

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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN O. HAYHURST

Appeal No. 1999-2728
Application No. 08/423,963

ON BRIEF

Before FRANKFORT, STAAB and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1-11, which are all of the claims pending in this application. Claim 6 was amended (Paper No. 23) subsequent to the appeal brief.

BACKGROUND

The appellant's invention relates to an apparatus for manipulating and anchoring cartilage and similar fibrous tissue

within a joint (specification, p. 1). A copy of the claims under appeal is set forth in the appendix filed with Paper No. 23.

The examiner relied upon the following prior art reference of record in rejecting the appealed claims:

Smith	3,845,772	Nov. 5, 1974
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The following rejection is before us for review.

Claims 1-11 stand rejected under 35 U.S.C. § 102(b) as being unpatentable over Smith.¹

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer and preceding Office action (Paper Nos. 17 and 14) for the examiner's complete reasoning in support of the rejection and to the brief and reply brief (Paper Nos. 16 and 18) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied Smith reference, and to the respective positions articulated by the appellant and the examiner. For the reasons which follow, we cannot sustain the examiner's rejection.

¹ The examiner's omission of claims 9-11 in the statement of the rejection on page 2 of the answer appears to us to have been an inadvertent error.

Smith discloses a retention suture and suture device arrangement wherein a retention suture 35 is looped around an incision 31 only in the muscle and fascial tissue layers 34 and drawn up tightly through a tubular retention suture device 20 on opposite sides of a dividing wall 24, with the ends 35a, 35b tied in a knot 36 over a spindle element 25 located at the top end 22 of the device 20. See Figure 6 and col. 4, lines 5-47, of Smith.

It is the examiner's position that claims 1-11 are clearly anticipated by Smith. In particular, the examiner considers the device 20 to be an elongated anchor member as recited in claim 1. The examiner contends that the suture 35 is "attached to the anchor member between opposite ends of the anchor member" as also recited in claim 1, "because the suture is inserted through the retention member and [fastened] to it" and thus "is actually attached to the retention element at any point" (answer, pp. 3-4).

Like appellant, we observe that Smith's suture 35 is attached to the device 20 only by means of the knot 36 tied to the spindle 25 and that, when the suture is so attached, it lacks "an end free for manipulating the tissue into which the anchor member [device 20] is inserted," as required in claim 1. In any event, the absence of a free end notwithstanding, the suture is not capable of manipulating the tissue 32, 33 into which the

device 20 is inserted. Rather, only tissue beneath the device 20, around which the suture is looped, can be manipulated by the suture 35. Moreover, we do not share the examiner's view that the suture is attached between opposite ends of the anchor member (device 20) simply because it is inserted through the device. Contrary to the examiner's position, the suture is attached only at one point, the spindle, which is located at one end of the device 20, not between opposite ends of the anchor member as recited in claim 1.

For the foregoing reasons, we conclude that independent claim 1 is not anticipated² by Smith. It follows that claims 2-11, which depend from claim 1 and thus incorporate all of the limitations thereof, are also not anticipated by Smith.

REMAND TO THE EXAMINER

This application is remanded to the examiner to consider the patentability of the claims over U.S. Pat. No. 4,235,238 (Ogiu) and International Patent Application Publication No. WO 87/01270

² Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

(Richards).³ With regard to Ogiu, we direct the examiner's attention to the suturing thread 9 and cylindrical stop 7, for example. The surgical fastener of Richards, comprising filament 10 and head 15, discussed on pages 5-11 and illustrated in Figures 1-6, appears pertinent to appellant's claimed invention.

³ These references were cited by appellant in Paper No. 9 and copies are of record in the application file. The publication date of Richards is March 12, 1987, subsequent to the filing dates of the earliest three applications in the continuity chain of the instant application. It thus follows that any determination as to the patentability of the claims over Richards involves a determination as to the effective filing date to which any such claim is entitled under 35 U.S.C. § 120.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-11 under 35 U.S.C. § 102(b) is reversed and the application is remanded to the examiner for consideration of the above-mentioned issues.

REVERSED AND REMANDED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
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