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PATTERSON THUENTE PEDERSEN, P.A. 80 SOUTH 8TH STREET 4800 IDS CENTER MINNEAPOLIS, MN 55402-2100			WEHNER, CARY ELLEN	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DEPUY ORTHOPAEDICS, INC.
Requester

v.

PUGET BIO VENTURES LLC¹
Patent Owner

Appeal 2016-007696
Reexamination Control 95/002,152
Patent US 7,967,822 B2²
Technology Center 3900

Before DANIEL S. SONG, RAE LYNN P. GUEST, and BRETT C.
MARTIN, *Administrative Patent Judges*.

MARTIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Patent Owner/Appellant appeals under 35 U.S.C. §§ 134(b) and 315 from the Examiner's rejection of claims 1–27, of which claims 1–8, 14, and 15 are independent. Third Party Requester/Cross-Appellant appeals under 35 U.S.C. §§ 134(c) and 315 the non-adoption of certain rejections under

¹ Formerly Hudson Surgical Design, Inc. (Rebuttal Brief, App. C)

² Issued to Haines et al. on June 28, 2011 (hereinafter the '822 patent).

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35 U.S.C. § 112 relating to claims that were amended during the reexamination prosecution.³ Oral arguments were presented in this case on November 16, 2016, a transcript of which will be entered in due course. We have jurisdiction under 35 U.S.C. §§ 134 and 315.

The '882 patent is related to its parent patent U.S. Patent No. 7,344,541, which was the subject of Appeal No. 2014-001731, decided on rehearing on December 2, 2014. The '822 patent is also currently involved in the following related proceedings:

Hudson Surgical Design, Inc. v. Biomet Orthopedics, LLC and Biomet Manufacturing Corporation, Case No. 3:10-CV-00465-PPS-CAN, N.D. Ind., stayed pending the result of the present reexamination;

Hudson Surgical Design, Inc. v. Depuy Orthopaedics, Inc., Case No. 3:10-CV-00463-HD-CAN, N.D. Ind., stayed pending the result of the present reexamination;

Hudson Surgical Design, Inc. v. Zimmer Holdings, Inc., Zimmer, Inc., Rush System for Health and Rush University Medical Center, Civil Action No. 08-CV-01566, N.D. Ill., dismissed with prejudice; and

Hudson Surgical Design, Inc. v. Smith & Nephew, Inc., Case No. 2:11-cv-01371, W.D. Wash., dismissed with prejudice.

³ By way of a terminal disclaimer to its parent patent, which has already expired, the present patent has also expired. Because claims of an expired patent cannot be amended, arguments related to the amended claims are moot and need not be addressed. Furthermore, the Patent Owner has withdrawn claims 3, 4, 7, 8, and 9–13 from this appeal, thus also mooting the Requester's cross-appeal. PO Reb. Br. 1.

THE INVENTION

The '882 patent is directed generally to “methods and apparatus for orthopedic surgical navigation and alignment techniques and instruments.” Spec. col. 1, ll. 34–36. Claims 1 and 5, reproduced below, are illustrative of the claimed subject matter:

1. A method for a total knee arthroplasty procedure comprising:

positioning a cutting guide in a position proximate an end of one of a femur or a tibia of a knee joint and adjacent one of a medial portion or a lateral portion of the one of the femur or the tibia, the cutting guide including a slot adapted to receive and guide an oscillating saw blade, the slot extending to less than about one-half of a mediolateral width of a surface to be resected across the end of the one of the femur or the tibia, the oscillating saw blade having at least one cutting edge at a distal end of a long axis of the saw blade;

cutting the end of the one of the femur or the tibia by plunging the saw blade through the slot to create at least a portion of at least one resected surface across both the medial portion and the lateral portion of the one of the femur or the tibia; and

implanting a total knee arthroplasty implant on the at least one resected surface.

5. A method for performing a total knee arthroplasty procedure on a knee joint in a patient's body comprising:

positioning a cutting guide having at least one guide surface adapted to guide an oscillating saw blade proximate an end portion of one long bone of the knee joint, the cutting guide having opposite medial and lateral ends which are spaced apart by a first distance;

moving the oscillating saw blade into engagement with the one long bone at the knee joint;

cutting the one long bone at the knee joint with the oscillating saw blade by moving the oscillating saw blade along the guide surface on the cutting guide and cutting bone to form a

cut surface which extends across the end portion of the one long bone a maximum of a second distance in a generally mediolateral direction parallel to a longitudinal central axis of the guide surface which is more than half again as long as the first distance of the cutting guide between the opposite medial and lateral ends; and

positioning a total knee arthroplasty implant into engagement with the cut surface.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Woolson	US 4,841,975	June 27, 1989
Samuelson	US 5,611,802	Mar. 18, 1997
Laboureau	FR 2,635,675 A1	Mar. 2, 1990
IMPACT	EP 0 538 152 A1	Apr. 21, 1993
Bosquet	FR 2,664,157 A1	Jan. 10, 1992

Mark II Total Knee Replacement System by Protek ("Mark II") (1985).

F/S Modular Total Knee Replacement System by Protek ("Protek") (1991).

REJECTIONS

The Examiner made the following rejections:

Claims 3–27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over IMPACT and additional references. PO App. Br. 6.

Claims 1, 2, 16–23, 25, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Laboureau and other references. *Id.*

Claims 1, 2, 16–23, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bosquet and other references. *Id.*

Claims 1, 2, 5, 6, and 14–27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Protek and other references. *Id.*

Claims 1, 2, 5, 6, and 14–27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mark II and other references. *Id.*

Claims 1, 2, 14–23, 25, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Samuelson and other references. *Id.*

Claims 1, 2, 16–23, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Woolson and other references. *Id.* at 7.

ANALYSIS

The Dual Guide References

Independent claims 1 and 2 as well as various combinations of independent claims 5, 6, 14, and 15 each stand rejected over one of Laboureau, Bosquet, Protek, Mark II, Samuelson, and Woolson along with other additional references. Samuelson, Woolson, Protek, and Mark II were each references discussed in the Reexamination Decision in Appeal 2014-001731. Laboureau and Bosquet are references similar to those discussed in the prior Decision. All six references disclose cutting guides that have cutting slots placed on both sides of the bone, also referred to as “dual guides,” for cuts to be made on the bone from the guide located along the adjacent side. In other words, each guide includes a medial guide and a lateral guide and are intended to be used to make a first cut generally on the lateral side using the lateral guide and to make a second cut on the medial side using the medial guide.

Although the language in the present claims does not mirror identically the language from the parent case, we conclude that each of the independent claims at issue in these rejections warrants treatment similar to

that of claims 35–38 and 49–52 of the parent case. For example, as stated in claim 1, “the slot extend[s] to less than about one-half of a mediolateral width of a surface to be resected across the end of the one of the femur or the tibia.” Additionally, the method requires “plunging the saw blade through the slot to create at least a portion of at least one resected surface across both the medial portion and the lateral portion of the one of the femur or the tibia.” Taken together, we understand these recitations to require both positioning a cutting guide only on one side of the bone and cutting through the guide on both the medial and lateral sides of the bone to create a resected surface. As with the parent patent, we do not agree that any of the dual guide prior art references disclose both the positioning and cutting requirements of the method claimed.

The Requester argues that our prior Decision reversing certain claim rejections was limited to claims that require a complete resection and that the present claims do not require such complete resection. Req. Reb. Br. 3–4. We disagree. While we did discuss a complete resection in the claims at issue in the prior Decision, such was predicated upon claim language that is similar to language found in the present case. For example, the above noted language of claim 1, as did claim 35 in the prior Decision, recites a cutting step that includes cutting both the medial and lateral sides of the bone. Requester further characterizes the Patent Owner’s arguments as suggesting that claim language found in the present claims likewise requires a complete resection, “Owner represents that the cutting step in claims 1–2 requires producing ‘a resected surface across both the medial portion and the lateral portion of the femur or tibia’ in an attempt to argue the claim requires

complete resection of the bone.” Req. Reb. Br. 4. We do not read the claims as requiring a complete resection, but merely that the claimed portion that is resected occurs across both the medial and lateral portions of the bone and is more than simply passing across the centerline from one side to the other, which is not explicitly taught in the prior art at issue.

Similarly with regard to claim 5 (and claim 6), although not using the same language, we also conclude that the language,

cutting bone to form a cut surface which extends across the end portion of the one long bone a maximum of a second distance in a generally mediolateral direction parallel to a longitudinal central axis of the guide surface which is more than half again as long as the first distance of the cutting guide between the opposite medial and lateral ends

requires cutting using a single guide to create a resected surface across the bone that is a distance more than merely across the centerline from one side to the other. As stated above, the prior art dual guides at issue may allow for some marginal cutting across a center line, but cutting “more than half again as long as the first distance of the cutting guide” as required by the claims is not explicitly taught or suggested by the references. Likewise, claims 14 and 15 require that the cutting blade be used to cut into the lateral half of the bone while only being guided by a guide from the medial half, thus precluding the application of the dual guides at issue. As such, we do not sustain the Examiner’s rejections of the claims over any of Laboureau, Bosquet, Protek, Mark II, Samuelson, and Woolson. None of the secondary references cures this deficiency.

IMPACT

The lone remaining reference is the IMPACT reference, which the Examiner uses to reject claims 3–27. Rather than being a cutting guide that is placed on the bone either medially or laterally (or both), IMPACT discloses a cutting guide that is placed either posteriorly or anteriorly and then a cut may be made across some or all of both the medial or lateral sides. As the Patent Owner states, “IMPACT provides no explicit disclosure as to how its guide is sized or dimensioned relative to the mediolateral width of the tibia.” PO App. Br. 27–28. The only figure contained in IMPACT showing the pertinent aspects of the guide shows the guide by itself without any placement next to a bone.

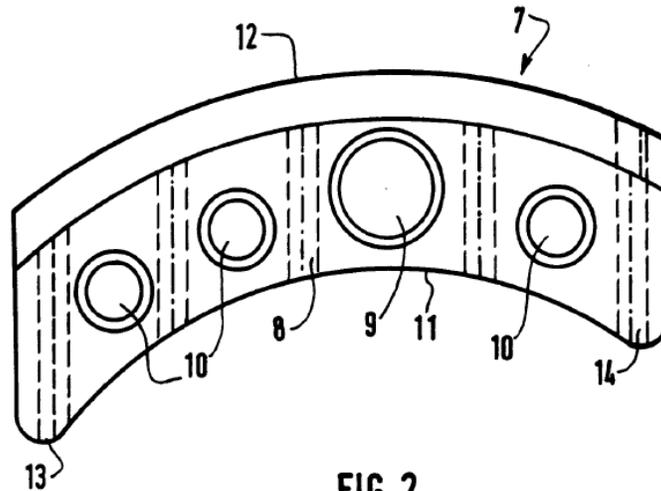
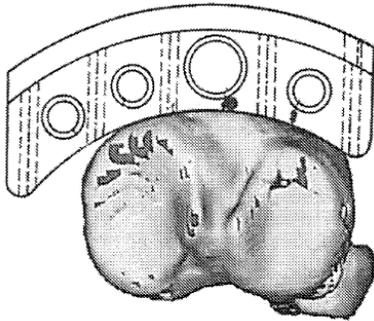


FIG. 2

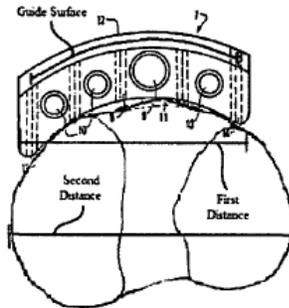
The figure above is Figure 2 from the IMPACT patent application showing a plan view of the cutting guide.

Both parties have included their own depictions of how the guide would be sized and placed next to a bone for use in a cutting procedure similar to the claims, but neither is particularly helpful because as is shown

below, each side has very different understanding as to how the guide would be sized.



Modified Figure 2 of IMPACT



Modified Figure 2 of IMPACT, with tibia added by Requester

The figures above depict the Patent Owner's and the Requester's versions of the sizing of the IMPACT cutting guide in relation to a tibia.

The Requester has shown the guide as not extending past either side of the tibia. This seems illogical because the cuts made for these resections usually start at either the lateral or the medial side and cut across the bone. In practice, the Requester's version would require first plunging the cutting blade into the top of the bone and working out to either the medial or lateral side. The Patent Owner's version allows for a blade to start at one side by extending past the medial side, but then extends along the entirety of the bone to the opposing lateral side. This sizing also seems unnecessarily large as the guide would not necessarily be required to extend all the way to the lateral side to complete a cut through the lateral side to the extent required by the claims. Regardless, we find it unnecessary to credit either depiction as accurate because the varied interpretations merely lead us to conclude that no proper sizing or positioning may be determined based upon the limited disclosure in IMPACT, which does not explain any actual procedure for use

of the device. IMPACT is simply too ambiguous as to sizing and positioning to meaningfully apply it to the claim language at issue.

Regarding claims 14 and 15, we also agree with the Patent Owner that “[t]here is no basis whatsoever in IMPACT for a teaching of using only a guide surface on one half of the bone to cut across to the other half of the bone.” PO App. Br. 30; *see also* Miller Dec. 27–29. Despite the Requester’s attempts to argue to the contrary, given that even in their most favorable depiction, the IMPACT guide extends across most of the bone, we see no basis to conclude that a surgeon would angle the blade as suggested and avoid an entire section of the guide simply to cut as the claims require. The much more logical manner of use would be to use as much of the guide as possible and as close to the area being cut, thus, using a portion of the guide that is excluded by the claims. As such, we do not sustain the Examiner’s rejections of claims 14 and 15 based upon IMPACT. None of the secondary references cures the deficiencies related to IMPACT and, thus, the rejections of all dependent claims also fails.

DECISION

For the above reasons, we REVERSE the Examiner’s decision to reject claims 1, 2, 5, 6, and 14–27.

Requests for extensions of time in this *inter partes* reexamination proceeding are governed by 37 C.F.R. §§ 1.956 and 41.77(g).

In the event neither party files a request for rehearing within the time provided in 37 C.F.R. § 41.79, and this decision becomes final and appealable under 37 C.F.R. § 41.81, a party seeking judicial review must

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timely serve notice on the Director of the United States Patent and Trademark Office. *See* 37 C.F.R. §§ 90.1 and 1.983.

REVERSED

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