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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* JEAN BORDEAUX, BRIAN BEALE, RANDY J. BOUDRIEAU,  
MICHAEL P. KOWALESKI, RICO VANNINI, and ALDO VEZZONI

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Appeal 2016-003999  
Application 13/796,086  
Technology Center 3700

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Before JEFFREY N. FREDMAN, ULRIKE W. JENKS, and  
JOHN E. SCHNEIDER, *Administrative Patent Judges*.

FREDMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal<sup>1</sup> under 35 U.S.C. § 134 involving claims to a bone fixation plate for pelvic osteotomy. The Examiner rejected the claims as anticipated and as obvious. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

*Statement of the Case*

*Background*

“Triple Pelvic Osteotomy (TPO) is typically performed on immature canines to treat coxofemoral joint subluxation, changing the orientation of

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<sup>1</sup> Appellants identify the Real Party in Interest as DePuy Synthes Products, Inc., a subsidiary of Johnson & Johnson (*see App. Br. 2*).

the acetabulum to allow improved congruity and coverage of the femoral head to increase coxofemoral joint stability” (Spec. 1:13–15). “Increasing this stability of the joint helps to maintain normal joint mechanics and minimizes the subsequent development of osteoarthritis” (Spec. 1:15–17). “In another procedure known as a Double Pelvic Osteotomy (DPO), only the pubic and ilial osteotomies are performed” (Spec. 1:24–25).

The Specification teaches “the exemplary bone plate according to the invention may be used in either a DPO or a TPO procedure, with a surgeon selecting the procedure to conform to the requirements of the animal to be treated” (Spec. 3:26–28).

*The Claims*

Claims 1–10 and 12–19 are on appeal. Claim 1 is representative and reads as follows:

1. A bone fixation plate for pelvic osteotomy comprising:
  - a plate body configured to be positioned over the ilial shaft and comprising a first body portion lying in a first plane, a second body portion lying in a second plane and an interface body portion lying in a third plane, wherein:
    - the first plane is angled relative to the second plane and laterally offset from the second plane and the third plane is angled relative to the first and second planes;
    - a longitudinal axis of the first body portion is angled with respect to a longitudinal axis of the second body portion;
    - the first body portion has first and second openings extending therethrough and is configured to avoid interfering with the tuberosity of the rectus femoris muscle; and
    - the second body portion has third and fourth openings extending therethrough.

*The issues<sup>2</sup>*

- A. The Examiner rejected claims 1, 3–8, 12, and 13 under 35 U.S.C. § 102(b) as anticipated by David<sup>3</sup> (Final Act. 2–3).
- B. The Examiner rejected claims 2, 18, and 19 under 35 U.S.C. § 103(a) as obvious over David and Bruecker<sup>4</sup> (Final Act. 4).

A. *35 U.S.C. § 102(b) over David*

The Examiner finds:

David et al discloses a bone fixation device comprising: a plate body comprising a first body portion (1) lying in a first plane, a second body portion (2) lying in a second plane and an interface body portion (3) lying in a third plane, wherein: the first plane is angled relative to the second plane and laterally offset (Figure 4D) and the third plane is angled relative to the first and second planes (Figure 4D); a longitudinal axis of the first body portion is angled with respect to a longitudinal axis of the second body portion (Figure 4C, 4D); the first body portion has first and second openings extending therethrough; and the second body portion has third and fourth openings extending therethrough (Figure 4D). The plate body is configured for use in one of a Triple Pelvic Osteotomy and a Double Pelvic Osteotomy.

(Final Act. 2).

The issue with respect to this rejection is: Does the evidence of record support the Examiner’s conclusion that David anticipates claim 1?

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<sup>2</sup> The Examiner identifies claims 11 and 20 as allowable, but objected to as dependent upon a rejected base claim (*see* Final Act. 5).

<sup>3</sup> David et al., US 4,800,874, issued Jan. 31, 1989 (“David”).

<sup>4</sup> Bruecker et al., US 2008/0045960 A1, published Feb. 21, 2008 (“Bruecker”).

*Findings of Fact*

1. David teaches “a bone transfixion plate for transfixing an acetabulum fragment of the os ilium to the os ilium following a hip osteotomy with rotation of the roof of the acetabulum” (David 1:7–10).

2. Figures 4c and 4d of David are reproduced below:

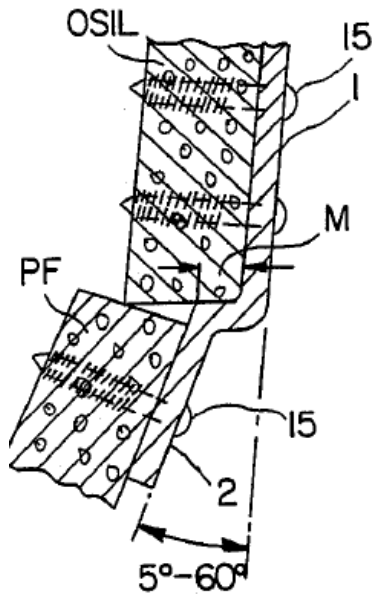


Fig. 4c

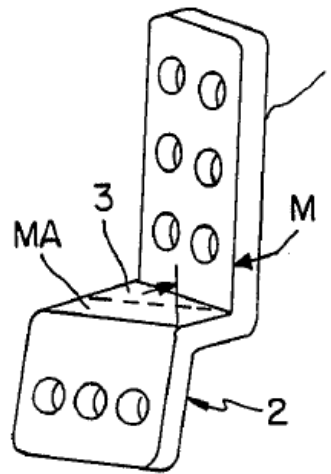


Fig. 4d

FIGS. 4c and 4d are, respectively, a cross-section and a perspective view of a transfixion plate, particularly for humans, whereby the acetabulum fragment PF is rotated, i.e. swung around the vertical axis, inclined outwardly and shifted medially. The medialization M is less than or equal to 13 mm, preferably 5-13 mm, depending on the size of the patient. The angle of inclination between the os ilium OSIL and the acetabulum fragment PF is set to 5-60°, and the angle between the distal and proximal regions 1, 2 of the plate is also 5-60°.

The length of the ventral end of the transition zone 3 thus corresponds to the required medialization M. The transition zone 3 widens with progression dorsally from the ventral end, in accordance with the horizontal angle between the proximal and distal regions 1, 2 of the plate. The transition zone 3 thus

comprises a medialization region MA (determined by the desired medialization) and a wedge-shaped region (determined by the horizontal angle between the said proximal and distal regions **1, 2**. The maximum horizontal width on this transfixion plate is on the dorsal edge.

(David 6:61 to 7:13).

*Principles of Law*

The Examiner bears the initial burden of establishing a prima facie case of anticipation. *In re King*, 801 F.2d 1324, 1326–27 (Fed. Cir. 1986). Anticipation under 35 U.S.C. § 102 requires that “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

*Analysis*

We adopt the Examiner’s findings regarding the scope and content of the prior art (Final Act. 2; FF 1–2) and agree that the claimed apparatus is anticipated by David.

Appellants contend “David fails to teach or suggest ‘a bone fixation plate for pelvic osteotomy,’ as recited in claim 1. Rather, David discloses a bone transfixion plate for transfixing an acetabulum fragment to the os ilium in a human patient” (App. Br. 4; *cf.* Reply Br. 3 “the recitation of the claims make clear that the plate is structured for use [in] quadrapedal animals such as dogs and cats and is not for humans.”).

We find this argument unpersuasive because the language “bone fixation plate for pelvic osteotomy” represents an intended use recitation that does not structurally distinguish the device of David. That is, whether the

device of David is intended for use in humans or quadrupedal animals, the issue is whether the devices differ in structure, not intended use.

“[A]pparatus claims cover what a device *is*, not what a device *does*.”

*Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990). Merely stating an intended use for an apparatus is not sufficient to distinguish the apparatus from the prior art. That is, all that is reasonably required by claim 1 is a fixation plate with planes angled and laterally offset with openings in the first and second portions, while the intended use for pelvic osteotomy does not impose any structural limitations on the bone fixation plate itself.

Appellants cite *Ex parte Masham*, 2 USPQ2d 1647 (BPAI 1987) for the proposition that there is a requirement that “the reference is capable of performing the claim limitation” and contend that “the structure of these plates is different from the claimed bone plate and the plate of David is not capable of use for pelvic osteotomy as claimed” (App. Br. 5).

We find this argument unpersuasive because the “osteotomy” limitation is an intended use, not a structural limitation as discussed above. Even if we treated this functional recitation as having some structural consequence, *Schreiber* teaches that writing a claim that mixes structural and functional limitations comes at a price. *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997). (“[C]hoosing to define an element functionally, *i.e.*, by what it does, carries with it a risk.”). The price is that when the structural limitations are met by a single prior art reference, and when the examiner “has reason to believe” that the prior art reference inherently teaches the functional limitation, the burden shifts to the patent applicant to show that

the functional limitation cannot be met by the single prior art reference. *Id.* See also *In re Best*, 562 F.2d 1252, 1254–55 (CCPA 1977) (“[W]here the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.”)

Here, the Examiner finds the “device of David is specifically disclosed to be used for pelvic osteotomies (Abstract) and specifically after triple osteotomies” (Ans. 2). Appellants provide no evidence rebutting this position, only argument. See *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974) (“Attorney’s argument in a brief cannot take the place of evidence.”).

Appellants contend “bone transfixion plate configured for human use would not have structure suitable for use in the shallow acetabulum found in the immature dogs and cats on which this procedure is performed” (App. Br. 6).

We find this argument unpersuasive for the same reasons as already given. Appellants do not identify any specific structural difference recited in claim 1 other than a “configured to be positioned over the ilial shaft” and this recitation imposes no specific structure on the fixation plate, but rather encompasses any structure that has the capacity for positioning over the ilial shaft. In particular, Appellants provide no evidence rebutting the Examiner’s findings regarding the suitability of the David device for treatment of animals or for positioning over the ilial shaft (*see* Ans. 2–3),



only attorney argument. “Attorney argument is not evidence.” *Icon Health and Fitness, Inc. v. Strava, Inc.*, 849 F.3d 1034, 1043 (Fed. Cir. 2017).

Appellants, in the Reply Brief, newly argue that “David fails to disclose that the first body portion is laterally offset from the second body portion in any way. Rather, David simply states that there is a wedge-shaped zone 3 that rotates regions 1 and 2 of the plate away from each other” (Reply Br. 4).

We find this argument unpersuasive because Figure 4d clearly shows a lateral offset between regions 1 and 2 as expressly found by the Examiner “the first plane is angled relative to the second plane and laterally offset (Figure 4D)” (Final Act. 2). Appellants provide no evidence explaining why this lateral offset discussed by the Examiner does not satisfy the structural recitation required by claim 1.

#### *Conclusion of Law*

The evidence of record supports the Examiner’s conclusion that David anticipates claim 1.

#### *B. 35 U.S.C. § 103(a) over David and Bruecker*

Appellants do not separately argue the claims in this obviousness rejection, instead relying upon their arguments to overcome David, which we found unpersuasive as discussed above. The Examiner provides sound fact-based reasoning for combining David and Bruecker (*see* Final Act. 4). Having affirmed the anticipation rejection of claim 1 over David for the reasons given above, we also find that the further obvious combination with

Bruecker renders claims 2, 18, and 19 obvious for the reasons given by the Examiner.

#### SUMMARY

In summary, we affirm the rejection of claim 1 under 35 U.S.C. § 102(b) as anticipated by David. Claims 3–8, 12, and 13 were not separately argued and fall with claim 1.

We affirm the rejection of claims 2, 18, and 19 under 35 U.S.C. § 103(a) as obvious over David and Bruecker.

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

AFFIRMED