

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte BRET A. FERREE and DAVID TOMPKINS

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Appeal No. 2006-0520  
Application No. 10/303,385

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ON BRIEF

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Before, OWENS, CRAWFORD, and BAHR, Administrative Patent Judges.  
CRAWFORD, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1 to 23.

Claims 24 and 25 are objected to by the examiner as being dependent on a rejected claim.

The appellants' invention relates to a intervertebral disk replacement apparatus (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

### THE PRIOR ART

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Zdeblick et al. (Zdeblick)	6,402,785	June 11, 2002
Weber et al. (Weber)	6,533,818	Mar. 18, 2003

### THE REJECTIONS

Claims 1 to 13 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 14 to 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Weber in view of Zdeblick.<sup>1</sup>

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed August 11, 2005 ) for the examiner's complete reasoning in support of the rejections, and to the brief (filed October 21, 2004) for the appellants' arguments thereagainst.

### OPINION

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<sup>1</sup> The examiner's rejection of claims 1 to 8 and 11 to 13 under 35 U.S.C. § 103 as being unpatentable over Weber has been withdrawn (answer at page 5).

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

We turn first to the examiner's rejection of claims 1 to 13 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. In connection with this rejection, the examiner states:

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular in claim 1 there is no support in the specification for a cushioning component disposed between the endplate components ***without being attached*** thereto (emphasis in the original) [answer at page 4].

We initially note that the test for determining compliance with the written description requirement of the first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventors had possession at the time of the later claimed subject matter, rather than the presences or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The content of the drawings may also be considered in determining compliance with the written description requirement. Id.

We will not sustain the rejection because in our view the appellants are correct that:

. . . figure 3 in particular, and the accompanying text, which shows a metal hub 302 which cooperates with a tire-like component 304. The endplates are shown at 310. Note that each endplate 310 includes a rounded centrally located projection. Though this is not explicitly specified in the specification, clearly this drawing discloses that subject matter. Figure 3 further shows that hub 302 includes depressions which cooperate with these rounded projections, and note further that these depressions are larger than the rounded projections. This is because of the fact that the tire-like component 304 is not attached to the endplates. If it were attached, the depressions on the hub portion could mimic the rounded projections on the endplates, since little, if any, lateral movement would be possible. However, since the tire-like component is not attached, the depressions in the hub-like portion are larger, as depicted. [emphasis in the original][brief at page 3]

As we are of the opinion that Figure 3 depicts that the tire-like component is not attached to the endplates 310, we will not sustain this rejection.

We turn next to the examiner's rejection of claims 14 to 23 as being unpatentable under 35 U.S.C. § 103 as being unpatentable over Weber in view of Zdeblick. We initially note that the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

The examiner is of the opinion that Weber describes the invention as recited in claim 14 except that Weber does not describe a rounded centrally located projection on each endplate component. The examiner relies on Zdeblick for teaching rounded/curved/lobed centrally located projection (projecting inward in Figure 20 and 44-45) on each endplate component. The examiner concludes:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to take the endplates (fig. 20, 44 and 45) of Zdeblick et al. and substitute them with the endplates of Weber et al. (figure 6) because both artificial disc replacements utilize a cushioned intermediate material and both utilize rounded projections that could "impinge" if the endplate components were subjected to an excessive force [answer at page 4 and 5].

The appellants argue that (1) there is no motivation to combine the teachings of Weber and Zdeblick and (2) neither reference describes a rounded centrally located projection configured to impinge if the endplate component is subjected to excessive force as is required by claim 15. We agree.

While Weber does disclose projections on material 14, Weber does not describe that the projections are configured to impinge when subjected to excessive force.

Likewise, Zdeblick does not teach that the rounded projection depicted in Figures 16, 20, 44 and 45 is configured to impinge if the endplate component is subjected to excessive force as required by claim 14. In fact, Zdeblick teaches that under the maximum expected load the rounded projections do not impinge but are

rather separated by a distance 466 depicted in Figure 45 (col. 12, lines 32 to 36) and that the upper and lower shells 112 and 114 of Figure 20 do not constrain more than 50 percent of the height of spacer 116 (col.9, lines 8 to 11).

In addition, we agree with the appellant that the examiner has not established that a person of ordinary skill in the art would have been motivated to combine the teachings of the references. Contrary to the examiner's assertion, neither reference discloses projections configured to impinge if subjected to excessive force.

In view of the foregoing, we will not sustain the rejection as it is directed to claim 14 and claims 15 to 23 dependent thereon.

The decision of the examiner is reversed.

REVERSED

TERRY J. OWENS )  
Administrative Patent Judge )  
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MURRIEL E. CRAWFORD ) BOARD OF PATENT  
Administrative Patent Judge ) APPEALS  
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 ) INTERFERENCES  
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JENNIFER D. BAHR )  
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**Comment [jvn1]:** Type address

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