

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARY FISCHETTI and DAVID SHEEHAN

Appeal No. 97-0933
Application 08/200,118¹

ON BRIEF

Before McCANDLISH, *Senior Administrative Patent Judge*, and
ABRAMS and McQUADE, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner
finally rejecting claims 1-7, which constitute all of the
claims of record in the application.

¹ Application for patent filed February 22, 1994.

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The appellants' invention is directed to a prosthesis having an offset attachment mechanism. The subject matter before us on appeal is illustrated by reference to claim 1, which has been reproduced in an appendix to the Appeal Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Bolesky	4,822,366	Apr. 18,
1989		
Elloy <i>et al.</i> (Elloy)	4,950,297	Aug. 21,
1990		
Slamin	5,152,796	Oct. 6,
1992		

THE REJECTIONS

Claim 1 stands rejected under 35 U.S.C. § 102(a, b, and e) as being anticipated by Slamin.

Claim 2 stands rejected under 35 U.S.C. § 103 as being unpatentable over Slamin in view of Elloy.

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Claim 3 stands rejected under 35 U.S.C. § 103 as being unpatentable over Slamin in view of Bolesky.

Claims 4-7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Slamin.

The rejections are explained in Paper No. 7 (the final rejection).

The opposing viewpoints of the appellants are set forth in the Appeal Brief.

OPINION

The Rejection Under Section 102

Independent claim 1 stands rejected as being anticipated by Slamin, which means that this reference must disclose, expressly or under the principles of inherency, each and every element of the claimed invention. See, for example, *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert. dismissed sub nom., *Hazeltine Corp. v. RCA Corp.*, 468 U.S. 1228 (1984).

Claim 1 is directed to a femoral component for a knee system. It requires, *inter alia*, that there be an implantable

femoral stem and a bolt for bolting the stem to an articulating component, and that the bolt have a shaft "offset" from the head of the bolt. The term "offset" is defined in the specification as meaning that the position of the head of the bolt is spaced from the longitudinal axis of the shaft portion of the bolt (page 3). The effect of this is to displace laterally the longitudinal axis of the bolt shaft with respect to that of the bolt head. The purpose of the offset is to allow the femoral stem to be adjusted to align with the axis of the bone into which it is to be inserted, by the use of a bolt having the appropriate amount of offset. This is illustrated in Figure 3.

Slamin, which was cited by the appellants as prior art in their specification, discloses a modular knee prosthesis which has much in common with the appellants' invention. Like the appellants, Slamin wishes to adjust the femoral stem to align with the bone into which it will be installed. However, Slamin is concerned with changing the angle of the stem and not its offset. This reference therefore teaches using bolts in which the shafts are at an angle to the heads, so that selection of a proper bolt results in the femoral stem being

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tilted at the desired angle with respect to the component to which it is attached by the bolt.

Claim 1 requires a bolt with an offset, whereas Slamin discloses a bolt with an angle. The reference therefore fails to anticipate the subject matter recited in claim 1, and we will not sustain this rejection.

The Rejections Under Section 103

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). However, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The initial burden of establishing a basis for denying patentability to a claimed invention rests with the examiner. See *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

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Claim 2, which depends from claim 1, stands rejected as being unpatentable over Slamin in view of Elloy. We have discussed the Slamin reference above, noting that it failed to teach offsetting the bolt, as required by claim 1. Claim 2 adds to claim 1 the limitation that the offset range from 0 to 5 mm.

Elloy discloses a knee prosthesis comprising tibial, meniscal and femoral components. The problem to which Elloy directs his inventive efforts is insuring that the movement of the meniscal component is limited, so that it does not move out of alignment with the other components, that is, dislocate, when the knee prosthesis is flexed, as in bending or rotation (columns 2 and 6). Elloy provides a control peg (21) which has a pair of parallel but offset portions (21a and 21b), one of which is inserted in a matching opening and the other in a round or elongated opening, depending upon the motion limits desired (Figures 7a, b, and c; column 6).

While we would agree with the examiner that Elloy discloses an element in which one component is offset from the other, neither the element nor the offset is for the same purpose as that of the appellants' invention. We fail to

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perceive any teaching, suggestion or incentive in either Slamin or Elloy which would have led one of ordinary skill in the art to modify the Slamin device by replacing the angled bolt stem with an offset one. In fact, to do so would destroy the very essence of the Slamin invention, which we regard as a disincentive for such modification. The examiner states that Elloy teaches it is well known "to effect an off-set . . . rather than an angular displacement for purposes of adjustability" (Paper No. 7, page 4). However, the examiner did not annotate to the patent for support for this conclusion, nor can we find such a teaching there. From our perspective, therefore, suggestion for the proposed modification of Slamin is found only in the luxury of the hindsight accorded one who first viewed the appellants' disclosure. This, of course, is not a proper basis for a rejection. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

The rejection of claim 2 is not sustained.

Nor will we sustain the rejection of claim 3, which is based upon Slamin and Bolesky, the latter of which was cited for disclosing a knee prosthesis having a flared inferior end

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on a stem. Be that as it may, it is our view that Bolesky fails to alleviate the shortcoming we have pointed out above in Slamin, namely, the lack of an offset attaching bolt.

Claims 4 through 7 are dependent from claim 1, and stand rejected as being unpatentable over Slamin. Again, the failure of Slamin to disclose or teach the required offset bolt recited in independent claim 1 rears its head. It is our opinion that this rejection fails at the outset on that ground, for lacking the required offset teaching Slamin fails to establish a *prima facie* case of obviousness with regard to the subject matter of independent claim 1 which, of course, forms a part of dependent claims 4-7.

The rejection of claims 4-7 is not sustained.

SUMMARY

None of the rejections are sustained.

The decision of the examiner is reversed.

REVERSED

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	Administrative Patent Judge)	
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