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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 12/601,406  | 03/03/2010  | Ulrich Schreiber     | 6117-P37648         | 7319             |
| 13897   | 7590        | 12/07/2016           | EXAMINER            |                  |
| Abel Law Group, LLP<br>8911 N. Capital of Texas Hwy<br>Bldg 4, Suite 4200<br>Austin, TX 78759 |             |                      | MAHMUD, ATIYA S     |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3733                |                  |
|   |             |                      | NOTIFICATION DATE   | DELIVERY MODE    |
|   |             |                      | 12/07/2016          | ELECTRONIC       |

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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* ULRICH SCHREIBER and STEFAN EICHHORN

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Appeal 2014-009805  
Application 12/601,406<sup>1</sup>  
Technology Center 3700

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Before MICHAEL L. HOELTER, JEREMY M. PLENZLER, and  
LISA M. GUIJT, *Administrative Patent Judges*.

PLENZLER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's Final Decision rejecting claims 40 and 43–46 under 35 U.S.C. § 103(a) as being unpatentable over Durham (US 6,106,528, iss. Aug. 22, 2000) and Metzinger (US 2007/0233104 A1, pub. Oct. 4, 2007). We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE and enter a NEW GROUND OF REJECTION in accordance with 37 C.F.R. § 41.50(b).

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<sup>1</sup> Appellants do not identify a real party-in-interest. Based on the statement under 37 C.F.R. § 3.73(c) filed November 12, 2015, OT Medizintechnik GMBH appears to be the real party-in-interest.

### CLAIMED SUBJECT MATTER

Claim 40, reproduced below, is the sole independent claim. Claims 43–46 depend from claim 40.

40. A locking intramedullary nail for insertion into a medullary cavity of a hollow bone and for supporting bone fractures and reinforcing or stiffening joints, respectively, wherein the nail comprises an elongated shaft having at least one through hole for receiving one or more locking screws, wherein in an area of at least one through hole a sleeve which is pivotable at least perpendicularly to a longitudinal axis of the intramedullary nail is supported in the shaft and comprises a bore for receiving a locking screw and is lockable in a positionally stable manner after insertion of the locking screw into the shaft, wherein at least two successive sleeves at least one of compress, block, and arrest each other by a force of a clamping screw, and wherein at least one supporting element is arranged between the at least two successive sleeves, the at least one supporting element abutting against the sleeves.

### OPINION

#### *New Ground of Rejection – Indefiniteness*

Pursuant to our authority under 37 C.F.R. § 41.50(b), we reject claims 40 and 43–46 under 35 U.S.C. § 112, ¶ 2 as being indefinite.

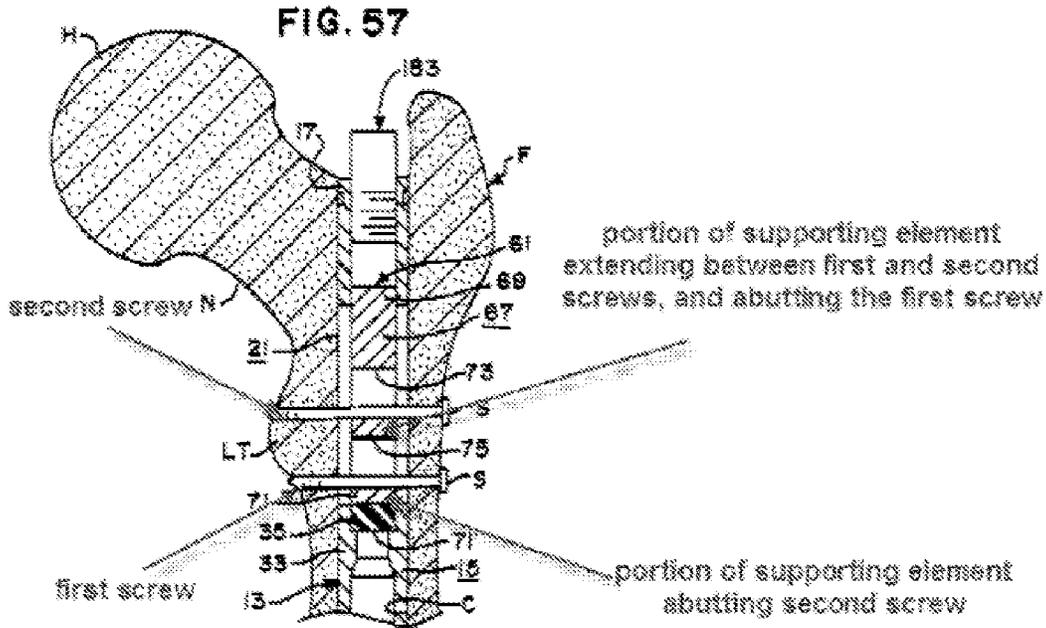
Claim 40 recites “a sleeve which is pivotable” and that “at least two successive sleeves at least one of compress, block, and arrest each other by a force of a clamping screw.” The claim is amenable to at least two plausible constructions. The claim could be read as requiring three sleeves, with the “two successive sleeves” being different than the “sleeve which is pivotable.” Under such an interpretation, neither of the “two successive sleeves” are required to be “pivotable.” Alternatively, the claim could be read as requiring only two “sleeves,” with the “sleeve which is pivotable”

being one of the “two successive sleeves.” Neither interpretation is so broad as to encompass the other. Claims 43–46 do not further clarify those limitations.

Accordingly, we enter a new ground of rejection under 35 U.S.C § 112, ¶ 2 because those claims are indefinite. *See Ex parte Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008) (precedential) (“if a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim . . . indefinite”).

#### *Examiner’s Rejection*

Although we determine that the claims are indefinite, we are still able to determine that the Examiner’s rejection of those claims cannot be sustained. The Examiner finds that Durham teaches the majority of the limitations recited in claim 40, but not the “sleeves.” Final Act. 2–3. The Examiner cites Metzinger as teaching “sleeves” and determines, in view of that teaching, “[i]t would have been obvious . . . to provide each of the locking screws of Durham with a sleeve[.]” *Id.* at 3–4. The Examiner explains that “the combination is such that the supporting element is arranged between the at least two successive sleeves and that since the support element of Durham is intended to abut the locking screw (S), the supporting element would abut the locking sleeves which receive the locking screws.” *Id.* The Examiner’s position is made clear by the annotated version of Durham’s Figure 57 from the Answer (hereinafter “the annotated figure”), reproduced below. *See* Ans. 9.



The figure reproduced above is a version of Durham's Figure 57 as annotated by the Examiner, showing a section view of Durham's intramedullary nail and intramedullary nail insert.

Claim 40 requires that a "supporting element is arranged between the . . . two successive sleeves" and "abut[s] against the sleeves." The Examiner considers intramedullary nail insert 61 to be a "supporting element." Final Act. 3. The Examiner notes that "supporting element (61) comprises two apertures (73, 75) for receiving two screws (S)" and that "[t]he supporting element extends above the first screw between both screws and below the second screw." Ans. 8.

Appellants contend the claim requires that the thing located *between* the sleeves (i.e., the "supporting element") must abut both sleeves. App. Br. 10. Appellants contend that the Examiner's reading of the claim as only requiring *a portion* of the "supporting element" to be located between

successive sleeves without requiring *that portion* to abut both sleeves is unreasonably broad. *See id.* at 14–15. We agree with Appellants.

Initially, we note that the Examiner does not respond to Appellants’ claim construction contentions in any meaningful way. *See* Ans. 10 (dismissing Appellants’ contentions by simply noting that “limitations from the specification are not read into the claims”). Moreover, the Examiner does not provide any explicit construction for this disputed claim language. As noted above, the claim clearly defines the position of the “supporting element” as “located between successive sleeves” and requires the “supporting element” to abut both sleeves. Under the construction implicit in the Examiner’s rejection, only some portion of a “supporting element” would need to be located between successive sleeves, and the portion of the supporting element abutting the sleeves could be wholly outside of the region between the sleeves (i.e., neither the portion that abuts the first sleeve nor the portion that abuts the second sleeve would need to be located *between* those sleeves). This is not a reasonable construction, as it is not only inconsistent with the plain language of the claim, but is also inconsistent with the Specification. *See, e.g.*, Spec. ¶ 54 (“Between the two sleeves 6 a block shaped separating element 13 is provided which abuts against both sleeves 6.”).

Whether the “supporting element” defines a discrete structure, or is part of some larger thing, that “supporting element,” itself, must be the structure that is located *between* and abuts the two successive sleeves.

Appellants contend that this feature is not present in the combination of teachings from Durham and Metzinger proposed by the Examiner. *See, e.g.*, App. Br. 10. We agree. Indeed, the rejection does not assert a teaching

or combination of teachings that meets this construction, as evidenced by the annotated figure from the Answer reproduced above. For example, supporting element 61 in the Examiner's modified version of Durham would abut a sleeve surrounding the portion labeled "first screw" in that figure at a location that is *not between* the successive sleeves. Accordingly, the Examiner has failed to establish that claims 40 and 43–46 are unpatentable under 35 U.S.C. § 103.

### DECISION

We REVERSE the Examiner's decision to reject claims 40 and 43–46; and

We also enter a NEW GROUND OF REJECTION of claims 40 and 43–46 on the basis that these claims are indefinite under 35 U.S.C. § 112, ¶ 2.

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 "[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 Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds 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 proceeding will be remanded to the examiner . . .

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

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)