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NOTICE OF ALLOWANCE AND FEE(S) DUE

23405 7590 02/24/2025
HESLIN ROTHENBERG FARLEY & MESITI PC
5 COLUMBIA CIRCLE
ALBANY, NY 12203

EXAMINER

GIBSON, ERIC SHANE

ART UNIT

PAPER NUMBER

3775

DATE MAILED: 02/24/2025

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
18/350,499	07/11/2023	Albert DACOSTA	3645.131C	7061

TITLE OF INVENTION: ALIGNMENT GUIDES, CUT GUIDES, SYSTEMS AND METHODS OF USE AND ASSEMBLY

APPLN. TYPE	ENTITY STATUS	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	SMALL	\$516	\$0.00	\$0.00	\$516	05/27/2025

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

HOW TO REPLY TO THIS NOTICE:

I. Review the ENTITY STATUS shown above. If the ENTITY STATUS is shown as SMALL or MICRO, verify whether entitlement to that entity status still applies.

If the ENTITY STATUS is the same as shown above, pay the TOTAL FEE(S) DUE shown above.

If the ENTITY STATUS is changed from that shown above, on PART B - FEE(S) TRANSMITTAL, complete section number 5 titled "Change in Entity Status (from status indicated above)".

For purposes of this notice, small entity fees are 40% the amount of undiscounted fees, and micro entity fees are 20% the amount of undiscounted fees.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Maintenance fees are due in utility patents issuing on applications filed on or after Dec. 12, 1980. It is patentee's responsibility to ensure timely payment of maintenance fees when due. More information is available at www.uspto.gov/PatentMaintenanceFees.

Treace Medical Concepts, Inc. v. Paragon 28, Inc.
IPR2027-00008
Treace Ex. 1005

PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), by mail or fax, or via the USPTO patent electronic filing system.

By mail, send to: Mail Stop ISSUE FEE
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

By fax, send to: (571)-273-2885

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications. **Because electronic patent issuance may occur shortly after issue fee payment, any desired continuing application should preferably be filed prior to payment of this issue fee in order not to jeopardize copendency.**

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being transmitted to the USPTO via the USPTO patent electronic filing system or by facsimile to (571) 273-2885, on the date below.

(Typed or printed name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
18/350,499	07/11/2023	Albert DACOSTA	3645.131C	7061

TITLE OF INVENTION: ALIGNMENT GUIDES, CUT GUIDES, SYSTEMS AND METHODS OF USE AND ASSEMBLY

APPLN. TYPE	ENTITY STATUS	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	SMALL	\$516	\$0.00	\$0.00	\$516	05/27/2025

EXAMINER	ART UNIT	CLASS-SUBCLASS
GIBSON, ERIC SHANE	3775	606-087000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

☐ Change of correspondence address (or Change of Correspondence Address form PTO/AIA/122 or PTO/SB/122) attached.

☐ "Fee Address" indication (or "Fee Address" Indication form PTO/AIA/47 or PTO/SB/47; Rev 03-02 or more recent) attached. **Use of a Customer Number is required.**

2. For printing on the patent front page, list

(1) The names of up to 3 registered patent attorneys or agents OR, alternatively,

1 _____

(2) The name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

2 _____

3 _____

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document must have been previously recorded, or filed for recordation, as set forth in 37 CFR 3.11 and 37 CFR 3.81(a). Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent) : ☐ Individual ☐ Corporation or other private group entity ☐ Government

4a. Fees submitted: ☐ Issue Fee ☐ Publication Fee (if required)

4b. Method of Payment: (Please first reapply any previously paid fee shown above)

☐ Electronic Payment via the USPTO patent electronic filing system ☐ Enclosed check ☐ Non-electronic payment by credit card (Attach form PTO-2038)

☐ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment to Deposit Account No. _____

5. Change in Entity Status (from status indicated above)

☐ Applicant certifying micro entity status. See 37 CFR 1.29

☐ Applicant asserting small entity status. See 37 CFR 1.27

☐ Applicant changing to regular undiscounted fee status.

NOTE: Absent a valid certification of Micro Entity Status (see forms PTO/SB/15A and 15B), issue fee payment in the micro entity amount will not be accepted at the risk of application abandonment.

NOTE: If the application was previously under micro entity status, checking this box will be taken to be a notification of loss of entitlement to micro entity status.

NOTE: Checking this box will be taken to be a notification of loss of entitlement to small or micro entity status, as applicable.

NOTE: This form must be signed in accordance with 37 CFR 1.31 and 1.33. See 37 CFR 1.4 for signature requirements and certifications.

Authorized Signature _____

Date _____

Typed or printed name _____

Registration No. _____



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18/350,499	07/11/2023	Albert DACOSTA	3645.131C	7061
23405	7590	02/24/2025	EXAMINER	
HESLIN ROTHENBERG FARLEY & MESITI PC 5 COLUMBIA CIRCLE ALBANY, NY 12203			GIBSON, ERIC SHANE	
			ART UNIT	PAPER NUMBER
			3775	
DATE MAILED: 02/24/2025				

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (Applications filed on or after May 29, 2000)

The Office has discontinued providing a Patent Term Adjustment (PTA) calculation with the Notice of Allowance.

Section 1(h)(2) of the AIA Technical Corrections Act amended 35 U.S.C. 154(b)(3)(B)(i) to eliminate the requirement that the Office provide a patent term adjustment determination with the notice of allowance. See Revisions to Patent Term Adjustment, 78 Fed. Reg. 19416, 19417 (Apr. 1, 2013). Therefore, the Office is no longer providing an initial patent term adjustment determination with the notice of allowance. The Office will continue to provide a patent term adjustment determination with the Issue Notification Letter that is mailed to applicant approximately three weeks prior to the issue date of the patent, and will include the patent term adjustment on the patent. Any request for reconsideration of the patent term adjustment determination (or reinstatement of patent term adjustment) should follow the process outlined in 37 CFR 1.705.

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

OMB Clearance and PRA Burden Statement for PTOL-85 Part B

The Paperwork Reduction Act (PRA) of 1995 requires Federal agencies to obtain Office of Management and Budget approval before requesting most types of information from the public. When OMB approves an agency request to collect information from the public, OMB (i) provides a valid OMB Control Number and expiration date for the agency to display on the instrument that will be used to collect the information and (ii) requires the agency to inform the public about the OMB Control Number's legal significance in accordance with 5 CFR 1320.5(b).

The information collected by PTOL-85 Part B is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. The United States Patent and Trademark Office (USPTO) collects the information in this record under authority of 35 U.S.C. 2. The USPTO's system of records is used to manage all applicant and owner information including name, citizenship, residence, post office address, and other information with respect to inventors and their legal representatives pertaining to the applicant's/owner's activities in connection with the invention for which a patent is sought or has been granted. The applicable Privacy Act System of Records Notice for the information collected in this form is COMMERCE/PAT-TM-7 Patent Application Files, available in the Federal Register at 78 FR 19243 (March 29, 2013).

<https://www.govinfo.gov/content/pkg/FR-2013-03-29/pdf/2013-07341.pdf>

Routine uses of the information in this record may include disclosure to:

- 1) law enforcement, in the event that the system of records indicates a violation or potential violation of law;
- 2) a federal, state, local, or international agency, in response to its request;
- 3) a contractor of the USPTO having need for the information in order to perform a contract;
- 4) the Department of Justice for determination of whether the Freedom of Information Act (FOIA) requires disclosure of the record;
- 5) a Member of Congress submitting a request involving an individual to whom the record pertains, when the individual has requested the Member's assistance with respect to the subject matter of the record;
- 6) a court, magistrate, or administrative tribunal, in the course of presenting evidence, including disclosures to opposing counsel in the course of settlement negotiations;
- 7) the Administrator, General Services Administration (GSA), or their designee, during an inspection of records conducted by GSA under authority of 44 U.S.C. 2904 and 2906, in accordance with the GSA regulations and any other relevant (i.e., GSA or Commerce) directive, where such disclosure shall not be used to make determinations about individuals;
- 8) another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c));
- 9) the Office of Personnel Management (OPM) for personnel research purposes; and
- 10) the Office of Management and Budget (OMB) for legislative coordination and clearance.

If you do not furnish the information requested on this form, the USPTO may not be able to process and/or examine your submission, which may result in termination of proceedings, abandonment of the application, and/or expiration of the patent.

Notice of Allowability	Application No. 18/350,499	Applicant(s) DACOSTA et al.	
	Examiner ERIC S GIBSON	Art Unit 3775	AIA (FITF) Status Yes

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

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed 06 February 2025.
☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

2. ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

3. ☒ The allowed claim(s) is/are 21-40. As a result of the allowed claim(s), you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

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

Certified copies:

a) ☐ All b) ☐ Some* c) ☐ None of the:

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)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)	5. ☒ Examiner's Amendment/Comment
2. ☒ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date _____.	6. ☐ Examiner's Statement of Reasons for Allowance
3. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material _____.	7. ☐ Other _____.
4. ☒ Interview Summary (PTO-413), Paper No./Mail Date. <u>20250212</u> .	

/ERIC S GIBSON/ Primary Examiner, Art Unit 3775	
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EXAMINER'S COMMENT

Terminal Disclaimer

The terminal disclaimer filed on 11 February 2025 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of **prior patent numbers 10856886 and 11696767** has been reviewed and is accepted. The terminal disclaimer has been recorded.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Gibson whose telephone number is (571)270-5274. The examiner can normally be reached Monday-Thursday ~6:00 A.M. to 4:00 P.M. (CST).

If attempts to reach the examiner by telephone are unsuccessful, ***please contact the examiner's supervisor, Kevin Truong, at (571) 272-4705***. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 18/350,499
Art Unit: 3775

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/ERIC S GIBSON/
Primary Examiner, Art Unit 3775

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Paragon 28, Inc.	Attorney Docket No.:	3645.131C
Inventors:	Albert DACOSTA, <i>et al.</i>	Confirmation No.:	7061
App No.:	18/350,499	Group Art Unit:	3775
Filed:	July 11, 2023	Examiner:	Eric GIBSON
Title:	ALIGNMENT GUIDES, CUT GUIDES, SYSTEMS AND METHODS OF USE AND ASSEMBLY		

* * * * *

To: Mail Stop AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO OFFICE ACTION

Dear Commissioner:

This Response is being submitted in reply to the Office Action mailed November 6, 2024 for the above-referenced application. The shortened statutory period is set to expire on February 6, 2025. Since this Response is being filed on or before February 6, 2025, this Response is being timely filed. *Should any issue remain unresolved by this paper, Applicant respectfully requests that the Examiner telephone their undersigned representative in order to discuss the issue in hope of facilitating prosecution of the application.* Allowance of the application is respectfully requested in view of the Amendments and Remarks below.

Amendments to the Claims are reflected in the listing of claims that begin on page 2 of this paper.

Remarks begin on page 6 of this paper.

Amendments to the Claims

The following claim listing reflects the status of the claims pending in this application.

1-20. ***(Canceled)***

21. ***(Currently Amended)*** A cut guide, comprising:

a base portion, comprising:

a first side positioned substantially opposite the base portion from a second side;

a first end positioned substantially opposite the base portion from a second end;

a top surface positioned substantially opposite the base portion from a bottom surface; and

at least one slot disposed between the first and second ends of the base portion and extending at least partially between the first side and the second side of the base, wherein the slot provides fluid communication between the top and bottom surfaces of the base;

at least one opening extending therethrough; and

an extension member extending downward from the bottom surface of the base, wherein the at least one opening extends into at least a portion of the extension member.

22. ***(Previously Presented)*** The cut guide of claim 21, wherein the at least one slot comprises at least one first slot and at least one second slot.

23. ***(Previously Presented)*** The cut guide of claim 22, wherein the extension member is positioned at least partially between the at least one first slot and the at least one second slot.

24. ***(Previously Presented)*** The cut guide of claim 23, wherein the extension member extends from the bottom surface of the base portion at a substantially orthogonal angle relative to the bottom surface of the base portion.

25. **(Previously Presented)** The cut guide of claim 24, wherein the at least one first slot is positioned in a first plane and the at least one second slot is positioned in a second plane, wherein the first and second planes form an oblique angle.
26. **(Currently Amended)** The cut guide of claim 25, ~~wherein the base portion comprises at least one opening extending therethrough,~~ wherein the at least one opening provides fluid communication between the top and bottom surfaces of the base portion.
27. **(Previously Presented)** The cut guide of claim 26, wherein the cut guide further comprises a first arm extending from the first end of the base portion.
28. **(Previously Presented)** The cut guide of claim 27, wherein the first arm forms a substantially orthogonal angle with the first end of the base portion.
29. **(Previously Presented)** The cut guide of claim 28, wherein the first arm comprises a first opening extending therethrough from a top surface through to a bottom surface thereof.
30. **(Previously Presented)** The cut guide of claim 29, wherein the first opening is positioned at a terminal end of the first arm.
31. **(Previously Presented)** The cut guide of claim 30, wherein the cut guide further comprises a second arm extending from the second end of the base portion.
32. **(Previously Presented)** The cut guide of claim 31, wherein the second arm forms a substantially orthogonal angle with the second end of the base portion.
33. **(Previously Presented)** The cut guide of claim 32, wherein the second arm comprises a second opening extending therethrough from a top surface through to a bottom surface thereof.
34. **(Currently Amended)** The cut guide of claim[[29]] 33, wherein the second opening is positioned at a terminal end of the second arm.

35. **(Previously Presented)** The cut guide of claim 21, wherein the top surface comprises a first portion and a second portion.

36. **(Previously Presented)** The cut guide of claim 35, wherein the first portion is positioned in a plane which is substantial parallel to a plane of the bottom surface, and the second portion is positioned in a plane which is substantially oblique to that of the first portion and the bottom surface.

37. **(Currently Amended)** The cut guide of claim 36, wherein at least a portion of the at least one ~~cut~~ slot is positioned in the first portion of the top surface and the second portion of the top surface.

38. **(Currently Amended)** A cut guide, comprising:
a base portion, comprising:
a first end positioned substantially opposite the base portion from a second end;
a top surface positioned substantially opposite the base portion from a bottom surface, comprising:
a first portion positioned in a first plane; and
a second portion positioned in a second plane, wherein the second plane is substantially ~~orthogonal~~ oblique to the first plane;
at least one slot disposed between the first and second ends of the base portion, wherein the at least one slot provides fluid communication between the top and bottom surfaces of the base, wherein at least a portion of the at least one slot is positioned in the first portion and the second portion of the top surface; and
at least one opening extending through the base portion; and
an extension member extending downward from the bottom surface of the base, wherein the at least one opening extends into at least a portion of the extension member.

39. **(Previously Presented)** The cut guide of claim 38, wherein the at least one slot comprises a first slot and a second slot, wherein the first and second slots are positioned in planes which form an oblique angle with one another.

40. **(Currently Amended)** A cut guide, comprising:
- a base portion, comprising:
 - a first side positioned substantially opposite the base portion from a second side, wherein the first and second sides are substantially parallel to one another;
 - a first end positioned substantially opposite the base portion from a second end;
 - a top surface positioned substantially opposite the base portion from a bottom surface, comprising:
 - a first portion positioned in a first plane; and
 - a second portion positioned in a second plane, wherein the second plane is substantially ~~orthogonal~~ oblique to the first plane;
 - at least one slot disposed between the first and second ends of the base portion, wherein the at least one slot provides fluid communication between the top and bottom surfaces of the base, wherein at least a portion of the at least one slot is positioned in the first portion and the second portion of the top surface; and
 - at least one opening extending from the top surface through to the bottom surface;
 - an extension member extending downward from the bottom surface of the base, wherein the at least one opening extends into at least a portion of the extension member;
 - a first arm extending from the first end of the base portion at a substantially orthogonal angle, comprising:
 - an opening positioned at a terminal end of the first arm and extending from a top surface of the first arm through to a bottom surface of the first arm; and
 - a second arm extending from the second end of the base portion, comprising:
 - an opening positioned at a terminal end of the second arm and extending from a top surface of the second arm through to a bottom surface of the second arm.

REMARKS

This is in response to the Office Action mailed November 6, 2024, for which the shortened statutory period is set to expire on February 6, 2025. Thus, this response is being timely filed. Claims 21-40 are pending in the application. Claims 1-20 have been canceled. Claims 21, 26, 34, 37, 38, and 40 have been amended, as follows.

Independent claim 21 has been amended to add “and,” “at least one opening extending therethrough;” and “, wherein the at least one opening extends into at least a portion of the extension member” and to delete “and.” Support for this amendment can be found, for example, throughout the Applicant’s specification, and more specifically in at least claim 26, paragraphs [0133], [0137], [0142], [0151], [0160], [0190], [0198], [0202], [0207], and [0211] and FIGS. 6, 10, 12, 15-16, 19-20, 23-24, 79-80, 84, 86, 89-90, 99-100, and 104.

Claim 26 is amended to delete “wherein the base portion comprises at least one opening extending therethrough,” for clarity.

Claim 34 has been amended to depend from claim 33 for proper antecedent basis of “the second opening” and “the second arm.”

Claim 37 has been amended to delete “cut” for proper antecedent basis.

Independent claim 38 has been amended to change “orthogonal” to “oblique” and to add “at least one opening extending through the base portion; and” and “, wherein the at least one opening extends into at least a portion of the extension member” for clarity. Support for this amendment can be found, for example, throughout the Applicant’s specification, and more specifically in at least claim 26, paragraphs [0133], [0137], [0142], [0151], [0160], [0190], [0198], [0202], [0207], and [0211] and FIGS. 6, 10, 12, 15-16, 19-20, 23-24, 79-80, 84, 86, 89-90, 99-100, and 104.

Independent claim 40 has been amended to change “orthogonal” to “oblique” and to add “, wherein the at least one opening extends into at least a portion of the extension member” for clarity. Support for this amendment can be found, for example, throughout the Applicant’s specification, and more specifically in at least claim 26, paragraphs [0133], [0137], [0142], [0151], [0160], [0190], [0198], [0202], [0207], and [0211] and FIGS. 6, 10, 12, 15-16, 19-20, 23-24, 79-80, 84, 86, 89-90, 99-100, and 104.

Accordingly, no new matter is added by this amendment and reconsideration of the application in view of the above Amendment and the Remarks below is respectfully requested.

Drawing Objection

The Patent Office objected to the drawings under 37 C.F.R. §1.83(a) as not showing every feature of the invention specified in the claims. Specifically, the Patent Office notes that the feature “a first portion positioned in a first plane; and a second portion positioned in a second plane, wherein the second plane is substantially orthogonal to the first plane” of claims 38 and 40 are not shown in the drawings. Applicant has amended “orthogonal” to “oblique” to correct the typographical error in claims 38 and 40.

In view of the amendments to claims 38 and 40, the Examiner is respectfully requested to reconsider and withdraw the drawing objection based upon the original drawings and claim amendments filed herewith.

Specification Objection

The Patent Office objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. Specifically, the Patent Office notes that the limitation “a first portion positioned in a first plane; and a second portion positioned in a second plane, wherein the second plane is substantially orthogonal to the first plane” is not provided in the specification. Applicant has amended claims 38 and 40 based on at least paragraph [0133] to change “orthogonal” to “oblique” as disclosed in the specification.

In view of the above-noted amendment, the Examiner is respectfully requested to reconsider and withdraw the specification objection.

Claim Rejection under 35 U.S.C. § 112

The Patent Office rejected claims 34 and 38-40 under 35 U.S.C. §112(b) as being indefinite for failing to particularly point out and distinctly claim the subject matter which the joint inventors regard as the invention. Specifically, the Patent Offices notes that the limitations “the second opening” and “the second arm” in claim 34 have insufficient antecedent basis. Applicant has amended claim 34 to depend from claim 33 for proper antecedent basis of “the second opening” and “the second arm.”

Further, the Patent Office Notes that the limitation “a top surface positioned substantially opposite the base portion from a bottom surface, comprising: a first portion positioned in a first plane; and a second portion positioned in a second plane, wherein the second plane is

substantially orthogonal to the first plane” in claims 38 and 40 is unclear based on the specification and figures. Applicant has amended claims 38 and 40 to change “orthogonal” to “oblique” for clarity.

For the above reasons, withdrawal of the rejection of claims 34 and 38-40 under Section 112(b) is respectfully requested.

Reconsideration and allowance of the claims in view of the above Amendments and the Remarks that follow is respectfully requested.

Claim Rejection under 35 U.S.C. § 102

The Patent Office rejected claims 21-40 under 35 U.S.C. § 102(a)(1) as anticipated by U.S. Publication No. 2017/0079669 to Bays *et al.* (hereinafter “Bays”). The Applicant respectfully requests that these rejections be reconsidered and withdrawn based upon the above Amendments and the following comments and observations.

The Applicant’s undersigned Attorney typically refers to the MPEP for guidance when considering whether an anticipation rejection is appropriate. For instance, MPEP § 2131 defines the conditions under which an anticipation rejection is appropriate:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”
Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

To expedite allowance and remove issues for consideration, Applicant herein amends the claims without prejudice or disclaimer and expressly reserves the right to present for examination any claim previously pending herein in another application, e.g., in a continuing application.

Independent claim 21, as amended, distinguishes patentably over Bays because each claim requires, at least, the recited “at least one opening extending therethrough; and an extension member extending downward from the bottom surface of the base, wherein the at least one opening extends into at least a portion of the extension member.”

Independent claim 38, as amended, distinguishes patentably over Bays because each claim requires, at least, the recited “at least one opening extending through the base portion; and

an extension member extending downward from the bottom surface of the base, wherein the at least one opening extends into at least a portion of the extension member.”

Independent claim 40, as amended, distinguishes patentably over Bays because each claim requires, at least, the recited “at least one opening extending from the top surface through to the bottom surface; an extension member extending downward from the bottom surface of the base, wherein the at least one opening extends into at least a portion of the extension member.”

In sharp contrast, Bays discloses a bone preparing guide and spacer (10) with a bone preparing guide (12) and a spacer (14). The bone preparing guide (12) includes a body (16) with a first guide surface (18) and a second guide surface (20). The body (16) also includes a first facing surface (22) is positioned adjacent to the first guide surface (18) and a second facing surface (24) is positioned adjacent the second guide surface (20). A first guide slot (26) extends through the body (16) between the first guide surface (18) and the first facing surface (22). A second guide slot (28) extends through the body (16) between the second facing surface (24) and the second guide surface (20). In addition, the body (16) includes an opening (30) extending therethrough between a surface (32) opposite the first facing surface (22) and a surface (34) opposite the second facing surface (24). The spacer (14) is inserted into the opening (30). Thus, the opening (30) does not and cannot extend through at least a portion of the extension member, as required by amended independent claims 21, 38, and 40. Therefore, Bays lacks disclosure of at least, the at least one opening extends into at least a portion of the extension member, as required by amended independent claims 21, 38, and 40.

It is well established that to be anticipatory, a prior art reference must disclose each and every element of the claimed invention. Here, Bays fails to disclose, at least, wherein the at least one opening extends into at least a portion of the extension member, as is required by each of rejected independent claims 21, 38, and 40. For at least these reasons, claims 21, 38, and 40, as amended, are not anticipated by Bays and withdrawal of the rejection of claims 21, 38, and 40 under 35 U.S.C. §102(a)(1) and (a)(2) is, therefore, respectfully requested. Dependent claims 22-37 and 39 are believed to be allowable for the same reasons noted above in connection with amended independent claims 21 and 38, from which they directly or ultimately depend, as well as for their own additional features.

Prior Art Made of Record and Not Relied Upon

Applicant notes that the Examiner also cited pertinent prior art on Form 892, Applicant will not burden the record with a discussion of the prior art cited but not applied to the claims.

Regarding the claims discussed herein, the Applicant's selective treatment and emphasis of independent claims of the application should not be taken as an indication that the Applicant believes that the Examiner's dependent claim rejections are otherwise sufficient. Applicant expressly reserves the right to present arguments traversing the propriety of the dependent claim rejections later in the prosecution of this or another application.

Regarding the dependent claims herein, the dependent claims are respectfully asserted to be allowable for their dependence on an allowable base claim and for the additional elements recited therein.

The various claim amendments are presented herein to address informalities or to add further clarity to the claims. These claim amendments do not further limit any claim and shall not be regarded as "narrowing" claim amendments unless specifically indicated as such.

No amendment presented herein contains new matter.

CONCLUSION

It is believed that all of the rejections to the pending claims have been addressed. However, failure to address a specific rejection, issue or comment in the present file history does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made in the present file history are not intended to be exhaustive, there may be reasons for patentability for any or all pending claims (or other claims) that have not been expressed. Finally, nothing in the present file history should be construed as an intent to concede any issue with regard to any claim, except as specifically stated, and the amendment of any claims does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Accordingly, in view of the above Amendments and Remarks, Applicant believes that all of the claims of the present application are in allowable form. As such, Applicant respectfully requests reconsideration and passage to allowance of the application.

If a telephone conference would be of assistance in advancing prosecution of the subject application, the Applicant's undersigned Attorney invites the Examiner to telephone her at the number provided.

The Commissioner is hereby authorized to charge any additional fees associated with this Response to Office Action, and only this Response to Office Action, or credit any overpayment to Deposit Account No. 08-1935, Docket No. 3645.131C.

Respectfully submitted,

/Jacquelyn A. Graff/

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Dated: February 6, 2025

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EXAMINER

GIBSON, ERIC SHANE

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PAPER

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

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Notice of Pre-AIA or AIA Status

The present application, filed on or after March 16, 2013, is being examined under the first inventor to file provisions of the AIA.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “a first portion positioned in a first plane; and a second portion positioned in a second plane, wherein the second plane **is substantially orthogonal** to the first plane” of claims 38 and 40 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "a first portion positioned in a first plane; and a second portion positioned in a second plane, wherein the second plane **is substantially orthogonal** to the first plane" should be added to the specification. No new matter should be entered.

Claim Rejections - 35 USC § 112

The following is a quotation of 35 U.S.C. 112(b):

(b) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

The following is a quotation of 35 U.S.C. 112 (pre-AIA), second paragraph:

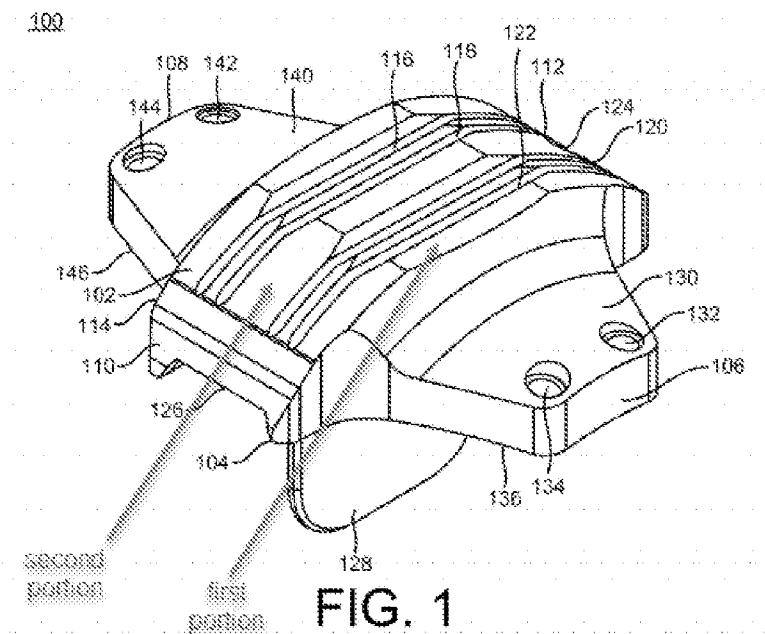
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 34 and 38-40 are rejected under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor (or for applications subject to pre-AIA 35 U.S.C. 112, the applicant), regards as the invention.

Claim 34 recites the limitation "the second opening" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 34 recites the limitation "the second arm" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claims 38 and 40 recite "a top surface positioned substantially opposite the base portion from a bottom surface, comprising: a first portion positioned in a first plane; and a second portion positioned in a second plane, wherein the second plane **is substantially orthogonal** to the first plane." However, looking to applicant's specification and drawings, the term "orthogonal/perpendicular" does not appear to be present in the specification when describing the top surface, and the top surface in the drawings appears to only show two portions with planes that are angled/oblique to one another (see applicant's Fig. 1 below as an example).



Therefore, claims 38 and 40 will be interpreted in that the “second plane” is substantially angled/oblique to the “first plane.” A further clarifying amendment is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a)(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention.

(a)(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

Claim(s) 21-40 is/are rejected under 35 U.S.C. 102(a)(1) and 102(a)(2) as being anticipated by Bays et al., U.S. PG-Pub 2017/0079669.

Regarding claim 21, Bays et al. discloses a cut guide, comprising: a base portion (16), comprising: a first side positioned substantially opposite the base portion from a second side; a first end positioned substantially opposite the base portion from a second end; a top surface positioned substantially opposite the base portion from a bottom surface; and at least one slot (26 or 28) disposed between the first and second ends of the base portion and extending at least partially between the first side and the second side of the base, wherein the slot provides fluid communication between the top and bottom surfaces of the base; and an extension member extending downward from the bottom surface of the base (examiner annotated Fig. 1 below).

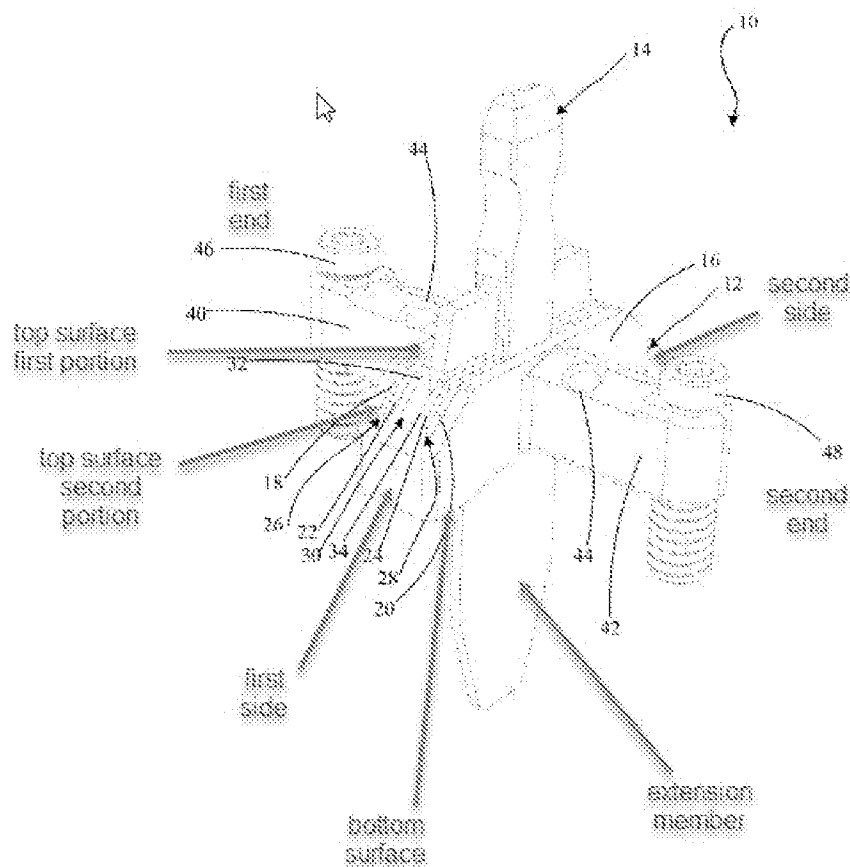


FIG. 1

Regarding claims 22-26, Bays et al. discloses wherein the at least one slot (26 or 28) comprises at least one first slot (26) and at least one second slot (28); wherein the extension member is positioned at least partially between the at least one first slot and the at least one second slot; wherein the extension member extends from the bottom surface of the base portion at a substantially orthogonal angle relative to the bottom surface of the base portion (examiner annotated Fig. 1 above); wherein the at least one first slot is positioned in a first plane and the at least one second slot is positioned in a second plane, wherein the first and second planes form an oblique angle (Fig. 5 and

paragraph [0032] discloses first and second slots 26, 28 may be skewed, e.g. non-parallel, to each other, thus making them form an oblique angle); and wherein the base portion (16) comprises at least one opening (30) extending therethrough, wherein the at least one opening provides fluid communication between the top and bottom surfaces of the base portion (examiner annotated Fig. 1 above).

Regarding claims 27-34, Bays et al. discloses wherein the cut guide further comprises a first arm (40) extending from the first end of the base portion (16), wherein the first arm forms a substantially orthogonal angle with the first end of the base portion, wherein the first arm comprises a first opening extending therethrough (opening in which fastener 46 extends through) from a top surface through to a bottom surface thereof, wherein the first opening is positioned at a terminal end of the first arm; and further comprises a second arm (42) extending from the second end of the base portion, wherein the second arm forms a substantially orthogonal angle with the second end of the base portion, wherein the second arm comprises a second opening extending therethrough (opening in which fastener 48 extends through) from a top surface through to a bottom surface thereof, wherein the second opening is positioned at a terminal end of the second arm (examiner annotated Fig. 1 above).

Regarding claims 35-37, Bays et al. discloses wherein the top surface comprises a first portion and a second portion, wherein the first portion is positioned in a first plane which is substantially parallel to a plane of the bottom surface, and the second portion is positioned in a plane which is substantially oblique to that of the first portion and the bottom surface; and wherein at least a portion of the at least one cut slot (26 or 28) is

positioned in the first portion of the top surface and the second portion of the top surface (examiner annotated Fig. 1 above and examiner annotated Fig. 1 below).

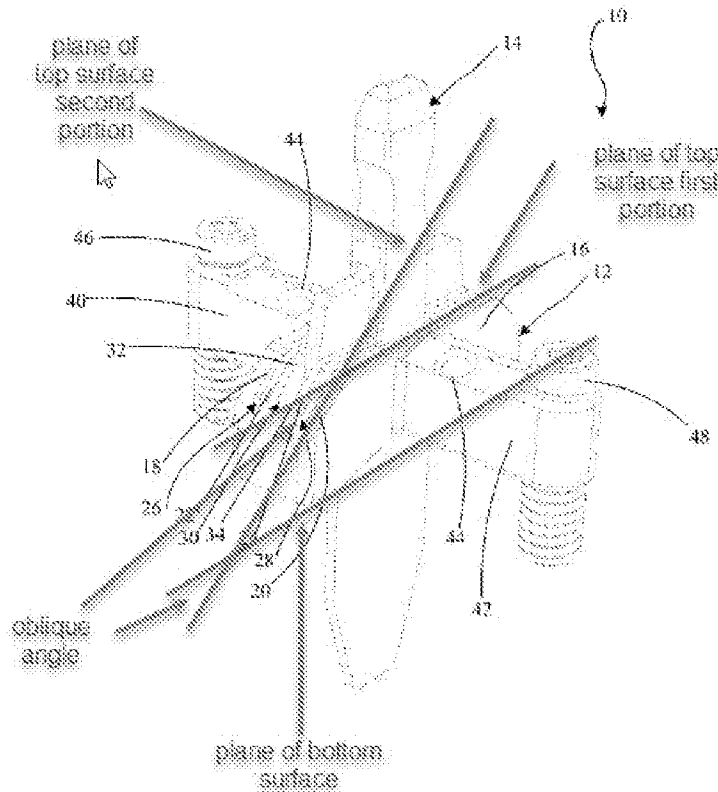


FIG. 1

Regarding claims 38 and 39, as best understood in view of the 35 U.S.C. 112(b) rejection set forth above, Bays et al. discloses a cut guide, comprising: a base portion (16), comprising: a first end positioned substantially opposite the base portion from a second end; a top surface positioned substantially opposite the base portion from a bottom surface, comprising: a first portion positioned in a first plane; and a second portion positioned in a second plane, wherein the second plane is substantially

orthogonal to the first plane (the first and second portions of Bays et al. are at an oblique angle similar to that disclosed in applicant's disclosure and as interpreted in the 35 U.S.C. 112(b) rejection set forth above; therefore, Bays et al. discloses first and second portions that are in as much substantially orthogonal to one another as applicant's); at least one slot (26 or 28) disposed between the first and second ends of the base portion, wherein the at least one slot provides fluid communication between the top and bottom surfaces of the base, wherein at least a portion of the at least one slot is positioned in the first portion and the second portion of the top surface; and an extension member extending downward from the bottom surface of the base (see both examiner annotated Figs. 1 above); wherein the at least one slot comprises a first slot (26) and a second slot (28), wherein the first and second slots are positioned in planes which form an oblique angle with one another (Fig. 5 and paragraph [0032] discloses first and second slots 26, 28 may be skewed, e.g. non-parallel, to each other, thus making them form an oblique angle).

Regarding claim 40, as best understood in view of the 35 U.S.C. 112(b) rejection set forth above, Bays et al. discloses a cut guide, comprising: a base portion (16), comprising: a first side positioned substantially opposite the base portion from a second side, wherein the first and second sides are substantially parallel to one another; a first end positioned substantially opposite the base portion from a second end; a top surface positioned substantially opposite the base portion from a bottom surface, comprising: a first portion positioned in a first plane; and a second portion positioned in a second plane, wherein the second plane is substantially orthogonal to the first plane (the first and second portions of Bays et al. are at an oblique angle similar to that disclosed in

applicant's disclosure and as interpreted in the 35 U.S.C. 112(b) rejection set forth above; therefore, Bays et al. discloses first and second portions that are in as much substantially orthogonal to one another as applicant's); at least one slot (26 or 28) disposed between the first and second ends of the base portion, wherein the at least one slot provides fluid communication between the top and bottom surfaces of the base, wherein at least a portion of the at least one slot is positioned in the first portion and the second portion of the top surface; and at least one opening (30) extending from the top surface through to the bottom surface; an extension member extending downwardly from the bottom surface of the base; a first arm (40) extending from the first end of the base portion at a substantially orthogonal angle, comprising: an opening (opening in which fastener 46 extends through) at a terminal end of the first arm and extending from a top surface of the first arm through to a bottom surface of the first arm; and a second arm (42) extending from the second end of the base portion, comprising: an opening (opening in which fastener 48 extends through) positioned at a terminal end of the second arm and extending from a top surface of the second arm through to a bottom surface of the second arm (see both examiner annotated Figs. 1 above).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Gibson whose telephone number is (571)270-5274. The examiner can normally be reached Monday-Thursday ~6:00 A.M. to 4:00 P.M. (CST).

If attempts to reach the examiner by telephone are unsuccessful, ***please contact the examiner's supervisor, Kevin Truong, at (571) 272-4705***. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ERIC S GIBSON/
Primary Examiner, Art Unit 3775