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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
10/413,696	04/14/2003	Peter M. Bonutti	782-A03-005-1	3597
33771 7590 09/23/2005 PAUL D BIANCO FLEIT, KAIN, GIBBONS, GUTMAN, BONGINI, & BIANCO P.L. 21355 EAST DIXIE HIGHWAY SUITE 115 MIAMI, FL 33180			EXAMINER JACKSON, GARY	
			ART UNIT 3731	PAPER NUMBER
DATE MAILED 09/23/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/413,696	BONUTTI, PETER M	
	Examiner	Art Unit	
	Gary Jackson	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on July 5, 2005

2a) ☐ This action is FINAL                      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-54 is/are pending in the application

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-54 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement

**Application Papers**

9) ☐ The specification is objected to by the Examiner

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f)

a) ☐ All    b) ☐ Some \* c) ☐ None of

1 ☐ Certified copies of the priority documents have been received

2 ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

3 ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)

Paper No(s)/Mail Date \_\_\_\_\_

4) ☐ Interview Summary (PTO-413)

Paper No(s)/Mail Date: \_\_\_\_\_

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: \_\_\_\_\_

#### **DETAILED ACTION**

This action is responsive to applicant's Election/Restriction response filed July 5, 2005. Applicant elect Group I species with traverse on the grounds that the restriction is improper and that the examiner has not demonstrated a serious burden to by showing appropriate explanation of separate classification, or separate status in the art or different field of search.

In view of applicant's remarks, the examiner has withdrawn the election of species requirement.

#### ***Double Patenting***

Claims 1-54 are rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 37 of US Patent 6,635,073.

Concerning claim 1, the subject matter recited in claim 1 of the present application - A method of securing first body tissue with second body tissue, said method comprising the steps of moving a first anchor along a first path into the second body tissue, moving a second anchor along a second path into the second body tissue said steps of moving the first and second anchors along first and second paths include moving the first and second anchors along first and second paths which intersect in the second body tissue, connecting the first and second anchors together at the intersection between the first and second path in the second body tissue, and transmitting force through a suture to the first body issue.

The method steps of claim 1 are found in claim 37 of the patent. The difference between claim 1 of the application and claim 37 of the patent lies in the fact that the

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patent claims includes providing a plurality of anchors with a suture extending between them. It has been held that the generic claim invention is "anticipated" by the "species". See in re Goodman, 29 USPQ 2d 2010 (Fed. Cir. 1993). Since claim 1 is anticipated by claim 37 of the patent, it is not patently distinct from claim 37.

The subject matter in claims 2-54 is also disclosed in the claims of the patent. Although the claims in the application are not identical to the claims of the patent, they are not patentably distinct from the patent claims. The transitional phrase "comprising" does not exclude the presents of method steps other than the method step of claim 37 of the patent—because of the phrase "comprising" the patent not only provides protection to claim 37 of the patent, but also extends coverage to the disclosed steps in claims 2-54 of the present application and disclosed in the patent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Jackson whose telephone number is (571) 272-4697. The examiner can normally be reached on Mon.-Thurs. 7:30 am to 6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gary Jackson  
Primary Examiner  
Art Unit 3731



gj  
September 19, 2005