

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RODNEY G. WOLFF and VINCENT W. HULL

Appeal No. 97-4258
Application No. 08/429,966¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, ABRAMS and STAAB, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed April 27, 1995. According to appellants, this application is a divisional of Application 08/171,361, filed December 21, 1993; which is a continuation-in-part of Application 07/815,560, filed December 27, 1991, now abandoned; which is a continuation of Application 07/486,580, filed February 28, 1990, now abandoned.

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This is an appeal from the decision of the examiner finally rejecting claims 14-18, 35 and 36. Claim 19 has been allowed, claims 1-13 and 20-34 have been canceled, and claims 37-45 have been withdrawn as being directed to a nonelected invention.

The appellants' invention is directed to a device for local intraluminal administration of drugs. The subject matter before us on appeal is illustrated by reference to claim 14, which has been reproduced in an appendix to the Appeal Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Pinchuk 1991	5,019,090	May 28,
Palmaz 1992	5,102,417	Apr. 7,

THE REJECTIONS

Claims 14-16, 18, 35 and 36 stand rejected under 35

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U.S.C.

§ 102(e) as being anticipated by Pinchuk.

Claims 14-16, 18, 35 and 36 alternatively stand rejected under 35 U.S.C. § 103 as being unpatentable over Pinchuk.

Claim 17 stands rejected under 35 U.S.C. § 103 as being unpatentable over Pinchuk in view of Palmaz.

The rejections are explained in the Examiner's Answer.

The arguments of the appellants are set forth in the Brief.

OPINION

The Rejection Under 35 U.S.C. § 102(e)

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of the claimed invention. See *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert. dismissed sub

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nom., Hazeltine Corp. v. RCA Corp., 468 U.S. 1228 (1984). A reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention. *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995), cert. denied, 116 S.Ct. 1362 (1996), quoting from *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962).

The appellants' invention is directed to a prosthesis for delivering drugs, such as those used to treat restenosis. As manifested in independent claim 14, the invention comprises a tubular body made up of a plurality of helical support elements wound in a helix configuration in opposing directions, "a flexible, polymeric filament attached to the support elements" so that at least a portion is exposed at an exterior surface of the body, and "a drug compounded into the polymeric filament such that the drug is delivered to the body lumen when the tubular body is radially expanded into contact

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with the portion of the body lumen to be treated.”

It is the examiner’s position that all of this structure is disclosed or taught by Pinchuk, and thus is anticipated by this reference. Specifically, the examiner finds the helix stent construction to be disclosed in lines 2-4 of column 7, and the drug location in lines 22-24 of that same column. The appellants dispute these findings.

Claim 14 requires that there be “a drug compounded into the polymeric filament” (emphasis added). In view of the explanation of the invention presented in the specification, we understand this to mean not that the drug is coated upon the exterior surface of the filament, but that it is impregnated in the polymeric material from which the filament is made (pages 12-15). No such teaching is present in Pinchuk. While this reference includes polymers in the list of materials from which the stent can be made, with regard to the incorporation of drugs therein its teaching is limited to coating (column 7, line 18) and the statement that “[t]he stents can be treated so that drugs can be eluted therefrom” (column 7, lines 22-23, emphasis added). No amplification of

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the term "treated" explicitly is provided, and we can find nothing in the reference from which to conclude that it encompasses compounding a drug "into" the filament.

It therefore is our conclusion that Pinchuk fails to disclose or teach all of the subject matter recited in claim 14, and thus cannot be considered to be anticipatory thereof.

The Section 102 rejection of independent claim 14, and of dependent claims 15, 16, 18, 35 and 36 therefore is not sustained.

The Section 103 Rejection

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness (see *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)), which is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)).

As we explained above, Pinchuk provides no explicit

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disclosure or teaching of compounding a drug into the filaments that form the structure of a helical stent. Considering the reference in the light of Section 103 does not alter this fact. While "treating" a filament with a drug might be considered after the fact to be broad enough to encompass compounding a drug into it, the reference nevertheless would not have suggested doing so to one of ordinary skill in the art. From our perspective, the only motivation for such is found in the hindsight afforded one who first viewed the appellants' disclosure. This, of course, is not permissible. *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

The rejection of claims 14-16, 18, 35 and 36 therefore cannot be sustained.

Nor is the rejection of claim 17 sustained, for the teachings of Palmaz, the secondary reference, fail to cure the deficiency in Pinchuk.

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SUMMARY

The Section 102 rejection is not sustained.

Neither of the Section 103 rejections is sustained.

The decision of the examiner is reversed.

REVERSED

HARRISON E. McCANDLISH, Senior))
Administrative Patent Judge))
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)	BOARD OF PATENT
NEAL E. ABRAMS))
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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LAWRENCE J. STAAB))
Administrative Patent Judge))

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