

## ALERT

## Federal Circuit Patent Bulletin: *TriVascular, Inc. v. Samuels*

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February 8, 2016

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On February 5, 2016, in *TriVascular, Inc. v. Samuels*, the U.S. Court of Appeals for the Federal Circuit (Moore, O'Malley,\* Wallach) affirmed the decision of the U.S. Patent & Trademark Office (PTO) Patent Trial and Appeal Board in an *inter partes* review that U.S. Patent No. 6,007,575, which related to intraluminal stents, was not invalid for obviousness. The Federal Circuit stated:

In construing claim terms, the Board must determine the scope of the claims by giving them their broadest reasonable construction in light of the specification as they would be interpreted by one of ordinary skill in the art. Under a broadest reasonable interpretation, words of the claim must be given their plain meaning, unless such meaning is inconsistent with the specification and prosecution history. While the broadest reasonable interpretation standard is broad, it does not give the Board an unfettered license to interpret the words in a claim without regard for the full claim language and the written description. Construing individual words of a claim without considering the context in which those words appear is simply not "reasonable." Instead, it is the "use of the words in the context of the written description and customarily by those of skill in the relevant art that accurately reflects both the 'ordinary' and 'customary' meaning of the terms in the claims." . . . We find the Board's reliance on the dictionary definition of ridge when considered in the context of the written description and plain language of the claims was proper.

TriVascular's other alleged basis of error was that the Board should have applied prosecution history disclaimer to prohibit a construction of "circumferential ridges" that is limited to continuous ridges. The same general tenets that apply to prosecution history estoppel apply to prosecution history disclaimer. Both doctrines require that the claims of a patent be interpreted in light of the proceedings in the PTO during the application process. As applied to a disclaimer analysis, "the prosecution history can often inform the meaning of the claim language by demonstrating how the inventor understood the invention." "Any explanation, elaboration, or qualification presented by the inventor during patent examination is relevant, for the role of claim construction is to 'capture the scope of the actual invention' that is disclosed, described, and patented." Accordingly, disclaimer "ensures that claims are interpreted by reference to those 'that have been

cancelled or rejected.” The party seeking to invoke prosecution history disclaimer bears the burden of proving the existence of a “clear and unmistakable” disclaimer that would have been evident to one skilled in the art.

TriVascular’s argument on prosecution history disclaimer proceeds in several steps. First, TriVascular notes that the examiner initially rejected the claims at issue by interpreting Samuels’851 as having “inflatable protrusions” that form a “circumferential ridge.” Second, TriVascular observes that Samuels responded to this rejection by (a) stating that Samuels’851 did not disclose “continuous” circumferential ridges and (b) introducing an “Amendment B” adding the word “continuously” to the claim phrase “at least one circumferential ridge continuously disposed about said inflatable cuff.” Third and finally, TriVascular notes that Samuels did not expressly include the term “continuous” in the final issued claims. TriVascular argues that this series of events triggers prosecution history disclaimer that bars Samuels from now arguing for a construction limited to “continuous” circumferential ridges, which was not claimed in the final issued claims.

The Board rejected TriVascular’s prosecution history disclaimer argument . . . . The Board found it significant that other amendments were made to the relevant claim, which apparently convinced the examiner of the patentability of the claimed invention over the prior art, without regard to the proposed addition of the word “continuously” to the claims. We find no error in the Board’s conclusion that Tri-Vascular has failed to meet its burden of demonstrating the existence of a “clear and unmistakable” disclaimer that would have been evident to one skilled in the art. Though Samuels offered the “continuously circumferential ridges” limitation as one of several possible bases for distinguishing the prior art, the Examiner never adopted Samuels’ proposed amendment as a reason for allowing the claims over the prior art. Since the Examiner ultimately allowed the claims over the prior art without the proposed amendment, it is difficult to see how a skilled artisan could interpret the proposed amendment as a disclaimer required for patentability. Indeed, Samuels offered several other amendments as possible bases for distinguishing the prior art . . . . Following the proposed amendment, Samuels and the Examiner engaged in an interview. Subsequently, Samuels submitted new claims “[i]n accordance with the Examiner’s instructions provided during [the] telephone interview,” and further noted that “the appropriate claims have been canceled to omit redundancy.” The examiner then allowed the final submitted claims to issue, over the prior art, without the “continuously circumferential ridges” limitation. During the IPR, the Board found that this subsequent prosecution history “shows that the positions of the Examiner and the patent applicant changed following a telephone interview,” regarding the allowability of the claims without the “continuously” limitation. We find no error in the Board’s finding that the examiner was convinced by these alternate claim amendments rather than the “continuously” circumferential ridges amendment. . . .

A patent is invalid “if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” Thus, a patent may be found invalid as obvious if “there are a finite number of identified, predictable solutions,[and] a person of ordinary skill has good reason to pursue the known options within his or her technical grasp.” Although the KSR test is flexible, the Board “must still be careful not to allow hindsight reconstruction of references. . . without any explanation as to how or why the references would be combined to produce the claimed invention.”

[A] key point of distinction between the '575 patent and the prior art is that the '575 patent teaches the use of inflatable, circumferential ridges that do not penetrate the vessel wall. TriVascular argues that the Board's conclusion on nonobviousness was erroneous because the Board improperly required the references to be physically "bodily incorporated" into each other, and because the Board ignored the state of the art and its predictability. TriVascular also argues that, contrary to the Board's findings, a skilled artisan would have been motivated to combine Samuels '851 and Todd by replacing the barbs of Samuels '851 with the gripping protuberances of Todd to obtain the desirable result of non-penetrating stent fixation. Thus, TriVascular argues, it would have been obvious for a skilled artisan to substitute the inflatable, penetrating barbs of Samuels '851 with the noninflatable, nonpenetrating protuberances of Todd. . . .

We find no error in the Board's rejection of TriVascular's argument that it would have been obvious to substitute the recessed barbs of Samuels '851 with the protuberances of Todd, since TriVascular's proposed substitution would destroy the basic objective of the barbs, which is to penetrate surrounding tissue. Moreover, in order to meet the claimed limitations, not only the barbs but also the underlying recesses in Samuels '851 would need to be replaced with inflatable non-penetrating protrusions. And, it would not have been obvious to substitute the inflatable barbed recesses with the non-penetrating protuberances of Todd because the protuberances taught in Todd were not inflatable, as recited in the asserted claims. Thus, the Board's findings regarding the lack of a motivation to combine are supported by substantial evidence.