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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JASON L. CHINAVARE,
SUNOJ NARAYANAN, DAVID L. DINGMANN,
and LITO CRUZ MEJIA

Appeal 2019-005302
Application 15/160,615
Technology Center 2800

Before BEVERLY A. FRANKLIN, GEORGE C. BEST, and LILAN REN,
Administrative Patent Judges.

FRANKLIN, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–8. 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(a). Appellant identifies the real party in interest as TA Instruments Waters L.L.C. Appeal Br. 2.

CLAIMED SUBJECT MATTER

Claim 1 is illustrative of Appellant's subject matter on appeal and is set forth below:

1. An apparatus for testing a prosthesis, comprising:
 - a first conduit frame disposed to be coupled to a first end of a conduit, wherein the conduit is disposed to receive a prosthesis;
 - a second conduit frame disposed to be coupled to a second end of the conduit opposite the first end;
 - a movable shaft disposed to cause relative motion between the first conduit frame and the second conduit frame, the prosthesis thereby being exposed to a tensile or a compressive force as a result of the relative motion; and
 - a pump fluidly connected to the conduit to provide a flow of fluid through the conduit and the prosthesis at least while the movable shaft is in motion.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Lorenz	US 8,196,478 B2	June 12, 2012
Conti ("Conti '534")	US 2007/0185534 A1	Aug. 9, 2007
Weinberg	US 2011/0146385 A1	June 23, 2011
J. Conti, <i>A Comprehensive Protocol and Procedural Considerations Designed to Evaluate the Shedding of Particles from Drug Eluting Stents</i> , Materials & Processes for Med. Devices Conf. 1-5 (2007)		

REJECTIONS

1. Claims 1, 5, 6, and 8 are rejected under 35 U.S.C. § 103 as being unpatentable over Weinberg in view of Lorenz.
2. Claims 2-4 are rejected under 35 U.S.C. § 103 as being unpatentable over Weinberg in view of Lorenz and Conti.

3. Claim 7 is rejected under 35 U.S.C. § 103 as being obvious over Weinberg in view of Lorenz and Conti, and further in view of Conti '534.

OPINION

We review the appealed rejections for error based upon the issues Appellant identifies, and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) (cited with approval in *In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (“[I]t has long been the Board’s practice to require an applicant to identify the alleged error in the examiner’s rejections.”). After considering the argued claims and each of Appellant’s arguments, we are persuaded of reversible error in the appealed rejections for the reasons provided by Appellant, and add the following for emphasis.

We can focus on the claim element of “a pump fluidly connected to the conduit to provide a flow of fluid through the conduit and the prosthesis at least while the movable shaft is in motion” in making our determinations herein. On the one hand, it is the Examiner’s position that this claim element is suggested by the combination of Weinberg in view of Lorenz for the reasons provided on pages 3–4 of the Final Office Action and on pages 4–7 of the Answer.

On the other hand, Appellant disagrees with this position for the reasons provided on pages 6–16 of the Appeal Brief and on pages 2–5 of the Reply Brief.

The Examiner recognizes that Weinberg does not teach this claim element, so relies upon Lorenz for curing this deficiency. Final Act. 4. However, we agree with Appellant’s position that Lorenz inadequately provides this missing element for the reasons stated by Appellant in the record. Specifically, the Examiner relies upon col. 15, ll. 9–13 of Lorenz which discloses that “[i]t is further possible to let water flow through the tube 17 . . .” Ans. 3–4. However (as pointed out by Appellant on pages 2–3 of the Reply Brief), Lorenz does not disclose or suggest the presence of the claim element of “a pump fluidly connected to the conduit to provide a flow of fluid through the conduit”, as required by claim 1. That is, Appellant argues Lorenz does not teach to attach insertable holder (15) of Lorenz to a pump. Appellant also argues that the rejection does not address whether and how the attachment of Lorenz would allow for fluid connection to a pump in the manner as claimed.² *Id.*

Appellant argues that the rejection therefore does not adequately account for this missing claimed feature and does adequately explain how to make the proposed modification to meet the claim in this regard. Reply Br. 3. We agree. Hence, a claim element is not adequately addressed in Rejection 1. We note that “[w]hen determining whether a claim is obvious, an examiner must make a searching comparison of the claimed invention, including all its limitations, with the teaching of the prior art.” *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995). Thus, “obviousness requires a suggestion of all limitations in a claim.” *CFMT, Inc. v. Yieldup Corp.*, 349

² The Examiner acknowledges this in the last full paragraph on page 4 of the Answer yet does not explain how the proposed combination of applied art meets this claimed feature.

F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). *See also In re Wada and Murphy*, Appeal No. 2007- 3733 (January 14, 2008) (a Board decision in support of the view that an examiner cannot skip a claim limitation when rejecting a claim as being obvious). Furthermore, “[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *See W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1551, 1553 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

We therefore reverse Rejections 1–3 (the Examiner does not rely upon the additionally applied references in Rejections 2 and 3 to cure the stated deficiencies of the combination of Weinberg in view of Lorenz).

CONCLUSION

We reverse the Examiner’s decision.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 5, 6, 8	103	Weinberg, Lorenz		1, 5, 6, 8
2–4	103	Weinberg, Lorenz, Conti		2–4
7	103	Weinberg, Lorenz, Conti, Conti ’534		7
Overall Outcome				1–8

REVERSED