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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RALPH JOHAN BERNHARD SAKKERS,
ALEIDA JOHANNA VAN DER WAL,
JORIS EMANUEL NICOLAAS JASPERS, and
PETER TIMO DIJKSTRA

Appeal 2018-003259
Application 12/601,899
Technology Center 3700

Before JENNIFER D. BAHR, MICHELLE R. OSINSKI, and
BRANDON J. WARNER, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Ralph Johan Bernhard Sakkers et al. (Appellants)¹ appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 18–32, 34–36, 38, and 39. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

¹ According to Appellants, the real party in interest is UMC Utrecht Holding B.V. Appeal Br. 3.

THE CLAIMED SUBJECT MATTER

Claim 18, reproduced below, is illustrative of the claimed subject matter.

18. A system for correcting bones, comprising:

at least a first pin which is configured to be connected to the bone at a first location;

at least a second pin which is configured to be connected to the bone at a second location at a distance from the first location;

a fixation member which is coupled rigidly to the first and second pins for the purpose of fixing the mutual distance between the pins during a hardening phase, and which is coupled flexibly to the first and the second pins during a correction phase;

at least a first annular fixation member which is connected to the first pin and at least a second annular fixation member which is connected to the second pin so that the mutual distance and/or orientation between the first and second annular fixation members can be adjusted while the fixation member remains coupled to the first pin and the second pin during the correction phase,

wherein the fixation member is configured to remain attached to the first pin and the second pin when the first annular fixation member and the second annular fixation member are removed during the hardening phase.

REJECTIONS

- I. Claims 18–23, 30, 31, 35, and 38 stand rejected under 35 U.S.C. § 102(b) as anticipated by Tasic (US 5,928,230, iss. July 27, 1999).
- II. Claims 18 and 24–26 stand rejected under 35 U.S.C. § 102(e) as anticipated by Stevens (US 2006/0184169 A1, pub. Aug. 17, 2006).

- III. Claims 18, 27–31, and 36 stand rejected under 35 U.S.C. § 102(b) as anticipated by Taylor (US 5,702,389, iss. Dec. 30, 1997).
- IV. Claims 32, 34, and 39 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Tosic and Kim (US 2004/0073212 A1, pub. Apr. 15, 2004).²

DISCUSSION

Rejection I

Independent claim 18 recites, in relevant part, that “the fixation member is *configured to remain attached to the first pin and the second pin when the first annular fixation member and the second annular fixation member are removed* during the hardening phase.” Appeal Br. 21 (Claims App.) (emphasis added). Appellants argue that Tosic fails to disclose this feature. *See id.* at 10–13; Reply Br. 2–5. In particular, Appellants assert that, with respect to the present invention, “[i]n the hardening phase, the fixation rings (5a, 5b) and tube system (3) are removed, and a fixation tube (6) is fixed in place. During the hardening phase, the pins (4a, 4b) remain connected to the bone to hold the bone in the desired position during calcification.” Appeal Br. 12–13. According to Appellants, Tosic “does not include pins and a fixation member configured to be positioned in this manner.” *Id.* at 13. For the reasons that follow, we agree with Appellants that the Examiner’s rejection is in error.

² Although the Examiner omits claim 39 from the statement of the rejection (*see* Final Act. 10), the Examiner addresses this claim in the detailed explanation of the rejection (*see id.* at 12). *See also* Ans. 10 (including claim 39 in the statement of the rejection in the Answer).

The Examiner finds that Tasic discloses, in relevant part, a fixation member (28) which is coupled rigidly to the first and second pins [(24)] for the purpose of fixing the mutual distance between the pins during a hardening phase, and . . . at least a first annular fixation member (14) which is connected to the first pin and at least a second annular fixation member (14) which is connected to the second pin[,] . . . wherein the fixation member is configured to remain attached to the first pin and the second pin when the first annular fixation member and the second annular fixation member are removed during the hardening phase.

Final Act. 2–3 (citing Tasic, col. 8, ll. 36–59). The Examiner takes the position that “one could remove the entire system of rings, pins and fixation members from the bone, *while each of the systems components remains attached to one another.*” *Id.* at 3 (emphasis added); *see also id.* (including annotated reproduction of Figure 31 of Tasic). However, the Examiner does not explain, nor is it apparent, how Tasic’s system could be removed from a patient’s bone while the fixation member, annular fixation members, and pins remain attached to one another.

In Appellants’ disclosed system, the structure that allows the fixation member (fixation tube 6) to remain attached to the pins (4a, 4b) when the annular fixation members (fixation rings 5a, 5b) are removed is an attachment between fixation member 6 and pins 4a and 4b that is independent of the annular fixation members. *See Spec. 10, ll. 29–34; Figs. 1, 5.* In other words, given the disclosure of the Specification, the claimed fixation member being “configured to remain attached to” the pins when the annular fixation members are removed requires an attachment between the fixation member and the pins that does not rely on the annular fixation members.

In Tusic’s system, in the Figure 31 embodiment comprising first and second annular fixation members, the fixation member (LCD bar 28) attaches to annular fixation members (ring members 14), which attach to pins (screws or pins 24, or wires 26). *See* Tusic, Fig. 31; col. 10, ll. 24–29. In other words, Tusic’s LCD bar 28 and pins are attached together *only via* ring members 14, and there is no independent attachment between LCD bar 28 and the pins.³ Given that the connection between LCD bar 28 and the pins appears to rely on ring members 14, we fail to see how Tusic’s LCD bar 28 could remain attached to the pins when ring members 14 are removed. The Examiner does not adequately explain how the entire system could be removed without detaching these elements from each other. *See* Final Act. 3; Ans. 16. Thus, the Examiner’s finding that Tusic discloses a fixation member “configured to remain attached to” the pins when the annular fixation members are removed (*see* Final Act. 2–3) lacks adequate evidentiary support.

For at least the above reasons, the Examiner fails to establish by a preponderance of the evidence that Tusic anticipates the subject matter of claim 18. Accordingly, we do not sustain the rejection of claim 18, or its dependent claims 19–23, 30, 31, 35, and 38, under 35 U.S.C. § 102(b) as anticipated by Tusic.

³ The Examiner alludes to Tusic’s Figure 1 embodiment, in which a fixation member (LCD bar 28) is attached at its lower end to screw or pin 24, independently of the annular fixation member (ring member 14), via extension finger 18. Ans. 21. However, this embodiment includes only one annular fixation member (ring member 14), not first and second annular fixation members, as required in independent claim 18.

Rejection II

In this rejection of claim 18, the Examiner finds that Stevens discloses, in relevant part,

a fixation member (20') which is coupled rigidly to the first and second pins [(12)] for the purpose of fixing the mutual distance between the pins during a hardening phase (see fig. 7a), and which is coupled flexibly to the first and the second pins during a correction phase (see fig. 7a); at least a first annular fixation member (16) which is connected to the first pin and at least a second annular fixation member (16) which is (indirectly) connected to the second pin . . . , wherein the fixation member is configured to remain attached to the first pin and the second pin when the first annular fixation member and the second annular fixation member are removed during the hardening phase.

Final Act. 5–6 (citing Stevens ¶ 50 and an annotated reproduction of Figure 7a of Stevens appearing on page 6 of the Final Action).

Appellants argue that,

at best, Stevens discloses that the first and second pins (12) are connected to the respective fixing blocks (20, 20'). While fixing blocks (20, 20') may be connected to one another and to the alleged annular fixation member (frame (16)), *Stevens fails to disclose that the pins (12) are connected to the frame (16) as specified by the present claims.*

Appeal Br. 14 (emphasis added). This argument is not persuasive.

To the extent that Appellants appear to argue that Stevens must disclose a *direct* connection between pins 12 and frame 16, such an argument is unpersuasive because it is not commensurate with the scope of claim 18, which does not require a direct connection between the pins and the annular fixation members. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) (noting that it is well established that limitations not appearing in the claims cannot be relied upon for patentability). Instead, claim 18 only

recites, in relevant part, “at least a first annular fixation member which is connected to the first pin and at least a second annular fixation member which is connected to the second pin.” Appeal Br. 21 (Claims App.). As discussed above, the Examiner finds that Stevens discloses an indirect connection between frame 16 and pins 12. *See* Final Act. 5; *see also* Ans. 18 (explaining that Appellants’ “bone correction system *also* relies on an indirect connection between the pins and fixation rings”). Appellants do not specifically address the Examiner’s position that Stevens’s indirect connection meets the disputed limitation or explain why it is deficient.

Appellants argue that the connection between Stevens’s pins 12 and fixation member (blocks 20, 20') does not allow the fixation member to remain attached to the pins when the annular fixation members (frame 16) are removed. Appeal Br. 14; *see also id.* at 13 (asserting that “Stevens suffers from the same deficiencies as Tonic”). In particular, Appellants assert that, “once the ‘entire system (rings, pins and fixation member)’ is removed, the bone would no longer be in a hardening phase.” *Id.* at 14 (quoting Final Act. 7). We are not persuaded by this argument.

Although the Examiner takes the position that the entire system of Stevens could be removed from the bone while the fixation member remains attached to the pins (*see* Final Act. 7), claim 18 only requires that the fixation member is configured to remain attached to the pins when the *annular fixation members* are removed (*see* Appeal Br. 21 (Claims App.)). As discussed above in connection with Rejection I of claim 18 based on Tonic, the claimed fixation member being “configured to remain attached to” the pins when the annular fixation members are removed requires an attachment between the fixation member and the pins that is independent of

the annular fixation members. Here, in contrast to Tasic, Stevens discloses such an attachment.

In particular, Stevens discloses, with reference to Figure 7a, that “any combination of fixing blocks 20 and/or fixing blocks 20', 20", 20''' can be vertically mounted or stacked together on frame 16.” Stevens ¶ 48 (boldface omitted). Stevens also discloses that “the fixing block[s] can be stacked so that two or more bone pins 12 can be mounted to the stacked fixing blocks so as to optimize bone pin placement and orientation.” *Id.* (boldface omitted). In other words, Stevens discloses that a stack of blocks 20 (fixation member) can be attached to pins 12 independently of frame 16 (annular fixation member), such that frame 16 can be removed without having to detach blocks 20 from pins 12. Thus, a preponderance of the evidence supports the Examiner’s finding that Stevens discloses a fixation member that is “configured to remain attached to” the pins when the annular fixation members are removed. *See* Final Act. 6.

For the above reasons, Appellants fail to apprise us of error in the Examiner’s finding that Stevens anticipates the subject matter of claim 18. Accordingly, we sustain the rejection of claim 18, and its dependent claims 24–26, for which Appellants rely on the same arguments (*see* Appeal Br. 14), under 35 U.S.C. § 102(e) as anticipated by Stevens.

Rejection III

In this rejection of claim 18, the Examiner finds that Taylor discloses, in relevant part, “a fixation member (53) . . . configured to remain attached to the first pin [(73)] and the second pin [(73)] when the first annular fixation member and the second annular fixation member are removed

during the hardening phase.” Final Act. 8 (citing Taylor, Fig. 1). Appellants argue that this rejection is in error because “Taylor suffers from the same deficiencies as Tonic discussed [in connection with Rejection I].” Appeal Br. 15. We agree with Appellants.

Taylor discloses that adjustable strut 53 (fixation member) attaches to rings 71 (annular fixation members), which are fixed to pins 73 using clamps 77. *See* Taylor, Fig. 1; col. 10, ll. 11–12, 42–46. In other words, the connection between strut 53 and pins 73 relies on rings 71, and there is no connection between strut 53 and pins 73 that is independent of rings 71. As is the case with Tonic, discussed above, removing Taylor’s annular fixation members (rings 71) would detach the fixation member (strut 53) from the pins (73). Consequently, the Examiner’s finding that Taylor discloses a fixation member that is “configured to remain attached to” the pins when the annular fixation members are removed (*see* Final Act. 8) lacks adequate evidentiary support.

For at least the above reasons, the Examiner fails to establish by a preponderance of the evidence that Taylor anticipates the subject matter of claim 18. Accordingly, we do not sustain the rejection of claim 18, or its dependent claims 27–31 and 36, under 35 U.S.C. § 102(b) as anticipated by Taylor.

Rejection IV

The Examiner’s rejection of independent claim 32 suffers from the same deficiency discussed above in connection with Rejection I. Namely, the rejection is predicated on an unsupported finding that Tonic’s annular fixation members (ring members 14) could be removed while the fixation

member (LCD bar 28) remains coupled to the pins. *See* Final Act. 11; Ans. 21. The Examiner’s position that a “user [could] remove the rings [of Tonic] from the fixation member 28 by loosening coupling assemblies 20 while leaving pins 24 attached to the bone and fixation member 28 via extension fingers 18” (Ans. 21) is not supported by any evidence of record, and, instead, appears to be based upon a speculative assumption that simply loosening the coupling assemblies would allow the entire fixator system to be removed from a patient without detaching any of the components. Such speculation is insufficient to support an obviousness conclusion. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967) (Rejections based on obviousness must rest on a factual basis; in making such a rejection, the Examiner has the initial burden of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions, or hindsight reconstruction to supply deficiencies in the factual basis.).

Accordingly, based on the record before us, the Examiner has not met the burden of establishing a proper case that independent claim 32 is unpatentable based on the cited references. On this basis, we do not sustain the rejection of claim 32, or its dependent claims 34 and 39, under 35 U.S.C. § 103(a) as unpatentable over Tonic and Kim.

DECISION

The Examiner’s decision rejecting claims 18–23, 30, 31, 35, and 38 under 35 U.S.C. § 102(b) as anticipated by Tonic is REVERSED.

The Examiner’s decision rejecting claims 18 and 24–26 under 35 U.S.C. § 102(e) as anticipated by Stevens is AFFIRMED.

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The Examiner's decision rejecting claims 18, 27–31, and 36 under 35 U.S.C. § 102(b) as anticipated by Taylor is REVERSED.

The Examiner's decision rejecting claims 32, 34, and 39 under 35 U.S.C. § 103(a) as unpatentable over Tosic and Kim is REVERSED.

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).

AFFIRMED-IN-PART