

[2016 Pat. App. LEXIS 1052](#)

Patent Trial and Appeal Board

March 17, 2016, Decided

Appeal 2014-001781; Application 12/988,878; Technology Center 3700

Reporter

2016 Pat. App. LEXIS 1052

Ex parte GERARD SCORTECCI¹

Notice:

[*1]

ROUTINE OPINION. Pursuant to the Patent Trial and Appeal Board Standard Operating Procedure 2, the opinion below has been designated a routine opinion.

Core Terms

stock, bone, unpatentable, drill, coating, skin, adamantine, displace, conical, iss, vibrate, tip

Panel: Before JENNIFER D. BAHR, GEORGE R. HOSKINS, and AMANDA F. WIEKER, Administrative Patent Judges.

Opinion By: AMANDA F. WIEKER

Opinion

WIEKER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Gerard Scortecci ("Appellant") appeals under [35 U.S.C. § 134\(a\)](#) from the Examiner's final rejection of claims 1-18 and 21.² We have jurisdiction over the appeal under [35 U.S.C. § 6\(b\)](#).

We AFFIRM.

¹ According to Appellant, the Real Party in Interest is the named inventor, Gerard Scortecci. Br. 1.

CLAIMED SUBJECT MATTER

The invention concerns a bone regeneration device. Spec. 1:15.

Claim 1 is illustrative of the subject matter on appeal, and recites:

1. A device for bone regeneration comprising:

an end section for endo-osseous penetration, the end section comprising a primary cylindrical section with a circular cross section and that is connected [*2] to a conical section ending in a tip, wherein *the conical section and tip are adapted to displace skin and bone material laterally at the site of the endo-osseous penetration, without removing the skin and bone material*, and wherein *the end section has a coating of adamantine carbon with a mirror-polished surface*.

Br. 13, Claims App. (emphasis added). Independent claim 21 contains similar language to that emphasized above in claim 1.

REJECTIONS The claims stand rejected as follows:

I. Claims 1-3, 5, 8, 12, and 13 under 35 U.S.C. § 103(a) as unpatentable over Leonard (US 4,580,979, iss. Apr. 8, 1986), Stock (US 5,271,696, iss. Dec. 21, 1993), and Jurewicz (US 5,706,906, iss. Jan. 13, 1998).

II. Claim 4 under 35 U.S.C. § 103(a) as unpatentable over Leonard, Stock, Jurewicz, and Holzapfel (US 2003/0108417 A1, pub. June 12, 2003).

III. Claim 6 under 35 U.S.C. § 103(a) as unpatentable over Leonard, Stock, Jurewicz, Meloul (US 5,330,480, iss. July 19, 1994), and Deutchman (US 2005/0167261 A1, pub. Aug. 4, 2005).

IV. Claim 7 under 35 U.S.C. § 103(a) as unpatentable over [*3] Leonard, Stock, Jurewicz, and Kazahaya (US 2006/0216515 A1, pub. Sept. 28, 2006).

V. Claims 8 and 9 under 35 U.S.C. § 103(a) as unpatentable over Leonard, Stock, Jurewicz, and Robertson (US 4,705,436, iss. Nov. 10, 1987).

VI. Claims 10 and 11 under 35 U.S.C. § 103(a) as unpatentable over Leonard, Stock, Jurewicz, and Huang (TW 516424, pub. Jan. 1, 2003).

VII. Claim 14 under 35 U.S.C. § 103(a) as unpatentable over Leonard, Stock, Jurewicz, and Beaty (US 6,171,312 B1, iss. Jan. 9, 2001).

VIII. Claims 15-18 under 35 U.S.C. § 103(a) as unpatentable over Leonard, Stock, Jurewicz, and Shelton (US 2006/0257817 A1, pub. Nov. 16, 2006).

IX. Claim 21 under 35 U.S.C. § 103(a) as unpatentable over Leonard, Stock, Jurewicz, Meloul, Deutchman, and Holzapfel.

ANALYSIS

The Examiner finds that Leonard discloses a device, shown in Figure 1, that includes a conical section ending in a tip (Figure 1, element 4). Final Act. 3. The Examiner finds that this tool is capable of "displac[ing] skin and bone material laterally . . . without removing the skin and bone material," [*4] as required by claim 1. *Id.* The Examiner finds that although Leonard's tool may drill holes using vibration, "the user does not have to turn on the vibration to make a hole. If you simply press a conical piece of stainless steel with enough force it will pierce through soft tissue and/or bone and the skin and bone will be forced to displace laterally." Ans. 3; *see also id.* at 2. The Examiner finds that Leonard's tool is locked into place, does not rotate, and does not include cutting flutes. *Id.* at 3-4. The Examiner also finds that Stock teaches a tool bit with an adamantite coating, and concludes that it would have been obvious to one skilled in the art to coat Leonard's tool with adamantite carbon, to provide a high resistance to wear. Final Act. 4.

Appellant contends that Leonard discloses a device for holding a drill, and that the drill is not capable of functioning as claimed. Br. 4-5. Specifically, Appellant argues that a drill "grinds the material being drilled so that the material is removed, not displaced laterally." *Id.* at 4; *see also id.* at 5 ("[A] drill uses rotating abrasion or cutting to remove the material. . . ."). Appellant contends that Leonard's [*5] drill "would include cutting and/or abrasive faces that apparently are not shown in [Leonard's] Figure." *Id.* at 5. Finally, Appellant contends that it would not have been obvious to add an adamantite coating to Leonard's tool because Stock discloses a tool bit for removing material, whereas claim 1 requires that material is not removed. *Id.* at 7.

We are not persuaded by Appellant's arguments. Claim 1 is drawn to an apparatus. "[A]pparatus claims cover what a device *is*, not what a device *does*" Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469 (Fed. Cir. 1990). If a prior art structure is capable of performing the claimed intended use, then it meets the claim. *See, e.g., In re Schreiber, 128 F.3d 1473, 1477 (Fed. Cir. 1997)*. Here, the Examiner finds that Leonard's tool 4 includes a conical portion and tip, as claimed, and is capable of being pressed against tissue and bone so as to displace that material. Final Act. 3; Ans. 2-3. Appellant has not explained persuasively how Appellant's structure differs from that disclosed by Leonard or how Leonard's conical portion and tip, when pressed against skin [*6] and bone in the absence of vibration, would not cause lateral displacement.

Appellant's suggestion that Leonard's device must include cutting flutes that remove material is unsupported. Br. 4. Leonard discloses that tool 4 is locked in place and is caused to vibrate by mechanism 2. Ans. 3; Leonard 1:53-55, 2:3-4. Appellant has not identified any evidence in the record to suggest that the locked and vibrating drill also includes cutting flutes that necessarily remove material when pressed against skin or bone.³ *See* Ans. 3-4.

³ Appellant relies on FR 82/18545 to provide details regarding the type of drill utilized in Leonard's device. Br. 6-7. This is inappropriate, as FR 82/18545 is not incorporated by reference. Leonard 1:7-8. Furthermore, these arguments are unpersuasive

We are also unpersuaded by Appellant's argument against the combination of Leonard and Stock. The Examiner finds that Stock discloses a tool bit having [*7] an adamantine coating, which provides high wear resistance. Final Act. 4; Stock 1:35-36. Appellant does not dispute this finding. In light of this uncontested finding, we see no error in the Examiner's conclusion that a person of ordinary skill in the art would be motivated to apply Stock's coating to Leonard's tool, to add a high resistance to wear. Final Act. 4. Indeed, we agree with the Examiner that "[r]egardless of how the tool is being used, a skilled artisan would certainly appreciate adding the adamantine carbon coating with a mirror polished surface, in order to increase the tool's resistance to wear." Ans. 4.

For the above reasons, Appellant fails to apprise us of error in the rejection of claim 1. Appellant presents the same arguments for independent claim 1 and independent claim 21. Br. 4-11; see *id.* at 8 ("The argument for allowance of claim 21 is the same as for claim 1."). Appellant does not present separate argument for claims 2-18. Thus, for the same reasons, Appellant also fails to apprise us of error in the rejections of claims 2-18 and 21.

DECISION

The rejections of claims 1-18 and 21 are AFFIRMED.

No time period for taking any subsequent action in connection [*8] with this appeal may be extended under [37 C.F.R. § 1.136\(a\)\(1\)\(iv\)](#).

AFFIRMED

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