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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MALAN DE VILLIERS and DAVID HOVDA

Appeal 2011-002818
Application 12/025,561
Technology Center 3700

Before MICHAEL C. ASTORINO, REMY J. VANOPHEM, and
NEIL T. POWELL, *Administrative Patent Judges*.

ASTORINO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants appeal under 35 U.S.C. § 134 from the Examiner's decision finally rejecting claims 1-8 and 10-18. Claims 9, 19, and 20 are withdrawn and claims 21-29 are cancelled. App. Br., Claims Appendix. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

Claimed Subject Matter

Claims 1 and 12 are the independent claims on appeal. Claim 12, reproduced below, is illustrative of the subject matter on appeal.

12. An intervertebral implant comprising:
 an implantable member which is expandable from an insertion configuration to an implanted configuration, the implantable member comprising:
 a first segment;
 a second segment pivotally connected to the first segment; and
 a third segment pivotally connected to the first segment;
 an insertion instrument removably attached to the implantable member and configured to pivot the second and third segments with respect to the first segment upon insertion of the implantable member into the body of a patient, wherein the insertion instrument is configured to sequentially pivot the second and then the third segments with respect to the first segment when the implantable member is within the intervertebral space.

Rejections

The following Examiner's rejections are before us for review.

Claims 1-4, 6-8, 10, and 11 are rejected under 35 U.S.C. § 102(b) as anticipated by Lim (US 2003/0236520 A1, publ. Dec. 25, 2003).

Claims 1, 5, and 12-18 are rejected under 35 U.S.C. § 102(e) as anticipated by Bartish (US 2006/0178746 A1, publ. Aug. 10, 2006).

OPINION

Rejection of claims 1-4, 6-8, 10, and 11 as anticipated by Lim

Independent claim 1 recites “[a]n intervertebral implant” including “an implantable member with upper and lower vertebral body support

surfaces which is expandable from an insertion configuration to an implanted configuration.” App. Br., Claims Appendix.

The Examiner finds that “Lim discloses an intervertebral implant (10) comprising an implantable member with upper and lower vertebral body support surfaces (lateral surfaces of 40).” Ans. 4. However, as pointed out by the Appellants Lim discloses that “[p]lates 50 are positioned on a first and second side of the spacer 10 to contact the vertebral members.” *See* Lim, para. [0020]. Additionally, Lim’s linkages 40 are used to enlarge the spacer 10, i.e., enlarge the space between plates 50. App. Br. 6. *See* Lim para. [0016], figs. 1, 2. As such, the Examiner misapplies Lim’s disclosure “which requires the particular orientation shown in the figures of Lim . . . for proper operation of the device.” App. Br. 5.

In response, the Examiner determines that Lim’s lateral surfaces (linkages 40) are capable of being “upper and lower vertebral body support surfaces” as recited in claim 1. *See* Ans. 7. In other words, the Examiner determines that linkages 40 can function as upper and lower vertebral body support surfaces. As such, the Examiner must provide sufficient evidence or scientific reasoning to establish there is a sound basis for the Examiner’s belief that the functional limitation is an inherent characteristic of the prior art. *See In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990). However, the Examiner’s determination lacks a sound basis for belief because it relies on a misapplication of Lim’s teachings and is supported by speculation and conjecture rather than evidence or scientific reasoning. *See also* Reply Br. 7-9. Accordingly, we reverse the rejection of independent claim 1 and its dependent claims 2-4, 6-8, 10, and 11 under 35 U.S.C. § 102(b) as anticipated by Lim.

Rejection of claims 1, 5, and 12-18 as anticipated by Bartish

Independent claim 12 recites “[a]n intervertebral implant” including “a first segment; a second segment pivotally connected to the first segment; and a third segment pivotally connected to the first segment.” App. Br., Claims Appendix. Independent claim 1 is similar to claim 12 in that second and third segments are pivotally connected to a first segment. *See id.*

The Examiner finds Bartish’s core module 36, insertion device 94, and insertion device 96, correspond to the first, second, and third segment, as recited in independent claims 1 and 12. Ans. 5; Bartish, paras. [0042], [0059], figs. 3, 5, 9. Accordingly, the Examiner also finds that the insertion devices 94 and 96 are “pivotally connected” to core module 36. *Id.* The Examiner determines that “it is well within broadest reasonable interpretation to interpret that the parts can pivot with respect to each other and are connected (i.e. joined).” Ans. 7.

The Appellants persuasively contend that the latter finding, that insertion devices 94 and 96 are “pivotally connected” to core module 36, is inadequately supported. Reply Br. 13, App. Br. 8. The Appellants provide definitions for the term “pivot,” and “connected.” Reply Br. 13, App. Br. 8. The Appellants note that the plain and ordinary meaning of “a pivot is a pin, point, shaft, etc., on which anything turns. (Webster's Unabridged Dictionary, 1983)” and “[t]he term ‘connected’ is defined as ‘joined or fastened together’ American Heritage online dictionary.” Reply Br. 13. The Appellants assert that insertion devices 94 and 96 merely rest on and slide over the core module 36 and are not joined or fastened together. App. Br. 7-8. Additionally, the Appellants assert that the “Examiner has failed to show a pin, point or shaft on which the endplates turn.” Reply Br. 13. Moreover,

Appeal 2011-002818
Application 12/025,561

“Bartish merely teaches the use of a cylindrical recess [50] and core [36] that allows the plates to slide without teaching pivoting as required by the plain and ordinary definition of pivot.” *Id.* Put simply, insertion devices 94 and 96 which rest on and slide over core module 36 are not “pivotally connected” to core module 36 as recited in independent claims 1 and 12. Accordingly, we reverse the rejection of independent claims 1 and 12 and their dependent claims 5 and 13-18 under 35 U.S.C. § 102(e) as anticipated by Bartish.

DECISION

We REVERSE the rejections of claims 1-8 and 10-18.

REVERSED

Klh