

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STANLEY L. KAMPNER

Appeal No. 95-1840
Application 07/897,197¹

ON BRIEF

MAILED

AUG 25 1995

**PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Before STONER, *Vice Chief, Administrative Patent Judge*, and COHEN and ABRAMS, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1 through 7 and 15 through 24. Claims 8 through 14 and 25 through 30 have been withdrawn from consideration as being directed to a non-elected invention. No claims have been allowed.

¹ Application for patent filed June 11, 1992. According to applicant, the application is a continuation-in-part of Application 07/850,891, filed February 12, 1992.

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The appellant's invention is directed to an anchor for a bone joint implant and to an implant for a bone joint. The subject matter before us on appeal is illustrated by reference to claim 1, which reads as follows:

1. An anchor for a bone joint implant adapted to be inserted in a cavity defined by a bone and having a given cross section for affixing the implant to the bone without substantial motion of the implant relative to the bone after affixation, the anchor comprising:

a nonresorbable core sized for insertion in the cavity and having a cross section sufficiently smaller than the cross section of the cavity so that contact between the bone and the core is prevented; and

a resorbable sleeve applied to the core and having a size so that it tightly engages the cavity in the bone to thereby immovably secure the anchor to the bone.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Blanquaert	4,495,664	Jan. 29, 1985
Langlais	4,950,300	Aug. 21, 1990
Osborn et al. (Osborn)	WO 90/09154	Aug. 23, 1990

THE REJECTIONS

Claims 3, 6 and 7 stand rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 1, 3, 6, 7, 15, 16, 19 and 24 stand rejected under 35 USC §102(b) as being anticipated by Osborn or, in the

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alternative, under 35 USC §103 as being unpatentable over Osborn.

Claims 2 and 18 stand rejected under 35 USC §103 as being unpatentable over Osborn in view of Blanquaert.

Claims 4, 5 and 17 stand rejected under 35 USC §103 as being unpatentable over Osborn.

Claims 20 through 23 stand rejected under 35 USC §103 as being unpatentable over Osborn in view of Langlais.

The rejections are explained in the Examiner's Answer.

The opposing viewpoints of the appellant are set forth in the Brief and the Reply Brief.

OPINION

The appellant's invention is professed to solve a number of problems that present themselves in the affixation of implants for the prosthetic replacement of joints, among which is abnormal stress transference from the implant to the joint. The inventive implant comprises an anchor including a stem having a nonresorbable core surrounded by a layer of resorbable material. When tightly installed in a cavity in the bone, the stem supports the load bearing part of the prosthesis. In the system disclosed by the appellant, over time the resorbable layer slowly degrades and ultimately disappears, resulting in the core remaining in the cavity, nonfunctional and not impeding the normal stress transfer through the joint. Thus, the stem and its surrounding layer

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support the implant during the initial period after installation, and when they no longer are needed they assume a passive role. See specification, pages 5 and 6.

A threshold issue is the matter of the rejection of three claims under 35 USC §112, second paragraph. The first of these concerns claim 3, which the examiner rejects on the basis that it "lacks clear antecedence from the specification" (Answer, page 3). We agree with the appellant that one of ordinary skill in the art would have no trouble understanding the meaning of this claim, even though the exact terminology utilized might not appear in the specification. The same conclusion is reached with regard to claim 7.

As for claim 6, wherein the rejection is predicated upon the examiner's belief that double inclusion of materials is improper, we reflect first upon the court's statement in *In re Kelly*, 305 F.2d 909, 134 USPQ 397 (CCPA 1967):

Automatic reliance upon a "rule against double inclusion" will lead to as many unreasonable interpretations as will reliance upon a "rule allowing double inclusion". The governing consideration is not double inclusion, but rather what is a reasonable construction of the language of the claims.

We view the governing issue here as not whether some of the terms are inclusive of others and thus might be considered overlapping or duplicative, but whether one of ordinary skill in the art would know with reasonable certainty the subject matter

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encompassed by the claim which, after all, is the purpose of the second paragraph of Section 112. It is our view that the artisan would have no trouble determining the metes and bounds of claim 6 even in the face of the alleged duplication, and therefore we decline to sustain this rejection.

We focus now upon the prior art rejections.

Claim 1 is directed to an anchor "for a bone joint implant adapted to be inserted into a cavity defined by a bone..." (emphasis added). The anchor comprises

a nonresorbable core sized for insertion in the cavity and having a cross section sufficiently smaller than the cross section of the cavity so that contact between the bone and the core is prevented; and

a resorbable sleeve applied to the core and having a size so that it tightly engages the cavity in the bone to thereby secure the anchor to the bone.

At the outset, it is important to recognize that this claim is directed to an anchor and not to the combination of an anchor and the bone within which it is installed.

Claim 1 first stands rejected as being anticipated by Osborn. Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440,

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221 USPQ 385 (Fed. Cir. 1984). The law of anticipation does not require that the reference teach what the applicant is claiming, but only that the claim on appeal "read on" something disclosed in the reference, *i.e.*, all limitations of the claim are found in the reference. See *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983).

Osborn discloses a femoral prosthesis comprising an anchor for a bone joint implant having a nonresorbable core and a resorbable sleeve applied to the core. Thus, Osborn discloses both of the structural elements recited in claim 1. Moreover, the Osborn device is adapted to be inserted into a cavity in the host bone in such a manner as stabilize the implant, the resorbable sleeve initially being of such size as to tightly engage the cavity (pages 2 and 3). There is some language in claim 1 that does not find correspondence in the teachings of Osborn, but this resides in the manner in which the Osborn device is used rather than the structure of the anchor. Osborn desires eventually to have bone fill the void left by the resorbable material, while in the appellant's method the core remains spaced from the bone when the resorbable material disappears.

However, it is well settled that the manner or method in which a device is to be used is not germane to the issue of the patentability of the device itself. See *In re Casey*, 370

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F.2d 576, 152 USPQ 235 (CCPA 1967), and *In re Otto*, 312 F.2d 937, 136 USPQ 458 (CCPA 1963). This being the case, we find ourselves in agreement with the examiner that the structure recited in claim 1 is anticipated by that disclosed by Osborn, even though the manner in which it is proposed to interact with the cavity in the host bone differs. Insofar as the anchor itself is concerned, apart from the bone and the cavity into which it is contemplated that the anchor will be installed, all of the structure recited in claim 1 reads on the Osborn device. From our perspective, the proper sizing of the Osborn device with respect to the dimension of the cavity would cause it to operate in the same manner as the appellant's device. However, as we stated above, this relates to the method of use, and not to the subject matter of this apparatus claim.

The same rationale applies to claim 15, which is directed to an "implant for a bone joint" (emphasis added). Again, the only differences we perceive between the claim language and the Osborn device regard the manner in which the device is to be related to the bone cavity when it is installed, and not to the structure of the implant itself, apart from the bone, as it is claimed.

The rejection of independent claims 1 and 15 as being anticipated by Osborn is sustained.

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Since the appellant has chosen not to challenge with any reasonable specificity before this Board the rejection of dependent claims 3, 6, 7, 16, 19 and 24, they are grouped with the independent claim from which they depend, and fall therewith. See *In re Nielson*, 816 F.2d 1567, 2 USPQ2d 1525, (Fed. Cir. 1987).

Anticipation being the epitome of obviousness, the alternative rejection of claims 1, 3, 6, 7, 15, 16, 19 and 24 under 35 USC §103 also is sustained. See *In re Fracalossi*, 681 F.2d 792, 215 USPQ 569 (CCPA 1982).

✓ We pause here to note that the appellant has argued separately the rejection of claim 24 with regard to the Section 103 rejection, although he did not do so with regard to that same claim *vis-a-vis* the Section 102 rejection. For the record, we wish to direct attention to pages 2 and 3 of Osborn, wherein the outer layer is described as a sleeve or sheath surrounding the stem, which may be preformed to be fitted around the stem of the prosthesis, as desired. It is our view that one of ordinary skill in the art would have found suggestion in this description, taken in the context of the remainder of the Osborn disclosure, for utilizing sleeves of such configuration as necessary to be accommodated in the bone cavity into which the device is being installed, and that they be removable from the stem.

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Several rejections under 35 USC §103 have been levied against the remaining claims. In rejecting claims under 35 USC §103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. See *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). A *prima facie* case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976). If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). This is not to say, however, that the claimed invention must expressly be suggested in any one or all of the references. Rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985); *In re Kaslow*, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983); *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Claims 2 and 18 stand rejected under 35 USC §103 as being unpatentable over Osborn in view of Blanquaert, the latter

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being cited by the examiner for the teaching of utilizing a core of quadrilateral cross section. We agree with the appellant, however, that the cross section disclosed by Blanquaert is not quadrilateral, but a series of curved segments. Thus, the required *prima facie* case of obviousness is not established by the combined teachings of these two references, and we will not sustain the rejection of claims 2 and 18.

No challenge having been raised to the examiner's rejection of claims 4, 5 and 17 as being unpatentable over Osborn apart from the claims from which they depend, this rejection is sustained.

Claims 20 through 23 stand rejected under 35 USC §103 as being unpatentable over Osborn in view of Langlais. Osborn teaches that it was known at the time of the appellant's invention to replace the neck and head of a patient's femur with a prosthesis comprising a stem, and upper body part, and a neck extending from the upper body part and adapted to fit into a cup prosthesis mounted in the patient's acetabular cavity. Osborn further points out that the prosthesis is held in place by ingrowth of bone onto the stem and the upper body part. See page 1. The upper body part corresponds to the "interface" recited in claim 15, for it is located between the operative component and the stem.

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Claim 20 adds to claim 15 the requirement that the operative component comprise a convex surface adapted to cooperate with a concave surface of another joint member, and claim 21 adds to this that it be a ball joint member. The Osborn reference, while it describes a neck portion being received in a cup of another joint member, does not illustrate such an arrangement. However, Langlais clearly shows a neck portion component comprising a ball 2 of convex shape, which one of ordinary skill in the art would, in our view, recognize is to be received in a concave surface of the cooperating joint member.

We therefore are of the opinion that the teachings of these two references establish a *prima facie* case of obviousness with respect to the subject matter of claims 20 and 21, and we will sustain this rejection.

Claim 22 states that the structure of claim 21 further includes a body connected with the ball and defining the interface. This corresponds to the upper body part of Osborn into which the recipient's bone grows, and therefore we will sustain the rejection of this claim also.

The additional limitation added by claim 23 is that the ball is detachably secured to the body. The appellant has pointed out in his specification that this arrangement has the advantage of minimizing the inventory of parts that must be kept.

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Osborn is silent as to the type of attachment between the neck and the upper body portion. Langlais recognizes the desirability of being able to mount balls of different sizes upon a stem. However, this reference teaches fixedly attaching the ball to the upper body portion and detachably securing the upper body portion to the stem, rather than the ball to the upper body portion, as required by claim 23. It therefore is our view that a *prima facie* case of obviousness is lacking here, and we will not sustain the rejection of claim 23.

We have, of course, carefully considered all of the arguments advanced by the appellant. However, with regard to those rejections which we have sustained, these arguments have not persuaded us that the decision of the examiner was in error. Our position with respect to the various arguments should be apparent from the foregoing recitations. We again emphasize that the extensive arguments concerning the spacing between the stem in the appellant's device and the walls of the cavity after the sleeve has been resorbed as opposed to the Osborn system are not persuasive because they focus upon limitations regarding the method of use rather than differences in the structure of the "anchor" of claim 1 and the "implant" of claim 15. Furthermore, the claims do not require that the resorbable sleeve cover the entire length of the stem, as the appellant has argued (Brief,

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pages 13 and 14). Claims 1 and 15 require merely that it be "applied to the core" so that it can tightly engage the cavity in the bone. That is the case in the Osborn arrangement.

Summary:

The rejection of claims 3, 6 and 7 under 35 USC §112, second paragraph, is not sustained.

The rejection of claims 1, 3, 6, 7, 15, 16, 19 and 24 under 35 USC §102(b) or, in the alternative, under 35 USC §103, is sustained.

The rejection of claims 2 and 18 under 35 USC §103 is not sustained.

The rejection of claims 4, 5 and 17 under 35 USC §103 is sustained.

The rejection of claims 20 through 22 under 35 USC §103 is sustained.

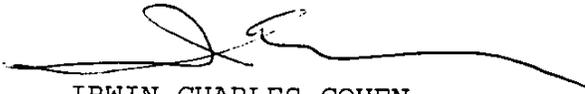
The rejection of claim 23 under 35 USC §103 is not sustained.

The decision of the examiner is affirmed-in-part.

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

AFFIRMED-IN-PART


BRUCE H. STONER, JR., Vice Chief)
Administrative Patent Judge)
)

IRWIN CHARLES COHEN)
Administrative Patent Judge)
)

NEAL E. ABRAMS)
Administrative Patent Judge)

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