

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MADHAVAN PISHARODI

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Appeal No. 1997-1145  
Application No. 08/210,229<sup>1</sup>

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ON BRIEF

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Before ABRAMS, STAAB, and GONZALES, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1-4, 16 and 17. Claims 7-15 have been withdrawn from consideration as being directed to a non-elected invention, claims 18 and 19 have been canceled, claims 21 and

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<sup>1</sup> Application for patent filed March 18, 1994.

22 have been allowed, and claims 5, 6 and 20 have been indicated as containing allowable subject matter.

The appellant's invention is directed to a vertebral disk stabilizer. The claims before us on appeal have been reproduced in an appendix to the Brief.

**THE REFERENCES**

The references relied upon by the examiner to support the final rejection are:

Kuntz	4,349,921	Sep. 21, 1982
Meyers	5,324,292	Jun. 28, 1994
		(Filed Feb. 10, 1993)

**THE REJECTIONS**

Claim 4 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite in that it fails to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 1-4, 16 and 17 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Meyers.

Claims 1-3, 16 and 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kuntz.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and the appellant regarding the rejections, we make reference to the Examiner's Answer (Paper No. 21 ) for the reasoning in support of the rejections, and to the Briefs (Papers Nos. 18 and 22), for the opposing viewpoints of the appellant.

**OPINION**

*The Rejection Under 35 U.S.C. § 112*

Claim 1 is directed to a vertebral disk stabilizer comprising an elongate implant having threads on its outer surface and an elongate applicator detachably mounted to the implant. Claim 4, which depends from claim 1, is directed to "[a] kit including the stabilizer of claim 1 and a spreader for use in connection therewith . . . ." The examiner has taken the position that claim 4 is indefinite "because it is unclear whether the kit includes all the limitations of claim 1 or not" and therefore "claim 4 is broader in scope than the claim it depends from" (Answer, page 3). While claim 4 may not present its subject matter in what the examiner believes to be the

conventional format, from our perspective it is not indefinite insofar as setting forth the metes and bounds of the invention is concerned.

This rejection is not sustained.

*The Rejections Under 35 U.S.C. § 102*

Anticipation under 35 U.S.C. § 102 is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See *In re Paulsen*, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

The first rejection under Section 102 set out by the examiner is that independent claim 1 and dependent claims 2-4, 16 and 17 are anticipated by Meyers. This reference is directed to a fracture fixation assembly for skeletal structures such as femurs and hips, and not to a vertebral disk stabilizer. Nevertheless, in the examiner's view, the subject matter of claim 1 reads on the Meyers device. In particular, the examiner takes the position that screw 4 and the

screwdriver intended for use in installing implant 20 (disclosed but not illustrated) together constitute the required elongate applicator. We cannot agree with this reasoning.

Screw 4 is disclosed as a compression fixture which functions to attach together implant 20 and supporting tube plate member 10. Not only is screw 4 not disclosed as being involved in the placement of the implant in position relative to the skeletal structure with which it is to interact, but it does not appear that screw 4 can even be installed until after the implant is in place. The only element disclosed as being used in installing the implant is the screwdriver, which engages slot 22 on the proximal end of the implant. In any event, it is our opinion that screw 4 and the screwdriver cannot be considered as the claimed "applicator" because they are not capable of performing in the manner required by the claim. Specifically, claim 1 requires that the "applicator" perform three functions, the first of which is "inserting said implant into the region from which a portion of the intervertebral disk has been removed." One of ordinary skill in the art would understand from the explanation of the

invention in the specification that the applicator must affirmatively engage the implant to facilitate handling it until it is the desired position between two vertebrae (pages 6-8). In the Meyers system there is no affirmative engagement between the screwdriver and the slot in the screw (or the slot in the implant, for that matter) and there need not be, because while there is no precise explanation on this point in the patent, it would appear that the implant is guided during insertion at least by the hollow barrel (14) of the plate member. In addition, the second function of the applicator, the task of rotating the implant, cannot be accomplished by engaging the screwdriver with screw 4 and then rotating it. As we perceive the Meyers invention, this would serve to rotate only screw 4 with respect to the implant until the implant and the plate member are locked together, and would not cause the implant to rotate (column 3, lines 5-8).

It is our opinion that, at the very least, considerable speculation concerning the operation of the Meyers device is necessary to support the examiner's position that claim 1 is anticipated thereby, and it is axiomatic that a rejection cannot be based upon speculation. We therefore will not

sustain this rejection of independent claim 1 or, it follows,  
of dependent claims 2-4, 16 and 17.

The second rejection under Section 102 is based upon  
Kuntz. This rejection fails at the outset because the Kuntz  
implant fails to have threads on its outside surface, as is  
required by independent claim 1. We therefore will not sustain  
this rejection of claims 1-3, 16 and 17.

**SUMMARY**

None of the rejections are sustained.

The decision of the examiner is reversed.

**REVERSED**

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
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	)	
JOHN F. GONZALES	)	
Administrative Patent Judge	)	

NEA/jlb

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