

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte BRET A. FERREE

Appeal 2008-2435
Application 10/987,914
Technology Center 3700

Decided: August 22, 2008

Before DONALD E. ADAMS, ERIC GRIMES, and LORA M. GREEN,
Administrative Patent Judges.

GRIMES, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a device used in artificial disc replacement surgery. The Examiner has rejected the claims as claiming a human body part and anticipated. We have jurisdiction under 35 U.S.C. § 6(b). We affirm in part.

DISCUSSION

1. CLAIMS

Claims 1-8 are on appeal. Claims 9-12 are also pending but have been withdrawn from consideration by the Examiner (Appeal Br. 1). Claims 1, 3, and 4 are representative and read as follows:

1. Apparatus for use in conjunction with a laterally placed artificial disc replacement (ADR) having a plate with a surface facing the lateral edge of a vertebral body, comprising:

a shim positioned between the plate and the lateral edge of a vertebral body.

3. The apparatus of claim 1, including a plurality of differently sized shims to accommodate different plate-vertebrae spacings.

4. The apparatus of claim 1, including a plurality of differently shaped shims to accommodate various lateral edge configurations.

The scope of claim 1 is central to resolving the rejections on appeal in this case. The Examiner interprets claim 1 as “positively claim[ing] both the plate [of the artificial disc replacement (ADR) device] and the vertebral body. It is the Examiner[’s] position that in positively claiming the plate which is part of the ADR, the ADR has to be given patentable weight.” (Answer 5.)

Appellant does not read claim 1 as encompassing either the recited ADR or vertebral body: “Although Appellant does not wish to claim the ADR in claim 1 . . . and although Appellant *cannot* claim the vertebral body . . . , the references in the body of the claim to the preamble render the limitations of the claim structurally different than the prior art” (Appeal Br. 10-11). That is, Appellant’s position is that, “based upon the way in which

the claim is written, the claimed shim is physically positioned between the plate of a laterally placed ADR facing the lateral edge of a vertebral body and the lateral edge of the vertebral body. . . . Appellant is claiming a shim placed in a particular location and not just to provide a particular function.” (*Id.* at 11.)

We disagree with both the Examiner’s and Appellant’s interpretation of claim 1. In our view, claim 1 is directed to nothing more than a shim that is configured appropriately for, and intended for, use with a laterally placed artificial disc replacement (ADR) device.

The preamble of claim 1 does nothing more than recite the intended use of the claimed shim, and therefore is not a claim limitation. *See Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999) (“If . . . the preamble offers no distinct definition of any of the claimed invention’s limitations, but rather merely states, for example, the purpose or intended use of the invention, then the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation.”); *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003)(“An intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates.”).

The body of claim 1 states that the claimed shim is “positioned between the plate and the lateral edge of a vertebral body.” The quoted recitation, as well, amounts to no more than a statement of intended use. The claims are directed to an apparatus, not a method of carrying out artificial disc replacement surgery. The claims therefore must structurally

define the claimed apparatus. A claimed apparatus does not differ structurally from others based on where it is positioned; e.g., whether or not it is between the plate of an ADR and the lateral edge of a vertebral body.

In re Pearson, 494 F.2d 1399 (CCPA 1974), is instructive. In that case, certain claims were directed to a “preparation for reducing pops and unsound kernels in peanut plants comprising, as an active ingredient, a calcium-containing compound” with a small particle size. *Id.* at 1401. The court held that the claim language stating the intended use of the composition did not limit the claims, so as to distinguish the claimed composition from the prior art. *Id.* at 1403.

The court concluded that “one of the compositions admitted to be old by the appellant would not undergo a metamorphosis to a new composition by labeling its container to show that it is a composition suitable for treating peanuts. . . . The container would still contain the old composition.” *Id.*

Similarly here, a shim that was otherwise identical to that disclosed in the instant Specification would not undergo a metamorphosis to a new apparatus if it were placed between an ADR device and a vertebral body. Thus, the claim language reciting the intended placement of the claimed shim states its intended use, and is not a structural limitation of claim 1.

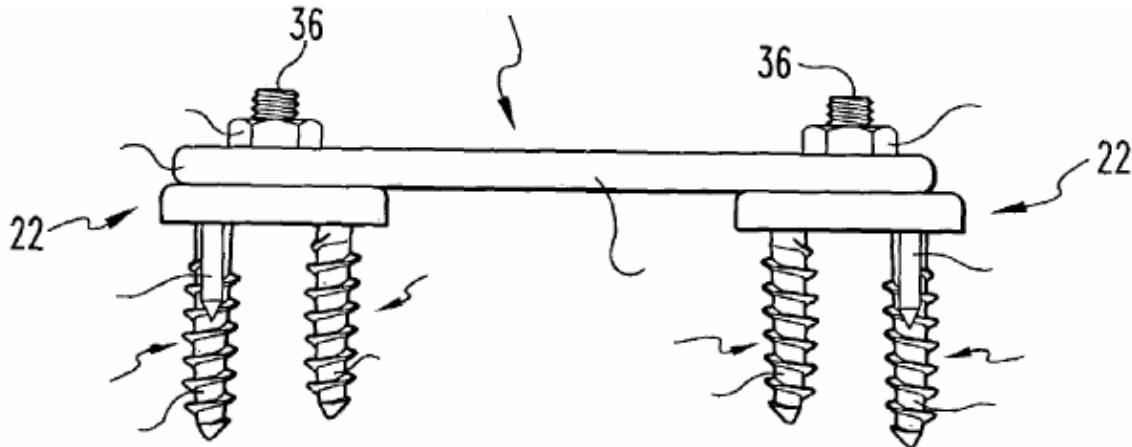
In sum, the intended use recitations of claim 1 are entitled to some weight, in that they limit the claimed shim to one that is sized and configured appropriately for use with a laterally placed ADR device, but the claim is directed to a shim, not a shim in any particular location and not a shim in combination with an ADR device and a vertebral body.

2. REJECTION UNDER 35 U.S.C. § 101

Claims 1-8 stand rejected under 35 U.S.C. § 101 (Answer 3). The Examiner reasons that “claims 1 and 5 are positively claiming the vertebral body” (*id.*). As discussed above, however, we interpret claim 1 as being directed to a shim that is configured appropriately for use with a laterally placed ADR device. The claim’s statement that the disc is “positioned between the plate [of the ADR] and the lateral edge of a vertebral body” is no more than a statement of the intended use of the claimed shim. We therefore reverse the rejection under 35 U.S.C. § 101.

3. REJECTION UNDER 35 U.S.C. § 102(e)

Claims 1, 3-5, 7, and 8 stand rejected under 35 U.S.C. § 102(e) as anticipated by Morrison¹ (Answer 3). Morrison discloses a device for assisting in bone fusion (Morrison, abstract) that includes “attachment members 22” (*id.* at ¶ 0036). Morrison’s Figure 2 is reproduced below (with unnecessary reference numerals removed):



¹ Morrison et al., US 2004/0102773 A1, published May 27, 2004.

The Figure shows a side view of one embodiment of Morrison's plate system (*id. at ¶¶ 0013-0014*). Morrison's Figures 3a and 3d are reproduced below (with unnecessary reference numerals removed):

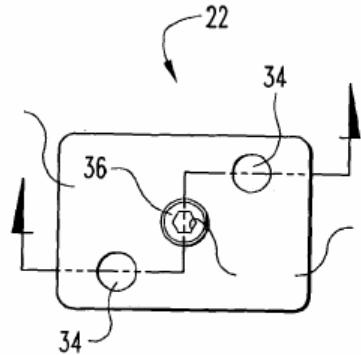


Fig. 3a

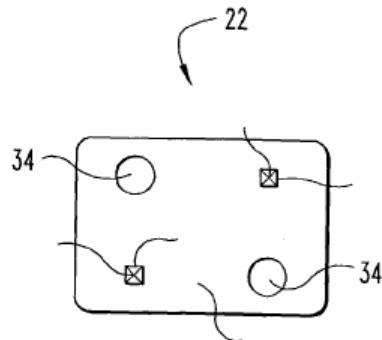
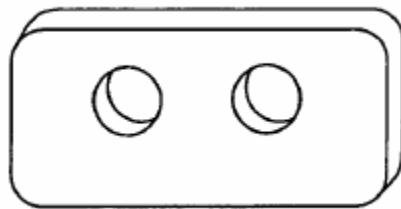


Fig. 3d

Figures 3a and 3d show a top view and a bottom view, respectively, of attachment member 22, with holes 34 and post 36 (*id. at ¶ 0040*). Morrison also discloses an embodiment that includes attachment members 22', which "are substantially the same as attachment members 22, with the exception that attachment members 22' do not include an attached or integral post 36" (*id. at ¶ 0051*).

Figure 4 of the instant application is reproduced below:



The figure shows an anterior view of an embodiment of the claimed shim (Spec. 3: 19-20).

The shim disclosed by Morrison reasonably appears to be sized and configured appropriately for use with a laterally placed ADR device. Morrison therefore anticipates instant claim 1.

Appellant argues that “Morrison has nothing to do with artificial disc replacement. . . . Morrison does not disclose a shim positioned between the plate of a laterally placed artificial disc replacement and the lateral edge of a vertebral body.” (Appeal Br. 4.) Appellant argues that the Examiner’s interpretation of the claims and reference is improper and that Morrison does not anticipate under the correct interpretation (*id.* at 4-8).

This argument is unpersuasive because, as discussed above, claim 1 is directed to a shim that is capable of being used with a laterally placed ADR device, not a shim in a particular location. While we agree with Appellant that the Examiner interpreted the claims incorrectly, we disagree with Appellant’s position that Morrison must disclose a shim positioned between an ADR device and the lateral edge of a vertebral body in order to anticipate. Appellant has pointed to no structural limitation of the shim of claim 1 that is not met by Morrison’s shim, and therefore has not rebutted the *prima facie* case of anticipation.

We affirm the rejection of claim 1 as anticipated by Morrison. Claim 5 falls with claim 1. 37 C.F.R. § 41.37(c)(1)(vii).

With respect to claims 3 and 7, Appellant argues that the Examiner has not shown that Morrison discloses ““a plurality of differently sized shims to accommodate different plate-vertebrae spacings,”” as recited in claims 3 and 7. (Appeal Br. 9.)

The Examiner points to Morrison's ¶ 0071 (Answer 4), which reads as follows:

It will be appreciated that the above embodiments can be constructed for use in the sacral, lumbar, thoracic and/or cervical regions of the spine, and for use along the junctions of those regions. The size of a given embodiment will depend on the region in which it is used.

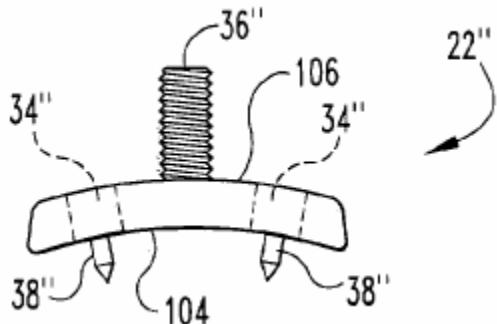
(Morrison, ¶ 0071.)

We agree with the Examiner that this disclosure describes a plurality of differently sized shims that are capable of being used with a laterally placed ADR device and can accommodate different plate-vertebrae spacings. Appellant has pointed to no structural limitation of claim 3 that is not met by Morrison's shims, and therefore has not rebutted the *prima facie* case of anticipation. We affirm the rejection of claim 3 as anticipated by Morrison. Claim 7 falls with claim 3. 37 C.F.R. § 41.37(c)(1)(vii).

With respect to claims 4 and 8, Appellant argues that these claims recite shims that "are not only different sizes, they are 'differently sized . . . to accommodate various lateral edge configurations.'"] This is a structural limitation." (Appeal Br. 9-10.)

Claim 4 is directed to the apparatus of claim 1, "including a plurality of differently shaped shims to accommodate various lateral edge configurations." The Examiner points to "the various shapes 22, 22', and 22" which can also be considered being different sizes" (Answer 4).

We agree with the Examiner that Morrison anticipates claim 4. Morrison's attachment member 22 is shown above. Morrison also discloses that the attachment member can have the shape shown in embodiment 22", which is shown in Fig. 11 (reproduced below):



The figure shows that “[a]ttachment member 22” is essentially the same as attachment member 22, with the exception that it has an underside 104 that has a concave curvature, and an upper side 106 that has a convex curvature” (Morrison, ¶ [0055]). We agree with the Examiner that Morrison’s different embodiments of the attachment member describe a plurality of differently shaped shims that are capable of accommodating various vertebral body lateral edge configurations when used with an ADR device. We affirm the rejection of claim 4 as anticipated by Morrison. Claim 8 falls with claim 4. 37 C.F.R. § 41.37(c)(1)(vii).

SUMMARY

We reverse the rejection based on 35 U.S.C. § 101 but affirm the rejection of claims 1, 3-5, 7, and 8 as anticipated by Morrison.

AFFIRMED-IN-PART

cdc

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