



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/372,300	02/17/2009	Gregory Merrell	60021-003001	9416
69713	7590	11/01/2016	EXAMINER	
OCCHIUTI & ROHLICEK LLP			PLIONIS, NICHOLAS J	
321 Summer St.			ART UNIT	
Boston, MA 02210			PAPER NUMBER	
			3733	
			NOTIFICATION DATE	
			DELIVERY MODE	
			11/01/2016	
			ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

INFO@ORPATENT.COM

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GREGORY MERRELL

Appeal 2014-001870
Application 12/372,300
Technology Center 3700

Before JOHN C. KERINS, WILLIAM A. CAPP, and
BRANDON J. WARNER, *Administrative Patent Judges*.

WARNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Gregory Merrell (“Appellant”) appeals under 35 U.S.C. § 134(a) from the Examiner’s decision rejecting claims 2–9 and 32–38, which are all the pending claims. Appeal Br.1. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE and ENTER A NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).

CLAIMED SUBJECT MATTER

Appellant's disclosed invention "relates to devices and methods for fixation and compression of bone fractures." Spec. ¶ 1. Claim 32, reproduced below with emphasis and line breaks added, is the sole independent claim appealed and is representative of the subject matter on appeal.

32. An intramedullary device for use in stabilizing a fracture of a bone, the device comprising:

a rod having a longitudinal axis and including an insertion end *configured for insertion into an intramedullary cavity of the bone* and a proximal end opposed to the insertion end, and a plurality of recesses formed along an outer surface of the insertion end of the rod in a direction transverse to the axis,

each recess including a flat engaging surface extending substantially transverse to the axis, a curved surface longitudinally spaced apart along the axis from the engaging surface, and a sliding surface extending between the engaging surface and the curved surface in a direction parallel to the axis.

EVIDENCE

The Examiner relied on the following evidence in rejecting the claims on appeal:

Trieu	US 2005/0278029 A1	Dec. 15, 2005
Hamm	US 2006/0175785 A1	Aug. 10, 2006
Sanders	US 2007/0069493 A1	Mar. 29, 2007

REJECTIONS

The following rejections are before us for review:

- I. Claims 2, 3, 5–7, 9, and 32–36 stand rejected under 35 U.S.C. § 102(b) as anticipated by Hamm. Final Act. 2–6.
- II. Claims 32, 37, and 38 stand rejected under 35 U.S.C. § 102(b) as anticipated by Trieu. *Id.* at 6–7.
- III. Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamm and Sanders. *Id.* at 8.
- IV. Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamm. *Id.* at 8–9.

ANALYSIS

New Ground of Rejection Claims 2–9 and 32–38 as indefinite

Independent claim 32 recites an intramedullary device that includes a rod having a longitudinal axis, an insertion end, a proximal end, and a plurality of recesses. *See* Appeal Br., Claims App. The Examiner makes sufficiently supported findings that each of Hamm and Trieu discloses a rod having these recited structural features. Final Act. 2–3, 6–7. The claim also recites that the insertion end of the rod is “configured for insertion into an intramedullary cavity of [a] bone.” Appeal Br., Claims App. The Examiner correctly identifies this recitation as a functional limitation and determines that each of Hamm’s rod and Trieu’s rod is capable of performing this function. Final Act. 2–3, 7 (citing *In re Casey*, 370 F.2d 576, 580 (CCPA 1967)).

Accurately noting that “claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function,” the Examiner’s position is that Appellant does not identify any structural recitations in the claim that would differentiate the claimed rod from the known rods of either Hamm or Trieu, which—having the same recited structure—logically would be capable of performing the same function. Ans. 10–11 (citing *In re Schreiber*, 128 F.3d 1473, 1477–78 (Fed. Cir. 1997)); see also *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990) (“apparatus claims cover what a device *is*, not what a device *does*”).

Appellant, on the other hand, takes the position that this function implies “*some structural change*” that would “separate the [claimed] rod . . . from all other rods in existence,” such as the rods of Hamm or Trieu. Appeal Br. 8 (emphasis added); see *id.* at 6–7, 8–9; see also Reply Br. 3 (asserting that the claim “restricts the invention to rods that work as intramedullary devices,” and that “[n]ot all rods would have *this property*,” but not identifying with any particularity what structure, other than that expressly recited in the claim, would be required in order to have “this property”) (emphasis added)).

Thus, the disputed issue in the appeal, as defined by Appellant’s arguments, centers on what specific structural features, if any, would be required for a rod to be “configured for insertion into an intramedullary cavity of [a] bone,” so as to be considered an intramedullary device, as claimed. Resolution of this issue, however, is not possible on the record before us because Appellant does not identify what specific structure would be implied by this functional recitation. Although it is certainly possible that

this function may imply some structural feature required of the rod, the problem here is that Appellant does not direct us to anything in the record, let alone in the claim itself, that would specifically identify what these structural features might be. *See* Appeal Br. 6–7, 8–9; *see also* Ans. 11–12.

Stated another way, because we are unable to determine the scope of what specific structure would be implied by the capability to perform the recited function, independent claim 32 is indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention. This inability to determine the claim scope also pervades the associated dependent claims.

Accordingly, we enter a new ground of rejection for claims 2–9 and 32–38 pursuant to 37 C.F.R. § 41.50(b). Claims 2–9 and 32–38 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

The essence of the requirement under 35 U.S.C. § 112, second paragraph, that the claims must be definite, is that the language of the claims must provide clarity to those skilled in the art regarding the scope of the subject matter which the claims encompass. *See In re Hammack*, 427 F.2d 1378 (CCPA 1970). The test for definiteness under 35 U.S.C. § 112, second paragraph, is “whether those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted).

Of course, it is not categorically indefinite to include functional limitations in an apparatus claim, but the reliance on functional language in a claim may fail “to provide a clear-cut indication of the scope of the subject matter embraced by the claim,” and thus be indefinite. *In re Swinehart*, 439

F.2d 210, 213 (CCPA 1971). Such is the case here. When a claim merely recites a function to be achieved by recited element—here, the rod having an insertion end that is “configured for insertion” into a cavity of a bone—the boundaries of the claim scope may be unclear. *See Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1255 (Fed. Cir. 2008) (noting that the Supreme Court has explained that a vice of functional claiming occurs “when the inventor is painstaking when he recites what has already been seen, and then uses conveniently functional language at the exact point of novelty”) (quoting *General Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 371 (1938)).

Here, Appellant urges that there is some structural distinction between the claimed rod and the known rods of either Hamm or Trieu implicit in the functional recitation, but does not identify with clarity what such a structural distinction would be. Although Appellant’s Specification provides some general guidance regarding structural details of one embodiment of the invention,¹ any such details are conspicuously absent from the claim itself. As stated by our reviewing court in *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998), “the name of the game is the claim.” It is well established

¹ For example, the background discussion describes intramedullary rods as simply including “an elongate rod,” without any structural specifics. Spec. ¶ 3. The detailed description of one depicted embodiment describes “a tapered portion” that can “reduce[] injury to the interior surface of the medullary canal . . . during insertion of the rod,” and mentions a “distal tip” of the insertion end as being “rounded to allow it to pass easily through the medullary canal.” *Id.* ¶¶ 40, 42; *see also* Figs. 1, 2, 4A–4C. But the disclosure also concludes by stating that the description covers only a “selected illustrative embodiment of the invention,” and that the invention “is not limited to the working example described,” indicating that such structural details are not necessarily imparted to the claims. Spec. ¶ 76.

that limitations not appearing in the claim cannot be relied upon for patentability. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982). Thus, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *See In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

To the extent that Appellant endeavors to rely on some structural distinction implied by the functional recitation, it is only fair—both to the Examiner and to the public—that Appellant clearly delineate, either by express language in the claim itself or by citation to evidence in the record, the scope encompassed by the claim. Appellant does not direct us to any such delineation; absent which, we are not in a position to speculate as to what specific structural features may be imparted by the function recitation of the insertion end of the rod being “configured for insertion” into a cavity of a bone. Unless and until one reading the claim is able to ascertain with reasonable certainty what the asserted structural features implied by this functional recitation may be, the scope of the claim is unclear because it lacks sufficient precision to permit one endeavoring to practice the invention to adequately determine the metes and bounds thereof.

In light of the above, we conclude that independent claim 32, and dependent claims 2–9 and 33–38, are indefinite under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention.

Rejections I–IV
Claims 2, 3, 5–7, 9, and 32–36 as anticipated by Hamm,
Claims 32, 37, and 38 as anticipated by Trieu,
Claim 4 as unpatentable over Hamm and Sanders, and
Claim 8 as unpatentable over Hamm

We do not sustain the Examiner's rejections of claims 2–9 and 32–38 under 35 U.S.C. §§ 102(b) or 103(a). For the reasons explained in detail *supra*, independent claim 32, and dependent claims 2–9 and 33–38 are indefinite. Before a proper review of these rejections can be performed, the subject matter encompassed by the claims on appeal must be reasonably understood without resort to speculation. Therefore, since the claims fail to satisfy the requirements of the second paragraph of 35 U.S.C. § 112, we are constrained to reverse, *pro forma*, the prior art rejections because they necessarily are based on speculative assumptions as to the scope of the claims. *See In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962) (holding that the Board erred in affirming a rejection of indefinite claims because the rejection was based on speculative assumptions as to the meaning of the claims). We emphasize, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied in support of the rejections.

DECISION

We ENTER A NEW GROUND OF REJECTION of claims 2–9 and 32–38 under 35 U.S.C. § 112, second paragraph, as being indefinite.

We REVERSE, *pro forma*, the Examiner’s decision rejecting claims 2, 3, 5–7, 9, and 32–36 under 35 U.S.C. § 102(b) as anticipated by Hamm.

We REVERSE, *pro forma*, the Examiner’s decision rejecting claims 32, 37, and 38 under 35 U.S.C. § 102(b) as anticipated by Trieu.

We REVERSE, *pro forma*, the Examiner’s decision rejecting claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Hamm and Sanders.

We REVERSE, *pro forma*, the Examiner’s decision rejecting claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Hamm.

FINALITY OF DECISION

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that 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 the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. . . .

Appeal 2014-001870
Application 12/372,300

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED; 37 C.F.R. § 41.50(b)