

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES S. HAMADA

Appeal 2007-2643
Application 10/165,805
Technology Center 3700

Decided: July 24, 2007

Before TONI R. SCHEINER, DONALD E. ADAMS, and
ERIC GRIMES, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134 involves claims 1-6 and 19-28. The Examiner has indicated that claims 29 and 30, the only remaining pending claims, are allowable (Answer 5). We have jurisdiction under 35 U.S.C. § 6(b).

INTRODUCTION

The claims are directed to an intervertebral measuring instrument.

Claims 1 and 27 are illustrative:

1. An intervertebral measuring instrument for use in spine surgery comprising:

a first portion fittable with respect to a second portion, said first and said second portions to form an intervertebral implant shape having opposing load distribution surfaces shaped for substantially even contact of adjacent vertebra above and below an intervertebral space for insertion into said intervertebral space;

a load cell mounted to receive a force of said first portion toward said second portion; and

information transmission structures associated with said load cell for transmitting information about a measured force of said first portion toward said second portion away from said load cell.

27. An intervertebral measuring instrument for use in spine surgery comprising:

a first portion fittable with respect to a second portion, at least a part of said first and said second portions to form an intervertebral implant shape having opposing load distribution surfaces shaped for substantially even contact of adjacent vertebra above and below an intervertebral space for insertion into said intervertebral space;

a load cell mounted on at least one of said first and second portions to receive a force of displacement said first portion with respect to second portion; and

information transmission structures associated with said load cell for transmitting information about a measured force of said first portion with respect to said second portion away from said load cell.

The Examiner relies on the following prior art reference to show unpatentability:

Yen US 5,456,724 Oct. 10, 1995

The rejection as presented by the Examiner is as follows:

Claims 1-6 and 19-28 stand rejected under 35 U.S.C. § 102(b), as being anticipated by Yen.

We affirm.

DISCUSSION

The Examiner finds that Yen teaches a measuring instrument comprising, *inter alia*, (1) a first portion; (2) a second portion; (3) load cells; and (4) an information transmission structure (Answer 3). The Examiner finds that Yen's first portion is fittable with respect to the second portion (*id.*). The Examiner finds that the first and second portions of Yen's device form an intervertebral implant shape having opposing load distribution surfaces (*id.*). The Examiner finds that the information transmission structures of Yen's device are associated with the load cells (*id.*).

Appellant sets forth two claim groupings: (1) 1-6 and 19-26, and (2) 27 and 28. Therefore, we limit our discussion to representative claims 1 and 27. 37 C.F.R. § 41.37(c)(1)(vii).

Claim 1:

Claim 1 is drawn to a device. The device of claim 1 comprises: (1) a first portion; (2) a second portion; (3) a load cell; and (4) information transmission structures. Claim 1 requires that the first portion is fittable with respect to a second portion to form an intervertebral implant shape having opposing load distribution surfaces shaped for substantially even contact of adjacent vertebra above and below an intervertebral space. In addition, claim 1 requires that the load cell is mounted in a manner to receive a force

of said first portion toward said second portion. Further, claim 1 requires the information transmission structures to be associated with the load cell to transmit information about a measured force of the first portion toward the second portion away from the load cell.

As the Examiner explains, it is well settled that the recitation of a new intended use for an old device does not make a claim to that old device patentable. *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962) (statement of intended use in an apparatus claim failed to distinguish over the prior art apparatus); *In re Hack*, 245 F.2d 246, 248, 114 USPQ 161, 162 (CCPA 1957) (“the grant of a patent on a composition or a machine cannot be predicated on a new use of that machine or composition”). Accordingly, we find that the recitation of the intended use of the device, for use in spine surgery, is not a positive limitation on the claimed invention.

Nevertheless, Yen teaches a load sensor for a bone graft (Yen, col. 1, ll. 6-7). Yen’s device can be used to measure, *inter alia*, the load on two segments of a patient’s spine (Yen, col. 2, ll. 55-56). Appellant does not dispute that Yen’s device comprises: (1) a first portion; (2) a second portion; (3) a load cell; and (4) information transmission structures (Yen, col. 1, l. 64 - col. 2, l. 3). Appellant does not dispute that the first portion of Yen’s device is fittable with respect to a second portion (Yen, col. 2, ll. 4-9). Further, Appellant does not dispute that the first and second portions of Yen’s device have opposing load distribution surfaces shaped for substantially even contact of adjacent vertebrae above and below an intervertebral space. Appellant does not dispute that the load cell of Yen’s device is mounted in a manner to receive a force of the first portion toward said second portion, or that the information transmission structures of Yen’s

device are associated with the load cell to transmit information about a measured force of the first portion toward the second portion away from the load cell (Yen, col. 1, l. 64 - col. 2, l. 3).

The bulk of Appellant's arguments focus on the intended use of the claimed invention. Appellant asserts that Yen's device is not an implant (Br. 10) and that it would make "no sense to even try to use the Yen device on a patient . . ." (Br. 12). However, as discussed above, the intended use of the claimed device is not a limitation on the device itself. Accordingly, we are not persuaded by Appellant's argument.

Appellant asserts that Yen's device does not have an implant shape (*see, e.g.*, Br. 10). Appellant asserts that "the term 'implant shape' is an unmistakable affirmative limitation as to the shape of the device" (Br. 15). According to Appellant the term "implant shape . . . includes the shape of anything which you would implant and leave in the body" e.g., from "an aspirin shape" to a shape that "is more curved on one side than the other, to one which has a thicker connection area at one edge than the other (quasi-slope shaped)" (Br. 15). There is, however, no requirement in claim 1 that the device have a specific "implant" shape. Claim 1 requires only that the device is configured to "form an intervertebral implant shape having opposing load distribution surfaces shaped for substantially even contact of adjacent vertebra above and below an intervertebral space" (Appellant's claim 1).

Nevertheless, despite Appellant's assertions to the contrary, Appellant recognizes that Yen's device can be inserted into the spine of a mammal (Reply Br. 2). In this regard, we note that Yen's device has an implant size and shape (Yen, col. 1, ll. 47-48; col. 3, ll. 26-30). Yen expressly teaches

that the device can be grafted into a “restoredly stretched” spine during its use in a clinical operation (Yen, col. 6, ll. 32-58). Further, Yen teaches the device for insertion between two segments of a patient’s spine (Yen, col. 1, ll. 55-56). Accordingly, we find that Yen’s device has an “implant shape.” Therefore, we are not persuaded by Appellant’s assertions to the contrary.

On reflection we find no error in the Examiner’s *prima facie* case of anticipation. For the foregoing reasons, we are not persuaded by Appellant’s rebuttal arguments. Accordingly, we affirm the rejection of claim 1 under 35 U.S.C. § 102(b). Claims 2-6 and 19-26 fall together with claim 1.

Claim 27:

Claim 27 is drawn to a device. The device of claim 27 comprises: (1) a first portion; (2) a second portion; (3) a load cell; and (4) information transmission structures. Claim 27 requires that at least a part of the first portion is fittable with respect to a second portion to form an intervertebral implant shape having opposing load distribution surfaces shaped for substantially even contact of adjacent vertebrae above and below an intervertebral space. In addition, claim 27 requires that the load cell is mounted on at least one of said first and second portions to receive a force of displacement of said first portion with respect to second portion. Further, claim 27 requires the information transmission structures to be associated with the load cell transmitting information about a measured force of the first portion with respect to the second portion away from the load cell.

Claim 27 differs from claim 1 in two respects. First, claim 27 requires that at least a part of the first and second portions of the device form an intervertebral implant shape. Second, claim 27 requires that a load cell be mounted on at least one of the first and second portions.

The Examiner relies on Yen as discussed above. From the foregoing discussion, it is clear that Yen teaches a device, wherein: (1) at least a part of the first and second portions form an intervertebral implant shape (Yen, col. 1, ll. 47-48; col. 3, ll. 26-30); (2) the device can be inserted into the intervertebral space (Yen, col. 1, ll. 55-56); and (3) a load cell is mounted on at least one of the first and second portions (Yen, col. 1, l. 64 – col. 2, l. 3).

In response Appellant states

Claim 27 also includes the term “intervertebral implant shape” as well as the terms “substantially even contact of adjacent vertebra”. The term “shaped for even contact” should not be interpreted as “poor but equal” contact, but contact evenly over the surface, with implant shape indicating a contact at least as good or over an area as good as the poorest object which would be implantably left in the body. Than this minimum, it is even better to have a shape matching the implant to be implanted. This full range is contemplated by the use of this language with the claims.

(Br. 16.) We are not persuaded by Appellant’s argument. As discussed above, Yen teaches a device for insertion between two segments of a patient’s spine (Yen, col. 1, ll. 55-56). There is no evidence on this record that the shape of Yen’s device will not provide for substantially even contact of adjacent vertebrae above and below an intervertebral space, when inserted into the intervertebral space.

On reflection we find no error in the Examiner’s *prima facie* case of anticipation. For the foregoing reasons, we are not persuaded by Appellant’s

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rebuttal arguments. Accordingly, we affirm the rejection of claim 27 under 35 U.S.C. § 102(b). Claim 28 falls together with claim 27.

CONCLUSION

In summary, we affirm the rejection of record.

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

AFFIRMED

Ssc

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