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EXAMINER

STEWART, ALVIN J

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ALBERT H. BURSTEIN and
JONATHAN T. DELAND

Appeal 2016-002851
Application 13/834,361
Technology Center 3700

Before LYNNE H. BROWNE, LEE L. STEPINA, and ERIC C. JESCHKE,
Administrative Patent Judges.

BROWNE, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Albert H. Burstein and Jonathan T. Deland (Appellants) appeal under 35 U.S.C. § 134 from the rejection of claims 1–13, 24, and 27–35.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

¹ Claims 19–21 and 25 are withdrawn from consideration, and claims 14–18, 22, 23, and 26 are cancelled.

CLAIMED SUBJECT MATTER

The claims are directed to a joint replacement spacer. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A spacer for (a) replacing a removed portion of a first bone, and (b) articulating with a second bone, the spacer comprising:
 - an articulating surface sized and shaped to articulate with an articular surface of the second bone; and
 - a stabilizing surface sized and shaped to conform to a cut surface of the first bone, wherein:
 - the spacer defines first axis and a second axis not parallel to the first axis;
 - in a cross-section of the spacer perpendicular to the first axis, the stabilizing surface defines a first curve including:
 - a first portion with a first radius of curvature; and
 - a second portion with a second radius of curvature not equal to the first radius of curvature;
 - in a cross-section of the spacer perpendicular to the second axis, the stabilizing surface defines a second curve including:
 - a third portion with a third radius of curvature; and
 - a fourth portion with a fourth radius of curvature not equal to the third radius of curvature;
 - the second and fourth radii of curvature are not equal;
- and the stabilizing surface is formed entirely of pyrolytic carbon.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Palmer	US 2009/0319050 A1	Dec. 24, 2009
Gannoe	US D642,689 S	Aug. 2, 2011

REJECTIONS

- I. Claims 24 and 27–35 stand rejected under 35 U.S.C. § 102(b) as anticipated by Gannoe.

- II. Claims 1–13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Gannoe and Palmer.

DISCUSSION

Rejection I

The Examiner determines that Gannoe discloses each and every limitation of independent claim 24. Non-Final Act. 3–4. In particular, the Examiner finds that Gannoe discloses “a stabilizing surface sized and shaped to conform to a cut surface of the first bone.” *Id.* at 3. In support of this finding, the Examiner provides a marked-up copy of Gannoe’s Figure 3 with the stabilizing surface labeled. *Id.* at 4.

Contending that “Gannoe does not identify any of its surfaces . . . as being ‘sized and shaped to conform to the cut surface of [a] bone,’” Appellants argue that the Examiner fails to explain how Gannoe’s figures “disclose ‘a stabilizing surface sized and shaped to conform to a cut surface of [a] bone.’” Appeal. Br. 3, 4.

Gannoe is a design patent directed to an “ornamental design for a trapezium prosthesis, as shown and described.” Gannoe, Clm. 1. Gannoe gives no indication as to how the surfaces depicted in its figures are sized and shaped. Thus, the Examiner’s finding that Gannoe’s trapezium prosthesis is sized and shaped “to conform to a cut surface of the first bone” is speculative. Non-Final Act. 3. Accordingly, the Examiner’s finding is not support by a preponderance of the evidence.

For this reason, we do not sustain the Examiner’s decision rejecting independent claim 24, and claims 27–35, which depend from claim 24.

Rejection II

The rejection of claims 1–13 relies upon the same unsupported finding as the rejection of claim 24. Palmer does not cure the deficiency in Gannoe discussed *supra*. Accordingly, we do not sustain the Examiner’s decision rejecting claims 1–13 for the reason discussed *supra*.

DECISION

The Examiner’s rejections of claims 1–13, 24, and 27–35 are REVERSED.

REVERSED