 12–16, 18–25, and 27, which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as “the Assignee of record, Sofradim Production.” Appeal Br. 1.

CLAIMED SUBJECT MATTER

The claimed invention is directed to a “Surgical instrument for deploying a prosthesis.” Spec., Title. Sole independent claim 10, reproduced below, is representative of the subject matter on appeal.

10. A surgical instrument for deploying a prosthesis intended to repair a hernial defect comprising:

at least one sheet made of a flexible resilient material, said sheet continuously overlapping itself one or more times so as to define a plurality of levels forming a spiral, wherein a central hole passes through said plurality of levels and said spiral is configured to adopt an idle configuration in which the plurality of levels are in contact with each other.

REJECTION

Claims 10, 12–16, 18–25, and 27 are rejected under 35 U.S.C. § 102(b) as anticipated by Shaw et al. (US 6,080,182, issued June 27, 2000) (“Shaw”).

OPINION

In rejecting independent claim 10 as anticipated by Shaw, the Examiner finds Shaw discloses the claimed surgical instrument at Figures 13, 32B, and 40C. Answer 2. As to the “spiral being configured to adopt an idle configuration in which the plurality of levels are in contact with each other,” the Examiner finds Shaw’s examples are “capable of being compressed to achieve this configuration, which is an idle configuration.” *Id.* at 2–3. Specifically, the Examiner explains, “the device may be compressed while in the spiral memory induced state, to form a device reading on the limitations as claimed in which the spiral is flat and the plurality of levels being in contact with each other.” *Id.* at 7–8. In addition,

the Examiner determines that because “Shaw discloses all of the structural limitations of the device, and may include a compressed or expanded state, it is concluded that Shaw is inherently capable of performing the [claimed] function.” *Id.* at 8.

Appellant argues:

given that claim 10 recites that the “spiral is configured to adopt an idle configuration in which the plurality of levels are in contact with each other,” and does not recite that the spiral is capable of adopting an idle configuration in which the plurality of levels are in contact with each other,[] Appellant maintains that the alleged physical capability of Shaw’s self-expanding sealing device to be “compressed to achieve [the claimed] configuration,” as asserted by the Office, is insufficient to provide a *prima facie* case of anticipation.

Appeal Br. 19; *see also* Reply Br. 2 (“Shaw does not expressly or inherently teach a spiral configured to adopt an idle configuration in which the plurality of levels (a, b, c) are in contact with each other.”).

We agree with Appellant.

The Federal Circuit has held that “configured to” language requires that the specific element is not only “capable of” performing the recited function, but is also specifically designed to accomplish the function claimed. *See Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.*, 672 F.3d 1335, 1349 (Fed. Cir. 2012) (The phrase “configured to” is construed more narrowly than “capable of” such that the structure must be designed to accomplish the specified objective, not simply that it can be made to serve that purpose.). *Cf.* Spec. 2:18–21 (“Due to the resilience of said sheet, the spiral is able to adopt a substantially flat configuration, in which each level

is in contact with the adjacent level, corresponding to an idle configuration in which the spiral does not undergo significant stresses.”)

The Examiner has not shown that Shaw’s device includes a “spiral configured to adopt an idle configuration in which the plurality of levels are in contact with each other,” because the Examiner has not established that Shaw’s device is specifically designed to adopt an idle configuration, as required by claim 10. For example, the Examiner does not point to a compressed configuration in Shaw, and does not show that Shaw expressly describes compressing its device to a compressed state. As such, the Examiner has not established that Shaw expressly anticipates claim 10.

As to the Examiner’s assertion that Shaw is “inherently capable of performing the function” (Answer 8), this is insufficient to establish anticipation of claim 10. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted) (internal quotation marks omitted). Inherency, however, may not be established by probabilities or possibilities. *Id.* The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *Id.* The Examiner has not established that an idle configuration, as claimed, is necessarily present in Shaw. As discussed above, when claim 10 is properly construed, the “configured to” language requires more than mere capability. To conclude an idle configuration as claimed is necessarily present in Shaw requires mere speculation, which is insufficient to establish anticipation based on inherency. “[A]bsence from

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the reference of any claimed element negates anticipation.” *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986).

For these reasons, we do not sustain the anticipation rejection under 35 U.S.C. § 102(b) over Shaw.

CONCLUSION

The Examiner’s rejection is REVERSED.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
10, 12–16, 18–25, 27	102(b)	Shaw		10, 12–16, 18–25, 27

REVERSED