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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GARY K. MICHELSON

Appeal 2010-006601
Application 10/911,919
Technology Center 3700

Before NEAL E. ABRAMS, EDWARD A. BROWN
and RICHARD E. RICE, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Gary K. Michelson (Appellant) seeks our review under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1-14, 17-20, 22, 23, 25-28, 31, 33-38 and 43-50. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

THE INVENTION

The claimed invention is directed to the combination of an interbody spinal implant and an implant holder for inserting the implant.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

A combination of an interbody spinal implant and an implant holder for use in human interbody spinal surgery comprising:

said interbody spinal implant having a trailing end adapted to be engaged to said implant holder; and

said implant holder having a body having a distal end, a proximal end, and a length therebetween, and at least two extensions extending from said distal end of said body, said extensions having an interior surface and an exterior surface opposite said interior surface, said extensions being adapted to be moved toward one another by an inward force applied by a user to said exterior surface to permit said extensions of said implant holder to pass into said trailing end of said implant and for said exterior surface to cooperatively engage said trailing end of said implant after the inward force is removed.

THE PRIOR ART

The Examiner relied upon the following as evidence of unpatentability:

Michelson	US 5,609,635	Mar. 11, 1997
Farris	US 6,066,174	May 23, 2000
Roufa	US 6,417,173 B1	Jul. 9, 2002
Zientek	WO 97/06753	Feb. 27, 1997
Liu	WO 00/12033	Mar. 9, 2000

THE REJECTIONS

Claims 1-5, 9, 10, 25, 26, 34-38, 43, 44 and 48-50 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Farris.

Claims 1-4, 7, 11, 17-20, 22, 23, 25, 27, 28 and 31 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Zientek.

Claims 11-14, 27, 28, 31 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Farris in view of Liu.

Claim 45 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Farris in view of Michelson.

Claims 46 and 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Farris in view of Roufa.

OPINION

*Claims 1-5, 9, 10, 25, 26, 34-38, 43, 44 and 48-50
Anticipation – Farris*

Farris discloses an intervertebral implant and an implant insertion device. The Examiner determined that the implant shown in Figure 2 has a “trailing end” and “an opening,” and that Figures 7 and 8 disclose an implant holder that can engage the implant by moving through “the opening (see Fig. 2, element 30) of the trailing end.” Ans. 4. The Examiner also found that the implant holder has two extensions 55, each having an interior surface and an exterior surface, with the exterior surfaces being adapted to “cooperatively engage the trailing end of the implant.” Ans. 4-5. In response to Appellant’s arguments, the Examiner further states that

[a]pplying the broadest reasonable interpretation to the claims, the examiner considers the “trailing end” to include the entire end portion (see [annotated] Fig. 2 below) of the implant. The

end portion . . . or trailing end of the implant includes multiple pieces of the implant and an **opening** extending between the implant pieces.

Ans. 15.

Appellant argues that the trailing end of the Farris implant shown in Figure 2 “is solid and possesses no opening. Instead, the upper and lower surfaces . . . include an opening extending therebetween.” Appellant further argues that the Examiner has failed to explain how the jaws of the Farris implant insertion device are capable of passing into the solid trailing end of the implant, and points out that in a previous set of annotated Figures 2 and 8, the Examiner showed the jaws of the implant insertion device passing into the opening in the upper surface of the implant, “[which] is not the trailing end.” Further, Appellant asserts that the Examiner has failed to explain how the exterior surfaces of the jaws of the implant holder cooperatively engage the trailing end of the implant, and points out that Farris teaches in Figure 11 that it is the interior surfaces of the jaws of the insertion device that engage the outer surfaces of the trailing end of the implant. *See* Br. 6-8.

Finally, Appellant argues that

the claims must be “given their broadest reasonable interpretation **consistent with the specification**,” and that “claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.” (In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364 (Fed. Cir. 2004) (emphasis added).),

and

“[o]rdinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say.” (MPEP § 2111.01, citing, In re Zietz

[sic., Zletz], 893 F.2d 319 (Fed. Cir. 1989) and Chef America, Inc. v. Lamb-Weston, Inc., 358 F.3d 1371 (Fed. Cir. 2004).)

Reply Br. 3-4. In this regard, Appellant submits that “the meaning of [the] term ‘trailing end’ is clear and unquestionable. The specification makes it clear that ‘trailing end’ means posterior.” *Id.* at 4.

In the description of related art on page 3 of Appellant’s Specification it is stated that expandable implants are adapted to be capable of increasing their height “posteriorly (at their trailing ends).” Implant 1700, which is the claimed embodiment of the invention and is illustrated in Figure 67 (Br. 2), is described as having “a trailing end 1704,” which clearly is shown in the drawing as the distal end of the implant. Thus, one of ordinary skill in the art would have understood from Appellant’s Specification that “trailing end” is intended to mean the distal end of the implant, which is labeled as 1704 in Figure 67. The Examiner has provided no evidence that such definition of “trailing end” is inconsistent with its use in the Specification or the common use of such terminology. Applying this definition to the Farris implant, it is clear that the “trailing end” of the implant shown in Figures 1-3 is surface 15, which is described in the Specification as “posterior wall **15**” (Col. 4, ll. 62-63). There is no opening in posterior wall 15. We therefore agree with Appellant that the Examiner’s finding that Farris discloses an implant having an opening in its trailing end is in error, and therefore the reference does not anticipate the requirement in claim 1 that “said extensions of said implant holder” are permitted “to pass into said trailing end of said implant.”

We further agree with Appellant that there is no support in Farris for the Examiner's conclusion that the exterior surfaces of implant holder extensions 55 have the capability "to cooperatively engage said trailing end of said implant after the inward force [placed upon them] is removed," also as required by claim 1. In this regard, the Farris teaching is limited to grasping the upper and lower outside surfaces of the trailing end of the implant between the interior surfaces of extensions 55 (Col. 10, ll.12-18; Fig. 11).

For the reasons set forth above, Farris does not anticipate the subject matter recited in Appellant's claim 1, and this rejection of independent claim 1 is not sustained. It follows that the like rejection of claims 2-5, 9, 10, 25, 26, 34-38, 43, 44 and 48-50, all of which depend from claim 1, also is not sustained.

*Claims 1-4, 7, 11, 17-20, 22, 23, 25, 27, 28 and 31
Anticipation – Zientek*

Citing to Zientek Figures 4 and 21, the Examiner determined that all of the elements recited in claim 1 were taught by this reference. In particular, the Examiner found that the implant (Fig. 4) had a "trailing end . . . adapted to be engaged to the implant holder" (Fig. 21). Ans. 7-9. In response to Appellant's arguments, the Examiner explained that the element shown in Figure 21 (110) is used for screwing the screw (13) into the bore in the trailing end of the implant, thereby contacting the implant through screw holding extensions 115 and 116, and "that a user could place an inward force to the exterior surface of the flexible extensions . . . to permit the extensions to pass into the trailing end of the implant . . . and into the bore." Ans. 19-20.

In response to the Examiner's findings, Appellant made reference to U.S. Patent No. 6,179,873, the U.S. equivalent of the foreign language version of Zientek cited by the Examiner in the rejection, pointing out that screw 13 is not installed in the bore of the implant until after the implant is placed, that Zientek does not disclose wrench 110 (Fig. 21) being used in combination with the implant but only in installing screw 13, and that wrench 110 "does not appear to purposefully contact, let alone hold the intervertebral implant." Thus, Appellant asserts, "the intravertebral implant and the hexagonal socket wrench (110) of Zientek are not akin to the interbody spinal implant and the implant holder recited in independent claim 1." Br. 10-11. Appellant further argues that

[n]othing in either the drawings or the text of U.S. Zientek indicates that the two tabs (115, 116) of hexagonal wrench (110) are adapted "to pass into said trailing end of said implant and for said exterior surface to cooperatively engage said trailing end of said implant," as recited in independent claim 1.

Br. 13.

We are persuaded by the arguments set forth in Appellant's Brief that the Examiner has mischaracterized the structure and operation of the implant and the tool disclosed, respectively, in Zientek's Figures 2 and 21. In particular, the tool (110) illustrated in Figure 21 does not constitute an "implant holder" in that there is no teaching in the reference that it is intended to or is capable of functioning in that manner. Nor is there support for the Examiner's conclusion that the exterior surfaces of the two extensions (tabs 115, 116) can pass into the trailing end of the implant "to cooperatively engage said trailing end of said implant," as required by claim 1. This being the case, Zientek does not anticipate the subject matter recited

in independent claim 1, and the rejection will not be sustained. It follows that this rejection of dependent claims 2-4, 7, 11, 17-20, 22, 23, 25, 27, 28 and 31 also is not sustained.

Claims 11-14, 27, 28 31 and 33
Obviousness – Farris In View Of Liu

These claims depend from claim 1. The teachings of Liu do not overcome the shortcomings pointed out above in the rejection of claim 1 as being anticipated by Farris. Therefore, this rejection is not sustained.

Claim 45
Obviousness – Farris In View Of Michelson

This claim depends from claim 1. The teachings of Michelson do not overcome the shortcomings pointed out above in the rejection of claim 1 as being anticipated by Farris. Therefore, this rejection is not sustained.

Claims 46 and 47
Obviousness – Farris In View Of Roufa

These claims depend from claim 1. The teachings of Roufa do not overcome the shortcomings pointed out above in the rejection of claim 1 as being anticipated by Farris. Therefore, this rejection is not sustained.

DECISION

None of the rejections are sustained.

The decision of the Examiner is reversed.

REVERSED

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