

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

*Ex parte* SHEDRICK D. JONES

---

Appeal No. 1999-0117  
Application 08/702,948

---

ON BRIEF

---

Before ABRAMS, STAAB and NASE, *Administrative Patent Judges*.  
STAAB, *Administrative Patent Judge*.

*REQUEST FOR REHEARING*

Appellant requests rehearing of our decision of September 22, 1999, wherein we (1) affirmed the examiner's final rejection of claims 6-15 as being based on an original disclosure that fails to comply with the written description requirement found in the first paragraph of 35 U.S.C. § 112, and (2) dismissed the

Appeal No. 1999-0117  
Application 08/702,948

appeal as to finally rejected claims 20 and 22.<sup>1</sup> Appellant requests rehearing only with respect to (1).

As explained on pages 3-4 of our decision, two limitations added to the claims during prosecution are considered by the examiner as lacking descriptive support in the application as originally filed. The first questioned limitation pertains to the distal end configuration of the implant, while the second limitation sets forth that the at least one helical channel of the implant has "closed ends." Appellant contends that we did not analyze the original disclosure's compliance with the written description requirement according to the test set forth by the Federal Circuit, but instead created and used our own test. Specifically, appellant contends that we, in effect, required that literal support be found in the original disclosure for the limitations in question.

We have carefully reviewed our decision affirming the examiner's rejection in light of appellant's request for rehearing, but find no point that we have misapprehended or overlooked in arriving at our decision. Accordingly, we decline

---

<sup>1</sup> The appeal as to claims 20 and 22 was dismissed in light of appellant's statement on page 1 of the brief that the appeal of these claims was no longer being pursued. These claims should be canceled. MPEP § 1214.05.

Appeal No. 1999-0117  
Application 08/702,948

to make any change thereto. Although we believe our original decision adequately treats all the points raised by appellant in the request for rehearing, we add the following comments for emphasis.

Throughout the request, appellant criticizes our decision for its alleged failure to take into account "the role of the artisan in determining compliance [with the descriptive support requirement of the first paragraph of § 112]" (request, page 3). According to appellant, the disclosure in the present application of tapered ends in the drawings, coupled with appellant's disclosure of the purpose of the distal ends as being to allow easy entry into the hole in the bone tissue, and the "presumed knowledge of a person skilled in the art of patents describing implants with flat distal ends that allow easy entry into holes" (request, page 5), would have conveyed to the artisan that

"reasonable variations" of the embodiments of Figs. 6 and 7 [e.g., claimed distal end configurations #3 and #4] are also embodiments of appellant's invention and were in the possession of the appellant at the time of filing of the application, even though there is an "absence of literal support in the specification for the claim language." [Request, page 6.]

Our difficulty with this argument is that it requires considerable speculation on our part of matters such as the presumed knowledge of the ordinarily skilled artisan, how the

artisan would use such knowledge to interpret appellant's disclosure, and what the ordinarily skilled artisan would consider a "reasonable variations" of the embodiments illustrated in the Figures 6 and 7 embodiments. For example, appellant lists on page 3 of the request several U.S. Patents, presumably for the proposition that they demonstrate "the skilled-in-the-art person's knowledge of patented implants having flat distal ends that permitted easy entry of the implants into holes."<sup>2</sup> It is not apparent to us that one of ordinary skill in the art would have understood these patents as teaching that flat distal ends permit easy entry of implants into holes. In any event, even assuming that these patents establish this concept as being generally within the skill in the art, appellant has not persuasively argued why the artisan would have presumed said concept to be part of appellant's invention in the present application. This is especially so in that appellant appears to teach the opposite, namely, that the distal end of the implant should be tapered. From our perspective, appellant appears to ask us to presume as an article of faith that one of ordinary

---

<sup>2</sup> To the extent these patents are cited for this purpose, this is a new point of argument made for the first time in this request, and is therefore untimely.

Appeal No. 1999-0117  
Application 08/702,948

skill in the art would understand the presently claimed distal end configurations #3 and #4 as being "reasonable variations" of the Figures 6 and 7 embodiments, notwithstanding that they are not disclosed in the original disclosure. In the absence of some more convincing line of reasoning or evidence in support of this position, we decline to do so.

On page 8 of the request, appellant maintains that "[t]he Board apparently did not recognize appellant's the [sic] claim-6 limitation that is at issue in this appeal as being a means-plus-function limitation." The parts of claims 6 and 15 that describe the shape of the distal end of the implant do not invoke the sixth paragraph of 35 U.S.C. § 112 because they do not use the word "means" in association with any function of the distal end. Accordingly, appellant's view that the parts of claims 6 and 15 that describe the shape of the distal end of the implant can somehow be interpreted as being means-plus-function limitations is not well taken.

Concerning the helical channel "closed end" limitation added to claim 6 during prosecution, we stand by our determination that this limitation is not inherently disclosed in the original disclosure of the present application. Where, as here, the channel could be configured to have ends that are either both

Appeal No. 1999-0117  
Application 08/702,948

open, or both closed, or one open and one closed, it is not apparent to us how one of these possible channel configuration choices, namely, both closed, is an inherent characteristic of the helical channel. Nor is it apparent to us that the mere disclosure of a helical channel, in and of itself, would be construed by a person skilled in the art as a disclosure of a channel having both ends closed.

Appellant's request for rehearing is granted to the extent of reconsidering our decision, but is denied as to making any change thereto.

*DENIED*

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
LAWRENCE J. STAAB	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

Appeal No. 1999-0117  
Application 08/702,948

Robert E. Malm  
16624 Pequeno Place  
Pacific Palisades, CA 90272

ljs/ki