

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARY KARLIN MICHELSON

Appeal 2008-4793
Application 10/883,382
Technology Center 3700

Decided: January 02, 2009

Before TONI. R. SCHEINER, RICHARD M. LEBOVITZ, and
FRANCISCO C. PRATS, *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 14-32.
Jurisdiction is under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

The claims are directed to methods of distracting a spinal disc space. Appellant appeals from the final rejection of claims 14-32. The claims stand rejected as follows:

- Claims 14-32 under 35 U.S.C. § 112, first paragraph, as lacking written description (Ans. 3); and
- Claims 14-32 under 35 U.S.C. § 112, second paragraph, as indefinite (Ans. 3).

Claim 14 is representative of the appealed subject matter and reads as follows:

14. A method for distracting a spinal disc space between endplates of adjacent vertebral bodies, the method comprising:

inserting a first distractor in the spinal disc space to contact both of the endplates of the adjacent vertebral bodies;
inserting a second distractor in the spinal disc space to contact both of the endplates of the adjacent vertebral bodies;
and

maintaining a spacing between the first distractor and the second distractor during relative movement of the first distractor and the second distractor with a guide surface medially offset from one of the first and second distractors.

PRINCIPLES OF LAW

The purpose of the written description requirement is to “ensure that the scope of the right to exclude, as set forth in the claims does not overreach the scope of the inventor’s contribution to the field of art as described in the patent specification.” *Reiffin v. Microsoft Corp.*, 214 F.3d 1342, 1345 (Fed. Cir. 2000). To that end, to satisfy the written description requirement, the inventor “must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession

of the invention.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). In describing the claimed invention, there is no requirement that the wording be identical to that used in the specification as long as there is sufficient disclosure to show one of skill in the art that the inventor “invented what is claimed.” *Union Oil Co. of California v. Atlantic Richfield Co.*, 208 F.3d 989, 997 (Fed. Cir. 2000).

A specification must conclude with claims “particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” 35 U.S.C. § 112, ¶ 2 (2000). The definiteness requirement of 35 U.S.C. § 112, ¶ 2, “is essentially a requirement for precision and definiteness of claim language.” *PPG Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 1562, (Fed. Cir. 1996) (quoting *In re Borkowski*, 422 F.2d 904, 909 (CCPA 1970)). The “purpose is to provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent, with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance.” *In re Hammack*, 427 F.2d 1378, 1382 (CCPA 1970).

ISSUES

There are two issues on appeal:

Does the original application as filed provide written description for the limitation recited in claim 14 of “a guide surface medially offset from one of the first and second distractors”?

Is the phrase “a guide surface medially offset from one of the first and second distractors,” as it appears in claim 14, definite?

WRITTEN DESCRIPTION

Claim 14 is directed to a method “for distracting a spinal disc space between endplates of adjacent vertebral bodies.” According to the method, first and second distractors are inserted “in the spinal disc space to contact both of the endplates of the adjacent vertebral bodies” (claim 14). A distractor is a long rod-like device with a penetrating portion that facilitates insertion between spinal vertebrae (*see App. Br. 3*). As explained in the Specification, the distractors serve to “separate two adjacent vertebrae to a preferred distance” (Spec. 12). According to claim 14, space is maintained between the first and second distractors during their “relative movement . . . with “a guide surface medially offset from one of the first and second distractors” (claim 14).

Claim 14 is not an original claim, but was added during prosecution of the application before the Examiner (*see Amendment, April 13, 2005*).¹ The Examiner responded to the Amendment by making a rejection under § 112, first paragraph, for lack of written description (Office Action, mailed December 13, 2005, page 2). The Examiner’s position then, as it is now, is that there is no support in the original written description for the limitation in claim 14 that requires “a guide surface medially offset from one of the first and second distractors” (Ans. 3).

Appellant does not challenge the finding that the “guide surface” limitation does not appear in the identical wording in the original written description as it is recited in claim 14. However, Appellant contends that the application as originally filed supports it. Appellant states that the claimed

¹ In the remarks, Appellant stated that claim 14 was added to provoke an interference with an issued patent (Amendment, April 13, 2005, page 5).

“guide surface” is “in the form of an extended portion (1121)” of the dual extended outer sleeve shown in original Figure 33 (App. Br. 3). Appellant explains:

When the first and second distractors (100) received in the hollow tubular members (1101) and (1102) are moved relative to one another (e.g., removed through the hollow tubular members (1101) and (1102)), the extended portion (1121) serves as a guide surface for maintaining a spacing therebetween. Furthermore, when viewing Fig. 33, it is apparent that the extended portion (1121) would be medially offset from the first and second distractors (100) during relative movement thereof through the hollow tubular members (1101) and (1102).

(App. Br. 5).

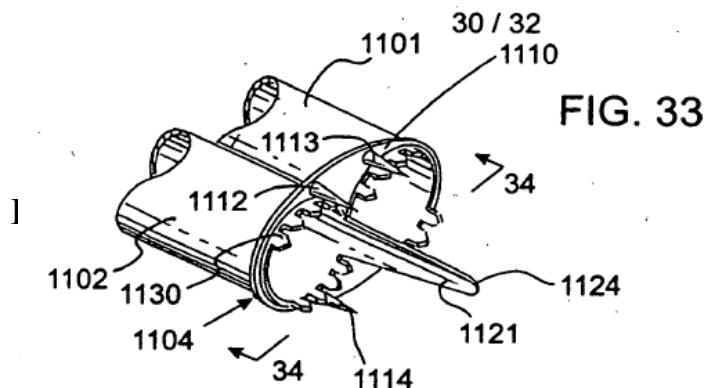
Defining “medially” to be ““of or in the middle””, Appellant states “it is apparent that the extended portion (1121) serves as a guide surface situated in or pertaining to the middle, situated in or toward the middle, or of or in the middle between the first and second distractors (1101) and (1102)” (Reply Br. 3).

The difficulty with Appellant’s position is that it does not track the actual language which appears in claim 14. The claim does not require the guide surface to be medially offset from “the first *and* second distractors” as argued by Appellant (*id.*) (Emphasis added.) Rather, the claim states that the guide surface is “medially offset from *one* of the first and second distractors” (claim 14) (Emphasis added.) The claim is therefore broader than argued by Appellant, covering embodiments in which the guide surface is medially offset from only *one* of the distractors, but not the other. Appellant has not provided any evidence that the latter configuration is supported by the original written description. Our examination of the

Specification, as set forth in the findings below, does not reveal any evidence which would support the claimed limitation.

Findings of Fact (FF)

1. The Specification describes single and dual extended outer sleeves which can serve as intervertebral distractors to restore the height of the intervertebral space (*see Spec. 53*).
2. Figure 33 of the Specification shows a dual extended outer sleeve comprising two hollow tubular member 1101 and 1102 (Spec. 55:6-8).
3. Figure 33 of the Specification is reproduced below:



4. “The two hollow tubular members 1101 and 1102 [of the dual extended sleeve] have a distal end 1104 which has been extended to form an extended portion 1121 which is essentially a continuation of the hollow tubular members 1101 and 1102 joined together” (Spec. 55:8-11).
5. “The extended portion 1121 has a height that is greater at a point proximate the distal end 1104 and decreases in the direction away from the hollow tubular members 1101 and 1102, in order to maintain the normal curvature of the spine [when inserted between the intervertebral discs]” (Spec. 55:13-25).

6. “The extended portion 1121, is tapered at its leading edge 1124 to facilitate insertion of the extended portion 1121 into the disc space between two adjacent vertebrae” (Spec. 55:16-18).
7. During an intervertebral procedure, first and second distractors are inserted into the intervertebral space to restore its height. After the first and second distractors are in place and protruding from the intervertebral space, the dual outer sleeve is placed over them (Spec. 46:3-5; App. Br. 4). “Once the Dual Outer Sleeve . . . is seated over the first and second distractors . . . , the first and second distractors can be removed through the tubular portions [of the sleeve]” (App. Br. 4; *see* Spec. 47).
8. The Specification does not expressly state that the extended portion 1121 is “a guide surface medially offset from one of the first and second distractors” as recited in claim 14.

Analysis

The written description requirement prohibits a patent applicant from claiming more than what they invented. *See Reiffin v. Microsoft Corp.*, 214 F.3d at 1345; *Union Oil Co. of California v. Atlantic Richfield Co.*, 208 F.3d at 997. It is not necessary that identical wording be duplicated from the Specification into the claims. *See Union Oil Co. of California v. Atlantic Richfield Co.*, 208 F.3d at 997. However, there must be evidence that the applicant invented what is claimed. *Id.* Here, Appellant is claiming a “guide surface” for “maintaining a spacing between” first and second distractors, when what has been invented is an extended outer sleeve with extended portions (FF1-4) that, when inserted into the disc space, maintain normal spinal curvature (FF5, 6). Appellant has not identified any disclosure in the original application which describes a “guide surface” in

the middle of one, but not *both* distractors. Nor has Appellant pointed to original disclosure that would support a “guide surface” in the absence of the extended sleeve/extended portion. For the reasons discussed above, we conclude that Appellant has claimed an invention which lacks written description in the originally filed application.

INDEFINITENESS

Claims 14-32 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite (Ans. 3). The Examiner contends that “it isn’t clear as to what the guide surface being medially offset from one of the first and second distractors is in reference to” (*id.*).

The claim language does not make it clear what subject matter the claims embrace. As pointed out by the Examiner, there is no reference point recited in the claims for determining what position on the distractor the guide surface is medially offset from.

CONCLUSIONS OF LAW

The original application as filed does not provide written description for the limitation recited in claim 14 of “a guide surface medially offset from one of the first and second distractors”. We affirm the rejection of claim 14 under 35 U.S.C. § 112, first paragraph, as lacking written description.

Claims 15-32 were not separately argued and therefore fall with claim 14.

See C.F.R. 41.37(c)(1)(vii).

The phrase “a guide surface medially offset from one of the first and second distractors”, as in claim 14, is not definite under 35 U.S.C. § 112, second paragraph. The rejection of claims 14-32 is affirmed, with claims

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15-32 falling with claim 14 because separate arguments for their patentability were not provided. *See* C.F.R. 41.37(c)(1)(vii).

TIME PERIOD

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

dm

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