

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHEDRICK D. JONES

Appeal No. 1998-2827
Application 08/614,494¹

ON BRIEF

Before ABRAMS, STAAB and NASE, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 9-13 and 22. Claims 16-20 has been allowed. Claims 14, 15 and 21, the only other claims

¹ Application for patent filed March 13, 1996. According to the appellant, the application is a division of Application 08/290,610, filed August 15, 1994.

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remaining in the application, have been indicated by the examiner as being allowable if rewritten in independent form to include all the limitations of the base claim from which they depend and any intervening claim. On page 1 of the brief under the heading "Status of Claims," appellant states that "Claims 9-13 and 22 are rejected" and that "Claims 9-13 are being appealed." Thus, by implication, the final rejection of claim 22 is *not* being appealed.² Accordingly, the appeal as to claim 22 is dismissed, leaving for our consideration only the rejection of claims 9-13.

This appeal is related to Appeal No. 1999-0117 in appellant's copending Application No. 08/702,948 in that the claimed subject matter in both appeals relates to a bone implant device.

Appellant's invention pertains to a dental or skeletal implant for attaching prosthetic devices to bone tissue. Claim 9 is illustrative of the appealed subject matter and reads as follows:

9. A device for implantation in bone tissue, the device

² The cover letter accompanying the corrected brief makes clear that this is appellant's intent.

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being a cylinder comprising a threaded section and a terminal section, the threaded section having at least one helical channel encircling the threaded section embedded in its surface.

The references of record relied upon by the examiner in support of rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103 are:

Sparkes 1987	4,697,969	Oct. 6,
Niznick 1991	5,076,788	Dec. 31,
Dury 1993	5,194,000	Mar. 16,

Claims 9 and 10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sparkes.

Claims 9 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dury in view of Sparkes.

Claims 12 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dury in view of Sparkes and further in view of Niznick.

The rejections are explained in the examiner's answer (Paper No. 11, mailed December 24, 1997).

The opposing viewpoints of appellant are set forth in the

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corrected brief (Paper No. 10, filed October 14, 1997).

Preliminary Matters

Before addressing the examiner's rejections, we must interpret appellant's claim language. Independent claim 9 calls for "A device for implantation in bone tissue, the device *being a cylinder* comprising a threaded section . . ." (emphasis added).

Terms in claims must be given their plain meaning, unless appellant has provided another definition in the specification. See *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) and *In re Barr*, 444 F.2d 588, 597, 170 USPQ 330, 339 (CCPA 1971). In this instance, appellant's specification is consistent with the claim terminology noted above in that it states on page 8 that "The implant 47 is a solid cylinder with screw threads"; however, the specification does not attempt to define the term "cylinder." Turning to the dictionary definition of "cylinder" for a plain meaning of that term, we note that "cylinder" is defined as

- a. A surface generated by a straight line moving

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parallel to a fixed straight line and intersecting a plane curve. **b.** The part of such a surface bounded by two parallel planes and the regions of the planes bounded by the surface. **c.** A solid bounded by two parallel planes and such a surface having a closed curve, esp. a circle, as a directrix.^[3]

Clearly, this definition does not apply very well to appellant's disclosed implant. In particular, appellant's implant includes, *inter alia*, screw threads (49), a helical channel (53), diametrical holes (57), and a tapered end (55), none of which is consistent with the above quoted definition of "cylinder."

It is an essential prerequisite that the scope and content of the claimed subject matter be fully understood prior to application of the prior art thereto. However, in this instance, we will not attempt to ascribe any particular definition to the terminology "cylinder" as used herein. Instead, for purposes of addressing the examiner's rejections,

³ *Webster's II New Riverside University Dictionary*, The Riverside Publishing Company (copyright © 1984 by Houghton Mifflin Company, Boston, MA 02108).

we will consider the terminology "cylinder" as encompassing any elongated shape having a generally curved sidewall, which may or may not also include surface portions comprising threads, channels, diametrical holes, tapered portions, etc.

The Anticipation Rejection

The only limitation of claim 9 argued by appellant as distinguishing over the wood screw of Sparkes is the requirement of claim 9 that the claimed device is a cylinder.⁴ Appellant contends that "The claim language specifically excludes compound devices such as cylinders joined with polyhedrons or truncated cones" (corrected brief, page 8), and that "The wood screws shown by Sparkes are compound devices which cannot be described as cylinders in that they consist of tapered bodies joined to hexagonal or truncated-cone heads"

⁴Appellant does not argue the preamble recitation "for implantation in bone tissue" as a difference over Sparkes and thus it will be assumed that Sparkes meets this preamble recitation in the sense that it is at least fully capable of the recited use. *Cf. In re Baxter Travenol Labs*, 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) ("It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art."); *In re Wiseman*, 596 F.2d 1019, 1022, 201 USPQ 658, 661 (CCPA 1979) (arguments must first be presented to the Board).

(corrected brief, page 9). Consequently, appellant concludes that Sparkes does not anticipate appellant's invention.

When considered in light of our above interpretation of the term "cylinder" as used herein, it is clear that appellant's argument is to no avail in convincing us that the examiner erred in rejections claims 9 and 10 as being anticipated by Sparkes. As we see it, the wood screw of Sparkes is just as much a "cylinder" as is appellant's Figure 5 implant device. Accordingly, we will sustain the standing § 102 rejection of claim 9, as well as claim 10 which has not been separately argued apart from claim 9.

The Obviousness Rejections

Turning to the § 103 rejection of claims 9 and 11 as being unpatentable over Dury in view of Sparkes, appellant argues as a threshold issue (corrected brief, pages 9-11) that Sparkes is not analogous art with respect to the claimed invention. However, even if we assume for the sake of argument that Sparkes is analogous art as urged by the

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examiner, the rejection is not sustainable. Simply stated, we see no suggestion in the combined teachings of the applied references for modifying Dury in a manner that would result in "a threaded section having at least one helical channel encircling the threaded section," as called for in claim 9. First, notwithstanding the examiner's view to the contrary, it is not apparent to us that the groove 17 of Dury is a helical groove. Based on Dury's specification (column 5, lines 43-47) and drawings, it appears just as likely that groove 17 is a straight groove. Second, we see no teaching in Sparkes for modifying Dury's groove so that it encircles the threaded section. This would require changing the pitch of the groove taught by Sparkes in opposition to the clear teaching of Sparkes at column 2, lines 22-29 to the contrary. It is error to disregard disclosures in the references that diverge from and teach away from the invention at hand. *W. L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983). Third, it appears likely to us that modifying Dury's groove 17 so that it encircles the threaded section would render Dury's implant, at best,

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unsuitable for its purpose of allowing bone wastes resulting from threading of the implant into the bone to be discharged, as intended by Dury (column 5, lines 44-47), thus presenting a disincentive to the modification proposed by the examiner.

See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); *Ex parte Rosenfeld*, 130 USPQ 113, 115 (Bd. App. 1961).

In light of the foregoing, we will not sustain the examiner's rejection of claims 9 and 10 as being unpatentable over the combined teachings of Dury and Sparkes.

Concerning the rejection of claims 12 and 13 as being unpatentable over Dury in view of Sparkes and further in view of Niznick, the Niznick reference additionally applied in this rejection does not render obvious what we have found to be lacking in Dury and Sparkes. Accordingly we also will not sustain this rejection.

New Rejection

Pursuant to 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claims 9-13 are rejected under 35 U.S.C. § 112, second

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paragraph, for failing to particularly point out and distinctly claim the subject matter sought to be patented.

The use of the terminology "being a cylinder" in claim 9 to describe appellant's implant is misdescriptive, inaccurate, and confusing for the reasons noted *supra*.

Summary

The rejection of claims 9 and 10 as being anticipated by Sparkes is affirmed.

The rejection of claims 9 and 11 as being unpatentable over Dury in view of Sparkes, and the rejection of claims 12 and 13 as being unpatentable over Dury in view of Sparkes and further in view of Niznick, are reversed.

A new ground of rejection of claims 9-13 pursuant to 37 CFR § 1.196(b) has been made.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that

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"[a] new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision. . . .

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), 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 the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing 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-IN-PART; 37 CFR § 1.196(b)

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NEAL E. ABRAMS))
Administrative Patent Judge)	
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LAWRENCE J. STAAB)	
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