

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH R. CALLOL
and W. STAN WILSON

Appeal 2006-3287
Application 10/022,996
Technology Center 3700

Decided: April 30, 2007

Before EDWARD C. KIMLIN, CATHERINE Q. TIMM, and LINDA M. GAUDETTE, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 8-14. Claim 8 is illustrative:

8. A method for treating the proximal portion of a main vessel and the opening of a side branch vessel at a bifurcation, comprising:

providing a stent having a plurality of first rings and a plurality of second rings;

mounting the stent on a catheter having a long balloon and a short balloon wherein the long balloon and short balloon are positioned side by side;

advancing the catheter and stent through the vascular system to a position proximal of the bifurcation;

positioning the stent at the bifurcation so that the second rings are aligned with the opening to the side branch vessel;

inflating the long balloon and the short balloon to radially expand the stent so that the first rings oppose and contact the main vessel proximal to the bifurcation and the second rings oppose and contact the opening of the side branch vessel; and

deflating the long balloon and the short balloon and withdrawing the catheter from the vascular system.

The Examiner relies upon the following references as evidence of obviousness:

| | | |
|-----|-----------------|--------------|
| Lam | US 5,607,444 | Mar. 4, 1997 |
| Kim | US 6,270,524 B1 | Aug. 7, 2001 |

Appellants' claimed invention is directed to a method for bifurcation of a blood vessel that includes, inter alia, mounting a stent on a catheter having a long balloon and a short balloon that are positioned side by side.

Appealed claims 8-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lam in view of Kim.

Appellants do not present separate arguments for any particular claim on appeal. Accordingly, all of the appealed claims stand or fall together with claim 8.

We have thoroughly reviewed each of Appellants' arguments for patentability. However, we are in complete agreement with the Examiner that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning of § 103 in view of the applied prior art. Accordingly, we will sustain the Examiner's rejection for essentially those reasons expressed in the Answer, and we add the following primarily for emphasis.

Appellants do not dispute the Examiner's factual determination that Lam discloses the provision of a stent that is mounted on a catheter having long and short balloons thereon. Also, Appellants do not contest the Examiner's legal conclusion that it would have been obvious for one of ordinary skill in the art to employ a stent constructed of a plurality of rings in the invention of Lam. Rather, the sole issue argued by Appellants is that "[t]he Lam patent discloses multiple balloons axially aligned, not side by side" (page 12 of principal Br., 3rd para.). Appellants contend that "[t]he specification and drawings of the present application clearly show that the claim term 'side by side' is intended to mean that the longer side of the long balloon (117) is positioned next to the longer side of the short balloon (129) during mounting as shown for example, for example, [sic] in FIG. 34 of the present patent application" (page 4 of Reply Br., first sentence). Appellants urge that their "drawings clearly show that the claim term 'side by side' should not be given the overly broad meanings of 'end-to-end,' 'by-the-side,'

or 'near-the-side' as argued by the Examiner" (page 4, Reply Br., first paragraph).

Appellants' argument does not refute the Examiner's finding that "Dictionary.com defines 'side by side' as 'next to each other; close together,'" and that "Appellant's specification does not include an alternative definition for this term" (page 4 of Answer, first para.). Hence, it is not enough for Appellants to simply point to their Specification and drawings for a depiction of their interpretation of the claim language "side by side" such that the claim language means something other than that defined in a dictionary. If an applicant wants to impart a meaning to a claim term that is narrower than its ordinary dictionary definition, it is incumbent upon the applicant to specifically do so in the Specification. In the instant case, Appellants point to no definition in the Specification of the claim term "side by side" which would preclude the axial alignment admittedly disclosed by Lam. Moreover, we concur with the Examiner that Figure 7 of Lam fairly depicts balloons situated side by side notwithstanding that they are separated by tissue. Manifestly, the disposition of the two balloons shown in Lam's Figure 7 meets the dictionary definition of "close together" presented by the Examiner.

The dissent's approach, in our opinion, would violate the proscription against reading limitations from the Specification into the claims during ex parte prosecution. As appreciated by the dissent, the *SciMed* case involves patent infringement, and it is well settled that claim interpretation in such inter partes cases is under a narrower standard, presuming patent validity, than the one applied in prosecution proceedings before the USPTO. Perhaps

that is why Appellants have not relied on the authority cited by our distinguished colleague. Indeed, Appellants have not established on this record that their definition of “side by side” is the only one accepted in the relevant art, to the exclusion of the dictionary definition that is not in dispute.

In conclusion, based on the foregoing and the reasons well stated by the Examiner, the Examiner's decision rejecting the appealed claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(iv) (effective Sept. 13, 2004).

AFFIRMED

Linda M. Gaudette, Administrative Patent Judge, dissenting:

The majority's decision to affirm the rejection of appealed claims 3-14 under 35 U.S.C. § 103(a) is based on a finding that the Examiner's claim construction is reasonable. See Decision 4 (noting that "[i]f an applicant wants to impart a meaning to a claim term that is different than its ordinary dictionary definition, it is incumbent upon the applicant to specifically do so in the Specification.") Decision 4. I disagree with this finding. In my view, the Examiner has improperly relied on a dictionary definition in construing the claims without proper consideration of the specification from the standpoint of a person of ordinary skill in the art. In so doing, the Examiner has applied an overly broad construction of the claim term "side by side."

During prosecution claims are given their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. Of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004):

"The inquiry into how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation. ... That starting point is based on the well-settled understanding that inventors are typically persons skilled in the field of the invention and that patents are addressed to and intended to be read by others of skill in the pertinent art."

Phillips v. AWH Corp., 415 F.3d 1303, 1313, 75 USPQ2d 1321, 1326 (Fed. Cir. 2005)(citing, *inter alia*, *In re Nelson*, 280 F.2d 172, 181, 126 USPQ 242, 251 (CCPA 1960) ("The descriptions in patents are not addressed to the

public generally, to lawyers or to judges, but, as section 112 says, to those skilled in the art to which the invention pertains or with which it is most nearly connected.”)). Thus, even where the claim language is facially unambiguous, the PTO is still obligated to examine the entire patent disclosure, since the specification can limit the apparent breadth of a claim. *Rowe v. Dror*, 112 F.3d 473, 480, 42 USPQ2d 1550, 1554 (Fed. Cir. 1997)(finding that Rowe’s claims, when properly interpreted, required a balloon angioplasty catheter capable of expanding radially and exerting pressure on the plaque-encrusted walls of a surrounding blood vessel).

The majority is certainly correct in stating that where a patent applicant intends to use a claim term in a manner which differs from its ordinary meaning, the applicant is obligated to provide a clear definition of that term in the Specification. However, the issue before us is not whether Appellants have acted as their own lexicographers and attempted to use the term “side by side” in a manner which differs from its ordinary meaning. Rather, the issue raised in this appeal is whether one of ordinary skill *in the balloon catheter art* would understand the term “side by side” as defining a specific configuration¹ which differs from the configuration, i.e., end to end (or coaxial), shown in the applied prior art². As explained by our reviewing Court, the PTO's interpretation of claim terms should not be so broad that it conflicts with the meaning given to identical terms in other patents from

¹ “The Examiner has taken the claim term ‘side by side’ out of the context of the art and has failed to define the term as it relates to the subject matter of intravascular balloon catheters within the reading of the specification and drawings of the patent application documents.” (Reply 4).

² “Those skilled in the art would interpret Lam as showing balloon sections positioned ‘end to end’ and not ‘side by side.’” (Reply 5).

analogous art. *In re Cortright*, 165 F.3d 1353, 1358, 49 USPQ2d 1464, 1467 (Fed. Cir. 1999). *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1584, 39 USPQ2d 1573, 1578-79 (Fed. Cir. 1996) (noting that prior art references may be indicative of what all those skilled in the art generally believe a certain term means and can often help to demonstrate how a disputed term is used by those skilled in the art).

In *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, the Court addressed the issue of whether patent claims were limited to a coaxial lumen configuration or whether they were broad enough to also encompass a side by side lumen configuration. 242 F.3d 1337, 58 USPQ2d 1059 (Fed. Cir. 2001)³. The Court's opinion in *SciMed* includes the following findings of fact relating to balloon catheter technology:

The parties agree that only two arrangements of the two lumens are known and practiced in the art. In the dual (or adjacent) lumen configuration, the two lumens are positioned side-by-side within the catheter. In the coaxial lumen configuration, the guide wire lumen runs inside the inflation lumen; in that configuration the inflation lumen, viewed in cross-section, is annular in shape.

242 F.3d at 1339, 58 USPQ2d at 1061. Upon review of the *SciMed* patent specification, the Court concluded that “the written description makes clear that when the asserted claims refer to the respective locations of the guide wire and inflation lumens, and in particular when the claims refer to the inflation lumen as ‘extending through the catheter separate from’ the guide wire lumen, the claim language refers to coaxial lumens.” 242 F.3d at 1344-

³ Although *SciMed* was a patent infringement case, it is instructive on claim interpretation.

45, 58 USPQ2d at 1065-66. The court, focusing on the description of the coaxial lumen structure as the “basic sleeve structure for all embodiments of the present invention contemplated and disclosed herein” concluded that the specification left “no doubt that a person skilled in the art would conclude that the inventor envisioned only one design for the catheters taught in *SciMed's* patents—an intermediate sleeve section containing two ... lumens arranged coaxially.” 242 F.3d at 1339-40, 58 USPQ2d at 1061-62.

SciMed supports Appellants’ contention that one of ordinary skill in the art would understand the term “side by side” as used in the appealed claims as describing the type of configuration shown in Figure 34 of the Specification (*see* Reply 3 (citing Specification, p. 48, ll. 9-14)). *Cf. In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997) (approving the Board's definition of claim terms consistent with their definitions in CCPA cases). Moreover, Appellants’ Specification, read as a whole, suggests that to properly function in accordance with the claimed method, the long and short balloons must have a “side by side” configuration of the type illustrated in Figure 34, rather than a coaxial configuration as shown in *Lam*, during the step of “mounting the stent on a catheter.” *See Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1326-27, 63 USPQ2d 1374, 1381 (Fed.Cir. 2002)(specification and drawings provide context for construction of the claims).⁴

⁴ Compare Specification, p. 48, ll. 9-14 with p. 16, ll. 9-12 and p. 25, ll. 24-25 (Figure 3 illustrates two stents implanted “side by side”), p. 40, ll. 10-13 (Figure 31 shows inner tubular members 172 and 174 within an inflation lumen 160 in a “side-by-side, radially spaced apart relation”) and p. 61, ll. 21-22 (In Figure 51, “the long balloon 500 is adjacent the short

“Where the specification makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question.”

SciMed, 242 F.3d at 1341, 58 USPQ2d at 1062-63. In my opinion, the present Specification makes clear that the term “side by side” was not intended to encompass the coaxially arranged balloons shown in Lam. Therefore, the Examiner’s reliance on a general dictionary definition for interpretation of the term “side by side” was improper since that definition was inconsistent with the definition ascertained upon review of the Specification and drawings. *See Phillips*, 415 F.3d at 1320-21, 75 USPQ2d at 1332.

The majority contends that the rejection of Claims 8-14 is proper even if the term “side by side” is given the interpretation advanced by Appellants, because “Figure 7 of Lam fairly depicts balloons situated side by side notwithstanding that they are separated by tissue.” Decision 4. In my opinion, it is unnecessary to reach the issue of whether the term “side by side” as used in the appealed claims reads on Figure 7 of Lam. Figure 7 of

balloon 501 with the stent 20 mounted thereon”). *See Autogiro Co. of America v. United States*, 384 F.2d 391, 398, 155 USPQ 697, 703 (Ct. Cl. 1967) (“[I]n those instances where a visual representation can flesh out words, drawings may be used in the same manner and with the same limitations as the specification.” (Citations omitted)). *See also, Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1565, 19 USPQ2d 1111, 1118 (Fed. Cir. 1991) (“[D]rawings alone may provide a ‘written description’ of an invention as required by § 112”).

Lam shows the configuration of the balloons *after* the step of mounting the catheter. Lam, col. 6, ll. 7-11 (“Prior to deformation, the flaring portion 25 is substantially parallel to the longitudinal axis 26 of the ostial stent 20. Upon expansion and deformation, the flaring portion is non-parallel to and at some angle slanting away from the longitudinal axis 26 of the ostial stent 20.”). *See* Answer 4. Appellants correctly point out that the language of the appealed claims requires that the long balloon and short balloon are positioned side by side *during* the step of mounting the catheter, which occurs *before* expansion of the balloons. *See* Brief, first paragraph on page 11 and paragraph bridging pages 12-13. Therefore, regardless of whether the claim language “side by side” reads on Lam Figure 7, Lam still fails to teach or suggest the claim 8 step of “mounting the stent on a catheter having a long balloon and a short balloon wherein the long balloon and short balloon are positioned side by side,” i.e., in the type of arrangement shown in Appellants’ Figure 34.

For the foregoing reasons, I would reverse the rejection of Claims 8-14 under 35 U.S.C. § 103 on the basis that the Examiner has failed to make a *prima facie* showing that the prior art teaches or suggests Appellants’

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claimed step of “mounting the stent on a catheter having a long balloon and a short balloon wherein the long balloon and short balloon are positioned side by side.”

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