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Paper No. 20

PATENT OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte GIUSEPPE VRESPA

Appeal No. 95-4533  
Application 08/025,119<sup>1</sup>

ON BRIEF

Before COHEN and MEISTER, *Administrative Patent Judges*, and  
CRAWFORD, *Acting Administrative Patent Judge*.

MEISTER, *Administrative Patent Judge*.

**DECISION ON APPEAL**

This is an appeal from the final rejection of claims 16-26,  
the only claims remaining in the application.

The appellant's invention pertains to a screw device for  
fixing a prosthesis to a bone. Independent claim 16 is further

<sup>1</sup> Application for patent filed March 2, 1993. According  
to applicant, the application is a division of Application  
07/601,416, filed October 22, 1990.

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illustrative of the appealed subject matter and a copy thereof, as it appears in the appendix to the appellant's brief, is appended to this opinion.

The references of record relied on by the Examiner are:

Laverty	4,027,573	June 7, 1977
Niznick	4,431,416	Feb. 14, 1984

Claims 16-26 stand rejected under 35 U.S.C. § 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. According to the examiner:

In re claim 16, "that of the neck" and "that of the first thread portion" lack proper antecedent basis. "That" is indefinite.

In re claim 18, "the core of the second thread portion" and "the core of the first thread portion" lack proper antecedent basis. It is unclear how the directrices can be internal to the other directrices.

In re claim 20, "its length" lacks proper antecedent basis.

In re claim 21, "that of the first thread portion" lacks proper antecedent basis. "That" is indefinite.

In re claim 23, "the self-tapping type" lacks proper antecedent basis.

In re claim 25, "the neck portion" lacks proper antecedent basis. (see answer, pages 3 and 4)

Claims 16, 17, 20 and 24 stand rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Laverty.

Claims 18, 19 and 21-23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Laverty. The examiner is of the opinion that it would have been "an obvious matter of design choice ... to vary the thread cross-sections and starts dependent upon the types of materials to be fastened."

Claims 25 and 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Laverty in view of Niznick. The examiner considers that it would have been obvious to "extend the slot of Laverty into a cavity" in view of the teachings of Niznick.

Rather than reiterate the arguments of the appellant and examiner in support of their respective positions, reference is made to the brief and answer for the full exposition thereof.

*OPINION*

We have carefully reviewed the appellant's invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellant in the brief and by the examiner in the answer. As a consequence of this review, we will sustain the examiner's rejection of claims 16-26 under 35 U.S.C. § 112, second paragraph. We will not, however, sustain the examiner's rejections of claims 16, 17, 20 and 24 under 35 U.S.C. § 102(b) or claims 18, 19, 21-23, 25 and 26 under 35 U.S.C. § 103. Additionally, pursuant to our authority under the provisions of

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37 CFR § 1.196(b), we will enter a new rejection of claims 16-26 under 35 U.S.C. § 112, first paragraph. Our reasons for these determinations follow.

Considering first the rejection of claims 16-26 under 35 U.S.C. § 112, second paragraph, the appellant has presented no arguments as to why the examiner's position might be in error. In fact, the appellant states that "[a]pplicant does not dispute most of the rejections made by the Examiner" (see brief, page 11). Instead of presenting arguments as to why the examiner's position might be in error, the appellant urges that the amendments after final rejection filed on September 6, 1994 (Paper No. 10) and on March 2, 1995), which amendments were refused entry by the examiner, addressed this rejection and should have been entered by the examiner. We must point out, however, that under 35 U.S.C. § 134 and 37 CFR § 1.191, appeals to the Board of Patent Appeals and Interferences are taken from the decision of the primary examiner to reject claims. We exercise no general supervisory power over the examining corps and decisions of primary examiners to enter or not enter amendments are not subject to our review. See *In re Mindick*, 371 F.2d 892, 152 USPQ 566 (CCPA 1967) and *In re Deters*, 515 F.2d 1152, 185 USPQ 644 (CCPA 1975). Note also M.P.E.P. § 1002.02(c) and § 1201. Thus, if the appellant wished to contest the

examiner's decision not to enter the amendments, then he should have done so via a petition to the Commissioner under 37 CFR § 1.181.

Since the appellant has presented no arguments as to why the examiner's position is in error, we will sustain the examiner's rejection of claims 16-26 under 35 U.S.C. § 112, second paragraph.

Turning now to the rejections of claims 16, 17, 20 and 24 under 35 U.S.C. § 102(b) and claims 18, 19, 21-23, 25 and 26 under 35 U.S.C. § 103, each of these rejections is bottomed on the examiner's position that Laverty teaches all the subject matter set forth in independent claim 16. We cannot agree. In particular, we find no teaching in Laverty of (1) a substantially cylindrical neck, (2) a shank having a core of generally frusto-conical shape and (3) a second thread portion of smaller pitch than the first thread portion. As to limitation (1) the examiner apparently is of the opinion that the Laverty in Fig. 1A shows a cylindrical neck in the "area right below, and immediately adjacent, the area pointed to by element 15" (see answer, page 4). We must point out, however, the lead line for the numeral 15 of Laverty points to a transitional area between the circular head and the cylindrical shank. The radii along the length of the central axis of Laverty's screw (which define the outer

surface) are not equal as would be necessary in the case of a cylinder. Instead, the radii along the length of the central axis vary in such a manner so as to define a parabola. Even if the examiner is referring to that portion of the transitional immediately adjacent the cylindrical shank, we observe that the diameter of Laverty's threads are substantially greater than the diameter of the neck in this immediately adjacent area, not "equal to or less" as expressly required by independent claim 16. As to limitation (2), the examiner contends that a frusto-conical core is shown "at the bottom edge of the screw." This area, however, is conical, not frusto-conical. Moreover, independent claim 16 expressly requires a shank having a core of generally frusto-conical shape. The "bottom edge" to which the examiner refers is the pointed end of the screw. As illustrated in the drawings (see Figs. 1, 1A and 6-11) the shank is cylindrical. As to limitation (3), the examiner identifies nothing, and we find nothing, in Laverty which would suggest a second thread of smaller pitch. Laverty's the first and second threads appear to be of the same pitch.

We have carefully reviewed the reference to Niznick but find nothing therein which overcomes the deficiencies already noted with respect to Laverty. This being the case, we will not

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sustain the examiner's rejections of claims 16, 17, 20 and 24 under 35 U.S.C. § 102(b) and claims 18, 19, 21-23, 25 and 26 under 35 U.S.C. § 103.

Under the provisions of 37 CFR § 1.196(b) we enter the following new rejection.

Claims 16-26 are rejected under 35 U.S.C. § 112, first paragraph, as being based upon an original disclosure which fails to provide support for the subject matter now being claimed. The description requirement found in the first paragraph of 35 U.S.C. § 112 is separate from the enablement requirement of that provision. *See Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991) and *In re Barker*, 559 F.2d 588, 194 USPQ 470 (CCPA 1977), *cert. denied, sub. nom, Barker v. Parker*, 434 U.S. 1238 (1978). Moreover, as the court stated in *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983):

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claimed language. The content of the drawings may also be considered in determining compliance with the written description requirement. (citations omitted)

Although the claimed invention does not necessarily have to be expressed in *ipsis verbis* in order to satisfy the description requirement (see *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976)), the fact one skilled in the art might realize from reading a disclosure that something is possible is not a sufficient indication to that person that the something is a part of an appellant's disclosure (see *In re Barker, supra*). Precisely how close the original description must come to comply with the description requirement must be determined on a case-by-case basis. The primary consideration is factual and depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure. See *Vas-Cath Inc. v. Mahurkar, supra*.

In the present case, we find no descriptive support in the original disclosure for the limitation of "the second thread portion having at least an equal number of starts ..." (emphasis ours) as set forth in independent claim 16 or "2-5 times as many starts" as set forth in dependent claim 21. The original specification on page 17 states that the number of starts on the second thread "is a multiple of that of the first thread" (emphasis ours) and on page 28 that there are three starts on

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the second thread vis-à-vis one start on the first thread.

"Multiple" is defined by Webster's dictionary<sup>2</sup> as

-- 1: consisting of, including or involving more than one (emphasis ours) --. It therefore follows that there is no descriptive support for "at least equal," which would include the same number of starts. With respect to claim 21, there is no disclosure of the specific range of 2-5 starts.

In summary:

The examiner's rejection of claims 16-26 under 35 U.S.C. § 112, second paragraph, is affirmed.

The examiner's rejection of claims 16, 17, 20 and 24 under 35 U.S.C. § 102(b) is reversed.

The examiner's rejections of claims 18, 19, 21-23, 25 and 26 under 35 U.S.C. § 103 are reversed.

A new rejection of claims 16-26 is made under 35 U.S.C. § 112, first paragraph.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date hereof (37 CFR § 1.197).

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<sup>2</sup> Webster's Third New International Dictionary of the English Language, Unabridged, G. & C. Merriam Co., Springfield, MA, 1981.

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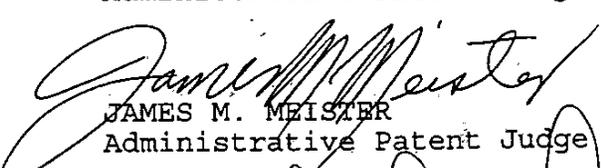
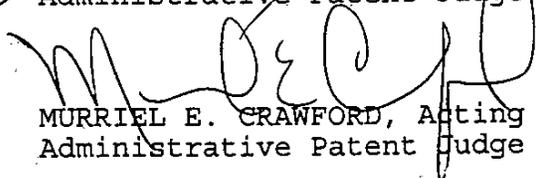
With respect to the new rejection under 37 CFR § 1.196(b), should appellant elect the alternate option under that rule to prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision. In the event appellant elect this alternate option, in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to us for final action on the affirmed rejection, including any timely request for reconsideration thereof.

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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  
37 CFR § 1.196(b)

  
IRWIN CHARLES COHEN )  
Administrative Patent Judge )  
  
JAMES M. MEISTER )  
Administrative Patent Judge )  
  
MURRIEL E. CRAWFORD, Acting )  
Administrative Patent Judge )

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*APPENDIX*

16. A screw device for fixing a prosthesis to a bone, the device comprising:

a substantially cylindrical neck; and

a shank having a core of generally frusto-conical shape and thread on the core, the thread having a diameter equal to or less than that of the neck, the thread comprising a first thread portion of large pitch suitable for fixing to trabecular bone tissue and a separate second thread portion of smaller pitch adjacent the first thread portion and suitable for fixing into a cortical part of the bone, the second thread portion having at least an equal number of starts to that of the first thread portion.