

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(2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ZAZA A. KAVTELADZE,
ALEKSANDR P. KORSHOK, ANDREJ A. KADNIKOV,
PALLE HANSEN and BETH A. KIRTS

Appeal No. 98-2783
Application 08/450,009¹

ON BRIEF

Before CALVERT, FRANKFORT and McQUADE, Administrative Patent Judges.

¹ Application for patent filed May 25, 1995. According to appellants, the application is a continuation-in-part of Application 29/034,346, filed February 2, 1995, now U.S. Patent D-380,831, issued July 8, 1997; which is a continuation-in-part of Application 08/379,582, filed February 1, 1995, now U.S. Patent No. 5,643,339, issued July 1, 1997; which is a National stage application under 35 U.S.C. § 371 of PCT/DK93/00256, filed August 6, 1993.

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FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 10 and 28. Claims 11 through 27 and 29, all the other claims pending in the application, stand allowed.

Appellants' invention relates to an implantable prosthetic device for sustaining a blood vessel or hollow organ lumen. As can be seen, for example, in Figure 6, the device is in the form of a tubular shaped wire frame (1) having a hollow cylinder body (13) wherein interconnected cells (2) are shaped and arranged to provide the frame with a large stiffness in the radial direction and only low stiffness in the axial direction so that the device without risk of traumatization will keep the blood vessel or hollow body lumen open, even if the latter changes shape due to external loads. Independent claim 1 is representative of the subject matter on appeal and a copy of that claim is attached to this decision.

The sole prior art reference relied upon by the examiner in rejecting the appealed claims is:

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Hillstead

4,856,516

Aug. 15, 1989

Claims 1 through 10 and 28 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim that which appellants regard as their invention. On page 3 of the answer, the examiner indicates that

[i]n regards to claim 1, the structure as defined is indefinite. Also "segments run longitudinally" is not understood and conflicts with dependent claims where the segments run helically.

In regards to claim 28, "branches" lacks antecedent basis.

Claims 1, 2, 6 and 9 stand additionally rejected under 35 U.S.C. § 102(b) as being anticipated by Hillstead. The examiner directs attention to Figures 2 and 2A of Hillstead, noting that

The Hillstead reference is interpreted as follows: the cells are separated by each hoop 52 (figure 2A shows 4 cells), each wire segment includes a longitudinal part 54 and a circumferential part 50, each segment are [sic] "wound around each other at an axially extending portion," and interconnections 56 are

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wound in a first direction and a second
opposite direction (answer, page 3).

Rather than reiterate the examiner's full position on the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we make reference to the examiner's answer (Paper No. 17, mailed July 15, 1997) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 16, filed May 13, 1997) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

The first rejection for our review is that of claims 1 through 10 and 28 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim

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that which appellants regard as their invention. With regard to claim 1, the examiner seems to be of the view that the structure of the prosthetic device recited in the claim is indefinite because the language "each of the first and second wire segments runs longitudinally along the wire frame and

through the interconnected cells" is unclear and conflicts with the recitations in, for example, dependent claims 4 and 5, which indicate that the first and second wire segments run in a "helical direction." On page 6 of their brief, appellants urge that claim 1 "merely refers to a pair of wire segments which all parts of wire segments run longitudinally along the wire frame." Like the examiner, we find appellants' language noted above in claim 1 to be unclear and indefinite, especially in light of appellants' argument on page 6 of their brief and in the paragraph bridging pages 4 and 5 of the brief where appellants attempt to distinguish the claimed prosthetic device from that of Hillstead based on the language questioned by the examiner.

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A review of appellants' disclosure and drawings reveals quite clearly that "all parts" of the first (e.g., 15) and second (e.g., 16) wire segments of appellants device do not run longitudinally along the wire frame, as appellants have argued. In fact, those portions of the first and second wire segments to which reference characters (15) and (16), in Figure 6, each respectively point, clearly do not "run longitudinally along the wire frame," but instead extend in a circumferential direction of the wire frame (1). While it is

true that each of the wire segments of a pair of wire segments (e.g., 24 in Figure 6) extends along the full extent of the wire frame (1) from one end (32) to the opposite end (33) by being helically formed on a mandrel together with other pairs of wires, this is not what is recited in claim 1 on appeal and there is no clear indication in the specification or appellants' brief that this is what the questioned language in claim 1 was intended to mean and would have reasonably conveyed to one of ordinary skill in the art. Thus, we agree with the examiner that independent claim 1 is indefinite and that claims 2

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through 10 which depend therefrom are also indefinite, given their dependency from claim 1.

With regard to claim 28, appellants have not disputed the examiner's position, but have merely given the examiner "the authority to amend and/or enter the amendment made to claim 28 in applicants' response of August 22, 1996 in order to more particularly point out and distinctly claim applicants' invention" (brief, page 5). Thus, since appellants have not taken issue with the examiner's position regarding claim 28, the rejection of that claim under 35 U.S.C. § 112, second paragraph, is summarily sustained.

We next look to the examiner's rejection of claims 1, 2, 6 and 9 under 35 U.S.C. § 102(b) as being anticipated by Hillstead. Given our determinations above concerning the indeterminate scope and content of claims 1, 2, 6 and 9 on appeal under 35 U.S.C. § 112, second paragraph, we find that it is not possible to apply the prior art relied upon by the examiner to these claims in deciding the question of anticipation under 35 U.S.C. § 102(b) without resorting to considerable speculation and conjecture as to the exact

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meaning of the language in claim 1 questioned by the examiner and the exact scope and content of these claims. This being the case, we are constrained to reverse the examiner's rejection of claims 1, 2, 6 and 9 under 35 U.S.C. § 102(b) based on Hillstead, in light of the holding in In re Steele, 305 F.2d 859, 134 USPQ 292 (CCPA 1962). We hasten to add that this reversal of the examiner's prior art rejection is not based on the merits of the rejection, but only on technical grounds relating to the indefiniteness of the claims under consideration.

To summarize our decision, we note that 1) the examiner's rejection of claims 1 through 10 and 28 under 35 U.S.C. § 112, second paragraph, has been sustained, and 2) the examiner's rejection of claims 1, 2, 6 and 9 under 35 U.S.C. § 102(b) based on Hillstead has not been sustained.

Since at least one rejection of each of the claims on appeal has been sustained, it follows that the decision of the examiner rejecting claims 1 through 10 and 28 on appeal is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

	IAN A. CALVERT)	
	Administrative Patent Judge)	
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)	
PATENT)	BOARD OF
	CHARLES E. FRANKFORT)	APPEALS AND
	Administrative Patent Judge)	
INTERFERENCES)	
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)	
	JOHN P. McQUADE)	
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APPENDED CLAIM

1. A prosthetic device (20) for sustaining a blood vessel or hollow organ lumen (21), comprising:

a wire frame (1) having a flexible tubular shape (13) and a plurality of interconnected cells (2) with flexible interconnections (14), wherein each of the flexible interconnections has first and second wire segments (15,16) that are wound around each other at an axially extending portion (17) of the wire frame, wherein each of the first and second wire segments runs longitudinally along the wire frame and through the interconnected cells, wherein the first and second wire segments in at least one of the flexible interconnections are wound in a first direction (18), and wherein the first and second wire segments in at least an other of the flexible interconnections are wound in a second direction (19) opposite to the first direction.