

UNITED STATES PATENT AND TRADEMARK OFFICE

BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GREG KEENE

Appeal 2008-5315
Application 10/486,385¹
Technology Center 3700

Decided: October 10, 2008

Before CAROL A. SPIEGEL, ERIC GRIMES, and JEFFREY N.
FREDMAN, *Administrative Patent Judges*.

SPIEGEL, *Administrative Patent Judge*.

DECISION ON APPEAL

I. Statement of the Case

This is an appeal under 35 U.S.C. § 134 from a final rejection of all pending claims, claims 1-11. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

¹ Application 10/486,385 ("the 385 application"), *Tibial Resection Guide*, filed 5 November 2004, is the national stage filing under 35 U.S.C. § 371 of international application PCT/GB02/03542, filed 7 August 2002, which claims foreign priority to United Kingdom application 0119540.3, filed 10 August 2001. The real party in interest is said to be DePuy International, Ltd. (Appeal Brief refiled 06 April 2006 ("Br.") at 1).

The subject matter on appeal is directed to a tibial resection guide for preparing a knee joint for implantation of a prosthesis.

Claim 1, the sole independent claim, is illustrative and reads (Br. 6):

1. A tibial resection guide for use in preparing a knee joint for implantation of a prosthesis, which comprises:
 - a. an alignment rod which can be positioned against the tibia, which can be fastened to the tibia towards its distal end, and which has a proximal slot formed in it extending substantially parallel to the axis of the alignment rod,
 - b. a cutting block at the proximal end of the alignment rod having a saw guide slot in it to guide a saw during resection of the patient's tibia,
 - c. a guide pin configured to be fastened into the tibia, the proximal slot being configured to slidably fit over the guide pin, and the cutting block or the alignment rod towards its proximal end having fixation holes for receiving fixation pins, to fix the cutting block and the alignment rod against further movement relative to the guide pin.

The Examiner has rejected claims 1-11 as unpatentable under 35 U.S.C. § 102(b) over Matsuno² (Ans.³ 3).

Appellant argues Matsuno fails to disclose a guide pin as recited in claim 1 (Br. 4).

II. Findings of Fact ("FF")

The following findings of fact are supported by a preponderance of the evidence of record.

² U.S. Patent 6,090,114, *Tibial Plateau Resection Guide*, issued 18 July 2000, to Matsuno et al. ("Matsuno").

³ Examiner's Answer mailed 27 July 2007 ("Ans.").

A. Appellant's 385 application

- [1] The 385 specification ("Spec.") describes "a tibial resection guide in which the alignment rod has a proximal slot formed in it extending substantially parallel to the alignment rod axis, which is a sliding fit on a guide pin" (Spec. 1).
- [2] An embodiment depicted in Figure 1 of the 385 application is said to show, in relevant part (Spec. 5-7),

. . . a resection guide which includes an alignment rod 2 .

. .

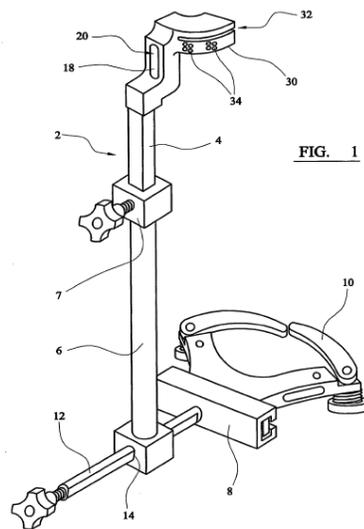
The alignment rod 2 has upper and lower parts 4, 6 which engage one another telescopically . . . to change the overall length of the alignment rod. The parts of the alignment rod can be locked against further movement by means of a screw-threaded clamp 7 . . .

The alignment rod has a cutting block 30 at its upper (proximal) end. The cutting block has a transverse saw guide slot 32 . . . The cutting block is fixed permanently at the top of the alignment rod. . .

The resection guide includes a bracket 8 for fastening the alignment rod at its distal end to the patient's leg. . . .

At its upper end, the alignment rod has a slot 20 formed in it, extending parallel to the axis of the rod. . . The resection guide includes a guide pin 18 which is a sliding fit in the slot. The pin can be drilled percutaneously into the tibia through the vertical slot 20 to stabilise the alignment rod. . . The combination of the bracket at the distal end and the pin in the slot at the proximal end serves to stabilize the alignment rod relative to the tibia while final adjustments are made to the position of the cutting block.

Figure 1 is reproduced below:



{Figure 1 of the 385 application shows an isometric view of the tibial alignment rod.}

- [3] Figure 2 shows the top of the alignment rod of Figure 1 with a stylus 40 fitted into the cutting block (Spec. 7). Guide pin 18 is visible in slot 20. Figure 2 is reproduced below.

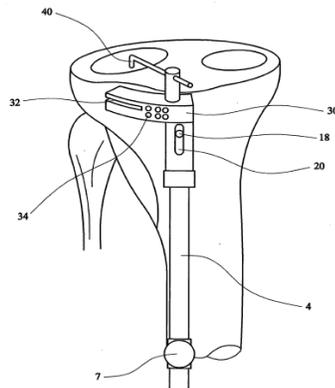


FIG. 2

{Figure 2 of the 385 application shows an isometric view of the top of the alignment rod with a stylus mounted on the cutting block.}

B. Matsuno

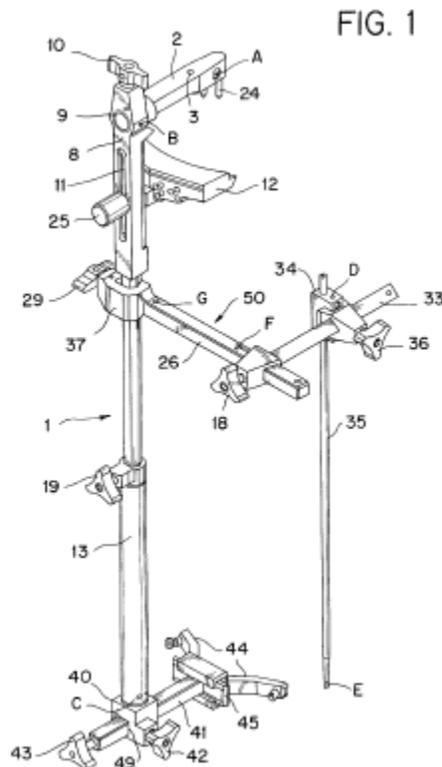
- [4] Matsuno discloses a tibial resection guide consisting of a first and second guide rod assembly (Matsuno 2:40-42, 55-59).

[5] Figure 1 illustrates an embodiment which shows, in relevant part,

. . .the first . . . guide assembly (1) is composed of four main elements: anchor block (2), support arm (8), cutting block (12), and frontal telescoping rod (13). In this embodiment, the securing pins (24) are affixed to the anchor block (2). The anchor block (2) is attached to the support arm (8). . . .

The anchor block (2) fits into the aperture (9) on the support arm (8) and [is] locked in place with a thumbscrew (10). The support arm (8) has an elongated aperture (11) in the approximant center of the support arm (8). A screw (25) fits through the elongated aperture (11) and allows for the tightening of the cutting block (12) against the support arm (8). This allows the cutting block (12) to be stabilized at an optimal position along the tibia . . . (Matsuno 4:64-5:26).

Figure 1 is reproduced below.



{Figure 1 of Matsuno is a perspective view of one embodiment of a tibial resection guide comprising first and second guide rod assemblies.}

[6] In addition, Matsuno discloses that the first guide assembly "may be secured to the tibia in various manners", e.g., it may be anchored through pins inserted through the cutting block (Matsuno 3:38-50).

Other findings of fact follow below.

III. Discussion

Since Appellant has not argued the separate patentability of any of claims 1-11 (Br. 3-5), we decide this appeal on the basis of claim 1. 37 C.F.R. § 41.37(c)(1)(vii).

A. The Examiner's findings

The Examiner found, in relevant part, that Matsuno discloses a tibial resection guide comprising an alignment rod, i.e., first guide assembly 1, with a proximal slot 11; a cutting block 12; and, a guide pin 25 configured to be fastened into the tibia, the proximal slot being configured to slidingly fit over the guide pin, as recited in claim 1 (Ans. 3). According to the Examiner, "**Configured to be fastened into the tibia** is a **functional statement**, which does not impose any structural limitations on the claims distinguishable over Matsuno . . . , which is capable of being used as claimed if one so desires to do so" (Ans. 5, original emphasis).

B. Appellant's position

According to Appellant, "guide pin 18 is configured to be fastened to the tibia through the vertical slot 20 of the alignment rod

so as 'to stabilize the alignment rod'. As a result, pin 18 would need to be of a length that will reach from slot 20 to the tibia into which it is attached" (Br. 3).

Appellant also notes the European Patent Office identified Matsuno as an "A" or background reference in a search connected with a related European patent application with similar claims which was issued without amendment as European Patent No. 1414355 (Br. 4-5).

C. Legal principles

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987). As set forth by the court in *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772 (Fed. Cir. 1983), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it." Moreover, a reference anticipates 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 LeGrice*, 301 F.2d 929, 936 (CCPA 1962).

D. Analysis

Here, we agree with the Examiner that there are no claimed structural limitations which distinguish the claimed tibial resection guide from that disclosed by Matsuno. There is no limitation regarding the length of the guide pin recited in claim 1. Indeed, the

length of a guide pin might well vary with the physical stature of the subject the tibial resection is being performed on. In addition, Matsuno teaches not only that corresponding guide pin, screw 25, not only allows for the tightening of the cutting block (12) against the support arm (8), thus allowing the cutting block to be stabilized at an optimal position along the tibia, but also that the first guide assembly rod (1) may be secured to the tibia through pins inserted in the cutting block (FF 5 and 6). Thus, Matsuno reasonably suggests screw (25) is capable of being configured to be fastened into the tibia. Therefore, Appellant's argument that the guide pin recited in claim 1 must be of a particular length which distinguishes it from screw (25) in Matsuno's tibial resection guide is neither persuasive of Examiner error nor commensurate in scope with the invention of claim 1.

Appellant's remaining argument is likewise unpersuasive of Examiner error. As noted by the Examiner (Ans. 5), the United States Patent and Trademark Office is not bound by the patentability determinations of foreign patent offices. Patentability criteria vary among different sovereign states. Moreover, as stated by Appellant, the claims issued in European Patent 1414355 are not identical to the claims on appeal. Therefore, the relevancy of those claims to the claims on appeal here is indeterminate based on the record before us.

In summary, we sustain the rejection of claims 1-11 as unpatentable under § 102(b) over Matsuno.

IV. Order

Upon consideration of the record, and for the reasons given, it is

Appeal 2008-5315
Application 10/486,385

ORDERED that the decision of the Examiner rejecting claims 1-11 as unpatentable under 35 U.S.C. § 102(b) over Matsuno is AFFIRMED, and

FURTHER ORDERED that 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

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