

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEVEN C. CHUDIK

Appeal 2013-006952¹
Application 11/525,631
Technology Center 3700

Before PHILIP J. HOFFMANN, CYNTHIA L. MURPHY, and
KENNETH G. SCHOPFER, *Administrative Patent Judges*.

MURPHY, *Administrative Patent Judge*.

DECISION ON APPEAL

The Appellant (Steven C. Chudik) appeals under 35 U.S.C. § 134 from the Examiner's rejections of claims 1, 15, 18, and 33–40. We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

We AFFIRM.

¹ In this opinion, we refer to the original Specification filed on September 25, 2006 (“Spec.”), the Final Action mailed on June 5, 2012 (“Final Action”), the Appeal Brief filed on November 2, 2012 (“Appeal Br.”), the Claims Appendix contained on pages 23 and 24 of the Appeal Brief (“Claims App.”), the Examiner’s Answer mailed on March 12, 2013 (“Answer”), and the Reply Brief filed on April 18, 2013 (“Reply Br.”).

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STATEMENT OF THE CASE

The Appellant's invention relates to "rotator cuff sparing procedures and associated devices for shoulder replacement surgery." (Spec. ¶ 2.)

Independent Claims

1. A glenoid implant comprising:
 a shell having
 a protruding surface on a first side arranged to engage the surface of a cavity formed in a glenoid extending between peripheral glenoid surfaces, and
 a flat surface on the first side adjacent the protruding surface arranged to engage the peripheral glenoid surfaces adjacent the cavity, and
 a wear-resistant articulating surface on a second side opposite the flat surface and the protruding surface.

40. A glenoid implant comprising:
 a protruding surface on a first side arranged to engage the surface of a cavity formed in a glenoid extending between peripheral glenoid surfaces, and
 a substantially planar wear-resistant articulating surface on a second side opposite the protruding surface.

References

Church	US 6,520,995 B2	Feb. 18, 2003
Bouttens	WO 01/47442 A1	July 5, 2001
Rambert	FR 2 579 454	Oct. 3, 1986

Rejections²

I. The Examiner rejects claim 40 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. (See Answer 3.)

² The Examiner withdraws the rejection of claims 1, 15, 18, and 33–39 under 35 U.S.C. § 112, first paragraph. (See Final Action 4; Answer 6.)

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II. The Examiner rejects claims 1, 15, and 33–39 under 35 U.S.C. § 102(b) as anticipated by Rambert. (Final Action 6.)

III. The Examiner rejects claim 40 under 35 U.S.C. § 102(b) as anticipated by Bouttens. (*Id.* at 7.)

IV. The Examiner rejects claim 18 under 35 U.S.C. § 103(a) as unpatentable over Rambert and Church. (*Id.* at 7.)

ANALYSIS

Independent claims 1 and 40 are each directed to a glenoid implant, and each recites “a protruding surface on a first side” and “a wear-resistant articulating surface on a second side.” (Claims App.)

Rejection I

Independent claim 40 recites that the articulating surface is a “substantially planar” surface. (Claims App.) The Examiner maintains that “[i]t is not evident to where there is written support” for an articulating surface “that is planar.” (Answer 3.) However, we agree with the Appellant (*see* Reply Br. 4–5) that a “substantially planar” articulating surface is disclosed in the Specification (*see* Spec. ¶ 147, Figs. 27a–27c).

Further, the Examiner’s withdrawal of the § 112 rejection of independent claim 1 (*see* Answer 6) is indicative that the issues raised by the Examiner concerning the Appellant’s alleged non-disclosure of a single-part implant (*see* Final Action 4–5) no longer need to be addressed. To the extent that this is not true, we agree with the Examiner that the scope of independent claim 40 is broad enough to encompass both a single-part implant and a two-part implant. (*Id.*) As such, independent claim 40 may indeed be broader than the specific embodiment disclosed in the

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Specification. However, the Examiner must do more than point out the difference in scope to establish a failure to comply with the written description requirement.³

Thus, we do not sustain the Examiner's rejection of independent claim 40 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Rejection II

Independent claim 1 recites a "shell" having the "protruding surface" and also "a flat surface" that is "adjacent the protruding surface." (Claims App.) Independent claim 1 requires the protruding surface to be "arranged to engage the surface of a cavity formed in a glenoid," and requires the flat surface to be "arranged to engage the peripheral glenoid surfaces adjacent the cavity." (*Id.*) The Examiner finds that Rambert discloses a glenoid implant comprising such a protruding surface and such a flat surface. (*See* Final Action 6, especially the Examiner's annotated drawing; *see also* Rambert Fig. 2.)

The Appellant advances arguments premised upon Rambert's protruding surface and its flat surface not being described or depicted as engaging the cavity and peripheral regions of the glenoid. (*See* Appeal Br. 15–18; *see also* Reply Br. 5–7.) As noted by the Appellant (*see* Appeal Br.16–17), in Rambert's glenoid implant 3, a first portion 27a is pressed against the glenoid cavity 6, and secured to the scapula 5 by brackets 21 and

³ "[T]hat a claim may be broader than the specific embodiment disclosed in a specification is in itself of no moment." *In re Rasmussen*, 650 F.2d 1212, 1215 (CCPA 1981). There are instances in which a narrower disclosure can support broader claims. (*Id.*)

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pin 28, while a second portion 27b is secured to the first portion 27a with screws 28. (See Rambert Fig. 2.) The surfaces identified by the Examiner as the “protruding surface” and the “flat surface” reside on Rambert’s second portion 27b (*id.*), and thus are not described or depicted as directly contacting bone regions of the scapula 5. As such, according to the Appellant, Rambert fails to disclose an implant that is arranged to engage the glenoid surfaces as claimed. (Appeal. Br. 16–17.)

We are not persuaded by these arguments because independent claim 1 is an apparatus claim and does not require the recited surfaces to “engage” the specified glenoid regions; rather, independent claim 1 requires only that the recited surfaces be “arranged” for such engagement. As such, the fact that Rambert’s protruding and flat surfaces are not described or depicted as actually engaging the specified glenoid regions is not dispositive, as they can still be arranged to do so. The Appellant does not point, with particularity to structural features of Rambert’s surfaces that would preclude them from being capable of performing the recited function (i.e., engaging the specified glenoid regions).⁴

Moreover, independent claim 1 does not specify a size, shape, or other physical characteristics of the cavity and its periphery.

⁴ It is permissible, as the Appellant does here, to recite features of an apparatus using functional language. See *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997) (citing *In re Swinehart*, 439 F.2d 210, 212–213 (CCPA 1971)). And in some circumstances, functional language can be relied on to limit an apparatus claim. See *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1363 (Fed. Cir. 1999). But functional language may not be relied on for patentability if the prior art discloses or suggests structure capable of performing the recited function. See *Schreiber*, 128 F.3d at 1478–1479.

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(Claims App.) And the Specification conveys that the cavity is formed in the glenoid by a central reaming surface 114 that “may be a convex dome, a square, triangle, pyramid, or any or other shape that matches the protruding surface of the novel glenoid implant 118.” (Spec. ¶ 124.) As such, a glenoid cavity could seemingly be formed having cavity and peripheral regions that match the profile of Rambert’s second portion 27b; and Rambert’s protruding and flat surfaces would be arranged to engage these glenoidal regions.

The Appellant also argues that surface identified by the Examiner as Rambert’s flat surface “is more likely a sectional view of a conical surface” and “[t]here is certainly no evidence” to support the Examiner’s finding that it is a flat surface. (Appeal Br. 16.) We are not persuaded by this argument because independent claim 1 does not require a particular incline or slope of the recited flat surface relative to, for example, the axis of the protruding portion. The outer surface of a conical shape shown by the Appellant (*see* Reply Br. 8) appears to differ in geometry from Appellant’s illustrated flat surface 121 (*see* Spec. Figs. 27a and 27b) only by virtue of its incline or slope relative to the protruding portion. As such, assuming *arguendo* that Rambert’s pertinent surface has a conical profile, it may still reasonably be considered a flat surface.

In view of the foregoing, we are not persuaded by the Appellant’s arguments that Rambert does not anticipate the glenoid implant recited in independent claim 1. Claims 15 and 33–39 depend directly or indirectly independent claim 1, and are not argued

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separately. Thus, we sustain the Examiner's rejection of claims 1, 15, and 33-39 under 35 U.S.C. § 102(b) as anticipated by Rambert.

Rejection III

As indicated above, independent claim 40 recites a "protruding surface," and independent claim 40, like independent claim 1, requires the protruding surface to be "arranged to engage the surface of a cavity formed in a glenoid." (Claims App.) The Examiner finds that Bouttens discloses a glenoid implant with such a protruding surface (surface 11 of glenoid sphere 9). (*See* Final Action 7; *see also* Bouttens Abstract, Fig. 5.)

The Appellant argues that, in Bouttens's implant, the protruding surface 11 "extends away from the glenoid, and not toward, into, or even touching it." (Appeal Br. 19.) According to the Appellant, "there is no way for the identified surface to engage such a cavity since there is no such cavity in [Bouttens's] glenoid 4." We are not persuaded by this argument because independent claim 40, like independent claim 1, is an apparatus claim; and the Appellant does not adequately address why Bouttens's surface 11 is structurally incapable of engaging a glenoid cavity that matches its protruding profile. As discussed above, the claim language does not specify shape characteristics of the cavity, and the Specification conveys that the cavity can have "any" shape that matches that of the protruding surface (*see* Spec. ¶ 124).

As also indicated above, independent claim 40 recites an "articulating surface" that is a "substantially planar" surface. (Claims App.) The Examiner finds that Bouttens discloses such a planar

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articulating surface (an interior surface of glenoid sphere 9 that receives plate 13 of meta-glenoid element 7.) (See Final Action 7; see also Bouttens, Abstract, Fig. 5.) The Examiner explains that “articulating surface” is interpreted to mean a surface “where elements unite as a joint” and Bouttens’s planar surface “engages and articulates with [a] plate [13] when it is assembled.” (Answer 5, 9.)

The Appellant argues that the Examiner’s interpretation of the term “articulating surface” is a “complete departure” from the Appellant’s disclosure. (Reply Br. 5.) To support this position, the Appellant quotes a sentence from the Specification regarding the surface of a humeral implant 94 that articulates with the glenoid or glenoid implant. (*Id.* at 10.)⁵ According to the Appellant, “[t]here is no suggestion anywhere in the [S]pecification that any other glenoid surface may be referred to as an ‘articulating surface.’” (*Id.*) The Appellant also implicates that “articulation” requires movement and that once Bouttens’s implant parts are assembled the planar surface “doesn’t move at all.” (*Id.* at 9.)

We are not persuaded by this argument because we consider the Examiner’s interpretation of the claim term “articulating surface” to be broad but reasonable and to be consistent with the Specification.⁶

⁵ The quoted sentence from the Specification reads “[i]t is contemplated that the surface of the humeral surface component 96 of the implant 94 that articulates with the glenoid or the glenoid implant, is smooth with a low coefficient of friction.” (Spec. ¶ 151.)

⁶ We must give the claims on appeal “their broadest reasonable interpretation consistent with the Specification.” See *In re Am. of Sci. Tech. Ctr.*, 367 F.3d. 1359, 1364 (Fed. Cir. 2004).

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The Examiner provides a dictionary definition supporting his interpretation (*see* Answer 5) and the Appellant does not propose, with particularity, a more appropriate definition (*see* Reply Br. 9–10). Additionally, the Examiner’s interpretation is consistent with the quoted sentence from the Specification in that the humeral implant element 96 and the glenoid implant component 96 unite as joint. (*See* Spec. ¶ 151.) We find nothing in the Specification precluding the modifier “articulating” from being used to describe other joined surfaces.

In view of the foregoing, we are not persuaded by the Appellant’s arguments that Bouttens does not anticipate the glenoid implant recited in independent claim 40. Thus, we sustain the Examiner’s rejection of claim 40 under 35 U.S.C. § 102(b) as anticipated by Bouttens.

Rejection IV

Claim 18 depends from independent claim 1. (Claims App.) With respect to this rejection, the Appellant argues only that Church “does not address any of the deficiencies of the Rampart” discussed above. (Appeal Br. 22; *see also* Reply Br. 11.) As we are not persuaded by the Appellant’s arguments that Rampart is deficient, we are not persuaded by this argument.

Thus, we sustain the Examiner’s rejection of claim 18 under 35 U.S.C. § 103(a) as unpatentable over Rambert and Church.

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DECISION

We REVERSE the Examiner's rejection of claim 40 under 35 U.S.C. § 112, first paragraph.

We AFFIRM the Examiner's rejection of claims 1, 15, 18, and 33–40 under 35 U.S.C. § 102(b) as anticipated by Rambert.

We AFFIRM the Examiner's rejection of claim 40 under 35 U.S.C. § 102(b) as anticipated by Bouttens.

We AFFIRM the Examiner's rejection of claim 18 under 35 U.S.C. § 103(a) as unpatentable over Rambert and Church.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED