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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* FRANCOIS PARADIS, HERBERT ANDRE  
JANSEN, BRUNO FALARDEAU, and LOUIS-PHILIPPE  
AMIOT<sup>1</sup>

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Appeal 2014-008049  
Application 11/339,499  
Technology Center 3700

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Before DONALD E. ADAMS, JEFFREY N. FREDMAN, and  
JACQUELINE T. HARLOW, *Administrative Patent Judges*.

*PER CURIAM*

DECISION ON REQUEST FOR REHEARING

Appellants request rehearing of the decision entered July 26, 2016 (“Decision”). The Decision affirmed the Examiner’s rejection of claims 1–15 as obvious.

We deny the requested relief.

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<sup>1</sup> According to Appellants, the Real Party in Interest is Orthosoft Inc. (App. Br. 3).

## DISCUSSION

Appellants argue that “the first portion of the Decision on Appeal that is misapprehended regards the limitation of ‘cylindrical head-resurfacing reamer’” (Req. Reh’g 2). Appellants contend that “DiGioia does not disclose a reamer” (*id.*).

As set forth in the Decision, we agree with the Examiner that Long and Ronningen render obvious the required cylindrical head-resurfacing reamer (Dec. 8, FF 10–11). In particular, as explained in the Decision, “Long teaches a reamer that is capable of shaping the femoral head into a cylindrical form,” and “Ronningen teaches reaming the femoral head into a cylinder” (Dec. 8, FF 10–11). “Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references []. [The reference] must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole.” *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Appellants argue that

the person of ordinary skills in the art would understand that no medical professional would even attempt to define a cylindrical surface with the hemispherical reamer shown in Figure 9 of Long. With the hemispherical surface of the reamer 685 of Long, it would be practically impossible to define a cylinder.

(Req. Reh’g 2.)

As we point out, we agree with the Examiner that

it is well known to an ordinary artisan that the femoral head can be rasped into any shape such as a cylinder by non-cylindrical reamer -- i.e., the reamer does not have to be cylindrical in

order to shape the femoral head into a cylinder just as the cylindrical torso of classical statues do not have to be shaped by cylindrical chisels.

(Dec. 7–8.) *See In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997) (“[A]ttorney argument [is] not the kind of factual evidence that is required to rebut a prima facie case of obviousness”).

Appellants argue that “the broadest reasonable interpretation includes any **reamer** that is capable of resurfacing an object into a cylindrical form. Hence, Ronningen does not meet this broadest reasonable interpretation as FF 11 confirms that Ronningen teaches a disk guided by a Steinmann pin” (Req. Reh’g 3).

We are not persuaded. As set forth in the Decision, “Ronningen discloses that ‘[t]he femoral head was *reamed* to a *cylindrical shape*” (Dec. 6 (FF 11 (emphasis added))). Furthermore, Appellants position attacks Ronningen in isolation, despite our determination, discussed above, that Long and Ronningen disclose cylindrical head-resurfacing reamers. *See In re Merck & Co.*, 800 F.2d at 1097.

Appellants argue that claim 9 has limitations pertaining to selecting an orientation of the drill, followed by creating a guide channel based on the selected orientation, followed by the resurfacing using this guide channel. The person skilled in the art would therefore understand that claim 9 recites the evaluation or prediction of the bone resurfacing evaluation before resurfacing occurs, based on the sequence of steps of claim 9.

(Req. Reh’g 3.)

This argument is unpersuasive. Claim 9 does not require that the steps be in a particular sequence and as Appellants recognize, “the exact

wording ‘*at least prior to resurfacing being performed*’ is absent from claim 9” (*id.*).

Appellants argue that “the Decision on Appeal has failed to provide Finding of Facts explaining how the prior art is capable of performing the functions prior to the resurfacing being performed (referred to as pre-resurfacing alteration evaluation for simplicity)” (Req. Reh’g 4). Appellants also argue that “the preoperative geometric planner of DiGioia is described in column 5 line 57 to column 6 line 23 and in no way recites pre-resurfacing alteration evaluations. The pre-operative geometric planner 12, is strictly limited to determining implant positions, and simulating joint movement” and that “the DiGioia tool tracking occurs ‘*During the intra-operative stages of the method, the computer system [] is used to display the relative locations of the objects being tracked with a tracking device []. . .*’” (*id.*).

As we explained in the Decision,

DiGioia, teaches “[t]he apparatus includes a *pre-operative* geometric planner” (FF 1 (emphasis added); *see also* Ans. 12–13), and Sati teaches “[a] system [] is used to assist the surgeon in performing an operation by acquiring and displaying an image of the pat[i]ent. *Subsequent* movement of the patient and instruments is tracked and displayed on the image” (FF 4; *see also* Ans. 11–12).

(Dec. 8–9.) *See In re Merck & Co.*, 800 F.2d at 1097. *See also In re Geisler*, 116 F.3d at 1470.

Appellants argue that “[c]laims 14 and 15, as justified above, relate to detecting the potential notch as an evaluation made prior to resurfacing. The excerpt of Sati is one that is performed during the act of altering the bone” (Req. Reh’g 5).

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As we observe in the Decision, and as recognized by Appellants, “Sati teaches ‘[t]he system [] *can help guide* the femoral reamer” (Dec. 10 (emphasis added); FF 8). *See also In re Merck & Co.*, 800 F.2d at 1097.

#### SUMMARY

We grant the Request to the extent that we have reconsidered the record. The Request for Rehearing is denied.

#### TIME PERIOD FOR RESPONSE

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

#### REHEARING DENIED