

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ALAN R. SPIEVACK

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Appeal No. 1999-0098  
Application No. 08/328,443<sup>1</sup>

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ON BRIEF

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Before CALVERT, CRAWFORD, and GONZALES, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 4 to 6, 11, 14 to 42, 44 and 45. The other claims in the application, claims 2, 3, 7 to 10, 12, 13, 43 and 46 to 58,

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<sup>1</sup> Application for patent filed October 25, 1994.

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have been either allowed or have been indicated as allowable,  
subject to being rewritten in independent form.

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The appealed claims are drawn to an intramedullary nail (claim 1, 4 to 6, 11 and 14), a system for fastening an intramedullary nail (claims 15 to 34), and a method of fastening an intramedullary nail (claims 35 to 42, 44 and 45). They are reproduced in the appendix of appellant's brief.

The references applied in the final rejection are:

Kranz et al. (Kranz)	5,057,110	Oct. 15, 1991
Tanguy (European Application)	218,492	Apr. 15, 1987 <sup>2</sup>

The claims on appeal stand finally rejected on the following grounds:<sup>3</sup>

- (1) Claims 1, 5, 11, 15 to 31, 34 to 42, 44 and 45, anticipated by Tanguy, under 35 U.S.C. § 102(b);
- (2) Claims 4, 14, 32 and 33, unpatentable over Tanguy, under

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<sup>2</sup> A copy of a translation of this reference, prepared for the PTO, is forwarded to appellant herewith. Any reference in this decision to Tanguy by page and line is to the translation.

<sup>3</sup> In the Advisory Action of July 10, 1996 (Paper No. 11), the examiner indicated that the amendment filed on June 20, 1996, had overcome a further rejection of claims 4, 6, 9, 10, 17 to 21, 26 to 30, 34 and 46 under 35 U.S.C. § 112, second paragraph.

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35 U.S.C. § 103;

(3) Claim 6, unpatentable over Tanguy in view of Kranz, under

35 U.S.C. § 103.

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We will first consider the rejection of independent claims 1, 11 and 42, keeping in mind that in order for Tanguy to anticipate these claims, it must disclose, expressly or inherently, every limitation recited. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

Claims 1 and 11 call for a guide member "integrally attached" within the intramedullary nail, and claim 42 for an intramedullary nail with an "integrally attached" guide member. Tanguy discloses an intramedullary nail 1 in which the guide member 15 is held in position for drilling the "adjacent cortical" (page 13, line 19) by the engagement of a spring biased ball detent 20 in positioning hole 21 in the wall of the nail. After the cortical is drilled, the guide is removed, as shown in Figs. 4C and 4D. Appellant argues that the guide member 15 is not "integrally attached" to the pin 1, while the examiner, citing two cases concerning the definition of "integral,"<sup>4</sup> asserts that it is.

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<sup>4</sup> In re Kohno, 391 F.2d 959, 960 n.4, 157 USPQ 275, 276 n.4 (CCPA 1968); In re Dike, 394 F.2d 584, 590 n.5, 157 USPQ 581, 585 n.5 (CCPA 1968).

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Words in a claim are generally given their ordinary and accustomed meaning, unless it appears from the specification that the inventor defined them differently. In re Paulsen, 30

F.3d

1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). Since

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appellant here did not define the expression "integrally attached" in the specification, it will be given its broadest reasonable interpretation. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993).

Looking at the operation of the Tanguy apparatus, after the pin 1 is in place, the guide member 15 is pushed into the bore of the pin until the ball detent 20 snaps into the hole 21; then, after the cortical has been drilled, the guide member is removed, presumably by pulling on handle 24 so that ball 20 is disengaged from hole 21. It is clear that when the ball detent 20 is engaged with hole 21, the guide member 15 is attached to nail 1. However, in an apparatus of this type, where two members are attached together by a detent for part of the operation, but are disengaged during the remainder of the operation, we do not consider it to be a reasonable interpretation to say that the two members are "integrally" attached. In this regard we note the case of In re Larson, 340 F.2d 965, 967-68, 144 USPQ 347, 349 (CCPA 1965), cited in appellant's reply brief, in which the Court, citing a dictionary definition of "integral," agreed that

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the parts of the reference (Tuttle et al.) were "integral"  
since

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they were "rigidly secured together as a single unit" and "so combined as to constitute a unitary whole" (340 F.2d at 967, 144 USPQ at 349). In the present case, Tanguy's guide 15 and nail 1 do not meet this definition.

The fact that the term "integral" "is not necessarily restricted to a one-piece article," and "may be construed as relatively broad," as stated in In re Kohno and In re Dike, supra<sup>5</sup>, does not mean that all parts which are attached together may be said to be "integrally" attached. Contrary to the well settled principle that specific limitations in a claim cannot be ignored, In re Boe, 505 F.2d 1297, 1299, 184 USPQ 38, 40 (CCPA 1974), here the examiner's interpretation in effect gives no weight to the limitation "integrally," for if the guide member and pin of Tanguy can be construed as being integrally attached together by ball detent 20, it is difficult to imagine how any two parts could be non-integrally attached together.

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<sup>5</sup> See also Advanced Cardiovascular Systems v. Scimed Life Systems Inc., 887 F.2d 1070, 1074, 12 USPQ2d 1539, 1542 (Fed. Cir. 1989).

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On page 7 of the supplemental answer, the examiner argues that

The structural difference between the applicant's disclosed device and the reference is a fuzzy, fuzzy line (particularly when all of the applicant's embodiments are considered). "Integral" does not to [sic] clear this line. The artisan would be unable to ascertain the scope of the rejected claims if they are found to be allowable over Tanguy.

These arguments are not considered relevant to the question of anticipation under § 102(b), since the issue is whether the claims are readable on the reference, rather than how appellant's disclosure differs from the reference. Whether the artisan could determine the scope of the claims concerns the question of compliance with the second paragraph of § 112, under which the claims have not been rejected.

Accordingly, we will not sustain the rejection of claims 1, 11 and 42, nor their dependent claims 5, 44 and 45, under § 102(b). The rejection of dependent claims 4, 6 and 14 under § 103 also will not be sustained, since, even considering Kranz, we find no evidence that it would have been obvious to integrally attach the guide member 15 of Tanguy to nail 1.

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We now turn to independent claims 15, 23, 35 and 40. System claims 15 and 23 each contain limitations exemplified by the following from claim 15:

an elongate member extendable from within the intramedullary nail, through a selected securing hole and through the skin of the patient to the outside of the patient's body; and

a fastener registered to the extending elongate member, the fastener constructed to be guided by the elongate member from the outside of the patient's body to the selected securing hole through the cortex of the bone.

Similarly, the following is typical of limitations included in method claims 35 and 40 (claim 35, lines 6 to 10):

extending the elongated member through the skin of a patient from within the intramedullary nail;

registering a fastener to the extending elongate member; and

guiding the fastener along the elongate member from outside of the patient's body to the selected securing hole through the cortex of the bone.

Although Tanguy does not explicitly disclose extending elongate member (drill shaft 8) through the patient's skin, the examiner seems to take the position that such a step would be inherent in use of the Tanguy apparatus (answer, page 7, second paragraph). While we are doubtful that this is

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correct, it is evident to us (and not addressed by the  
examiner) that Tanguy does not disclose guiding the fastener  
(screw 4) by means of the

elongated member 8. Instead, Tanguy discloses at pages 13 to 14 that after the cortical is drilled by means of flexible shaft 8 carrying drill bit 12, a drill guide is put in place on the outer side of the skin (the flexible shaft and guide member having removed from the bore of the nail 1, as shown in Fig. 4D), the cortical is drilled from the outside (Fig. 4F), and a fastener (screw 4) is placed as shown in Figs. 5 and 6.

Accordingly, since Tanguy does not disclose a fastener "constructed to be guided by the elongated member from the outside of the patient's body" as recited in claims 15 and 23, or the step of "guiding the fastener along the elongate member from outside of the patient's body" as recited in claims 35 and 40<sup>6</sup>, the rejection under § 102(b) of claims 15, 23, 35 and 40, and of dependent claims 16 to 22, 24 to 31, 34, 36 to 39 and 41, will not be sustained. The rejection of dependent claims 32 and 33 under § 103 also will not be sustained, there being no evidence that the above-noted difference between the system recited in parent claim 23 and Tanguy would have been obvious to one of ordinary skill in the art.

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<sup>6</sup> Claim 40 adds the word "extending" before "elongate" in the quoted phrase.

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Conclusion

The examiner's decision to reject claims 1,4 to 6, 11, 14 to 42, 44 and 45 is reversed.

REVERSED

IAN A. CALVERT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
MURRIEL E. CRAWFORD	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JOHN F. GONZALES	)	
Administrative Patent Judge	)	

SLD

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