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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROQUE HUMBERTO IRIGOYEN FERREYRO and
MARIO MARQUEZ MIRANDA

Appeal 2018-006313
Application 14/929,628
Technology Center 3700

Before JOHN C. KERINS, WILLIAM A. CAPP, and
GEORGE R. HOSKINS, *Administrative Patent Judges*.

HOSKINS, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 6–15² in this application. The Board has jurisdiction over the appeal under 35 U.S.C. § 6(b).

A hearing was held on March 4, 2020. *See* Transcript (entered Mar. 18, 2020) (“Tr.”).

We REVERSE.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies DePuy Synthes Products, Inc. as the real party in interest. Appeal Br. 1.

² Claims 1–5 are canceled. *See* Appeal Br. (Claims App.).

CLAIMED SUBJECT MATTER

Claim 6 is the sole independent claim on appeal, and it recites, with our emphasis added:

6. A device for delivering a viscous bone cement material under fluoroscopy to a site in a patient, comprising:

an injection part for placement next to a patient *having a chamber loaded with viscous bone cement* prior to the viscous bone cement having set, an exit port connected to a bone needle, and a plunger that pushes the viscous bone cement through the exit port for injection into a vertebral body;

a hollow pressure part having a closed hydraulic space for transmitting pressure to the plunger;

a hydraulic pressure generator containing enough volume of an incompressible fluid to impel the plunger of the injection part to deposit the required quantity of viscous bone cement in the vertebral body; and

a hydraulic tube for pressure transmission connecting the hydraulic pressure generator to the pressure part;

wherein the hydraulic tube connecting the hydraulic pressure generator to the pressure part facilitates the generation of hydraulic pressure from a location outside a field of fluoroscopic imaging of the patient so that a flow of viscous bone cement can be hydraulically driven through the exit port to the desired injection site within the patient whilst reducing exposure of an operator to ionizing radiation.

Appeal Br. (Claims App.) (emphases added).

REJECTIONS ON APPEAL

Claims 6, 7, and 9–15 are rejected under 35 U.S.C. § 102(b) as anticipated by Dardik (US 4,250,887, iss. Feb. 17, 1981).

Claim 8 is rejected under 35 U.S.C. § 103(a) as unpatentable over Dardik.

OPINION

A. *Anticipation by Dardik*

As reflected above, claim 6 recites “an injection part . . . having a chamber loaded with viscous bone cement prior to the viscous bone cement having set.” Appeal Br. (Claims App.). In construing claim 6, the Examiner determines “the bone cement is not [positively] recited in” claim 6. Ans. 6. Therefore, the Examiner’s view is that Dardik need not disclose loading the injection part’s chamber with bone cement in order for Dardik to anticipate claim 6, and instead it is sufficient for anticipation if Dardik’s syringe 24 is merely capable of being loaded with and injecting bone cement. Final Act. 2–3 (finding Dardik’s syringe 24 is “*capable [of]* delivering a viscous bone cement material,” and “*can be loaded with and inject viscous bone cement*”) (emphases added), 4–5 (“the chamber of Dardik can be loaded with viscous bone cement”) (applying *In re Schreiber*, 128 F.3d 1473, 1477–78 (Fed. Cir. 1997)); Ans. 5–6.

Appellant objects that claim 6 does positively recite viscous bone cement, via the limitation reciting “a chamber loaded with viscous bone cement.” Appeal Br. 2, 10; Reply Br. 2.³ In Appellant’s view: “There is no reasonable way to read ‘a chamber *loaded* with viscous bone cement’ as ‘a chamber that *can be loaded* with viscous bone cement’” as the Examiner has done, because this “simply changes the claim language to be something other than what it is.” Reply Br. 2–3 (emphases modified): Tr. 8:19–9:4, 11:23–12:20. Appellant asserts the Specification supports Appellant’s

³ Appellant’s Reply Brief does not include page numbers. Our citations treat the cover page as page 1, extending through page 5 which bears the signature of Appellant’s attorney.

interpretation. Reply Br. 3 (citing Spec. ¶¶ 9, 52). When claim 6 is thus properly construed, according to Appellant, Dardik does not anticipate because Dardik’s syringe 24 “is loaded with ‘radiopaque dye,’ not viscous bone cement.” Appeal Br. 2, 10, 11 (citing Dardik, 2:52–54, 2:63–65).

We agree with Appellant. Claim 6, in reciting “an injection part . . . *having a chamber loaded with viscous bone cement,*” positively requires an amount of bone cement that is loaded in the chamber. Appeal Br. (Claims App.). The Examiner’s contrary construction is unreasonable, based on the “loaded with” term in claim 6. The Examiner’s construction in effect reads claim 6 as reciting a chamber that is capable of being loaded with bone cement, which is not what the claim recites.

Thus, in order to anticipate claim 6, Dardik must disclose that syringe 24 is loaded with bone cement. Dardik falls short in that regard, because Dardik discloses only that syringe 24 is loaded with radiopaque dye, not bone cement. *See* Dardik, Abstract, 1:5–8, 2:52–65, 3:67–4:5, 4:59–60.

For the foregoing reasons, we do not sustain the rejection of claim 6, and claims 7 and 9–15 depending therefrom, as anticipated by Dardik.

B. Obviousness over Dardik

The Examiner’s additional consideration of claim 8, and the obviousness of claim 8 based on Dardik, does not cure the deficiency of Dardik as to parent claim 6 noted above. *See* Final Act. 4. Therefore, for the reasons identified above, we do not sustain the rejection of claim 8 as unpatentable over Dardik.

CONCLUSION

In summary we reverse each of the rejections on appeal, as summarized in the following table:

| Claim(s) Rejected | 35 U.S.C. § | Reference | Affirmed | Reversed |
|------------------------------|--------------------|------------------|-----------------|-----------------|
| 6, 7, 9–15 | 102(b) | Dardik | | 6, 7, 9–15 |
| 8 | 103(a) | Dardik | | 8 |
| Overall Outcome | | | | 6–15 |

REVERSED