

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 24

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte JACQUES-PHILLIPPE LABOUREAU  
and  
BERNARD BRULEZ

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Appeal No. 2004-1442  
Application No. 09/308,548

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ON BRIEF

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Before ABRAMS, McQUADE, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 28 to 36. Claims 14 to 27, which are all of the other claims pending in this application, have been withdrawn from consideration.

We REVERSE.

BACKGROUND

The appellants' invention relates to a left or right-oriented prosthetic ligament to replace a biological joint ligament, and to several methods for making such pre-oriented ligaments; these left-zyratory or right-zyratory ligaments can be especially used in knee plasty to replace anterior or posterior cruciate ligaments whether for left or right knee joints (specification, p. 1). A copy of the dependent claims under appeal is set forth in the appendix to the appellants' brief. Claim 28, the only independent claim on appeal, reads as follows:

A method for producing a prosthetic ligament to replace a natural joint ligament, said method comprising:  
first applying a predetermined torsion individually to each of a plurality of strands,  
thereafter forming a bundle of said strands aligned in a parallel lengthwise relationship, each strand having a median part and first and second end parts,  
securing said strands to each other at said respective first and second end parts to form first and second end sections of said bundle, said first and second end sections forming respective end members of said prosthetic ligament, and having sufficient length to be embedded in bone insertion tunnels of a joint, and  
leaving said median parts of said strands unattached to collectively form a middle section of said bundle, said middle section of said bundle comprising a central member of said prosthetic ligament approximating a length of an intra-articular portion of a natural ligament.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hlavacek et al. (Hlavacek)	4,792,336	Dec. 20, 1988
Li et al. (Li)	5,263,984	Nov. 23, 1993

Laboureau (Laboureau '710)	EP 0 561 710 A1	Sept. 22, 1993
Laboureau (Laboureau '151) <sup>1</sup>	FR 2 697 151	Apr. 29, 1994

Claims 28 to 31 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hlavacek.

Claims 28, 29 and 34 to 36 stand rejected under 35 U.S.C. § 103 as being unpatentable over Li in view of Hlavacek.

Claims 28, 30 and 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Laboureau '710 in view of Hlavacek.

Claim 33 stands rejected under 35 U.S.C. § 103 as being unpatentable over Laboureau '151 in view of Hlavacek.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 18, mailed January 13, 2003) for the examiner's complete reasoning in

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<sup>1</sup> In determining the teachings of Laboureau '710 and Laboureau '151, we will rely on the translations of record provided by the USPTO.

support of the rejections, and to the brief (Paper No. 17, filed September 26, 2002) and reply brief (Paper No. 19, filed March 17, 2003) for the appellants' arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

#### **The anticipation rejection**

We will not sustain the rejection of claims 28 to 31 under 35 U.S.C. § 102(b) as being anticipated by Hlavacek.

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, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman

v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), 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."

In this case, the last element of claim 28 (i.e., "leaving said median parts of said strands unattached to collectively form a middle section of said bundle, said middle section of said bundle comprising a central member of said prosthetic ligament approximating a length of an intra-articular portion of a natural ligament") is not readable on Hlavacek for the reasons set forth in the brief (p. 10) and reply brief (pp. 2-3). As shown in Figures 1- 2 of Hlavacek, the elongated textile structure 1 comprises a flat braid having primarily axial (quoit) yarns 2 and sleeve/carrier yarns 5, which are given a nominal 1.4 turn per inch twist before further processing to facilitate handling and to minimize fiber breakage. Swivel end cap(s) 3 and surgical needle(s) 4 may be attached at the end(s) of the elongated textile structure 1 to facilitate placement and attachment. As such, Hlavacek's primarily axial (quoit) yarns 2 are attached together at their median parts by the sleeve/carrier yarns 5. Therefore, Hlavacek's primarily axial (quoit) yarns 2 lacks the last element of claim 28.

For the reasons set forth above, the decision of the examiner to reject claim 28, and claims 29 to 31 dependent thereon, under 35 U.S.C. § 102(b) as being anticipated by Hlavacek is reversed.

### **The obviousness rejections**

We will not sustain the rejection of claims 28, 29 and 34 to 36 under 35 U.S.C. § 103 as being unpatentable over Li in view of Hlavacek. We will not sustain the rejection of claims 28, 30 and 32 under 35 U.S.C. § 103 as being unpatentable over Laboureau '710 in view of Hlavacek. We will not sustain the rejection of claim 33 under 35 U.S.C. § 103 as being unpatentable over Laboureau '151 in view of Hlavacek.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

As acknowledged by the examiner (answer, pp. 4-6), the primary references to Li, Laboureau '710 and Laboureau '151 do not disclose imparting a predetermined torsion to individual strands prior to forming the bundle. To account for this deficiency, the examiner relies on Hlavacek.

After reviewing the teachings of Li, Laboureau '710, Laboureau '151 and Hlavacek, we found no reason, absent the use of impermissible hindsight,<sup>2</sup> for a person of ordinary skill in the art at the time the invention was made to have modified the individual strands of either Li, Laboureau '710 or Laboureau '151 by imparting thereto a predetermined torsion to the individual strands prior to forming the bundle of strands. While Hlavacek's sleeve/carrier yarns 5 are given a twist before further processing to facilitate handling and to minimize fiber breakage, such teaching provides no suggestion or motivation to have modified the individual axial strands of either Li, Laboureau '710 or Laboureau '151.

For the reasons set forth above, the decision of the examiner to reject claims 28, 29 and 34 to 36 under 35 U.S.C. § 103 as being unpatentable over Li in view of Hlavacek is reversed; the decision of the examiner to reject claims 28, 30 and 32 under 35 U.S.C. § 103 as being unpatentable over Laboureau '710 in view of Hlavacek is reversed; and the decision of the examiner to reject claim 33 under 35 U.S.C. § 103 as being unpatentable over Laboureau '151 in view of Hlavacek is reversed.

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<sup>2</sup> The use of hindsight knowledge derived from the appellants' own disclosure to support an obviousness rejection under 35 U.S.C. § 103 is impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

CONCLUSION

To summarize, the decision of the examiner to reject claims 28 to 31 under 35 U.S.C. § 102(b) as being anticipated by Hlavacek is reversed; the decision of the examiner to reject claims 28, 29 and 34 to 36 under 35 U.S.C. § 103 as being unpatentable over Li in view of Hlavacek is reversed; the decision of the examiner to reject claims 28, 30 and 32 under 35 U.S.C. § 103 as being unpatentable over Laboureau '710 in view of Hlavacek is reversed; and the decision of the examiner to reject claim 33 under 35 U.S.C. § 103 as being unpatentable over Laboureau '151 in view of Hlavacek is reversed.

REVERSED

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
JOHN P. McQUADE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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