

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(2) is not binding precedent of the Board.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 GORAN LUKIC and EUGEN HOFMANN

Appeal No. 97-2551
Application 08/249,821¹

HEARD: JUNE 9, 1998

Before STAAB, McQUADE and CRAWFORD, Administrative Patent Judges.

CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 11-34. Claims 1-10 have been canceled. Appellant's claimed subject matter is self-

¹ Application for patent filed May 26, 1994.

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expanding endoprosthesis. Claim 11 is illustrated of the subject matter on appeal and recites:

11. A device for releasing a self-expanding endoprosthesis, the device comprising:

(a) an inner catheter,

(b) a first outer catheter slidably disposed at least partially about the inner catheter and having an inner surface; and

(c) a second outer catheter slidably disposed at least partially about the first outer catheter and having an inner surface;

wherein the inner surface of the first outer catheter is adapted to receive a first end portion of a self-expanding endoprosthesis and the inner surface of the second outer catheter is adapted to receive a second end portion of the endoprosthesis.

THE REFERENCE

The following reference is relied on by the examiner in support of the rejection under 35 USC § 102(b):

Garza et al. (Garza)	4,665,918	May 19,
1987		

THE REJECTION

Claims 11-34 stand rejected under 35 USC § 102(b) as being anticipated by Garza.

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Rather than reiterate the examiner's full statement of the above-noted rejection and the conflicting viewpoints advanced by the examiner and the appellants regarding the rejection, we make reference to the examiner's answer (Paper No. 22) for the examiner's complete reasoning in support of the rejection and the appellant's brief (Paper No. 21) for the appellant's arguments thereagainst.

OPINION

We have carefully reviewed appellants' invention as described in the specification, the appealed claims, the prior art reference applied by the examiner, and the respective positions advanced by the appellants and the examiner. As a consequence of our review, we have made the determinations that follow.

Garza discloses a device for releasing a self-expanding endoprosthesis 25. The device includes an inner catheter 18 and a first outer catheter 50, which is slidably disposed about the inner catheter. (Figures 1 and 6; Column 3, lines 51-53; Column 5, lines 37-38). Garza also discloses a second outer catheter 78 slidably disposed about the first outer catheter 50 (Figures 1 and 6; Column 4, lines 18-20;

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Column 5, lines 3-6). Each of the outer catheters (50, 78) has an inner surface. As the inner catheter 18 is slidably received in the first outer catheter 50 and the first outer catheter is slidably received in the second outer catheter 78, the inner surface of the first outer catheter 50 is capable of receiving a first end portion of the self-expanding endoprosthesis. Likewise, the inner surface of the second outer catheter 78 is capable of receiving a second end portion of the endoprosthesis.

Appellants argue that Garza does not disclose a second outer catheter. We simply do not agree and find that Garza clearly discloses a second outer catheter 78. Appellant also argues that the endoprosthesis are clearly shown configured within the single outer catheter 50. We are not persuaded by this argument because the law of anticipation does not require that the reference teach what the appellant is claiming, but only that the claims on appeal "read-on" something disclosed in the reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)). In our view, the device disclosed by Garza is capable of disposing the

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endoprosthesis within both the first outer catheter 50 and the second outer catheter 78 and as such is "adapted to receive a first end portion of a self-expanding endoprosthesis" as recited in claim 11.

Appellants further argue that the device of Garza is incapable of separately releasing respective ends of a prosthesis or recapturing a device in mid-release by moving a second outer catheter distally to its original position. We do not find this argument persuasive because it is not commensurate with the actual scope of claim 11 which does not recite that the respective ends of the prosthesis are separately released or that the device is recaptured in mid-release by moving a second outer catheter distally to its original position.

In view of the foregoing, we will sustain the examiner's rejection of claim 11. We will also sustain the examiner's rejection of claims 12-22, as the appellants indicate that these claims stand or fall together (Brief at page 3).

We will not, however, sustain this rejection as it relates to claim 23 because there is no disclosure in Garza of

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a self-expanding endoprosthesis having "a second end portion configured within and in contact with the curved inner surface of the second outer catheter." Rather, Garza discloses that outer catheter 78 covers catheter 50 and at no point is there disclosure that the outer catheter 78 is in contact with the prosthesis as required by claim 23. In view of the foregoing we will not sustain the examiner's rejection of claim 23, nor of claims 24-34 dependant therefrom.

The examiner's rejection of claims 11-22 is sustained. The examiner's rejection of claims 23-34 is not sustained.

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

AFFIRMED-IN-PART

LAWRENCE J. STAAB)
Administrative Patent Judge)
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) BOARD OF PATENT

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JOHN P. McQUADE)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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