

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DIRKJAN BAKKER,
JOHANNES J. GROTE, and
CLEMENS A. VAN BLITTERSWIJK

Appeal No. 1997-0975
Application No. 08/389,303¹

ON BRIEF

Before PAK, OWENS, and KRATZ, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 41-48 and 52-59. Claims 49-51, which are all of the

¹ Application for patent filed February 16, 1995. According to appellants, this application is a division of Application 08/089,854, filed July 12, 1993; which is a continuation-in-part of Application 07/907,674, filed July 2, 1992, now abandoned; which is a continuation-in-part of Application 07/479,197, filed February 13, 1990, now abandoned; which is a continuation-in-part of Application 07/240,810, filed September 2, 1988, now abandoned.

remaining claims pending in this application, stand objected to as being dependent upon a rejected base claim (final rejection, page 5).

BACKGROUND

Appellant's invention relates to a process for implanting into an animal a prosthetic device for binding to bone. An understanding of the invention can be derived from a reading of exemplary claim 54, which is reproduced below.

54. A process for providing an animal with a prosthetic device for binding to bone, comprising: implanting into an animal a prosthetic device, said prosthetic device being implanted to bind the prosthetic device to bone by contact between said prosthetic device and bone, said prosthetic device comprising a polymer including a first component comprising a polyalkylene glycol; and

a second hydrophobic component which imparts stability to the first component in water.

The sole prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Jones et al. (Jones) 3,908,201 Sep. 30, 1975

Claims 41-48 and 52-59 stand rejected under 35 U.S.C. § 102 as being anticipated by Jones or, alternatively, under 35 U.S.C. § 103 as being unpatentable over Jones.

OPINION

Having carefully reviewed the respective positions of appellants and the examiner, including the declaration evidence

relied upon by appellants, we concur with the examiner's determinations regarding the unpatentability of the claimed subject matter and find no reversible error on the examiner's part in maintaining the rejections under review. Accordingly, we will sustain the examiner's rejections under 35 U.S.C. §§ 102 and 103 for essentially those reasons expressed in the examiner's answer and as further explained below.

Appellants "assert that the rejected claims do not stand or fall together" (brief, page 4). However, appellants do not separately argue the appealed claims with respect to the rejections advanced by the examiner with any reasonable specificity consistent with 37 CFR § 1.192 (c) (7) and (8) (1995). In this regard, merely pointing out differences in the coverage of the claims does not amount to a separate argument warranting separate consideration of the claims (brief, pages 2 and 3). Accordingly, we consider the patentability of the claims to rise or fall together. See *In re Nielson*, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987); *In re Kaslow*, 707 F.2d 1366, 1376, 217 USPQ 1089, 1096 (Fed. Cir. 1983). We will direct our comments primarily to claim 54.

As indicated above, claim 54 is directed to a method comprising the sole step of implanting a plastic prosthetic

device comprising two components into an animal to bind the device to bone via contact therewith.

An anticipation under 35 U.S.C. § 102(b) is established when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. See *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). Additionally, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984) (and overruled in part on another issue), *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1125, 227 USPQ 577, 588 (Fed. Cir. 1985).

Jones discloses a method including the step of implanting, in an animal, a prosthetic device comprising a plastic material including a first poly (ethylene glycol) component and a second water stabilizing component such as an ester, urethane or amide containing unit such that the prosthetic device bonds to

collagenous body tissue (column 2, lines 1-49; column 3, line 36 to column 4, line 39; and Examples 1-11).²

Therefore, the question before us is whether bonding the prosthetic device to collagenous body tissue, as taught by Jones, is encompassed by the claimed implanting step. We answer this question in the affirmative.

In proceedings before the Patent and Trademark Office, an application claim is to be given its broadest reasonable interpretation which is consistent with the specification as it would be interpreted by one of ordinary skill in the art. *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Here, the specification (pages 15 and 16) states that:

Examples of prosthetic devices which may be formed from the polymers of the present invention include, but are not limited to, ... artificial palates; typanic and sinus ventilation tubes; ... ear canal walls; and closures of the nasal septum; ... preformed noses; ... peridontal ligament replacements; ... artificial ligaments; interstitial cartilage repair or replacement; anchor elements for ligament repair; ... cartilage sheets; tubes to direct nerve growth....

² Appellants also admit that the claimed prosthetic device polymer materials are known (brief, page 4). Moreover, appellants do not specifically dispute that the prosthetic device components as described in claim 54 encompasses the prosthetic device components of Jones. In this regard, we note that appellants acknowledge that the copolymers of Jones are useful in their process (specification, page 8).

From the above, we determine that either "bone," as used in the appealed claims, includes collagenous body tissues or the claimed bone contacting includes indirect contact with bone via ligament and/or other body tissues. Note also that the claimed limitation "... to bind the prosthetic device to bone by contact between said prosthetic device and bone" (claim 54) does not call for a particular type of bond or direct bone contact such that the claimed method would have excluded, for example, the nose implant use taught by Jones.

With regard to the § 103 rejection, we agree with the examiner that the teachings of Jones regarding the use of the implant for bonding to collagenous body tissue would have reasonably suggested to one of ordinary skill in the art the use of the prosthetic devices for bonding to bone. Jones broadly teaches the prosthetic material for use in an animal body, which is inclusive of bone contacting uses. Jones further teaches the prosthetic materials may be cast or compression molded (column 6) indicating the prosthetic would have structural rigidity in addition to biocompatible properties. Thus, a skilled artisan would have had a reasonable expectation of success in using the device for hard body (bone) implant utilities. *Compare American Standard Inc. v. Pfizer Inc.*, 722 F. Supp. 86, 131, 14 USPQ2d

1673, 1710 (D. Del., 1989) wherein the court found that, as early as 1968-1969, "...the field of biomaterials crossed the orthopedic, dental and cardiovascular specialties, and (2) it was well known at the critical time that soft and bone tissue would grow into pores."

In view of the above, we find that the examiner has established a *prima facie* case of anticipation under 35 U.S.C. § 102(b) and a *prima facie* case of obviousness under 35 U.S.C. § 103 of the claimed subject matter over the teachings of Jones.

Appellants' contentions regarding Jones only teaching a soft tissue prosthesis utility and not the claimed bone bonding (hard tissue) method are not found convincing in light of our construction of appellants' claimed implanting step as being inclusive of the nose implant method taught by Jones. We note that the appealed claims do not require a direct bond between the implant device and hydroxyapatite phase of bone as argued as a distinguishing feature (brief, page 4). See *In re Self*, 671 F.2d 1344, 1351, 213 USPQ 1, 7 (CCPA 1982).

Moreover, we do not find the declaration of Klaas de Groot convincing on the ultimate issue of anticipation or obviousness. In this regard, we note that the declaration attempts to differentiate appellants' invention from the prior art based on a

particular use of the prosthetic device in binding to a hydroxyapatite portion of bone and on the capability of the device to induce the formation of a calcium phosphate layer or deposit calcium, all of which are not required by the claims. *See In re Self, supra.* Indeed, appellants appear to further undercut the de Groot declaration by acknowledging in their specification that the claimed invention is not limited to the theoretical discussion therein regarding how the polymer may bind to bone (specification, pages 2 and 3).

Appellants' additional arguments and the de Groot declaration opinion regarding Jones teaching away from the claimed bone binding properties by teaching collagenous tissue bonding and surface energy matching are likewise unconvincing for the reasons discussed above and since the claims do not require a specific bone binding mechanism but rather a prosthetic device that could be fastened to bone by a variety of techniques unrelated to those discussed by the de Groot declaration.

Upon consideration of the evidence and arguments presented, we find ourselves in agreement with the examiner's position. Accordingly, we will sustain the examiner's stated § 102 and § 103 rejections.

CONCLUSION

To summarize, the decision of the examiner to reject claims 41-48 and 52-59 under 35 U.S.C. § 102 as being anticipated by Jones or, alternatively, under 35 U.S.C. § 103 as being unpatentable over Jones is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

CHUNG K. PAK)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
TERRY J. OWENS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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PETER F. KRATZ)	
Administrative Patent Judge)	

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