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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT AND APPEAL BOARD

NuVASIVE, INC.,
Requester and Appellant

v.

ZIMMER SPINE, INC.,
Patent Owner and Respondent

Appeal 2012-003391
Reexamination Control 95/000,449
Patent 6,936,051 B2
Technology Center 3900

Before RICHARD E. SCHAFER, SALLY G. LANE, and
RICHARD M. LEOVITZ, *Administrative Patent Judges*.

LEOVITZ, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

In accordance with 37 C.F.R. § 41.79(a)(4), Third Party Requester requests rehearing of the June 25, 2012 decision of the Board (“Decision 2”). Request for Rehearing (Req. Reh’g) 1 (July 25, 2012).

Claim 1 and dependent claims 9, 12, and 13 are pending. The Examiner confirmed the patentability of these claims, a determination we

affirmed. Decision 2. However, for the reasons set forth below, we now set forth new grounds of rejection under 35 U.S.C. § 103(a) of claim 1. We leave it to the Examiner's discretion as to whether these new grounds should be applied to dependent claims 9, 12, and 13.

Third Party Requester identifies several points that they contend were "misapprehended or overlooked" in rendering the Decision. *See* 37 C.F.R. § 41.79(b). We address them below.

- **"The Patent Office must provide an explanation as to why claims from this reexamination having *all* of the same language from claim 1 are deemed obvious, yet claim 1 is not."** Req. Reh'g 1.

Findings of Fact ("FF")

1. Claims 40-48 were added by Patent Owner after the Board decision of March 9, 2011 ("Decision 1") in which we reversed the Examiner's Decision not to adopt the rejection of claims 1-4, 6, 7, 9, 11-17, 21, 22, 24-28, and 30-36 of the '051 Patent as anticipated by U.S. Patent No. 5,888,223 to Bray, Jr. ("Bray") under 35 U.S.C. §102(e). Claims 40 and 41 were independent claims. The pending dependent claims were also amended to depend on claims 40 and 41.

2. When adding these claims, Patent Owner stated:

New independent claim 40 includes the limitations of original independent claim 1 and additional recitations discussed below.

...

New independent claim 41 includes the limitations of original independent claim 1 and additional recitations discussed below.

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Patent Owner Response after Board Decision (March 9, 2011), p. 9.

3. In response to the claim amendments and new claims, Third Party Requester proposed new rejections as follows (Requester's Comments on Patent Owner's Response after Board Decision (July 5, 2011), p. i):

A. Independent claims 40 and 41 (and dependent claims 2-4, 11, 14-17, and 42-48) under 35 U.S.C. § 103 as obvious over Lowery (US 5,364,399) in view of Yapp (US 5,549,612).

B. Independent claims 40 and 41 (and dependent claims 2-4, 11, 14-17, and 42-48) as obvious 35 U.S.C. § 103 over Orion Brochure in view of Habermeyer (EP 0538895).

C. Independent claims 40 and 41 (and dependent claims 2-4, 6, 7, 11, 14-17, and 42-48) as obvious over Lowery in view of Wagner (US 3,842,825).

D. Independent claim 41 and dependent claims 46-47 are obvious over Bray (US 5,888,223) in view of Gelbard (US 5,397,363).

4. The Examiner adopted rejections A through D. Examiner's Determination (August 11, 2011), p. 5.

5. Claims 1, 9, 12, and 13 were not rejected.

6. Patent Owner subsequently canceled claims 2-4, 6, 7, 11, 14-17, and 40-48. Patent Owner's Comments on Examiner's Determination (September 12, 2011), p. 3.

Discussion

The Examiner adopted Rejections A-D of independent claims 40 and 41, and all the dependent claims. FF3-FF4. Claims 1, 9, 12, and 13 were not rejected. FF5. Patent Owner, rather than address the merits of the rejections, canceled all the rejected claims, i.e., claims 2-4, 6, 7, 11, 14-17, and 40-48. Patent Owner acknowledged that claims 40 and 41 incorporated all the limitations of claim 1. FF2. Requester compared claim 1 and claims 40 and 41, and showed that claims 40 and 41 simply incorporated additional limitations to claim 1, and thus were narrower than claim 1. Req. Reh'g 2-3. Yet, claim 1 was determined by the Examiner to be patentable over other prior art. Examiner's Determination under 37 CFR 41.77(d), p. 5, "Current Status of the Claims"; Board Decision, p. 16.

As argued by Requester, there appears to be a contradiction in the record: if claims 40 and 41 are not patentable over the prior art cited in Rejections A-D, then how can broader claim 1 be patentable? The discrepancy arose procedurally because the addition of new claims 40 and 41 by Patent Owner prompted Requester to propose new rejections. *See* Third Party Requester Comments after Patent Owner's Request to Reopen Prosecution (July 5, 2011). Requester did not apply these new rejections to claim 1 because it was procedurally uncertain whether they were permitted to do so at this stage in the proceeding where the prosecution had only been opened for the purpose of making a determination of the patentability of claim 1 over an existing rejection. *See id.* at 50. Requester stated: "In an effort to avoid any appearance of non-compliance, the Requester does not

formally submit these four grounds for rejection against original claim 1 but rather leaves such a consideration to the discretion of the Patent Office.” *Id.*

Initially, the Examiner considered the proposed rejections as to claims 40 and 41 and adopted them, but did not apply the rejections to claim 1 which is broader. While procedurally it may have been proper for the Examiner to proceed in this way, we agree with the Requester that by adopting the rejections A-D of claims 40 and 41 in the Examiner’s Determination under 37 CFR § 41.77(d), and not of the broader claim 1 which has the same but fewer limitations, there is an open question of whether claim 1 is unpatentable over this same prior art, and should have been so rejected.

After reviewing Third Party Requester’s proposed rejections, we shall make the following new grounds of rejection of claim 1 under 37 C.F.R. § 41.77(b): Rejections C and D as proposed by Requester. We designate these rejections as new grounds under 37 CFR § 41.77(b).

Rejections A and B appear to involve at least some of the same issues as in Rejection C. Under 35 U.S.C. § 314(c), inter partes reexaminations are to be conducted with “special dispatch.” Additional rejections add to the time it takes to conduct an appeal, and because this case has already been returned to the Board twice, we shall limit the issues to Rejections C and D in this next round in order comply with the “special dispatch” requirement of § 314(c).

- **“The Board’s Decision to affirm claim 1 over Bray merely because Bray's drawings are allegedly not to scale ignores the law and the teaching of the '051 patent.”** Req. Reh’g 15.

Claim 1

1. A plate system adapted for application to the anterior human cervical spine and for contacting at least a portion of the anterior aspects of at least two cervical vertebral bodies, said plate system comprising:
 - a plate having a longitudinal axis and a length sufficient to span a disc space and overlap portions of at least two adjacent cervical vertebral bodies, said plate having a lower surface for placement against the vertebral bodies and an upper surface opposite said lower surface, said lower surface being concave along a substantial portion of the longitudinal axis of said plate;
 - at least two bone screw receiving holes extending through said plate from said upper surface through said lower surface, each of said bone screw receiving holes having a central longitudinal axis and being adapted to receive a bone screw to attach for engaging said plate to the cervical spine; and
 - a lock adapted to overlie at least a portion of said at least two bone screw receiving holes, said lock having an elongated segment having a width, a length longer than said width, and a surface adapted to bear against said plate, said lock being adapted to engage said plate and being adapted to retain at least two bone screws to said plate when said length of said elongated segment is generally transverse to the longitudinal axis of said plate.

Discussion

Claim 1 requires that the retaining plate must overlie “at least a portion of said at least two bone screw receiving holes.” While the plate is depicted in Figure 4 of Bray as overlying the screw heads, it is neither shown nor described as overlying at least a portion of the screw receiving hole as required by the claim. Third Party Requester asserted that, based on the drawings, it would be apparent that “retaining plate 17 has a sufficient

size so as to overlap edge portions of the bone screw apertures 19.” Lowery Decl. ¶ 19.

For the reasons stated in the Decision, we do not agree that sufficient evidence has been provided that Bray’s drawings are drawn to scale and necessarily describe the lock as covering a portion of the bone screw holes. “Inherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002).

Nonetheless, there are two apparent configurations reasonably suggested by Bray: one in which the bone screw hole is covered by the lock and the other in which it is not. Dr. Lowery in his declaration testified that that it would have been obvious to select a size for Bray’s lock that would at least partially cover the screw holes as recited in claim 1. Lowery Dec. ¶ 20. It does not appear that partially covering the screw holes with the lock, or having the lock only cover the screw head but not the hole, would affect the operability of the lock in any way. To the contrary, it appears that one having ordinary skill in the art would have recognized that each configuration would serve the same purpose in securing the screws as long as the lock covered a sufficient portion of the screw head to prevent it from backing out. We thus find both configurations are suggested by Bray and equally obvious. The skilled worker would have routinely picked a configuration in which the lock partially covered the bone screw hole as suggested by Bray to prevent the screw from backing out. We therefore conclude that the subject matter of claim 1 would have been obvious under

35 U.S.C. § 103(a) in view of Bray. We designate this rejection as a new grounds under 37 CFR § 41.77(b).

NEW GROUNDS OF REJECTION

37 C.F.R. § 41.77(a) states that “[t]he reversal of the examiner’s determination not to make a rejection proposed by the third party requester constitutes a decision adverse to the patentability of the claims which are subject to that proposed rejection which will be set forth in the decision of the Board of Patent Appeals and Interferences as a new ground of rejection.”

This decision also contains new grounds of rejection pursuant to 37 C.F.R. § 41.77(b) which provides that “[a]ny decision which includes a new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Accordingly, no portion of the decision is final for purposes of judicial review. A requester may also request rehearing under 37 C.F.R. § 41.79, if appropriate, however, the Board may elect to defer issuing any decision on such request for rehearing until such time that a final decision on appeal has been issued by the Board.

The following are the new grounds of rejection:

1. *Claim 1 under 35 U.S.C. § 103(a) as obvious over Lowery (US 5,364,399) in view of Wagner (US 3,842,825).*
2. *Claim 1 under 35 U.S.C. § 103(a) as obvious over Bray (US 5,888,223) in view of Gelbard (US 5,397,363).*
3. *Claim 1 under 35 U.S.C. § 103(a) as obvious over Bray.*

For further guidance on new grounds of rejection, *see* 37 C.F.R. § 41.77(b)-(g). The decision may become final after it has returned to the Board. 37 C.F.R. § 41.77(f).

37 C.F.R. § 41.77(b) also provides that the Patent Owner, **WITHIN ONE MONTH FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* The owner may file a response requesting reopening of prosecution before the examiner. Such a response must be either an amendment of the claims so rejected or new evidence relating to the claims so rejected, or both.

(2) *Request rehearing*. The owner may request that the proceeding be reheard under § 41.79 by the Board upon the same record. ...

Any request to reopen prosecution before the examiner under 37 C.F.R. § 41.77(b)(1) shall be limited in scope to the “claims so rejected.” Accordingly, a request to reopen prosecution is **limited** to issues raised by the new ground(s) of rejection entered by the Board. A request to reopen prosecution that includes issues other than those raised by the new ground(s) is unlikely to be granted. Furthermore, should the patent owner seek to substitute claims, there is a presumption that only one substitute claim would be needed to replace a cancelled claim.

A requester may file comments in reply to a patent owner response. 37 C.F.R. § 41.77(c). Requester comments under 37 C.F.R. § 41.77(c) shall be **limited** in scope to the issues raised by the Board's opinion reflecting its decision to reject the claims and the patent owner's response under paragraph 37 C.F.R. § 41.77(b)(1). A newly proposed rejection is not permitted as a matter of right. A newly proposed rejection may be appropriate if it is presented to address an amendment and/or new evidence properly submitted by the patent owner, and is presented with a brief explanation as to why the newly proposed rejection is now necessary and why it could not have been presented earlier.

Compliance with the page limits pursuant to 37 C.F.R. § 1.943(b), for all patent owner responses and requester comments, is required.

The examiner, after the Board's entry of a patent owner response and requester comments, will issue a determination under 37 C.F.R. § 41.77(d) as to whether the Board's rejection is maintained or has been overcome. The proceeding will then be returned to the Board together with any comments and reply submitted by the owner and/or requester under 37 C.F.R. § 41.77(e) for reconsideration and issuance of a new decision by the Board as provided by 37 C.F.R. § 41.77(f).

Requests for extensions of time in this *inter partes* reexamination proceeding are governed by 37 C.F.R. § 1.956. *See also* 37 C.F.R. § 41.79.

REHEARING GRANTED; NEW GROUNDS UNDER § 41.77(b)

alw

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