

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No.29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARTHUR B. FONTAINE

Appeal No. 96-0211
Application 07/929,150¹

ON BRIEF

Before OWENS, CRAWFORD, and RUGGIERO, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of the following design claim:

I CLAIM the ornamental design for AN IMPLANTABLE INTRAVASCULAR STENT as shown and described.

¹ Application for patent filed August 13, 1992.

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THE REFERENCES

Palmaz	4,733,665	Mar. 29, 1988
Wiktor	5,133,732	Jul. 28, 1992

THE REJECTIONS

The claim stands rejected under 35 U.S.C. § 103 as being unpatentable over Palmaz, and also over Palmaz (Figs. 1A and 1B) in view of Wiktor.²

OPINION

We have carefully considered all of the arguments advanced by appellant and the examiner and agree with appellant that the aforementioned rejection is not well founded. Accordingly, we do not sustain this rejection.

The ultimate inquiry when obviousness of a design is considered under 35 U.S.C. § 103 is whether the design would have been obvious to a designer of ordinary skill who designs articles of the type involved. *See Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103, 40 USPQ2d 1788, 1790 (Fed. Cir. 1996). For a design to be unpatentable because of obviousness, there must be a reference which shows "something in existence, the design

² Although the examiner's answer does not so state, it appears from the discussion in the answer that in the rejection over Palmaz alone, the examiner also relies upon Figs. 1A and 1B of that reference.

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characteristics of which are basically the same as the claimed design". *In re Rosen*, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982). If this primary reference alone is not sufficient for rendering obvious the claimed design, then design elements from secondary references may be considered, provided that the references are related such that the appearance of ornamental features of the secondary references would have suggested applying those features to the primary reference. See *In re Borden*, 90 F.3d 1570, 1574-75, 39 USPQ2d 1524, 1526-27 (Fed. Cir. 1996). For a design to be unpatentable as being obvious, the design in the primary reference, or the design produced by modifying the primary reference in view of the secondary references, must have the same overall appearance, or visual effect as a whole, as the claimed design. See *In re Harvey*, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993).

The similarities and differences between Palmaz's design and that of appellant are well stated by appellant (brief, pages 6-8):

Applicant's stent, like Palmaz, has a number of cells formed by a wire frame construction. Unlike Palmaz, however, Applicant's cells are arranged in a single spiral configuration, much like a barber pole. The cells of Palmaz are disposed in multiple rings, with each ring being vertically offset with respect to the previous row. The shape of the cells in Applicant's stent are remarkably different in appearance compared to the shape of the cells in Palmaz. Applicant's cells are curvilinear and asymmetrical whereas the Palmaz cells are regular, linear

and symmetrical. The asymmetrical nature of Applicant's stent results from the spiral nature of the cell pattern. Furthermore, the intersection of the wires forming the cells in Applicant's stent is smooth and continuous whereas the wires forming the stent in Palmaz overlap to form a sharp, pointed and angular appearance. The walls of Applicant's stent are of single wire thickness whereas at least the overlapping points in the Palmaz construction are of two wire thicknesses.

. . .

. . . In summary, Applicant's stent has an ornamental appearance of a single continuous, half-round wire in a curvilinear waveform pattern spirally wound into a tubular shape with the troughs and peaks of vertically adjacent waveforms connected in the same plane to form a spiral series of curvilinear asymmetric rhomboid cells. On the other hand, the Palmaz design has an overall appearance of multiple offset rows of symmetric, repetitive diamond-shaped cells formed by two parallel sets of multiple wires which are oriented at an acute angle to each other.

. . .

Applicant's stent and Palmaz's graft are similar to the extent that they both have wire frames which form a cylindrical tube.

The above-noted differences in the appearances of the designs of Palmaz and appellant are not minute as argued by the examiner (answer, pages 3, 4 and 7).

The examiner argues that the designs of both Palmaz and appellant have the overall appearance of a tubular-shaped stent which has numerous rhomboid cells in a repetitive pattern which are formed of wire (answer, page 7). This argument is deficient in that the examiner does not address the many differences in the

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appearances of appellant's stent and Palmaz's graft pointed out by appellant, as set forth above. The examiner improperly focuses on the design concept of a stent which is made of wire, has a tubular shape, and has numerous rhomboid cells in a repetitive pattern, rather than considering the overall appearance, or visual effect as a whole, of the designs of appellant and Palmaz. *See Harvey*, 12 F.3d at 1064, 29 USPQ2d at 1208.

Because of above-noted differences between appellant's stent and Palmaz's graft, appellant's stent and Palmaz's graft do not have design characteristics which are basically the same. Thus, Palmaz is not suitable as a primary reference. *See Rosen*, 673 F.2d at 391, 213 USPQ at 350. We therefore do not sustain the rejection over Palmaz. Also, because Palmaz is not suitable as a primary reference, and because the examiner has not argued, and it does not appear, that Wiktor is suitable as a primary reference, we do not sustain the rejection over Palmaz and Wiktor. *See id.*

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DECISION

The rejections of appellant's design claim under 35 U.S.C. § 103 over Palmaz, and over Palmaz in view of Wiktor, are reversed.

REVERSED

TERRY J. OWENS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	

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Richard J. Godlewski
P.O. Box 2256
West Lafayette, IN 47906