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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/112,415	04/30/2008	Anton G. Clifford	P044	9173
118733	7590	11/23/2016	EXAMINER	
Moximed, Inc 26460 Corporate Ave Suite 100 Hayward, CA 94545			PRONE, CHRISTOPHER D	
			ART UNIT	PAPER NUMBER
			3738	
			NOTIFICATION DATE	DELIVERY MODE
			11/23/2016	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANTON G. CLIFFORD, JOSHUA MAKOWER,
MICHAEL E. LANDRY, and CLINTON N. SLONE¹

Appeal 2014-007140
Application 12/112,415
Technology Center 3700

Before ERIC B. GRIMES, AMANDA F. WIEKER, and
JACQUELINE T. HARLOW, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to an implantable device for a knee joint, which have been rejected as obvious. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

STATEMENT OF THE CASE

The Specification discloses “an implantable extra-articular system” (Spec. ¶ 9) that is intended to address “a need for devices which facilitate the control of load on a joint undergoing treatment or therapy, to thereby enable

¹ Appellants identify the Real Party in Interest as Moximed, Inc. (Br. 3.)

use of the joint within a healthy loading zone” (*id.* ¶ 4) and “a need to reliably and durably transfer loads across members defining a joint” (*id.* ¶ 8).

Claims 1–10, 12–23, and 25–27 are on appeal. Claim 1 is illustrative and reads as follows (emphasis added):

Claim 1. An implantable mechanical extra-articular system for a knee joint including a joint capsule, comprising:

an absorber, *the absorber absorbs a predetermined compression load applied to the knee joint*; and

a base having two ends, an upper surface, an inner surface opposite the upper surface and a mounting surface,

wherein the inner surface includes a bone contacting surface configured to engage and attach to exterior surfaces of bone, and a non-contacting surface displaced vertically from the bone contacting surface and closer towards a portion of the upper surface overlaying the non-contacting surface so as to be offset from exterior surfaces of the bone,

wherein the mounting surface alone is configured to operatively engage and connect to the absorber, and wherein the mounting surface is located at one of the two ends with all portions of the mounting surface elevated above the bone surface to position the absorber outside the joint capsule.

Claims 10, 23, and 26 are the other independent claims and include substantively the same relevant limitations.

The claims stand rejected as follows:

Claims 1, 2,² 5, 9, 10, 13, 16–19, 23, 25, and 26 under 35 U.S.C. § 103(a) as obvious based on Manspeizer³ and Orsak⁴ (Final Rej.⁵ 3);

² Although claim 2 is not listed in the heading, it is addressed in the body of the Examiner’s rejection. *See* Final Rej. 3; *see also* Ans. 2.

³ Manspeizer, US 6,540,708 B1, issued Apr. 1, 2003.

⁴ Orsak et al., US 6,162,223, issued Dec. 19, 2000.

⁵ Office Action mailed Apr. 25, 2013.

Claims 3, 4, 12, 14, 15, and 20–22 under 35 U.S.C. § 103(a) as obvious based on Manspeizer, Orsak, and Michelson⁶ (Final Rej. 6); and

Claims 6–8 and 27 under 35 U.S.C. § 103(a) as obvious based on Manspeizer, Orsak, and Hunt⁷ (Final Rej. 6).

DISCUSSION

The Examiner has rejected all of the claims on appeal as obvious based on Manspeizer and Orsak, by themselves or further combined with either Michelson or Hunt. The same issues are dispositive for all three rejections.

The Examiner finds that Manspeizer discloses a device that meets all of the limitations of the base component of the claims on appeal. (Ans. 4; Final Rej. 3–4.) The Examiner finds that Manspeizer’s base components are connected by a link but “Manspeizer does not disclose the use of a link comprising an absorber having a predetermined compression.” (Final Rej. 5.)

The Examiner finds that Orsak teaches “an implantable knee joint comprising base members 80 having a plurality of bores connected to an absorbing link (spring) . . . for the purpose of providing a means for absorbing natural forces of the knee shown best in figures 11 and 16-18.” (*Id.*) The Examiner concludes that it would have been obvious “to replace the link of Manspeizer with the absorbing link as taught by Orsak . . . in

⁶ Michelson, US 2006/0085001 A1, issued Apr. 20, 2006.

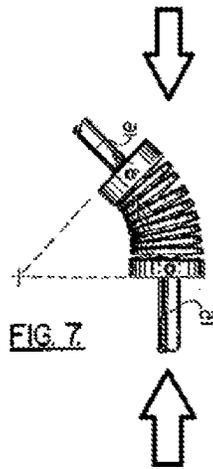
⁷ Hunt et al., US 4,851,005, issued July 25, 1989.

order to improve the range of motion and provide a means for absorbing natural forces.” (*Id.*)

Appellants argue that “the external fixator structure of *Orsak et al.* does not absorb compression loads. . . . As seen in FIG. 11, ends of the rods 15 and 16 abut. Thus, the device cannot be compressed but, rather, only expanded against the force of the spring 22.” (Br. 8.) Appellants argue that the embodiment shown in Orsak’s Figures 16 and 17 is also incapable of compression. (*Id.*) Appellants also argue that Manspeizer’s device does not include all of the components of the base of the claims on appeal; in particular, “there is nothing corresponding to a mounting surface that ‘alone is configured to operatively engage and connect to the absorber . . .’.” (*Id.* at 9.)

We agree with Appellants that the Examiner has not made a prima facie case of obviousness for the claimed device. All of the claims include a component (“absorber” or “link”) that absorbs a compression load. (*See* independent claims 1, 10, 23, and 26.) The Examiner relies on Orsak’s device as meeting this limitation. (Final Rej. 5.) However, as Appellants have pointed out, Orsak’s device includes either rods that meet in the middle of the spring or a continuous rod or cable. (Orsak, Figs. 11 and 17; col. 4, ll. 63–67; col. 6, l. 27.) Orsak states that “the hemispherical ends of the rods will allow flexion of the wrist while maintaining contact with each other to *prevent loss of distraction and length.*” (*Id.* at col. 3, ll. 19–22, emphasis added.) This disclosure further supports Appellants’ position that Orsak’s device is not capable of compressing.

The Examiner reasons that “when the absorber of Orsak is bent through knee flexion (Figures 7 and 15) the elongation of the absorber and the separation of the support rods enable the absorber to directly absorb compression loads.” (Ans. 3.) The Examiner provides a marked-up figure from Orsak, reproduced below:



The marked-up figure shows Orsak’s Figure 7 with a compressive force indicated by arrows at the top and bottom of the figure. Orsak, however, expressly states that the hemispherical ends of the rods maintain contact with each other under flexion to prevent loss of length. (Orsak, col. 3, ll. 19–22.) The Examiner has not provided adequate evidence to support a finding that Orsak’s device absorbs a compression load.

With regard to Appellants’ argument that Manspeizer’s device does not include “a mounting surface that ‘alone is configured to operatively engage and connect to the absorber . . .’” (Br. 9), the Examiner responds that “the base member of Manspeizer discloses all the claimed structural components.” (Ans. 4.) The marked-up figure provided in the Answer (*id.*), however, does not indicate any part of Manspeizer’s device that corresponds to the “mounting surface” of the claims on appeal. *See also* Final Rej. 4.

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For this reason as well, the Examiner has not made a prima facie case for obviousness based on Manspeizer and Orsak.

The Examiner cites Michelson and Hunt only for their disclosures of dependent claim limitations (Final Rej. 6–7), and does not point to any disclosure in these references of the limitations missing from Manspeizer and Orsak.

SUMMARY

We reverse all of the rejections on appeal.

REVERSED