

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HERBERT RESCH, DAMON SERVIDIO
and PETER NUIJTEN

Appeal No. 2001-0515
Application 08/926,358

HEARD: MAY 9, 2001

Before CALVERT, Administrative Patent Judge, MCCANDLISH, Senior Administrative Patent Judge, and BAHR, Administrative Patent Judge.

MCCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1 and 3 through 8. No other claims are pending in the application.

Appellants' invention relates to a prosthetic glenoid component for a human shoulder joint. Claim 1, the only independent claim on appeal, defines the invention as follows:

1. A one piece prosthetic glenoid component, comprising an oval body¹ having a major axis extending along the largest diameter² of said oval body, said body having a concave laterally facing surface and an opposed medially facing surface³ with only a single keel extending from the medial [sic, medially facing] surface, said concave lateral [sic, laterally facing] surface being defined by one or more radii⁴, said keel lying in a medial-lateral plane⁵ parallel to and anteriorly⁶ offset from a medial-lateral plane containing said major axis of said oval body.

The following references are relied upon by the examiner as evidence of anticipation and obviousness in support of his rejections under 35 U.S.C. § 102(b) and

35 U.S.C. § 103:

Kinnett	4,550,450	Nov. 5, 1985
Worland	4,986,833	Jan. 22, 1991
Lippincott III et al. (Lippincott)	5,405,401	Apr. 11, 1995
Williamson et al. (Williamson)	5,800,551	Sep. 1, 1998
Rambert et al. (Rambert) (French Patent document)	2,579,454 ⁷	Oct. 3, 1986

The grounds of rejection are as follows:

¹ When read in light of appellants' specification, we interpret the recitation of an "oval body" to mean that the perimeter of the body has an oval configuration.

² The recitation of the "largest diameter" is understood to mean the largest dimension of the oval defined by the perimeter of the body.

³ The claimed "laterally facing surface" and "medially facing surface" are understood to relate to anatomical terms of the human body. For explaining these terms, appellants have attached to their main brief a copy of a page from an unidentified text on the human anatomy. This page from this text illustrates figures of the human body and identifies various anatomical terms, including the terms "medial", "lateral", "anterior", "posterior", "sagittal plane" and "frontal plane" (also referred to as the "coronal plane"). As we understand the claim language, all recitations of anatomical terms in claim 1 are with reference to the implanted orientation of the glenoid component in the human body. In the event of further prosecution, appellants should identify this anatomical text.

⁴ This limitation is understood to refer to the radii of curvature of the concave laterally facing surface.

⁵ Based on the illustrations in the page of the anatomical text referred to in note 3 supra, the "medial direction" and the "lateral direction" are perpendicular to the sagittal plane. Therefore, "a medial-lateral plane" (which may be vertical or horizontal) is understood to perpendicularly intersect the sagittal plane.

⁶ This anatomical term is identified in the page of the anatomical text referred to in note 3 supra.

⁷ An English translation of this French document is attached to this decision.

1. Claims 1, 6 and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lippincott.

2. Claims 1 and 4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Rambert.

3. Claims 1, 3, 4 and 6 through 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Worland in view of Kinnett.

4. Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Worland in view of Kinnett and Williamson.

Reference is made to the examiner's answer (Paper No. 24) for a discussion of the foregoing rejections.

To the extent that the language of claim 1 is understandable, we cannot sustain either of the examiner's § 102(b) rejections.⁸

With regard to the § 102(b) rejection of claims 1, 6 and 7 based on Lippincott, this reference discloses a pair of components making up a joint prosthesis for replacing a joint in a finger of a human hand. On the other hand, a "glenoid component," as recited in the preamble of claim 1, is a term of art (see, for example column 2, lines 6-19, of the cited Kinnett patent) and refers to a prosthetic replacement for the glenoid cavity in the upper part of the human scapula. The examiner dismisses this difference as being a statement of intended use.

Appellants argue on page 2 of the reply brief that the preamble of claim

⁸ See our new ground of rejection under 35 U.S.C. § 112, second paragraph, as set forth infra.

1 gives “life and meaning” to the claim and therefore constitutes a positive limitation that must be considered in determining the patentability of the claimed subject matter.

The test for determining whether or not the preamble of a claim may be deemed to be a limitation of the claim is whether the preamble gives “life and meaning” to the claim. See, Corning Glass Works v. Sumitomo Elec. U.S.A. Inc., 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989). See also In re Paulsen, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994) (Terms appearing in a preamble may be deemed limitations of a claim when they give meaning to the claim and properly define the invention.).

In the present case, the preambular recitation of the prosthetic glenoid component in claim 1 imports into the claim that the laterally facing concave surface is capable of receiving and articulating the humerus. Lippincott’s prosthetic component obviously lacks such a capability. We, therefore, agree with appellants that the preamble of appealed claim 1 gives “life and meaning” to the claim and thus provides a limitation that cannot be dismissed as a statement of intended use. For this reason alone, we cannot agree that claims 1, 6 and 7 are anticipated by Lippincott since the absence from the reference of any element of a claim negates anticipation of that claim by the reference. See Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986), cert. denied, 479 U.S. 1034 (1987).

With regard to the § 102(b) rejection of claims 1 and 4 based on Rambert, we agree with the examiner that the projection 21 shown in Figure 1 of the Rambert reference resembles a keel. However, Rambert discloses that the glenoid component has two of those projections, not one. See page 13 of the accompanying translation of the Rambert

specification. Since claim 1 is limited to a single keel, the subject matter of claim 1 and, hence, claim 4 is not anticipated by Rambert.

With regard to the § 103 rejection of claims 1, 3, 4 and 6-8 and the § 103 rejection of claim 5, it is not possible to apply the prior art to these claims without resorting to speculation and conjecture as to the meaning of certain language in claim 1. Accordingly, we are constrained to reverse the § 103 rejections of claims 1, 3 and 4-8 in light of the holding in In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962).

Under the provisions of 37 CFR § 1.196(b), the following new grounds of rejection are entered against claims 1 and 3 through 8:

1. Claims 1 and 3 through 8 are rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite for hence failing to particularly point out and distinctly claim the subject matter which appellants regard as their invention.

2. Claims 1 and 3 through 8 are rejected under the first paragraph of 35 U.S.C. § 112 as being based on a specification which, as filed, does not satisfy the description requirement in that paragraph.

3. Dependent claim 3 is rejected under the fourth paragraph of 35 U.S.C. § 112 as failing to further limit parent claim 1.

With regard to our new rejection of the appealed claims under the second paragraph of § 112, it is established patent law that the claims must define the metes and bounds of the invention with a reasonable degree of precision. In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976). Moreover, the question of compliance with

the second paragraph of § 112 requires a determination of whether those skilled in the art would understand what is claimed when the claim is read in light of the specification. See Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986) and cases cited therein.

In the present case, our difficulty with the language in claim 1 centers on the recitation that the keel lies “in a medial-lateral plane” (emphasis added). A three dimensional object, such as appellants’ keel, cannot be said to lie “in” a plane because, by definition (see Webster’s Third New International Dictionary (G. & C. Merriam Company, 1971)), a plane is nothing more than a dimensionless imaginary planar surface. It is not clear how appellants’ three dimensional keel can lie in such an imaginary surface.

Appellants’ specification, as filed, is of no avail for interpreting the recitation that the keel lies in a medial-lateral plane. The specification does not describe the keel as lying in or even along any plane, let alone a medial-lateral plane. Furthermore, this claim limitation cannot be interpreted as meaning that the keel lies along a medial-lateral plane because the keel is tapered as shown in Figures 1 and 4 of appellants’ drawings (see page 10 of the specification) to lie along a plane that intersects a medial-lateral plane at an acute angle, as we have interpreted the term “medial-lateral plane” in note 5 supra. There also is no basis in the specification as filed for interpreting this claim limitation to mean that the keel is somehow symmetrical about a medial lateral plane. If in some way this claim limitation were interpreted to mean that the keel lies along a medial-lateral plane, then the subject matter of claim 1 would read on the Kinnett patent because the anterior face of Kinnett’s keel 27 lies along a medial-

lateral plane that is parallel to and anteriorly offset from a medial lateral plane containing the major axis of Kinnett's oval body 24.

In the final analysis, we can conceive of no understandable interpretation of the recitation that the keel lies in a medial-lateral plane to establish the metes and bounds of the claimed subject matter. At best, this limitation is inaccurate. Claim 1 and, hence, dependent claims 3-8 therefore fail to satisfy the requirements of § 112, second paragraph, because it cannot be said that an inaccurate claim particularly points out and distinctly claims the subject matter which appellants regard as their invention. Compare In re Knowlton, 481 F.2d 1357, 1366, 178 USPQ 486, 492 (CCPA 1973) (claims in an application must accurately define the invention).

With regard to our new ground of rejection under the first paragraph of § 112, the test for determining compliance with the written description requirement in that paragraph is whether the disclosure in appellants' application as originally filed reasonably conveys to the artisan that appellants had possession at that time of the subject matter now claimed. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The content of the original specification, including the original claims, and the original drawings may be considered in determining compliance with the descriptive requirement. Id.

In the present case, neither the original specification nor the original drawings provide the requisite descriptive support for the recitation in claim 1 that the keel lies in a medial-lateral plane, particularly a medial-lateral plane that is parallel to and anteriorly offset from a medial-lateral plane containing the major axis of the oval body. There also is no descriptive support in the original specification for the recitation that the major axis (which is

recited to extend along the largest diameter of the oval body) lies in a medial-lateral plane. With regard to this latter claim limitation, the original drawings are inconclusive, particularly in view of their sketchy nature.

With regard to the new ground of rejection of claim 3 under the fourth paragraph of § 112, claim 3 recites that the body is “substantially oval.” As such, claim 3 has the effect of broadening parent claim 1, rather than further limiting claim 1 as required in the fourth paragraph of § 112.

The examiner’s decision to reject claims 1, 6 and 7 under § 102(b) as anticipated by Lippincott is reversed, the examiner’s decision to reject claims 1 and 4 under § 102(b) as anticipated by Rambert is reversed, the examiner’s decision to reject claims 1, 3, 4 and 6-8 under § 103 as unpatentable over Worland in view of Kinnett is reversed and the examiner’s decision to reject claim 5 under § 103 as unpatentable over Worland, Kinnett and Williamson is reversed. In addition, new grounds of rejection of claims 1 and 3-8 have been introduced pursuant to 37 CFR § 1.196(b).

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, “A new ground of rejection shall not be considered final for purposes of judicial review.”

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with

respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

REVERSED
37 CFR § 1.196(b)

Ian A. Calvert)
Administrative Patent Judge)
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Administrative Patent Judge) APPEALS AND
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Appeal No. 2001-0515
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