

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL A. MASINI

Appeal 2007-4202
Application 10/685,620
Technology Center 1600

Decided: December 12, 2007

Before, DONALD E. ADAMS, DEMETRA J. MILLS, and
RICHARD M. LEBOVITZ, *Administrative Patent Judges*.

MILLS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134. The Examiner has rejected the claims for anticipation. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

Claims 1, 7, 9, and 17 are representative.

1. Bone-conserving orthopedic apparatus, comprising:
a cutting guide for performing a set of lateral and medial resections,
the cutting guide including:
first and second saw-receiving slots, each slot being associated with a
respective one of the lateral and medial resections, and wherein the

resections resulting from the use of the slots slope inwardly along different planes from a respective outer medial and lateral surface.

7. The orthopedic apparatus of claim 1, further including a prosthetic element having a set of bone-contacting surfaces corresponding to the resections.

9. Bone-conserving orthopedic apparatus, comprising:

a cutting guide for a resecting a pair of lateral and medial protrusions, each protrusion having a sidewall sloping toward a central valley region, the cutting guide including: first and second saw-receiving slots the first slot being substantially conformal to the sidewall of one of the protrusions, and the other slot being substantially conformal to the sidewall of the other protrusion, and wherein the resections resulting from the use of the slots do not lie in the same plane.

17. Orthopedic apparatus for use with a bone having a longitudinal axis, the apparatus comprising:

a cutting guide including a stem insertable into the bone in substantial alignment with the longitudinal axis; and

at least one saw-receiving slot on the cutting guide for resecting the bone along a plane which is not transverse to the longitudinal axis.

Cited References

Whiteside	U.S. 5,879,393	Mar. 9, 1999
Johnson	U.S. 5,980,526	Nov. 9, 1999

Grounds of Rejection

Claims 1-7, 9-15 and 17-23 stand rejected under 35 U.S.C. § 102(b) for anticipation over Johnson. (Answer 3.)

Claims 1-23 stand rejected under 35 U.S.C. § 102(b) for anticipation over Whiteside. (Answer 4.)

DISCUSSION

Background

Whether for primary or revision arthroplasty, cutting guides are typically employed to ensure that the bone saw performs resections corresponding to mating surfaces of the prosthetic component. For example, in a femoral knee replacement, cutting guides or blocks are temporarily secured to the distal end of the femoral shaft, and include slots into which the blade of an oscillating saw is inserted to shape the end of the bone in accordance with corresponding surfaces of the prosthetic element.

In the case of a revision, the procedure is usually more elaborate due to deterioration of the previously prepared surfaces resulting from decomposition of the bone/prosthesis interface, necrosis, and other factors. Cutting blocks are also typically used in revision procedures, though bone deficiency often renders stabilization of the block impossible. In addition, if the cutting block includes a stem, the positioning of the stemmed implant can alter the fit of the final prosthesis relative to the bone. More recently introduced techniques attempt to base the cuts on an intramedullary guide to which additional cutting blocks are mounted. Though such approaches improve bone cutting accuracy, there remains an unacceptable margin of error, the correction of which in some cases requiring a freehand shaping of the bone.

(Specification 1-2.)

According to the Specification, the claimed invention comprises an improved cutting guide to better assist a surgeon in preparing bone, for example, to receive an implant. (Specification 1.)

For reference purposes, the term “lateral” is defined as, “[i]n anatomy, the side of the body or a body part that is farther from the middle or center of

the body. Typically, lateral refers to the outer side of the body part, but it is also used to refer to the side of a body part. For example, when referring to the knee, lateral refers to the side of the knee farthest from the opposite knee. The opposite of lateral is medial.”¹ The term “medial” means “[p]ertaining to the middle; in or toward the middle; nearer the middle of the body. Medial is as opposed to lateral. For example, the medial side of the knee is the side closest to the other knee whereas the lateral side of the knee is the outside of the knee.”²

Anticipation I

Claims 1-7, 9-15 and 17-23 stand rejected under 35 U.S.C. § 102(b) as anticipated by Johnson.

The Examiner finds that Johnson teaches a cutting guide for performing a set of lateral and medial resections, the cutting guide including first and second saw-receiving slots 100, 110. (Answer 3.) The Examiner finds that the cutting guide comprises slots “associated with a respective one of lateral and medial resections” and that the guide is capable of resecting bone, “wherein the resections resulting from the use of the slots slope inwardly along different planes from a respective outer medial and lateral surface”³ as recited in claim 1 (Answer 3.) Thus, the Examiner concludes claim 1 is anticipated by Johnson’s disclosure.

¹ <http://www.medterms.com/script/main/art.asp?articlekey=6226>

² <http://www.medterms.com/script/main/art.asp?articlekey=9276>

We find that the Examiner has not provided sufficient evidence to support a *prima facie* case of anticipation. The standard under § 102 is one of strict identity. “Under 35 U.S.C. § 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim.” *Gechter v. Davidson*, 116 F.3d 1454, 1457 (Fed. Cir. 1997). “Every element of the claimed invention must be literally present, arranged as in the claim.” *Richardson v. Suzuki Motor Co., Ltd.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

Johnson describes an osteotomy device wherein “the drill guide … is configured to fit against the lateral surface of the tibia and capable of use with both right and left knees.” (Johnson, col. 3, ll. 13-16; see also Johnson, Fig. 7.) Thus, Johnson provides a cutting guide that can make lateral resections if positioned on the lateral side of the right or left knee. However, Johnson does not describe a cutting guide including “first and second saw-receiving slots, each slot being associated with a respective one of the lateral and medial resections.” *See* claim 1. In other words, the device of Johnson does not possess respective cutting guide slots that can make both lateral and medial resections.

In view of the above, the anticipation rejection over Johnson is reversed.

Anticipation II

Claims 1-23 stand rejected under 35 U.S.C. § 102(b) for anticipation over Whiteside.

Claim 1 requires:

-- first and second saw-receiving slots, each slot being associated with a respective one of the lateral and medial resections

--wherein the resections resulting from the use of the slots slope inwardly along different planes from a respective outer medial and lateral surface.

Thus the first and second saw receiving slots must slope inwardly along different planes from respective outer medial and lateral surfaces. An example of an apparatus in accordance with claim 1 is set forth in Figure 6B of Appellant's Specification and reproduced below. (Reply Br. 1.)

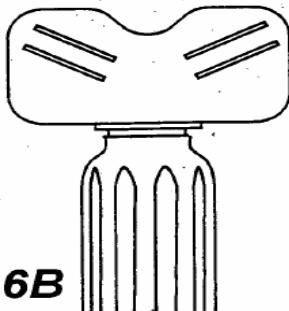


Figure 6B shows a cutting guide for performing lateral and medial resections provided with non-parallel slots. (Specification 8.)

The Examiner finds that

Whiteside et al teaches an orthopedic apparatus for use with a bone having a longitudinal axis, the apparatus comprising:

a cutting guide including a stem 60 insertable into the bone in substantial alignment with the longitudinal axis; and

at least one saw-receiving slot 36A on the cutting guide for resecting the bone along a plane which is not transverse to the longitudinal axis.

Regarding claim 1, see figure 1, wherein first and second slots, for example elements 35A and 35B, which wherein the apparatus can be tilted while cutting to form resections that slope inwardly.

(Answer 4.)

With respect to claim 1, we find that the Examiner has not provided sufficient evidence to support a prima facie case of anticipation. Figure 1 of Whiteside is reproduced below:

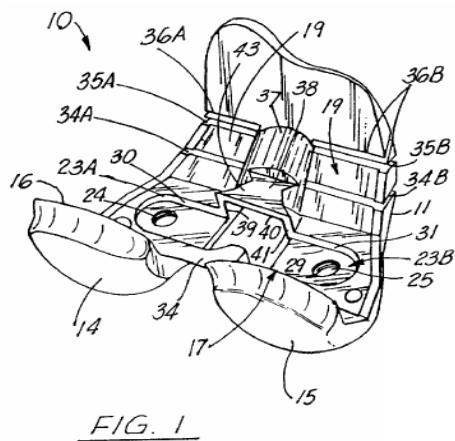


Figure 1 is a perspective view illustrating the trial prosthesis portion of Whiteside. (Whiteside, col. 2, ll. 40-42.) In particular, Whiteside discloses in Figure 1 a trial body with “cutting guide slots 34A, 35A, 36A and 34B, 35B, 36B.” (Whiteside, col. 4, ll. 11-13.) Whiteside describes that a “plurality of cutting guide slots extend from the proximal to the distal surface of the body and along medial and lateral lines. There are preferably three sets of cutting guide slots including distal cutting guide slots and anterior chamfer cutting guide slots.” (Whiteside, col. 2, ll. 1-5.)

Appellant argues with respect to claim 1, that “Appellant cannot figure out how the apparatus of Whiteside can be tilted when cutting” to perform resections that slope inwardly. (Br. 6.)

We agree with Appellants that Whiteside does not describe a cutting guide for performing lateral and medial resections including “slots [that] slope inwardly along different planes from a respective outer medial and lateral surface,” as claimed. While slots 36A and 36B of Whiteside Figure 1 prepare bone from the “medial or lateral distal surface” and slope inwardly, Whiteside fails to disclose multiple slots which slope inwardly along different planes from a respective outer medial and lateral surface.

In view of the above, the anticipation rejection over Whiteside is reversed.

CONCLUSION

The anticipation rejection over Johnson is reversed. The anticipation rejection over Whiteside is reversed.

REVERSED

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