

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

*Ex parte* BRET A. FERREE

Appeal 2006-0423  
Application 10/426,995  
Technology Center 3700

Decided: May 15, 2007

Before TERRY J. OWENS, STUART S. LEVY and ANTON W. FETTING,  
*Administrative Patent Judges.*

## FETTING, *Administrative Patent Judge.*

## DECISION ON APPEAL

## STATEMENT OF CASE

This appeal involves claims 1-9, the only claims pending in this application.

We have jurisdiction over the appeal pursuant to 35 U.S.C. §§ 6 and 134.

## We AFFIRM-IN-PART.

The Appellant invented an artificial intervertebral disc replacement and repair. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. Apparatus for limiting the movement of a prosthetic device situated between opposing bones, comprising:
  - an articulating device;
  - an anchoring unit adapted for fastening to at least one of the bones; and
  - a link member coupling the articulating device to the anchoring unit, thereby facilitating a limited degree of movement of the device.

This appeal arises from the Examiner's final rejection, mailed June 30, 2005.

14 The Appellant filed a brief in support of the appeal on December 7, 2005, and the  
15 Examiner mailed an answer to the appeal brief on October 5, 2006. The Appellant  
16 presented an oral argument on Apr. 24, 2007.

PRIOR ART

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

21 Doty US 4,599,086 Jul. 8, 1986  
22 Michelson US 6,190,388 B1 Feb. 20, 2001

1 REJECTION

2 Claims 1-5 and 7-9 stand rejected under 35 U.S.C. § 102(b) as anticipated by  
3 Doty.

4 Claims 1-4, 6, and 7 stand rejected under 35 U.S.C. § 102(b) as anticipated by  
5 Michelson.

6 Claims 1-4 and 7-9 stand provisionally rejected<sup>1</sup> under the judicially created  
7 doctrine of obviousness-type double patenting as claiming the same subject matter  
8 as claims 5 and 8 of copending Application No. 10/754,042.

9

10 ISSUES

11 The issues pertinent to this appeal are

- 12 • Whether the Examiner was correct in rejecting claims 1-5 and 7-9 under 35  
13 U.S.C. § 102(b) as anticipated by Doty.
  - 14 ○ Whether Doty's artificial disk replacement (Doty, Fig. 1:12), plate  
15 (Doty, Fig. 7:66), and screw (Doty, Fig. 7:68) are an articulating  
16 device, anchoring unit, and link member.
  - 17 ○ Whether Doty's screw (Doty, Fig. 7:68) as a link member is capable  
18 of facilitating a limited degree of movement of the device.

---

<sup>1</sup> The Appellant did not raise this as an issue in the Brief.

- 1
- 2     ● Whether the Examiner was correct in rejecting claims 1-4, 6, and 7 under 35
- 3                 U.S.C. § 102(b) as anticipated by Michelson.
- 4                 ○ Whether Michelson's cylindrical fusion implant (Michelson, Fig.
- 5                         1:10), variable angle screw (Michelson, Fig. 1:30), and spinal rod
- 6                         (Michelson, Fig. 3:50) are an articulating device, anchoring unit, and
- 7                         link member.
- 8                 ○ Whether Michelson's spinal rod (Michelson, Fig. 3:50) as a link
- 9                         member is capable of facilitating a limited degree of movement of the
- 10                         device.

11     In particular, the Appellant contends that a person of ordinary skill in the art

12     would understand an articulating device to be moveable in operation.

13

14                         FACTS PERTINENT TO THE ISSUES

15     The following Findings of Fact (FF), based upon a preponderance of

16     substantial evidence, are pertinent to the above issues.

- 17     01.    The Specification does not contain a lexicographic definition of the word
- 18                 “articulating” or the phrase “articulating device.” Indeed the only use of
- 19                 the word “articulating” in the disclosure as filed is in the claims.
- 20     02.    The use of the phrase “articulating device” in the only independent
- 21                 claim, claim 1, would clearly be construed by a person of ordinary skill
- 22                 in the art as within the anatomical context because of the preamble
- 23                 reference to “movement of a prosthetic device situated between

1        opposing bones” coupled with the reference to those bones in the body  
2        of claim 1 relative to the anchoring unit.

3        03. There are several definitions for the word “articulate,” but a person of  
4        ordinary skill in the art would understand it to be among those within an  
5        anatomical context.

6        04. The pertinent definitions are, as a transitive verb, to unite by forming a  
7        joint, and as an intransitive verb, to form a joint. Because this definition  
8        merely describes articulating in terms of joints, the definition of joint  
9        becomes material. Again, there are many definitions, but that within an  
10      anatomical context is, as a noun, a point of articulation between more or  
11      less moveable parts, as between bones or between segments in the leg of  
12      an arthropod<sup>2</sup>.

13      05. Thus, in an anatomical context, articulating means joining moveable  
14      parts.

15      06. Doty’s artificial disk replacement (Doty, Fig. 1:12), plate (Doty, Fig.  
16      7:66), and screw (Doty, Fig. 7:68) are a device placed between bones,  
17      anchoring unit, and link member. Once installed, Doty’s artificial disk  
18      replacement forms a joint that does not move relative to the bones to  
19      which it is attached. However, during installation, until all the anchoring  
20      screws and pins are in place, while the artificial disk replacement is in  
21      place, it forms a joint that does move relative to the bones between  
22      which it is placed.

---

<sup>2</sup> Webster’s II New Riverside University Dictionary, 1994.

07. Michelson's cylindrical fusion implant (Michelson, Fig. 1:10), variable angle screw (Michelson, Fig. 1:30), and spinal rod (Michelson, Fig. 3:50) are a device placed between bones, anchoring unit, and link member. Once installed, Michelson's cylindrical fusion implant forms a joint that does not move relative to the bones between which they are installed. However, during installation, until all the anchoring screws and the rod are secured in place, while the cylindrical fusion implant is in place, it forms a joint that does move relative to the bones between which it is placed.

08. Therefore, in neither Doty nor Michaelson does the device placed between bones move in operation, i.e. neither device joins moveable parts (FF 05), and therefore the device cannot be said to be articulating.

09. Similarly, it cannot be said that they facilitate a limited degree of movement of the device, since there is no movement of the device.

## ANALYSIS

*Claims 1-5 and 7-9 rejected under 35 U.S.C. § 102(b) as anticipated by Doty.*

18 From the above Findings of Fact, supported by a preponderance of substantial  
19 evidence, we conclude that

- Doty's artificial disk replacement (Doty, Fig. 1:12) is not an articulating device, although plate (Doty, Fig. 7:66), and screw (Doty, Fig. 7:68) are an anchoring unit and link member (FF 08).

- Doty's screw (Doty, Fig. 7:68), as a link member that precludes movement, is not capable of facilitating a limited degree of movement of the device (FF 09).

Although Doty's artificial disk replacement may be moveable during installation as argued by the Examiner, it is clear that it must be moveable in operation to be considered articulating in an anatomical context. Although the appellant provided no definition in the Specification, or other evidence in the record for this definition, the ordinary and customary meaning of the term in an anatomical context clearly requires movement in operation (FF05).

As to the Examiner's contention that functional language in a thereby clause is a field of use limitation and does not have to be explicitly recited in prior art to negate patentability (Answer 7), the prior art must exhibit the capacity to meet that functional language. Accordingly we do not sustain the Examiner's rejection of claims 1-5 and 7-9 under 35 U.S.C. § 102(b) as anticipated by Doty.

*Claims 1-4, 6 and 7 rejected under 35 U.S.C. § 102(b) as anticipated by Michelson*

From the above Findings of Fact, supported by a preponderance of substantial evidence, we conclude that

- Michelson's cylindrical fusion implant (Michelson, Fig. 1:10) is not an articulating device, although, variable angle screw (Michelson, Fig. 1:30), and spinal rod (Michelson, Fig. 3:50) are an anchoring unit and link member (FF 08).

- Michelson's spinal rod (Michelson, Fig. 3:50), as a link member that precludes movement, is not capable of facilitating a limited degree of movement of the device (FF 09).

The Examiner's contentions are essentially the same as in the rejections under Doty and our findings are therefore the same. Accordingly we do not sustain the Examiner's rejection of claims 1-4, 6 and 7 under 35 U.S.C. § 102(b) as anticipated by Michelson.

*Claims 1-4 and 7-9 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as claiming obvious subject matter over claims 5 and 8 of copending Application No. 10/754,042.*

The Appellant did not raise this as an issue for appeal. Accordingly we sustain, *pro forma*, the Examiner's provisional rejection of claims 1-4 and 7-9 under the judicially created doctrine of obviousness-type double patenting as claiming subject matter that would have been obvious to one of ordinary skill in the art over the subject matter of claims 5 and 8 of copending Application No. 10/754,042.

## DECISION

To summarize, our decision is as follows:

- The rejection of claims 1-5 and 7-9 under 35 U.S.C. § 102(b) as anticipated by Doty is not sustained.
  - The rejection of claims 1-4, 6 and 7 under 35 U.S.C. § 102(b) as anticipated by Michelson is not sustained.
  - The provisional rejection of claims 1-4 and 7-9 under the judicially created doctrine of obviousness-type double patenting as claiming subject matter

Appeal 2006-0423  
Application 10/426,995

that would have been obvious to one of ordinary skill in the art over the subject matter of claims 5 and 8 of copending Application No. 10/754,042 is sustained.

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

6

## AFFIRMED-IN-PART

9

10

11 JRG  
12

Appeal 2006-0423  
Application 10/426,995

1 John G. Posa  
2 Cifford, Krass, Groh, Sprinkle, Anderson  
3 & Citkowski, P.C.  
4 P.O. BOX 7021  
5 Troy, MI 48007