

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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 KIM C. BERTIN, ROBERT BOOTH JR., DENNIS W. BURKE,
RODNEY BAYS, TERRY L. DIETZ, GREGORY C. STALCUP
and RICHARD D. VANLANINGHAM

Appeal No. 96-3696
Application No. 08/242,987¹

ON BRIEF

Before ABRAMS, FRANKFORT and McQUADE, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1, 3-7 and 9-17. Claim 8 has been

¹Application for patent filed May 16, 1994.

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indicated as containing allowable subject matter, and claims 2 and 18-20 have been canceled. No claims have been allowed.

The subject matter before us on appeal is an apparatus for guiding a device for milling a portion of exposed bone. It is illustrated by reference to claim 1, which has been reproduced in an appendix to the Appellant's Brief.

THE REFERENCE

The reference relied upon by the examiner to support the final rejection is:

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|-------------------------------|-----------|----------|
| Bowman <i>et al.</i> (Bowman) | 4,952,213 | Aug. 28, |
| 1990 ² | | |

THE REJECTION

Claims 1, 3-7 and 9-17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bowman.

The rejection is explained in the Examiner's Answer.

²Although the examiner has listed twenty-seven references in the Answer as being relied upon in the rejection of the claims, the fact is that only Bowman has been applied in the rejection.

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The opposing viewpoints of the appellants are set forth
in the Brief.

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OPINION

Anticipation under 35 U.S.C. 102(b) 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 *In re Paulsen*, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). Since we find this not to be the case with regard to the claims before us on appeal, we will not sustain the rejection. Our reasoning follows.

Claim 1 is directed to an apparatus for guiding a milling device for producing a planar surface on a portion of an exposed bone. The claim recites a template means having a reference surface and defining a track for accommodating a milling machine, and a guide means

to be secured adjacent said bone for positioning said template means over said bone portion . . . [which] includes alignment means for aligning said template means over said bone portion (emphasis added).

It is the examiner's position that the subject matter of claim 1 is anticipated by Bowman, which discloses an apparatus for

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guiding a saw that cuts an exposed portion of a bone. The appellants argue that the Bowman template means is not "over" the bone, as is required by claim 1, but is positioned laterally of the bone. According to the examiner, however, "over" is a term "dependent on one's point of reference and the position of the patient" (Answer, page 6), and therefore the Bowman template qualifies as being "over" the bone.

The interpretation to be given to "over" therefore is of primary importance in evaluating whether claim 1 is anticipated by Bowman. Looking to the appellants' specification, the portion of the bone upon which the burr of the appellants' milling machine is to work is the exposed proximal end of the tibia. To do so, the milling machine and the template that holds it is positioned "over" the end of the bone, that is, spaced from the end of the bone along its longitudinal axis, above it as is shown in Figure 13. This interpretation is confirmed by considering the apparatus recited in independent claim 15, which is shown in Figures 3 and 5 and described in claim 15 also as being "over" the bone.

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We therefore shall interpret the phrase "over said bone" in the manner expressed above.³

Considering this interpretation, the Bowman template 28 is not "over" the bone, but is lateral of the bone. This being the case, while Bowman discloses guide means secured adjacent to the bone for positioning the template means, it does not disclose or teach means for positioning the template means "over" the bone portion. Nor does the Bowman alignment means align the template means "over" the bone portion in the medial-lateral direction.

In view of the foregoing, we have concluded that Bowman does not anticipate the structure recited in claim 1 and we will not sustain the rejection of this claim or of those that depend from it.

Independent claim 15 is directed to an apparatus used with an "extramedullary alignment guide" to position the guide with respect to the bone. The apparatus includes a planar

³We note that while the term "over" is not used in the description of the invention in the specification, it is present in the original claims.

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member paralleling a portion of the bone and including a means for centering the planar member "over" the bone.

In the Bowman system, the alignment guide comprises a rod 40 "adapted to be inserted into the medullary canal in the tibia bone" (column 2, lines 38 and 39, emphasis added). All of the other elements of the mechanism that aligns planar member 28 are carried by rod 40, including the means for centering it. It is clear that Bowman utilizes an intramedullary guide, rather than the extramedullary guide required by this claim, and the rejection fails at the outset. Moreover, there thus is no "body part adapted for longitudinal connection to said extramedullary guide," "planar member paralleling a portion of said bone when said extramedullary guide is properly positioned with respect to said bone," or "means for centering said planar member over said bone when the extramedullary guide is properly positioned with respect to said bone."

Since Bowman fails to disclose all of the required structure, it does not anticipate claim 15 and the rejection of this claim and those which depend from it is not sustained.

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SUMMARY

The rejection of claims 1, 3-7 and 9-17 is not sustained.

The decision of the examiner is reversed.

REVERSED

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|------------------------------|---|-----------------|
| NEAL E. ABRAMS |) | |
| Administrative Patent Judge) |) | |
|) |) | |
|) |) | |
| CHARLES E. FRANKFORT |) | BOARD OF PATENT |
| Administrative Patent Judge) |) | APPEALS AND |
|) |) | INTERFERENCES |
|) |) | |
| JOHN P. McQUADE |) | |
| Administrative Patent Judge) |) | |

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