

IN RE CHUDIK, Appeal No. 2016-1817 (Fed. Cir. March 27, 2017). Before Dyk, Reyna, and Stoll. Appealed from PTAB.

Background:

Chudik filed a patent application with apparatus claims directed to an implant for shoulder replacement surgery that requires "a protruding surface . . . arranged to engage the surface" of a scapula's glenoid cavity. The Patent Office issued a Final Rejection in which the claims were rejected as anticipated by the prior art. Chudik appealed to the Patent Trial and Appeal Board (Board).

The Board indicated that the claims at issue do not require that the recited surfaces engage the specified glenoid regions, but rather require only that the recited surfaces be arranged for such engagement. Thus, the Board affirmed the Examiner's determinations that the claims at issue were anticipated. In affirming the Examiner's rejections, the Board indicated that the fact that the protruding and flat surfaces of the prior art were not described or depicted as actually engaging the specified glenoid regions is not dispositive, as they can still be arranged to do so. Chudik appealed, arguing that the prior art does not anticipate the claims at issue without improper modification thereof.

Issue/Holding:

Was the Board's anticipation finding supported by substantial evidence? No, reversed.

Discussion:

Because the prior art failed to disclose all the claimed elements in the same form and order as in the claims at issue the Federal Circuit found that substantial evidence did not support the Board's anticipation finding. In reaching this finding, the Federal Circuit reiterated that (i) a prior art reference that "must be distorted from its obvious design" does not anticipate a patent claim (citing *In re Wells*, C.C.P.A. (1931)), and (ii) "It is not sufficient to constitute an anticipation that the device relied upon might, by modification, be made to accomplish the function performed by the patent in question, if it were not designed by its maker, nor adapted, nor actually used, for the performance of such functions" (citing *Topliff v. Topliff*, U.S. (1892)).

The Federal Circuit determined that while the "arranged to engage" language of the apparatus claims at issue could imply that the protruding surface on the flat side need not always actually engage the glenoid cavity surface, it must be at least capable of doing so. Here, without either impermissibly modifying or tearing the prior art invention apart, neither the Examiner nor the Board described how the protruding surface element of the prior art was capable of engaging the surface of the glenoid cavity. Therefore, the Federal Circuit reversed the Board's anticipation finding as not supported by substantial evidence.