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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JOHN A. BONITATI, ANDREW JACOBS, KYLE THOMAS,  
MARIO BERTAZZONI, and NIKHIL KULKARNI

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Appeal 2012-002471  
Application 11/859,425  
Technology Center 3700

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Before JEFFREY N. FREDMAN, STEPHEN WALSH, and  
ULRIKE W. JENKS, *Administrative Patent Judges*.

WALSH, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the rejection of claims directed to an orthopaedic prosthesis. The Patent Examiner rejected the claims for obviousness. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

## STATEMENT OF THE CASE

Claims 7, 8, 12, and 13 are on appeal. Claim 7 is representative and reads as follows:

7. An orthopaedic prosthesis comprising:
  - a tibial tray configured to be coupled to a surgically-prepared surface of the proximal end of a tibia, the tibial tray including a platform having an upper surface, a bottom surface, a side surface extending between the upper surface and the bottom surface, a first guide track defined in the bottom surface extending from a first opening in the side surface to a second opening in the side surface, and an elongated opening defined in the upper surface, the elongated opening extending downwardly from the upper surface of the tibial tray to the first guide track;
  - a stem coupled to the tibial tray, the stem including a mounting end received in the first guide track such that the mounting end of the stem is permitted to slide to any location along the elongated opening; and
  - a fastener received in the elongated opening of the tibial tray and in a threaded aperture defined in the mounting end of the stem, wherein the fastener secures the stem to the tibial tray at any location along the elongated opening.

The claims stand rejected under 35 U.S.C. § 103(a) as follows:

- I. claims 7 and 8 in view of Slamin<sup>1</sup> and Schall;<sup>2</sup> and
- II. claims 12 and 13 in view of Slamin, Schall, and Oudard.<sup>3</sup>

## DISCUSSION

Appellants group claims 7 and 8 together, and claims 12 and 13 separately. However, the arguments presented for all four claims are the same; we therefore consider them together. As a helpful preliminary, Appellants direct attention to Specification Figures 109-111 for an

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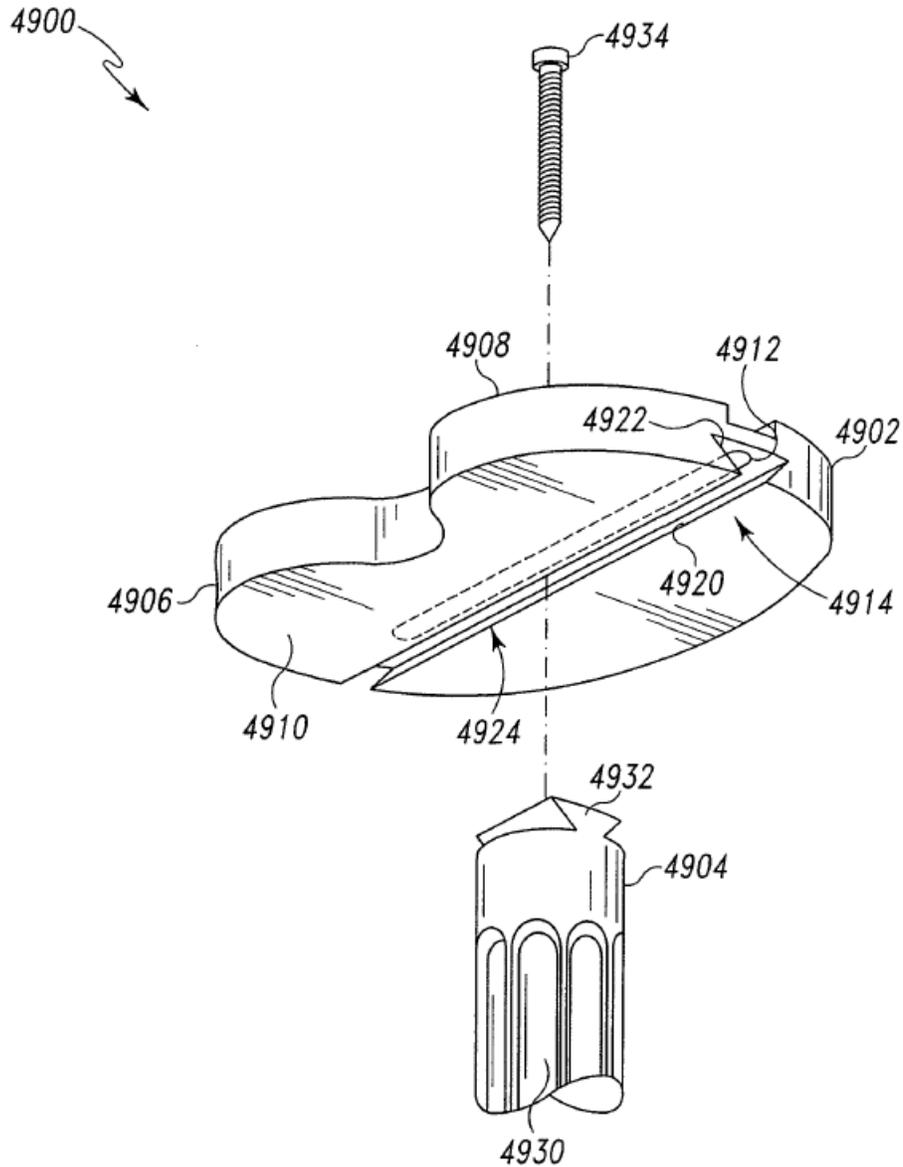
<sup>1</sup> John E. Slamin, US 5,879,391, issued March 9, 1999.

<sup>2</sup> Scott Schall et al., US 6,033,440, issued March 7, 2000.

<sup>3</sup> Jean-Loup Oudard, US 5,326,359, issued July 5, 1994.

illustration of the prostheses of claims 7 and 13. (App. Br. 3-4.)

Specification Figure 109 is reproduced here:



**Fig. 109**

“FIG. 109 is a bottom perspective view of another embodiment of the orthopaedic prosthesis assembly of FIG. 108.” (Spec. 15, [00126].)

The Examiner's position is that Slamin described a tibial tray in an orthopaedic prosthesis, but that Slamin's tibial tray differed from Appellants' tray in that

Slamin does not teach a first opening in the side surface or a second opening in the side surface from which the first guide track extends or corresponding dovetail shapes. Slamin also does not explicitly teach that the mounting end of the stem is permitted to slide to any location along the elongated opening or that the stem is secured to the tray at any location along the elongated opening.

(Ans. 6.) Finding that Schall described an analogous tray in its prosthetic limb assembly, the Examiner reasoned:

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of Slamin to include a first opening in the side surface or a second opening in the side surface from which the first guide track extends, in order to provide further adjustability and easy removal of the tray component, as indicated by Schall, particularly in view of the lack of any disclosed criticality of the claimed limitation (see paragraph 00302 of applicant's specification which states that the guide track may be closed on one or both ends).

It also would have been obvious to one having ordinary skill in the art at the time of the invention to modify the shapes of the guide track and mounting end to have corresponding dovetail shapes, in order to allow sliding connection between the components, thereby allowing lateral adjustment of position, as taught by Schall, particularly since this type of connection is well known in the art and the claim limitation appears to lack disclosed criticality. It would have been an obvious matter of design choice to make the guide track and mounting end of whatever form or shape was desired or expedient. . . .

Schall also contemplates the use of the invention on a knee joint assembly (24; fig. 1 b). Therefore, the examiner takes

the position that it would have been obvious to one having ordinary skill in the art to apply the apparently well-known adjustable dovetail configuration, such as that taught by Schall, to a tibial tray and stem connection, such as that taught by Slamin, in order to provide an adjustable coupling between prosthetic components, as taught by Schall.

(*Id.* at 7-8.)

Appellants contend that the prior art teaches away from the rejections' proposed modifications of Slamin's tibial base plate. (App. Br. 6.)

According to Appellants,

Slamin teaches having a limited, discrete number of possible engagement positions for the stem instead of permitting the stem to be positioned at any location as claimed. Similarly, Oudard, which has been used to reject claims 12 and 13, also *teaches away* from an *implantable device* having the claimed configuration. Oudard, like Slamin, teaches having the stem secured to the tibial component at a limited, discrete number of positions.

(*Id.*) Importantly, “those teachings, which run counter to the rejection's central assertion, are not reconciled or even addressed in the rejection.”

(*Id.*)

We find this argument unpersuasive. Slamin described an arrangement “to allow the adapter to be retained at a selected one of numerous possible positions on the base plate **70** from one end of the aperture **76** to the opposite end thereof;” and explained that “[t]he number of possible engagement positions for the adapter is determined by the length of the aperture **70** and the size, shape, and spacing of the teeth **82**.” (Slamin, col. 6, ll. 1-16.) By providing “numerous” positions, Slamin suggested that position adjustment is a desirable feature, and did not lead away from the

greater number of positions suggested by Schall. Oudard described an arrangement providing “a possibility of laterally adjusting the position of the bushing, therefore of the stem, due to the presence of a plurality of impressions **16, 17, 18** in the bottom of the slideway **15**.” (Oudard, col. 2, ll. 53-56.) By providing a “plurality” of positions, Oudard suggested that position adjustment is a desirable feature, and did not lead away from the greater number of positions suggested by Schall.

Appellants also contend that “merely because a technical solution is advantageous in an external prosthetic limb design by no means suggests that the same solution would be advantageous (or even desirable) if included in an implantable prosthetic device . . . .” (App. Br. 8-9.) Appellants further argue that

[w]hile the rejection suggests that the proposed modification of Slamin is obvious “to provide an adjustable coupling between prosthetic components, as taught by Schall,” that assertion is undermined by the fact that (1) Slamin *already discloses* one form of adjustable coupling for an implantable device, and (2) Oudard *already discloses* another form of adjustable coupling for an implantable device that includes a “dovetail configuration” for a tibial tray and stem connection. Indeed, the rejection has not explained why Schall's disclosure, which pertains to *external prosthetic limbs*, should outweigh the combined teachings of Slamin and Oudard, which are both directed to *implantable* prosthetic devices.

(*Id.* at 11.)

The Examiner found the distinction between implantable and external prostheses unpersuasive because both are in the same field of endeavor, and because Schall's disclosure was reasonably pertinent to the problem Slamin or Oudard addressed, which is the same as the problem Appellants address.

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(Ans. 11-12.) We agree with the Examiner's response. Accordingly, we sustain the Examiner's rejections for the reasons set forth in the Answer.

#### SUMMARY

We affirm the rejection of claims 7 and 8 under 35 U.S.C. § 103(a) over Slamin and Schall.

We affirm the rejection of claims 12 and 13 under 35 U.S.C. § 103(a) over Slamin, Schall, and Oudard.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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