

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

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Appeal No. 2006-1916  
Application No. 10/438,604  
Technology Center 3700

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ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 1-4 and 6-9. Claims 2 and 3 were amended subsequent to the final rejection to overcome the rejection of these claims under 35 U.S.C. § 112, second paragraph, and claim 5 has been canceled.

We REVERSE and enter a new ground of rejection.

## BACKGROUND

The appellant's invention relates to conformable endplates for artificial disc replacement (ADR) devices. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The examiner relies upon the following as evidence of unpatentability:

Frey	US 4,932,969	Jun. 12, 1990
Suddaby	US 6,395,034 B1	May 28, 2002 (Nov. 24, 1999)

The rejections of claims 1-4 under 35 U.S.C. § 102(b) as being anticipated by Frey, claims 1, 6, 8 and 9 under 35 U.S.C. § 102(e) as being anticipated by Suddaby and claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Suddaby are before us for review.

Rather than reiterate in their entirety the conflicting viewpoints advanced by the examiner and the appellant regarding this appeal, we make reference to the final rejection (mailed December 30, 2004) and examiner's answer (mailed August 10, 2005) for the examiner's complete reasoning in support of the rejections and to the appellant's brief (filed July 7, 2005) and reply brief (filed October 10, 2005) for the appellant's arguments thereagainst.

## OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art, and to the respective positions articulated by the appellant and the examiner. For the reasons that follow, we cannot sustain the examiner's rejections.

We begin our review of this appeal with a list of deficiencies in the examiner's answer. The examiner's statement on page 2 of the answer that the brief does not contain a statement identifying the related appeals and interferences which will directly affect or

be directly affected by or have a bearing on the decision in the pending appeal is incorrect. Appellant's brief (p. 1) contains a clear statement that there are no such appeals or interferences. Moreover, in section (4) on page 2 of the answer, the examiner simply states that appellant's statement of the status of amendments after final rejection contained in the brief is correct, without confirming whether the amendment filed with the brief has been entered, a question left open in appellant's statement. The examiner's initialed notation on the copy of the amendment entered into the electronic record August 10, 2005 indicates that the amendment has been entered, but the examiner should have indicated such in section (4) of the answer. The provision of such information is, after all, the purpose of that section. The examiner's remarks in section (4) were of no informative value. Furthermore, the examiner's answer does not restate the rejections, instead simply referring to the final rejection. As provided in Manual of Patent Examining Procedure (MPEP) § 1207.02, “[a]n examiner's answer should not refer, either directly or indirectly, to any prior Office action without fully restating the point relied on in the answer.” Moreover, the examiner's answer does not even include the examiner's position and response to appellant's arguments, once again referring to the final rejection. Consequently, the answer in this case provides absolutely no useful information in explaining the status of the application, the rejections on appeal or the examiner's position in response to appellant's arguments.

The deficiencies in the answer noted above provide more than sufficient justification for remanding the application to the examiner and requiring an answer in compliance with 37 CFR § 41.39 and MPEP §§ 1207 through 1207.02. Nevertheless, in the interest of administrative efficiency and fairness to appellant, we have entered a decision on the merits of this appeal.

We turn our attention first to the rejection of claims 1-4 as being anticipated by Frey. Each of claims 1-4 calls for a substrate, *physically configured to leave a concavity in a vertebral endplate when urged thereagainst* and a convex piece configured to consume the concavity between the substrate and the vertebral endplate. The top and bottom surfaces of the elastic hollow compressible body 6, on which the examiner attempts to read the claimed substrate, are not physically configured to leave a concavity in a vertebral endplate when urged thereagainst. Rather, the top and bottom surfaces of the body 6, which is made of a compressible plastic and filled with an incompressible fluid medium, such as silicon oil, are configured to conform to a surface against which they are urged, in this case pressing against the anchoring elements 4, 5, formed of wire mesh and secured to the vertebral bodies by ingrowth of bone tissue, by the sandwiching of the body 6 between the anchoring elements. Consequently, the anticipation rejection cannot be sustained.

We turn next to the rejection of claims 1, 6, 8 and 9 as being anticipated by Suddaby. The disc prosthesis of Suddaby includes an expandable stent, comprising a pair of elements 10, 12, each having a broad head 14 with a convex surface facing outwardly, and a mass of material 30 that is hardened in situ around the stent, in the disc space. In rejecting these claims, the examiner reads the claimed substrate on the broad heads 14. Each of the broad heads 14 is outwardly convex and thus configured to fill the natural concavity of the endplate of the vertebral body against which it is urged, quite the opposite of being “physically configured to leave a concavity” in the endplate as called for in claims 1, 6, 8 and 9. It follows that this rejection also cannot be sustained.

The rejection of claim 7, which depends from claim 6, as being unpatentable over Suddaby is grounded in part on the examiner’s finding that Suddaby discloses a substrate physically configured to leave a concavity in a vertebral endplate when urged

thereagainst. In view of the above-discussed lack of support in Suddaby for this finding, we cannot sustain this rejection.

#### NEW GROUND OF REJECTION

Pursuant to our authority under 37 CFR § 41.50(b), we enter the following new ground of rejection.

Claims 2-4 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention.

Claim 1 is specifically directed to the embodiment of Figures 4A and 4B, which includes a generally flat or planar tray 408 and convex or hemi-convex pieces 402, 404, 406 designed to fit between the tray 408 and the vertebral endplate. Claim 2, which recites a substrate constructed of multiple pieces adapted to conform to the vertebral endplate, and claims 3 and 4, which recite a substrate constructed of a flexible material to fit the vertebral endplate, are directed exclusively to the embodiment of Figures 2A, 2B and to the embodiments of Figures 2A, 2B and 3A, 3B, respectively. The embodiments of Figures 2A, 2B and 3A, 3B comprise substrates that are physically configured to conform to the vertebral endplate, not to leave a concavity in a vertebral endplate as called for in claim 1 from which claims 2-4 depend. Accordingly, claims 2-4 are inconsistent both internally and with appellant's underlying disclosure, as they recite a substrate which is both physically configured to leave a concavity in a vertebral endplate when urged thereagainst and constructed of either multiple parts or of a flexible material to conform to or fit the vertebral endplate.

## CONCLUSION

To summarize, the decision of the examiner to reject claims 1-4 and 6-9 is REVERSED and a new rejection of claims 2-4 is entered pursuant to 37 CFR § 41.50 (b).

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 41.50(b)

TERRY J. OWENS	)	
Administrative Patent Judge	)	
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MURRIEL E. CRAWFORD	) BOARD OF PATENT	
Administrative Patent Judge	) APPEALS	
	) AND	
	) INTERFERENCES	
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JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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