

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAIME VARGAS, STEPHEN A. YENCHO, JAMEY NIELSEN,
MICHAEL HENDRICKSEN, and BERNARD A. HAUSEN

Appeal 2006-3416
Application 10/884,751
Technology Center 3700

Decided: September 13, 2007

Before TERRY J. OWENS, LINDA E. HORNER, and ANTON W. FETTING,
Administrative Patent Judges.

HORNER, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Jaime Vargas *et al.* (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 3, 11-14, and 17-21, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE and ENTER NEW GROUNDS OF REJECTION.

THE INVENTION

The Appellants' claimed invention is to an anastomosis device for forming a sutureless connection between two blood vessels (Specification 1). Claims 11 and 20, reproduced below, are representative of the subject matter on appeal.

11. An anastomosis device, comprising:
 - a central region; and
 - a first flange connected to the distal end of said central region and deployable from a first position to an expanded position, wherein said first flange includes at least one multi-sided first flange element.

20. An anastomosis device, comprising:
 - a first flange deployable from a first position to an expanded position, wherein said first flange includes at least one multi-sided first flange element; and
 - a second flange proximal to said first flange and deployable to an expanded position, wherein said second flange includes at least one multi-sided second flange element.

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USPQ2d 1152, 1156 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The customary and ordinary meaning of “flange” is “[a] protruding rim, edge, rib, or collar, as on a wheel or a pipe shaft, used to strengthen an object, hold it in place, or attach it to another object.” *The American Heritage Dictionary of the English Language* (4th ed. 2000), found at www.bartelby.com.
2. The customary and ordinary meaning of “protrude,” as an intransitive verb, is “[t]o jut out; project.” *The American Heritage Dictionary of the English Language* (4th ed. 2000), found at www.bartelby.com.
3. The Summary of the Invention of Appellants’ Specification describes the flanges as “radially extending” (Specification 3:7 and 9) and further describes that an expander causes a portion of the tube “to fold outward forming a first annular flange; and forming a second annular flange on the anastomosis device to trap a wall of the target vessel between the first and second annular flanges and seal the graft vessel to the target vessel” (Specification 4:1-4).
4. The Examiner failed to provide a definition of flange or to consider the ordinary and customary meaning of the term “flange.”
5. Furst discloses an expandable intraluminal graft including a tubular-shaped member 10 having a first end 12, a second end 14, and a wall surface 16 disposed between the first and second ends (Furst, col. 4, ll. 52-55; Fig. 1).

6. Furst discloses that the wall surface 16 is formed by a plurality of intersecting elongated members 18, and adjacent elongated members 18 are joined together by at least one U-shaped member 17 (Furst, col. 4, ll. 56-57 and col. 5, ll. 48-53).
7. In use, Furst's tubular-shaped member 10 is expanded by standard procedures, i.e., by inflating a balloon inside the member or by self expansion, from a first diameter to a second, expanded diameter (Furst, col. 1, ll. 34-36, col. 1, ll. 47-50, col. 3, ll. 43-45 and col. 4, ll. 59-65).
8. Furst does not disclose that any portion of elongated members 18 or any other portion of tubular member 10 juts out from its tubular-shaped member to create a flange upon expansion of the tubular-shaped member.
9. Furst's graft is described as being used inside a body passageway to provide support and/or to open blocked passageways (Furst, col. 4, ll. 21-51).

PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987).

We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims “their broadest reasonable interpretation consistent with the specification” and “in light of the specification as

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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).

ANALYSIS

Claim Interpretation

We first construe the meaning of the claimed “flange” based on its ordinary and customary meaning and taking into account the description in the Specification and how one of ordinary skill in the art would interpret the term. The customary and ordinary meaning of “flange” is “[a] protruding rim, edge, rib, or collar, as on a wheel or a pipe shaft, used to strengthen an object, hold it in place, or attach it to another object” (Finding of Fact 1). The customary and ordinary meaning of “protrude,” as an intransitive verb, is “[t]o jut out; project” (Finding of Fact 2). As such, we interpret the claimed flange to mean a portion of the anastomosis device that juts out from the central region, as in a protruding rim, edge, rib, or collar, and is used to attach the device to another object. This definition is consistent with the use of the term flange in Appellants’ Specification, which consistently describes the flange as extending radially outwardly from the central connecting portion of the device (Finding of Fact 3).

Rejection of Claims 3, 11-14, 17, 20 and 21 under 35 U.S.C. § 102(e)

The Examiner found that Furst’s graft includes two flanges (Answer 4-5). The Examiner, however, failed to provide us with any interpretation of the term

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“flange” in keeping with its ordinary and customary meaning (Finding of Fact 4), and further failed to show where Furst’s graft includes any portion that juts out from its tubular-shaped member to create a protruding rim, edge, rib, or collar that is used to attach the graft to another object. Rather, the Examiner pointed to portions of Furst’s elongated members 18 that form the wall surface 16 of tubular member 10 as first and second flanges (Answer 5; Findings of Fact 5, 6). These portions of elongated members 18 are expanded during use from a first diameter to a second, expanded diameter (Finding of Fact 7). Furst, however, does not disclose that any portion of elongated members 18 or any other portion of tubular member 10 juts out from its tubular-shaped member to create a flange upon expansion of the tubular-shaped member 10 (Finding of Fact 8). Accordingly, Furst does not anticipate independent claim 11 because it does not disclose “a first flange connected to the distal end of said central region and deployable from a first position to an expanded position.” Likewise, Furst does not anticipate independent claim 20 because it does not disclose “a first flange deployable from a first position to an expanded position” or “a second flange proximal to said first flange and deployable to an expanded position.”

As such, we cannot sustain the Examiner’s rejection under 35 U.S.C. § 102(e) of claim 11 and its dependent claims 3, 12-14, and 17 and claim 20 and its dependent claim 21.

Rejection of Claims 18 and 19 under 35 U.S.C. § 103(a)

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Claims 18 and 19 depend from independent claim 11 and further recite the particular material of the claimed first flange. The Examiner failed to explain why one having ordinary skill in the art at the time the invention was made would have been led to modify the graft of Furst to add a flange. As we found *supra*, Furst does not disclose the claimed “first flange” (Finding of Fact 8). Similarly, we see no reason why one having ordinary skill in the art would have added a flange to a graft. Specifically, Furst’s graft is described as being used inside a body passageway to provide support and/or to open block passageways (Finding of Fact 9), and in such use, there would have been no reason to add a flange to the graft. As such, the Examiner has failed to set forth a prima facie case of obviousness of claims 18 and 19 and we cannot sustain the rejection of these claims.

NEW GROUNDS OF REJECTION

Rejection of claim 3 under 35 U.S.C. § 112, second paragraph

Claim 3 depends from independent claim 11 and recites, “wherein at least one of *said projection* is substantially trapezoidal” (emphasis added). Claim 11 does not contain any recitation of “a projection.” As such, the phrase “said projection” in claim 3 lacks proper antecedent basis. The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986) (citations omitted). We find that claim 3 is indefinite

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as it would be unclear to those skilled in the art what the Appellants meant by “said projection.” Accordingly, we enter a new ground of rejection of claim 3 under 35 U.S.C. § 112, second paragraph on the ground that the claim fails to particularly point out and distinctly claim the subject matter that the Appellants regard as their invention.

Rejection of claims 3, 11-13, and 17-19 under 35 U.S.C. § 112, first paragraph

Independent claim 11 and dependent claims 3, 12, 13, and 17-19 recite an anastomosis device requiring only a single flange. We reject these claims under 35 U.S.C. § 112, first paragraph, because the written description does not convey to those skilled in the art that, as of the filing date, the Appellants had possession of the claimed anastomosis device requiring only a single flange.

“The function of the description requirement [of the first paragraph of 35 U.S.C. 112] is to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him.” *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976) (citations omitted). “It is not necessary that the claimed subject matter be described identically, but the disclosure originally filed must convey to those skilled in the art that applicant had invented the subject matter later claimed.” *In re Wilder*, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 1209 (1985) (citing *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)). “To fulfill the written description requirement, the patent specification ‘must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is

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claimed.”” *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1479, 45 USPQ2d 1498, 1503 (Fed. Cir. 1998) (citing *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989)). “An applicant is entitled to claims as broad as the prior art and *his disclosure* will allow.” *In re Rasmussen*, 650 F.2d 1212, 1214, 211 USPQ 323, 326 (CCPA 1981) (emphasis added).

The Specification discloses only devices having first and second flanges on either end to trap the wall of the target vessel between the flanges so as to secure the graft vessel to the target vessel (Specification 8:22-24, 9:15-17, 10:4-5, 11:17-20, 11:23, 12:25-27, 13:2-4, 14:3-6, 15:26-27, 17:17-19, and 19:15-19) whereas claims 3, 11-13, and 17-19 do not limit the device to having two flanges. In particular, independent claim 11 is written in open-ended fashion using the transitional term “comprising” and recites only a first flange connected to the distal end of the central region, which means that claim 11 is broad enough to encompass a device having only a single flange. Similarly, dependent claims 3, 12, 13, and 17-19 do not add a limitation of a second flange. As such, these claims read on embodiments outside the scope of the written description. We fail to see why persons skilled in the art would recognize in the disclosure a description of the invention having only a single flange.

While a description of the invention which is narrower than the subject matter encompassed by the claims will not always result in a failure to fulfill the written description requirement of 35 U.S.C. § 112, first paragraph, *see Bilstad v. Wakalopoulos*, 386 F.3d 1116, 1124, 72 USPQ2d 1785, 1791 (Fed. Cir. 2004) (applying the general rule that disclosure of a species may be sufficient written

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description support for a later-claimed genus including that species); *see also In re Smythe*, 480 F.2d 1376, 1382, 178 USPQ 279, 284 (CCPA 1973), “the case law does ‘not compel the conclusion that a description of a species always constitutes a description of a genus of which it is a part’” either. *Gentry Gallery*, 134 F.3d at 1479, 45 USPQ2d at 1503 (quoting *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1568, 43 USPQ2d 1398, 1405 (Fed. Cir. 1997)); *see also In re Curtis*, 354 F.3d 1347, 69 USPQ2d 1274 (Fed. Cir. 2004); *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 993, 50 USPQ2d 1607, 1613 (Fed. Cir. 1999) (explaining that *Gentry Gallery* concerns “the situation where the patent's disclosure makes crystal clear that a particular (*i.e.*, narrow) understanding of a claim term is an ‘essential element of [the inventor's] invention’”); and *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 47 USPQ2d 1829 (Fed. Cir. 1998). “It is a truism that a claim need not be limited to a preferred embodiment. However, in a given case, the scope of the right to exclude may be limited by a narrow disclosure.” *Gentry Gallery*, 134 F.3d at 1479, 45 USPQ2d at 1503. Each case must be decided on its own facts. *In re Smythe*, 480 F.2d at 1382, 178 USPQ at 284.

On the facts before us, the Specification describes in every embodiment that the second flange is necessary to secure the graft vessel to the target vessel. If only a single flange were used, it is not clear how the graft vessel would be prevented from simply passing through the opening in the target vessel. As such, although the Appellants’ Specification does not explicitly disavow or disclaim an embodiment having a single flange, neither does the Specification present any alternative to a device having two flanges that would achieve the function of the

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anastomosis device to secure the graft vessel to the target vessel. Accordingly, we find that the second flange is an essential element of the Appellants' invention. In the balance of interests, i.e., the balance of the public interest to protect against overly broad claims and the Appellants' interest to obtain a patent based on the disclosed invention, we come down on the side of the public interest, because the Appellants' disclosure is narrow and the second flange is an essential element to the claimed anastomosis device. Accordingly, we enter this new ground of rejection of claims 3, 11-13, and 17-19 in an effort to prevent the Appellants from claiming more than what they described in their narrow disclosure to be their invention.

CONCLUSIONS OF LAW

We conclude that the Appellants have shown that the Examiner erred in rejecting claims 3, 11-14, 17, 20, and 21 under 35 U.S.C. § 102(e) as anticipated by Furst and erred in rejecting claims 18 and 19 under 35 U.S.C. § 103(a) as unpatentable over Furst.

We further conclude that claim 3 is indefinite for failing to particularly point out and distinctly claim the subject matter the Appellants regard as their invention, and the Specification lacks an adequate written description to support claims 3, 11-13, and 17-19.

DECISION

The decision of the Examiner to reject claims 3, 11-14, and 17-21 is reversed. We enter a new ground of rejection of claim 3 under 35 U.S.C. § 112, second paragraph and a new ground of rejection of claims 3, 11-13, and 17-19 under 35 U.S.C. § 112, first paragraph.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b) (2006). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

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REVERSED; § 41.50(b)

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