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EXAMINER

PRONE, CHRISTOPHER D

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOSEPH P. IANNOTTI

Appeal 2015-002963
Application 13/393,257¹
Technology Center 3700

Before ANTON W. FETTING, KENNETH G. SCHOPFER, and
TARA L. HUTCHINGS, *Administrative Patent Judges*.

SCHOPFER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the rejection of claims
1–4. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

BACKGROUND

According to Appellant, “[t]he present invention relates to the field of
joint replacement and/or resurfacing, and more particularly [to] total

¹ According to Appellant, the real party in interest is The Cleveland Clinic
Foundation. Br. 3.

shoulder arthroplasty or hemiarthroplasty using a stemmed or humeral resurfacing prosthetic.” Spec. 1, ll. 9–11.

CLAIMS

Claims 1–4² are on appeal. Claim 1 is the only independent claim on appeal and recites:

1. A device for replacing a portion of a shoulder bone joint, comprising:

a prosthetic humeral head comprising an articulation surface having a shape of a semi-ellipsoid, and a bottom surface, wherein the bottom surface includes a taper feature for engagement with an engagement member connectable to the shoulder joint, the engagement member connectable to said prosthetic humeral head and operable to maintain a desired orientation of said semi-ellipsoid shape of said articulation surface with respect to the shoulder joint.

Br. 11.

REJECTION

The Examiner rejects claims 1–4 under 35 U.S.C. § 102(b) as anticipated by Ball.³

DISCUSSION

With respect to claim 1, the Examiner finds that Ball discloses a device as claimed. Final Act. 3 (citing Ball Figs. 3, 4). The Examiner further states:

The examiner recognizes that Ball discloses his invention as being used within a wrist joint instead of a shoulder joint, but in the new amendments defining the bone joint as a shoulder joint and calling the prosthetic head a humeral head are considered to

² Claims 5–25 have been withdrawn. *See* Br. 12–17.

³ Ball et al., US 6,890,358 B2, iss. May 10, 2005.

be language defining the applicant's intended use for their invention. The examiner maintains that all of the claimed structural components are disclosed by Ball and that the invention of Ball is fully capable of being implanted in a shoulder joint. The invention of Ball may not provide an exact replica of the natural joint but it is capable of restoring movement and some function to a shoulder joint.

Id.

Although we agree with the Examiner that the claim preamble recites only an intended use for the device, we agree with Appellant that the limitations requiring a prosthetic humeral head and member connectable to the shoulder joint are more than just intended use recitations and require a structure that is sized and shaped to approximate the size and shape of the humeral head and is sized in scale with the shoulder joint. *See* Br. 6. The Examiner acknowledges that Ball's device is a wrist joint prosthetic, and we find that the Examiner has not adequately shown how Ball's device meets these structural limitations in order to support an anticipation rejection.

We also find that the Examiner has not shown that Ball's device is necessarily capable of performing the intended use claimed. "Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations and internal quotation marks omitted). Although Ball's device might be capable of replacing a portion of a shoulder bone joint, we find that a preponderance of the evidence before us does not show that this is necessarily the case as would be required for Ball to anticipate the claim. In particular, Appellant provides evidence that because of the difference in anatomy between a wrist joint and a shoulder joint, Ball's wrist prosthetic would not be adequate to

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restore function to a shoulder a joint. *See* Affidavit of Mark Schickendantz, MD at 5.

For these reasons, we do not sustain the rejection of claim 1 as anticipated by Ball. We also do not sustain the rejection of dependent claims 2–4 for the same reasons.

CONCLUSION

For the reasons set forth above, we REVERSE the rejection of claims 1–4.

REVERSED