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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
13/998,567 11/12/2013 Steven C. Chudik 5181-1011.1 1569

7590 01/29/2019
Gregory B. Beggs
Brookdale Lisle # 372
1700 Robin Lane
Lisle, IL 60532

EXAMINER

PELLEGRINO, BRIAN E

ART UNIT PAPER NUMBER

3774

MAIL DATE DELIVERY MODE

01/29/2019

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEVEN C. CHUDIK

Appeal 2018-001997
Application 13/998,567
Technology Center 3700

Before DANIEL S. SONG, JEREMY M. PLENZLER, and
NATHAN A. ENGELS, *Administrative Patent Judges*.

PLENZLER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134(a) of the Examiner's Decision rejecting claims 1–7, 10, 11, and 36. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

CLAIMED SUBJECT MATTER

Claims 1 and 36 are independent. Claims 2–7 depend from claim 1 and claims 10 and 11 depend from claim 36. Claim 1 is reproduced below:

1. A cortical loop comprising
a central portion configured to engage a bundle of soft tissue and capture the bundle against a bone surface, and
attachment ends configured to engage a cortical surface of the bone at separate locations on the bone.

REJECTIONS

1. Claim 6 is rejected under 35 U.S.C. § 112(a) as failing to comply with the enablement requirement.
2. Claims 1–7 and 36 are rejected under 35 U.S.C. § 102(a)(2) as being anticipated by McKay (US 2014/0072934 A1, published Mar. 13, 2014).
3. Claims 10 and 11 are rejected under 35 U.S.C. § 103 as being unpatentable over McKay.

OPINION

Enablement

Claim 6 depends from claim 1 and recites that “[t]he cortical loop of claim 1 . . . is configured to engage the cortical surface without anchors in the bone.” The Examiner rejects claim 6 under 35 U.S.C. § 112(a) as failing to comply with the enablement requirement. The Examiner asserts that Appellant “never states how the attachment ends are configured to attach the graft to the ligament sites without drilling into the bone.” Non-Final Act. 2.

When rejecting a claim for lack of enablement, the USPTO bears an initial burden of setting forth a reasonable explanation as to why the

Examiner believes that the scope of protection provided by the claim is not adequately enabled. *In re Wright*, 999 F.2d 1557, 1561–62 (Fed. Cir. 1993).

Although Appellant does not identify any particular disclosure of attachment from the Specification, Appellant responds that the specific attachment is known “based upon an assumed level of expertise possessed by persons skilled in the art of orthopedic surgery.” Appeal Br. 18. The Examiner identifies manners in which the attachment ends are configured to engage the cortical bone, and Appellant agrees. *See* Non-Final Act. 2 (identifying potential “attach[ment] via sutures, knots, etc.”); Appeal Br. 18 (agreeing with the Examiner’s identification of “sutures, knots, etc.”). These are the same structures noted by the Examiner and Appellant during prosecution as providing the attachment between the “attachment ends” and “cortical surface of the bone.” *See* Pages 9–10 of the Response filed Feb. 2, 2016. Appellant also notes that attachment may be accomplished via “winding another suture around the bone and over an attachment end, gluing the end to the bone, or a clip.” Appeal Br. 18.

The Examiner asserts that “Appellant fails to indicate and explain how the claimed configuration is accomplished [based on any disclosure in the Specification] and thus cannot rely on what may be known in the art when such a description was not in the [S]pecification.” Ans. 9–10. A patent need not disclose what is well known in the art. *In re Wands*, 858 F.2d 731, 735 (Fed. Cir. 1988). The Examiner does not dispute that the exemplary ways to attach without anchors in the bone identified by Appellant are well known in the art, and fails to offer sufficient explanation as to why the broad disclosure of “engag[ing] the cortical surface without anchors in the bone” is insufficient for enablement of claim 6. The Examiner makes no attempt, for

example, to explain why it would require undue experimentation for one of ordinary skill in the art to make and/or use the invention. *See In re Wands*, 858 F.2d at 737.

Based on the record before us, the Examiner has failed to establish that the features recited in claim 6 are not enabled.

Anticipation

The Examiner finds that McKay discloses each limitation of independent claims 1 and 36, including a “central portion [of the cortical loop] configured to engage a bundle of soft tissue and capture the bundle against a bone surface.” Non-Final Act. 3.

The problem with the Examiner’s finding, which Appellant identifies (*see* Appeal Br. 15), is that the Examiner has failed to establish sufficiently that McKay’s barrier 18 “engage[s] a bundle of soft tissue and capture[s] the bundle against a bone surface” as required by the claims. McKay describes barrier 18 as simply being a “device that shields . . . the periodontal defect from material that slows healing of the periodontal defect.” McKay ¶ 36. Barrier 18 is a “sheet that is configured to reduce an amount of material from entering into the periodontal defect.” *Id.* Barrier 18 “prevents saliva, other liquids, food, bacteria and/or other material that slows healing of the periodontal defect.” *Id.* ¶ 37. The Examiner fails to explain sufficiently, and it is not apparent to us, how or why barrier 18 “engage[s] . . . and capture[s]” the gingival tissue against the tooth surface. The Examiner simply asserts, without meaningful explanation, that McKay’s barrier 18 “engage[s]” and “capture[s]” in the manner recited in the claims. *See* Final Act. 3; Ans. 8.

For at least this reason, we do not sustain the Examiner's decision to reject claims 1–7 and 36 as being anticipated by McKay.

Obviousness

Claims 10 and 11 depend from claim 36. The stated basis for the rejection of claims 10 and 11 does not cure the deficiency in the rejection of claim 36 noted above. Accordingly, we also do not sustain the Examiner's decision to reject claims 10 and 11.

DECISION

We REVERSE the Examiner's decision to reject to reject claim 6 under 35 U.S.C. § 112(a) as failing to comply with the enablement requirement.

We REVERSE the Examiner's decision to reject claims 1–7 and 36 as unpatentable under 35 U.S.C. § 102(a)(2).

We REVERSE the Examiner's decision to reject claims 10 and 11 as unpatentable under 35 U.S.C. § 103.

REVERSED