

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALEXANDER TSCHAKALOFF

Appeal No. 95-2392
Application 08/105,794¹

ON BRIEF

MAILED

MAY 3 - 1996

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

Before SCHAFER, Vice Chief Administrative Patent Judge, COHEN and
McQUADE, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 19 through 22, all of the claims remaining in the application.

¹ Application for patent filed August 12, 1993. According to appellant, the application is a division of Application 07/898,453, filed June 15, 1992, now Patent No. 5,290,281, granted March 1, 1994.

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Appellant's invention pertains to a bodily tissue fixation plate. A basic understanding of the invention can be derived from a reading of exemplary claim 19, a copy of which is appended to this opinion.

In rejecting appellant's claims under 35 USC 102(b) and 35 USC 103, the examiner has relied upon the single reference specified below:

Tunc	4,905,680	Mar. 6, 1990
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The following rejections are before us for review.

Claims 19 through 21 stand rejected under 35 USC 102(b) as being anticipated by Tunc.

Claims 19 through 22 stand rejected under 35 USC 103 as being unpatentable over Tunc.

The full text of the examiner's rejections and response to the argument presented by appellant appears in the answer (Paper No. 8), while the complete statement of appellant's argument can be found in the main (pages 5 through 24) and reply briefs (Paper Nos. 7 and 9).

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In the main (page 5) and reply (pages 2 through 4) briefs, appellant indicates the wish to have each of claims 19 through 22 considered separately on appeal. However, a reading of the arguments advanced by appellant in the main brief reveals that the specific subject matter of each of claims 20 and 21 is not addressed relative to the disclosure of Tunc, as required by 37 CFR 1.192 (5), (6)(iii) and (6)(iv). In the reply brief (page 3), appellant indicates that there are several instances where each of claims 19 through 22 are separately discussed. However, a review of the pages of the main brief referred to by appellant indicates that the substance of each of claims 20 and 21 has not been separately argued. Thus, in the respective rejections under 35 USC 102(b) and 35 USC 103, we view claims 20 and 21 as standing or falling with independent claim 19, and will focus our attention, *infra*, upon claims 19 and 22.

OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered

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appellant's specification and claims, the applied references,² and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The rejection under 35 USC 102(b)

We sustain this rejection of appellant's claims.

Anticipation under 35 USC 102(b) is established only when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). However, the law of anticipation does not require that the reference teach specifically what an appellant has disclosed and is claiming but only that the claims 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

² In our evaluation of the applied references, we have considered all of the disclosure of each reference for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings of each reference, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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Clark Corp., 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983).

Our assessment of the teaching of Tunc clearly indicates to us that the subject matter of appellant's independent claim 19 is anticipated thereby. In other words, the bodily tissue fixation plate of claim 19 reads on the absorbable bone plate disclosed by Tunc (Figures 6 through 8).

Appellant's argument has not persuaded us that the examiner erred in making the rejection under 35 USC 102(b).

We certainly understand appellant's surgical procedure involving a heating apparatus wand that is intended to be used in applying the claimed bodily tissue fixation plate to a bone. However, consistent with the examiner's expressed point of view, we find that the aforementioned intended surgical procedure and apparatus does not impart to the article now claimed any feature lacking in the reference document.

Contrary to appellant's argument (main brief, page 7 and 8) that the Tunc plate is not capable of fixation to irregularly shaped bones or capable of being bent, it is readily apparent to us that Tunc is capable of this fixation since, like

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appellant's plate, Tunc expressly indicates that the plate can be bent (column 5, lines 14 through 16).

Appellant also argues (main brief, page 7) that the formation, adapted to substantially matingly cooperate with a heating tip of a heating apparatus, as set forth in claim 19, is lacking in Tunc. We disagree. As pointed out by the examiner, formations are disclosed by Tunc (Figures 6 and 8), appearing as reinforcing areas 28 with a channel therebetween. From our perspective, these formations clearly are capable of or adapted to be, because of their configuration, engaged by objects, such as the intended heating tip of a heating apparatus.

It is also argued by appellant (main brief, page 8) that the elongated cleft (formation) of Tunc would promote sliding or slippage of the heating tip of a heating apparatus, whereas a central object of the present invention is to prevent such slippage. In this regard, appellant makes reference to claim 22. First, we note that claim 19 is totally silent as to any formation structure or configuration which would prevent sliding or slippage of an object engaging the formation. Second, appellant's reference to claim 22 is this argument addressed to the anticipation issue is neither understood nor relevant since this claim is not rejected under 35 USC 102(b).

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Appellant further points out (main brief, page 9) that whether a statement of intended purpose constitutes a claim limitation is a matter to be determined on the facts of each case. We are in general accord with this view. However, as we explained earlier, and based upon the facts of the present case, we have determined that appellant's bodily tissue fixation plate, as now claimed, is not distinguished from the teaching of Tunc by its possible use with the heating tip of a heating apparatus, as intended by appellant. Unlike the present circumstances, the decision in In re Stencel, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987), cited by appellant, pertained to an obviousness determination, and addressed a claimed structural entity (driver) defined by the structure of the article (collar) with which it was intended to be used. In the present case, the structure of the heating tip is undefined and all that claim 19 requires is a broadly recited formation that is broadly recited as adapted to "substantially matingly cooperate with" the aforementioned structurally undefined heating tip.

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The rejection under 35 USC 103³

We sustain the rejection of claims 19 through 21 under 35 USC 103 for the following reason.

This panel of the board determined above that the subject matter of claims 19 through 21 is anticipated by the Tunc patent. Thus, appellant's claims 19 through 21 lack novelty. Lack of novelty is the ultimate of obviousness. See In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982).

We do not sustain the rejection of claim 22 under 35 USC 103.

The examiner is of the opinion that the particularly claimed shape of the formation as defined in claim 22 would have been an obvious matter. For reasons set forth, infra, we do not share this point of view.

³ Both the examiner (answer, pages 6 and 7) and appellant (reply brief) discuss art furnished by appellant in an information disclosure statement. This art is not the evidence of obviousness relied upon by the examiner in the statement of the rejection under 35 USC 103. Accordingly, we shall not address this art in evaluating the obviousness rejection on appeal.

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A reading of the patent to Tunc, in its entirety, reveals to us that this document would not have provided any suggestion for modifying the configuration of the formation between the plurality of through-bores (Figures 6 through 10) to effect the now claimed formation shape.

On the other hand, appellant's disclosure (specification, pages 9 and 19) expressly teaches that the formations of truncated, substantially concave spherical shape mate with a heating tip whereby the heating tip does not slip relative to the formations during heating of the plate so that the potential for accidental damage to surrounding bodily tissue is reduced. Thus, the specific shape now claimed solves a particular problem.

Since the evidence of obviousness (the patent to Tunc) fails to suggest the claimed formation shape, the rejection under 35 USC 103 must be reversed.

In summary, this panel of the board has

affirmed the rejection of claims 19 through 21 under 35 USC 102(b) as being anticipated by Tunc,

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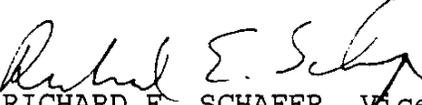
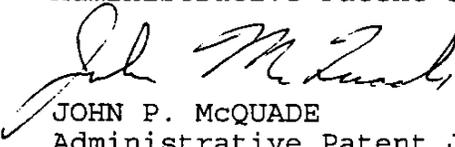
affirmed the rejection of claims 19 through 21 under 35
USC 103 as being unpatentable over Tunc, and

reversed the rejection of claim 22 under 35 USC 103 as
being unpatentable over Tunc.

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

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

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RICHARD E. SCHAFFER, Vice Chief))	
Administrative Patent Judge)	
)	
IRWIN CHARLES COHEN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS
)	AND
JOHN P. McQUADE)	INTERFERENCES
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APPENDIX

19. In a bodily tissue fixation plate formed of thermoplastic, body absorbable material and having a plurality of through-bores for receiving fasteners for attaching said plate to bodily tissue, the improvement comprising at least one formation situated between a pair of said through-bores and adapted to substantially matingly cooperate with a heating tip of a heating apparatus wand.