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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TOMOTAKA OYABU

Appeal 2019-004450
Application 14/441,729
Technology Center 3700

Before ANNETTE R. REIMERS, JEREMY M. PLENZLER, 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 8–16 in this application.²

We AFFIRM.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies Seiyukai Healthcare Corporation as the real party in interest. Appeal Br. 2.

² Claims 1–7 are canceled. See Appeal Br. 4, 16 (Claims App.).

CLAIMED SUBJECT MATTER

Claim 8 is the sole independent claim on appeal, and it recites, with our emphases added:

8. A guide jig for guiding a cutting bar attached to a handpiece when forming an implant cavity at an implantation position of an implant, the guide jig comprising:
an elongated handle section;
*a pole section that supports an end side of the handle section on an alveolar bone*³; and
a guide section, provided on the end side of the handle section, the guide section having a tubular shape, the tubular shape fixed to and in contact with the pole section, the guide section configured to guide the cutting bar along the pole section;
wherein:
the pole section is formed into a columnar shape and is fixed to the end of the handle section in an upright position,
the pole section is tiltably and rotatably supported by abutting against the alveolar bone,
at least one of the pole section and the guide section protrudes from the end side of the handle section in a direction opposite to a direction of cutting by the cutting bar, and
the pole section comprises an abutting section formed on one end of the pole section, the abutting section being tapered such that a diameter of the abutting section decreases in size in the cutting direction.

Appeal Br. 16–17 (Claims App.) (emphases added).

REJECTIONS ON APPEAL

Claims 8–16 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Final Act. 2.

³ The alveolar bone is part of a person’s jaw. *See* Subst. Spec. (filed May 8, 2015) ¶¶ 2, 27–28; Appeal Br. 12 (stating “the alveolar bone is a thickened ridge of bone on a jaw that contains the tooth sockets that hold teeth”).

Claims 8–16 are rejected under 35 U.S.C. § 102(e) as anticipated by Wong (US 2013/0103037 A1, published Apr. 25, 2013). Final Act. 3–5.

OPINION

A. *Statutory Subject Matter*

The Examiner determines claims 8–16 are directed to non-statutory subject matter, because claim 8 “recite[s] part of the human body in combination with the device, e.g. ‘a pole section that supports an end side of the handle section on an alveolar bone’ and ‘abutting against the alveolar bone.’” Final Act. 2. In the Examiner’s view, these limitations “appear[] to structurally require that the pole section is in contact with an alveolar bone, and thus positively recite[] the alveolar bone.” Ans. 5. The Examiner concludes “a human being will not be considered to be patentable subject matter under 35 U.S.C. 101,” because the grant of an exclusive property right in a human being is prohibited by the constitution. Final Act. 2 (citing *In re Wakefield*, 422 F.2d 897 (CCPA 1970)). The Examiner suggests Appellant might overcome this rejection by amending claim 8 to include “[l]anguage such as ‘when in use’, ‘adapted to be attached’, or ‘for attachment to.’” *Id.*; Ans. 5.

Appellant opposes on the basis that “the limitations of independent Claim 8 are not directed to a human body or part thereof, nor is the human body included within the scope of Claim 8.” Appeal Br. 10 (emphases by Appellant). In Appellant’s view: “Claim 8 recites a structure of a guide jig, and the guide jig’s structural components do not include ‘an alveolar bone.’” *Id.* Appellant argues claim 8’s references to an alveolar bone simply specify “a **mounting location**” and “support features” for the claimed guide jig to

interact with bone, such that “**no claim is made to the alveolar bone itself.**” Reply Br. 7 (emphases by Appellant). Appellant disagrees with the Examiner’s determination that additional claim language is necessary to clarify that claim 8 is not directed to a part of the human body. Appeal Br. 10–11. Appellant concludes the claim construction underlying the Examiner’s rejection is unreasonably broad and inconsistent with Appellant’s Specification. Reply Br. 8.

We agree with Appellant’s position that the Examiner’s rejection relies upon an unreasonable claim construction. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (holding that, during examination of a patent application, pending claims are given their broadest reasonable construction consistent with the Specification).

[U]nder the broadest reasonable [claim] interpretation, the Board’s construction “cannot be divorced from the specification and the record evidence,” *In re NTP, Inc.*, 654 F.3d 1279, 1288 (Fed. Cir. 2011), and “must be consistent with the one that those skilled in the art would reach,” *In re Cortright*, 165 F.3d 1353, 1358 (Fed. Cir. 1999). A construction that is “unreasonably broad” and which does not “reasonably reflect the plain language and disclosure” will not pass muster.

Microsoft Corp. v. Proxyconn, Inc., 789 F.3d 1292, 1298 (Fed. Cir. 2015) (quoting *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010)).

A person of ordinary skill in the art would understand Appellant’s invention is directed to a tool that may be used to guide a cutting implement during oral surgery, by placing a pole section of the tool against the alveolar bone in the patient’s mouth. *See, e.g.*, Subst. Spec. ¶¶ 1–2, 5–7, 27–28. The Examiner’s conclusion that claim 8 is directed to the combination of the tool and an alveolar bone is not consistent with how a person of ordinary skill in

the art would read claim 8. Instead, such a person would read claim 8 as requiring only that the guide jig is capable of being used to guide a cutting implement during oral surgery, by placing a pole section of the tool against the alveolar bone in the patient's mouth. Indeed, this is how the Examiner construes claim 8 in support of the anticipation rejection, as discussed below. *See, e.g.*, Ans. 6 (stating that “all of Appellant’s arguments appear to be directed to the intended use of the device rather than the structure of the device,” and “[s]ince the claims are directed to an apparatus, it is only the resulting structure at issue and the prior art only need be capable of such use”).

Because the rejection of claims 8–16 as directed to non-statutory subject matter is based upon an unreasonable claim construction, we do not sustain the rejection.

B. Anticipation by Wong

In response to the anticipation rejection based on Wong, Appellant argues claims 8–16 as a group, without separately arguing any one claim in the group. Appeal Br. 11–15. Accordingly, we select claim 8 to decide the appeal as to this rejection, with the other grouped claims standing or falling with claim 8. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2018).

The Examiner cites Figures 1 and 2 of Wong as disclosing a device that anticipates claim 8. *See* Final Act. 3–4. Figure 1 of Wong is reproduced here:

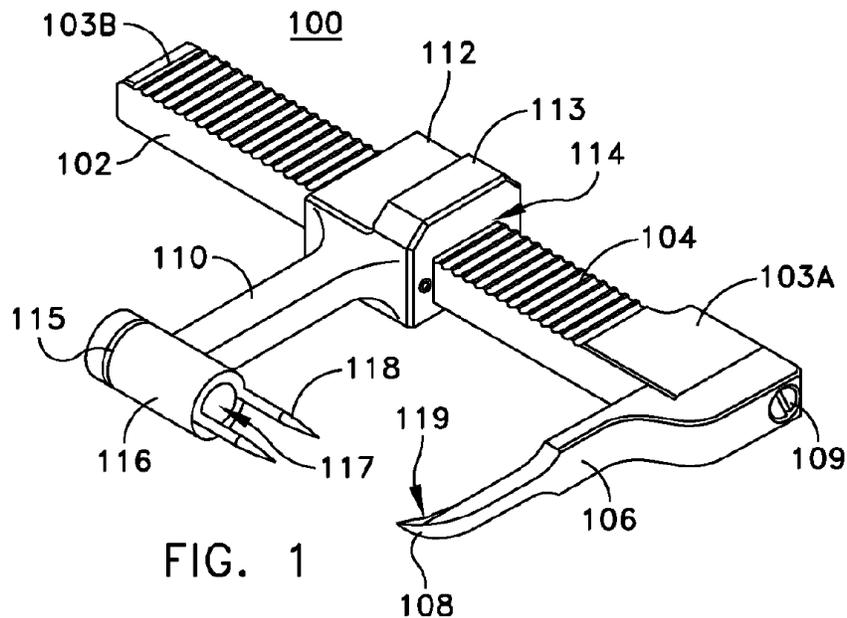


Figure 1 of Wong is a perspective view of drill guide assembly 100. Wong ¶¶ 8, 45. As described in Wong, assembly 100 may be used to repair damaged or fractured foot bones, by “provid[ing] guidance for targeting, aligning, measuring and drilling of a hole for placement of a bone screw and then actual placement of the bone screw while holding or compressing the bones in reduction.” *Id.* ¶¶ 2–4. In use, one or more bones are grasped between first arm 106 and second arm 110 by adjusting the longitudinal position of second arm 110 along body 102, using ratchet teeth 104. *Id.* ¶¶ 45, 48, 50. Then, a drill bit (not shown) is inserted through bore 117 of guide housing 116 to perform a drilling operation on the bone(s). *Id.* ¶¶ 45–46. Sharp tip 108 of first arm 106, and spikes 118 on guide housing 116, dig into the bone(s) to provide a good grip during the drilling operation. *Id.* ¶ 51.

Comparing claim 8 to Figure 1 of Wong, the Examiner finds Wong discloses a guide jig comprising a handle section (i.e., the portion of second arm 110 extending between base portion 112 and guide housing 116), a pole

section (i.e., one of the spikes 118), a guide section (i.e., guide housing 116), and an abutting section (i.e., the tapered end of the spike 118). Final Act. 3–4. Appellant does not challenge these findings.

The Examiner additionally finds Wong’s pole section 118 “supports an end side of the handle section . . . on an alveolar bone (capable of being used on an alveolar bone),” and “is tiltably and rotatably supported by abutting against the alveolar bone (capable of being placed against alveolar bone and since the pole section ends in a point, it may be tilted and rotated in relation thereto).” Final Act. 3; *id.* at 5 (referring to “placing the pointed tip of the pole [118] against alveolar bone and tilting/rotating”).

Appellant disputes the Examiner’s findings that Wong’s pole section 118 is capable of supporting the handle section on an alveolar bone, and that Wong’s pole section 118 is capable of being tiltably and rotatably supported by abutting against the alveolar bone. Appeal Br. 12–14. Appellant asserts “[a]ccess is limited” within a person’s oral cavity, which precludes insertion of Wong’s drill guide assembly 100 so that pole section 118 may contact the alveolar bone, because Wong’s device is designed to clasp bones or tissue between first arm 106 and second arm 110 for foot or ankle repair. *Id.* at 12 (citing Wong ¶¶ 3–5), 14; Reply Br. 11–12. Thus, Appellant’s view is that “it cannot be said that the drill guide assembly 100 of Wong is capable of performing” the functions recited in claim 8, and the Examiner’s findings to the contrary are not supported by the evidence of record. Appeal Br. 12–13.

Appellant further contends Wong’s disclosure establishes that Wong’s device is not capable of performing the functions recited in claim 8. *Id.* at 13–14. For example, according to Appellant, Wong does not describe

spikes 118 “as being tiltably or rotatably supported by abutting against a bone.” *Id.* at 13. Further: “Wong merely describes the drill guide assembly 110 as being immovably fixed to a bone in order to align and drill a hole in a bone,” with tip 108 of first arm 106 and spikes 118 of second arm 110 being “fixed to a bone as a single assembly.” *Id.* (emphasis by Appellant) (citing Wong ¶ 51); Reply Br. 9–10, 12–14. Thus, in Appellant’s view, second arm 110 cannot be removed from first arm 106 to be used separately from first arm 106. Appeal Br. 13–14; Reply Br. 13.

The Examiner answers “that all of Appellant’s arguments appear to be directed to the intended use of the [claimed] device rather than the structure of the [claimed] device.” Ans. 6. The Examiner’s view is that Wong “only need[s to] be capable of” the uses recited in claim 8, and Wong is so capable, “such as placing the pointed tip of the pole [118] against alveolar bone and tilting/rotating.” *Id.* The Examiner analogizes this capability as being “essentially equivalent to taking a pencil, placing the tip against a surface, and then rotating or tilting the pencil relative to the surface.” *Id.*

Upon review of the foregoing, we determine it is undisputed that the claim limitations reciting “a pole section that *supports* an end side of the handle section *on an alveolar bone*” and “the pole section is *tiltably and rotatably supported by abutting against the alveolar bone*” (emphases added) are functional limitations. This claiming strategy, while permissible, “carries with it a risk.” *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997). When an Examiner has reason to believe that a functional limitation asserted to be critical may in fact be an inherent characteristic of the prior art, the Examiner possesses the authority to shift the burden to the applicant to show otherwise. *Id.*; *see also In re Simpson*, 102 F. App’x 675, 678

(Fed. Cir. 2004) (unpublished) (as in *Schreiber*, existence of claimed structural elements in prior art gave the Office reason to believe those elements could perform the claimed function, thereby shifting burden to applicant to show lack of inherency of claimed functionality). The Examiner may do this by establishing that the structure disclosed in the prior art is capable of performing the recited function. *Schreiber*, 128 F.3d at 1478–79.

In this case, a preponderance of the evidence supports the Examiner’s finding that Wong discloses a device that is capable of performing the claimed functions. In particular, the Examiner finds Wong’s Figure 1 discloses all of the structural limitations recited in claim 8: a handle section as the portion of second arm 110 extending between base portion 112 and guide housing 116, a pole section as spike 118 with an abutting section formed at one end, and a guide section as guide housing 116. Appellant does not challenge these findings. All of the identified structures are found on the “modular” second arm 110 that is “a piece separate from the elongated body 102” such that second arm 110 “is configured and adapted to be longitudinally movable along the elongated body [102] in two directions, towards or away from the first arm member 106.” Wong, Fig. 1, ¶ 45. Assembly 100 is formed by sliding elongated body 102 into through-hole 114 of base portion 112, and second arm 110 may be removed from body 102. *Id.* at Figs. 1 & 12, ¶¶ 49–50, 57–58.

We find that when second arm 110 is removed from elongated body 102, pole section 118 is capable of supporting an end side of second arm 110 on an alveolar bone inside a person’s mouth, and pole section 118 is tiltably and rotatably supported by abutting against the alveolar bone, as

recited functionally in claim 8. *See, e.g.,* Wong, Figs. 27B–27D (illustrating a typical size of second arm 110 in relation to a person’s foot). Appellant’s arguments that the entire assembly 100 is too large to fit inside a person’s mouth, such that pole section 118 is not capable of performing the recited functions, overlook the fact that second arm 110 is removable from body 102, to be handled like “a pencil” in the Examiner’s analogy. Ans. 6.

Appellant’s further argument that second arm 110 “cannot be removed” from body 102 to be “separately used” is not a persuasive rebuttal to the Examiner’s rejection. *See* Appeal Br. 13–14; Reply Br. 13. While it is true that Wong does not disclose removing second arm 110 from body 102 in order to perform a surgical operation, the fact remains that the two components are capable of being separated. Wong, Figs. 1 & 12, ¶¶ 49–50, 57–58. Thus, the structures of Wong cited by the Examiner as corresponding to the structures recited in claim 8 are capable of performing the functions recited in claim 8, so Wong anticipates. *See Schreiber*, 128 F.3d at 1478–79.

For the foregoing reasons, we sustain the rejection of claims 8–16 as anticipated by Wong.

CONCLUSION

In summary, we reverse the statutory subject matter rejection, and we affirm the anticipation rejection, as summarized in this table:

Claims Rejected	35 U.S.C. §	Reference / Basis	Affirmed	Reversed
8–16	101	Eligibility		8–16
8–16	102	Wong	8–16	
Overall Outcome			8–16	

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TIME PERIOD FOR RESPONSE

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