

# PATENT COOPERATION TREATY

# PCT

From the INTERNATIONAL SEARCHING AUTHORITY

To:  
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INVITATION TO PAY ADDITIONAL FEES  
 AND, WHERE APPLICABLE, PROTEST FEE  
 (PCT Article 17(3)(a) and Rule 40.1 and 40.2(e))

	Date of mailing (day/month/year) <span style="float: right;">27 March 2018 (27-03-2018)</span>
Applicant's or agent's file reference DSP5315WOPCT	<b>PAYMENT DUE</b> within <b>ONE MONTH</b> from the above date of mailing
International application No. PCT/US2018/013940	International filing date (day/month/year) <span style="float: right;">17 January 2018 (17-01-2018)</span>
Applicant  DEPUY SYNTHES PRODUCTS, INC	

1. This International Searching Authority

(i) considers that there are 3 (number of) inventions claimed in the international application covered by the claims indicated on an extra sheet:

(ii) therefore considers that **the international application does not comply with the requirements of unity of invention** (Rules 13.1, 13.2 and 13.3) for the reasons indicated on an extra sheet:

(iii)  has carried out a partial international search (see Annex)  will establish the international search report on those parts of the international application which relate to the invention first mentioned in claims Nos.:  
**see extra sheet**

(iv) will establish the international search report on the other parts of the international application only if, and to the extent to which, additional fees are paid.

2. Consequently, the applicant is hereby **invited to pay**, within the time limit indicated above, the amount indicated below:

<u>EUR 1.875,00</u>	x	<u>2</u>	=	<u>EUR 3.750,00</u>
Fee per additional invention		number of additional inventions		currency/total amount of additional fees

3. The applicant is informed that, according to Rule 40.2(c), **the payment of any additional fee may be made under protest**, i.e., a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fee is excessive, where applicable, subject to the payment of a protest fee.  
 Where the applicant pays additional fees under protest, the applicant is hereby invited, within the time limit indicated above, to pay a protest fee (Rule 40.2(e)) in the amount of EUR 875,00 (currency/amount)

Where the applicant has not, within the time limit indicated above, paid the required protest fee, the protest will be considered not to have been made and the International Searching Authority will so declare.

4.  Claim(s) Nos. \_\_\_\_\_ have been found to be unsearchable under Article 17(2)(b) because of defects under Article 17(2)(a) and therefore have not been included with any invention.

Name and mailing address of the International Searching Authority European Patent Office, P.B. 5818 Patentlaan 2 NL-2280 HV Rijswijk Tel. (+31-70) 340-2040 Fax: (+31-70) 340-3016	Authorized officer STAUBER, Regina Tel: +49 (0)89 2399-5654
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This International Searching Authority found multiple (groups of) inventions in this international application, as follows:

1. claims: 1-12

Device for cutting a surgical cable, in which the first and second coaxial member each comprise at least two openings acting as shearing structures.

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2. claims: 13-23

Cutting surgical device having a gear mechanism actuated by the handle unit.

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3. claims: 24-33

Device for cutting a surgical cable, the device having a gear mechanism actuated by a handle unit for rotating two tubular members with respect to each other.

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The application lacks unity (Rules 13.1 and 13.2 PCT), as 3 groups of invention are claimed:

I) Claims 1-12, which essentially define a device for cutting a surgical cable, in which the first and second coaxial member each comprise at least two openings acting as shearing structures.

II) Claims 13-23, which essentially define a cutting surgical device having a gear mechanism actuated by the handle unit.

III) Claims 24-33, which essentially define a device for cutting a surgical cable, the device having a gear mechanism actuated by a handle unit for rotating two tubular members with respect to each other.

The common subject-matter between any two groups of inventions is at most:

A device for cutting a surgical cable, comprising:

an intervention unit comprising first and second members each comprising at least one opening in a distal end; and

a handle unit comprising an actuatable handle adapted to rotate the second coaxial member relative to the first;

wherein the two openings in the distal ends of the coaxial members function as coordinating shearing structures when the actuatable handle is actuated.

Said subject-matter is clearly not novel over the general common knowledge. There are also several documents disclosing said subject-matter, see for example document US 2005/149086 A1 (paragraphs [0031] - [0036]; figures 1-4B).

The features of each group which are not common with the other group also address different objective technical problems.

Said problems may be regarded as being:

I) Provide at least two opening positions for cutting the cable

II) Provide means for actuate the pinion against the coupling

III) Provide a mechanism for rotating the first tubular member with respect to the second tubular member and thereby exert a shearing force

on the cable.

Therefore, according to Rules 13.1 and 13.2 PCT the requirement of unity is not fulfilled, because there are no common or corresponding special technical features.

**Annex to Form PCT/ISA/206  
COMMUNICATION RELATING TO THE RESULTS  
OF THE PARTIAL INTERNATIONAL SEARCH**

International Application No  
PCT/US2018/013940

1. The present communication is an Annex to the invitation to pay additional fees (Form PCT/ISA/206). It shows the results of the international search established on the parts of the international application which relate to the invention first mentioned in claims Nos.:
- see 'Invitation to pay additional fees'
2. This communication is not the international search report which will be established according to Article 18 and Rule 43.
3. If the applicant does not pay any additional search fees, the information appearing in this communication will be considered as the result of the international search and will be included as such in the international search report.
4. If the applicant pays additional fees, the international search report will contain both the information appearing in this communication and the results of the international search on other parts of the international application for which such fees will have been paid.

**C. DOCUMENTS CONSIDERED TO BE RELEVANT**

Category °	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	US 2011/062204 A1 (AEBI THIS [CH] ET AL) 17 March 2011 (2011-03-17) paragraphs [0027] - [0033], [0035], [0037], [0040] - [0042], [0045], [0046]; figures 1-6 -----	1-12
A	US 2005/149086 A1 (HUXEL SHAWN T [US] ET AL) 7 July 2005 (2005-07-07) paragraphs [0031] - [0036]; figures 1-4B -----	1
A	US 5 980 547 A (RINNER JAMES A [US]) 9 November 1999 (1999-11-09) the whole document -----	1
A	WO 2008/073949 A1 (SYNTHES USA [US]; SYNTHES GMBH [CH]; DELL OCA ALBERTO A FERNANDEZ [UY]) 19 June 2008 (2008-06-19) paragraphs [0011] - [0018]; figures 1-8 -----	1

Further documents are listed in the continuation of box C.

Patent family members are listed in annex.

° Special categories of cited documents :

- "A" document defining the general state of the art which is not considered to be of particular relevance
- "E" earlier document but published on or after the international filing date
- "L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)
- "O" document referring to an oral disclosure, use, exhibition or other means
- "P" document published prior to the international filing date but later than the priority date claimed

- "T" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention
- "X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone
- "Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art.
- "&" document member of the same patent family

# Patent Family Annex

Information on patent family members

International Application No <b>PCT/US2018/013940</b>
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Patent document cited in search report	Publication date	Patent family member(s)	Publication date
US 2011062204 A1	17-03-2011	EP 2294996 A1 ES 2539123 T3 US 2011062204 A1	16-03-2011 26-06-2015 17-03-2011
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US 2005149086 A1	07-07-2005	NONE	
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US 5980547 A	09-11-1999	NONE	
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WO 2008073949 A1	19-06-2008	NONE	
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Application no:  
Demande n°: PCT/US2018/013940  
Anmelde-Nr:

#### DISCLAIMER

The attached provisional opinion on the patentability of the first invention searched serves only as information.  
A reply addressing the points raised in the opinion is **not** required and will **not** be taken into account when issuing the final search report and opinion on patentability.

#### AVERTISSEMENT

L'avis provisoire ci-joint sur la brevetabilité de la première invention recherchée ne sert qu'à titre d'information.  
Une réponse abordant les points soulevés dans l'avis n'est **pas** nécessaire et ne sera **pas** prise en compte lors de l'établissement du rapport final de la recherche et de l'avis sur la brevetabilité.

#### DISCLAIMER

Die beigefügte vorläufige Stellungnahme zur Patentierbarkeit der ersten geprüften Erfindung dient lediglich zur Information.  
Eine Antwort auf die erhobenen Punkte in der Stellungnahme ist **nicht** erforderlich und bleibt bei der Erstellung des endgültigen Recherchenberichts und der Stellungnahme zur Patentierbarkeit **unberücksichtigt**.

## **Re Item IV**

### **Lack of unity of invention**

Reference is made to the following documents:

- D1 US 2011/062204 A1 (AEBI THIS [CH] ET AL) 17 March 2011  
(2011-03-17)
- D2 US 2005/149086 A1 (HUXEL SHAWN T [US] ET AL) 7 July 2005  
(2005-07-07)
- D3 US 5 980 547 A (RINNER JAMES A [US]) 9 November 1999  
(1999-11-09)
- D4 WO 2008/073949 A1 (SYNTHESES USA [US]; SYNTHESES GMBH [CH];  
DELL OCA ALBERTO A FERNANDEZ [UY]) 19 June 2008 (2008-06-19)

The application lacks unity (Rules 13.1 and 13.2 PCT), as 3 groups of invention are claimed:

- I) Claims 1-12, which essentially define a device for cutting a surgical cable, in which the first and second coaxial member each comprise at least two openings acting as shearing structures.
- II) Claims 13-23, which essentially define a cutting surgical device having a gear mechanism actuated by the handle unit.
- III) Claims 24-33, which essentially define a device for cutting a surgical cable, the device having a gear mechanism actuated by a handle unit for rotating two tubular members with respect to each other.

The common subject-matter between any two groups of inventions is at most:

A device for cutting a surgical cable, comprising:

an intervention unit comprising first and second members each comprising at least one opening in a distal end; and

a handle unit comprising an actuatable handle adapted to rotate the second coaxial member relative to the first;

wherein the two openings in the distal ends of the coaxial members function as coordinating shearing structures when the actuatable handle is actuated.

Said subject-matter is clearly not novel over the general common knowledge. There are also several documents disclosing said subject-matter, see for example document D2 (paragraphs [0031] - [0036]; figures 1-4B).

The features of each group which are not common with the other group also address different objective technical problems.

Said problems may be regarded as being:

- I) Provide at least two opening positions for cutting the cable
- II) Provide means for actuate the pinion against the coupling
- III) Provide a mechanism for rotating the first tubular member with respect to the second tubular member and thereby exert a shearing force on the cable.

Therefore, according to Rules 13.1 and 13.2 PCT the requirement of unity is not fulfilled, because there are no common or corresponding special technical features.

### **Re Item V**

#### **Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

1. The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claims 1-8 and 12 is not new in the sense of Article 33(2) PCT.

Document D1 discloses (see paragraphs [0027] - [0033], [0035], [0037], [0040] - [0042], [0045], [0046]; figures 1-6):

A device for cutting a surgical cable, comprising:

an intervention unit comprising first (3, 13) and second (4, 14) coaxial members each comprising at least two openings (51, 52, 53) in a distal end; and

a handle unit comprising an actuatable handle (7) adapted to retain and engage the first and second coaxial members at a proximal end and to rotate the second coaxial member relative to the first;

wherein the at least two openings in the distal ends of the coaxial members function as coordinating shearing structures when the actuatable handle is actuated.

Claim 1 is therefore not new.

Document D1 also anticipates the subject-matter of claims 2-8 and 12 (see paragraphs [0027] - [0033], [0035], [0037], [0040] - [0042], [0045], [0046]; figures 1-6).



2. In claims 9-11, slight constructional changes in the device of claim 1 are defined which come within the scope of the customary practice followed by persons skilled in the art, especially as the advantages thus achieved can readily be foreseen. Consequently, the subject-matter of claims 9-11 lacks an inventive step in the sense of Article 33(3) PCT.

### **Re Item VII**

#### **Certain defects in the international application**

1. The independent claims are not in the two-part form in accordance with Rule 6.3(b) PCT, which in the present case would be appropriate, with those features known in combination from the prior art (document D1) being placed in the preamble (Rule 6.3(b)(i) PCT) and the remaining features being included in the characterising part (Rule 6.3(b)(ii) PCT).

2. The features of the claims are not provided with reference signs placed in parentheses (Rule 6.2(b) PCT).

3. Contrary to the requirements of Rule 5.1(a)(ii) PCT, the relevant background art disclosed in documents D1, D2 is not mentioned in the description, nor are these documents identified therein.

### **Re Item VIII**

#### **Certain observations on the international application**

1. The vague and imprecise statement "*As is readily apparent to those skilled in the art, variations and modifications can be effected while remaining within the spirit and scope of the invention. Further, various elements from the various embodiments may be combined to form other embodiments that are within the spirit and scope of the invention.*" in the description paragraph [0061] implies that the subject-matter for which protection is sought may be different to that defined by the claims, thereby resulting in lack of clarity (Article 6 PCT) when used to interpret them.