

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* GIL VARDI  
and CHARLES DAVIDSON

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Appeal 2008-0978  
Application 10/440,401  
Technology Center 3700

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Decided: March 21, 2008

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Before ERIC GRIMES, LORA M. GREEN,  
and RICHARD M. LEBOVITZ, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1, 3-9, and 18. We have jurisdiction under 35 U.S.C. § 6(b). Claim 1 is representative of the claims on appeal, and reads as follows:

1. A stent comprising a main body portion having a wall structure extending between first and second opposing ends, the wall structure having a plurality of cells including a side branch cell, the side branch cell having a shape that is different from any other cell when the stent is unexpanded.

The Examiner relies on the following references:

McDonald	US 5,676,697	Oct. 14, 1997
Imran	US 5,817,126	Oct. 6, 1998
Khosravi	EP 0621017 A1	Oct. 26, 1994

We affirm, but designate our affirmance as a new ground of rejection.

## DISCUSSION

Claims 1, 3-5, 7, 9, and 18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Khosravi. As Appellants do not argue the claims separately, they stand or fall together, and we focus our analysis on independent claim 1. 37 C.F.R. § 41.37(c)(1)(vii).

According to the Examiner:

Khosravi anticipates the claim language where main body portion as claimed is the flat sheet or membrane (10) of Khosravi, the wall structure as claimed is the body (15) combined with the buckle portion (20), the opposing ends as claimed are the left and right edges of the sheet, the cells as claimed are the apertures (33), and the side branch cell is the loop (30); see Figures 1 to 4 and column 7, line 35 to column 8, line 19.

(Ans. 3.)

The Examiner, in the response to arguments, also relies on Figures 12 and 13 as examples of stents that utilize teeth without a buckle (Ans. 5).

In order for a reference to anticipate a claim, every element and limitation of the claimed invention must be found in a single prior art

reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001).

Appellants argue that the stent of Figure 1 of Khosravi cannot be considered a side branch cell, because when it is rolled to form a stent, the buckle portion 20 “becomes part of the engagement mechanism that retains the shape of the ‘rolled stent.’” (App. Br.<sup>1</sup> 5.) While we agree as to Appellants’ argument regarding the embodiment of Khosravi shown in Figure 1, we find that Khosravi in Figure 13 teaches an embodiment that does anticipate the stent of claim 1.

Figure 13 of Khosravi is reproduced below:

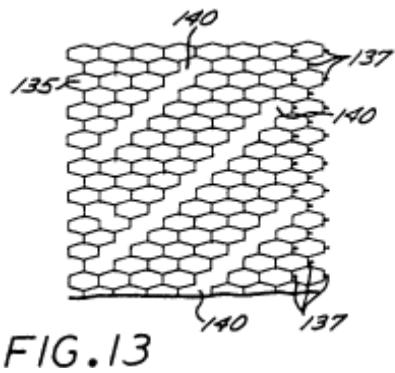


FIG. 13

Figure 13 of Khosravi shows an embodiment “using a reticulated, honeycomb-like structured sheet material having transversely-spaced gaps to allow increased flexibility.” (Khosravi col. 6, ll. 54-57.) In Figure 13, the “sheet . . . has a plurality of honeycomb-like cells 135 that end at the edge in two rows of interlocking teeth 137, with the addition of diagonally slanted gaps 140 to allow increased flexibility.” (*Id.* at col. 10, ll. 26-30.)

Thus, the sheet reads on the stent of claim 1 comprising a main body portion having a wall structure extending between first and second opposing

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<sup>1</sup> All references to the Appeal Brief (App. Br.) are to the Revised Brief on Appeal date stamped January 4, 2007.

ends, the honeycomb-like cells 135 read on the plurality of cells, and the center diagonally slanted gap 140 reads on a side branch cell that has a shape that is different from any other cell when the stent is unexpanded.

We thus affirm the rejection as to claim 1, and as claims 3-5, 7, 9, and 18 stand or fall with claim 1, we affirm the rejection as to those claims as well. But as our rationale differs from that of the Examiner, and in order to give Appellants a full and fair opportunity to respond, we designate our affirmation as a new ground of rejection.

Claims 1, 3-5, 7, and 9 stand rejected under 35 U.S.C. § 102(e) as being anticipated by McDonald.

According to the Examiner:

McDonald anticipates the claim language where main body portion as claimed is the graft prosthesis (110) of McDonald, the wall structure as claimed is the wall (112), the cells as claimed are the diamond shaped structures of the wall, and the side branch cell is opening (114); see Figures 2 and 6 to 8 as well as column 7, lines 5-21 and column 10, lines 29-65.

(Ans. 4.)

Appellants argue that McDonald does not disclose a stent having “wall structure having a plurality of cells,” as required by claim 1 (Reply Br. 7). McDonald, Appellants assert, teaches that the wall 112 is continuous and made of a woven Dacron fabric, and is thus not a “wall having a plurality of cells.” (*Id.*).

The Examiner relies on Figure 2 of McDonald, stating that the “wall structure as claimed is the wall (112),” and that the cells “are the diamond shaped structures of the wall.” (Ans. 4.) McDonald teaches, however, that

the wall 112 is “continuous” and “formed of a woven biocompatible Dacron fabric of a type employed in . . . flexible fabric grafts.” (McDonald, col. 7, ll. 5-9.) Thus, the disclosure of McDonald does not describe any structure that corresponds to the diamond shaped structures shown in wall 112 of Figure 2. Moreover, the Examiner has not provided any evidence that a woven biocompatible fabric such as that described by McDonald has cells as required by independent claim 1. Thus, the Examiner has not met the burden of setting forth a *prima facie* case of anticipation, and we are compelled to reverse the rejection.

Claims 6 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Khosravi as combined with Imran.

Khosravi is relied upon as above (Ans. 4). The Examiner notes that Khosravi “fails to disclose the dimensions of the stent as claimed.” (*Id.*)

Imran is relied upon for teaching that the dimensions required by claims 6 and 8 are “within those used to treat vascular lumens.” (*Id.*) Thus, according to the Examiner, “it would have been obvious to make the Khosravi stent within the claimed dimensional ranges for the same reasons that Imran teaches doing the same, that is, to adapt the device to a particular patient and vascular lumen.” (*Id.*)

Appellants do not dispute that Imran teaches stents having the dimensions required by claims 6 and 8. Appellants argue only that Imram does not remedy the deficiencies of Khosravi (App. Br. 6). Thus, we affirm this rejection for the same reasons set forth as to our affirmance of claims 1, 3-5, 7, 9, and 18 under 35 U.S.C. § 102(b) as being anticipated by Khosravi.

## CONCLUSION

In summary, we reverse the rejection of claims 1, 3-5, 7, and 9 stand rejected under 35 U.S.C. § 102(e) as being anticipated by McDonald.

We affirm, however, the rejection of claims 1, 3-5, 7, 9, and 18 under 35 U.S.C. § 102(b) as being anticipated by Khosravi; and the rejection of claims 6 and 8 under 35 U.S.C. § 103(a) as being obvious over the combination of Khosravi and Inman. As our rationale differs from that of the Examiner's, we designate the affirmance as new grounds of rejection.

## TIME PERIOD FOR RESPONSE

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 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 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground 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 . . . .

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

AFFIRMED; 37 C.F.R. § 41.50(b)

Ssc:

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