UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/444,788	06/01/2006	Michael E. Fein	TYHC:0078-16/FLE	7502

52144 7590 03/01/2013
Covidien LP
ATTN: IP Legal
6135 Gunbarrel Avenue
Boulder, CO 80301

EXAMINER
WEATHERBY, ELLSWORTH

ART UNIT	PAPER NUMBER
3768	

NOTIFICATION DATE	DELIVERY MODE
03/01/2013	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ip.legal@covidien.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL E. FEIN, MARCIA FEIN, PAUL D. MANNHEIMER, ADNAN MERCHANT, CHARLES PORGES, and DAVID SWEDLOW

Appeal 2010-006725
Application 11/444,788
Technology Center 3600

Before: PHILLIP J. KAUFFMAN, BARRY L. GROSSMAN, and MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants[1] appeal under 35 U.S.C. § 134 from a rejection of claims 1-3 and 5-15. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

The Claimed Subject Matter

The claimed subject matter relates to pulse oximetry sensors which include coded information relating to characteristics of the sensor. Spec. [02]. Claims 1, 5, 7, 10, 11, and 12 are the independent claims. Claim 1, reproduced below, is illustrative of the claimed subject matter:

> 1. A sensor, comprising:
> a light emitting element configured to emit light;
> a light detecting element configured to detect the light; and
> a memory storing sensor model identification data, the memory providing access to an oximeter monitor to read the sensor model identification data, wherein the memory stores data relating to an action to be performed by the oximeter monitor in response to reading the senor model identification data.

References

The Examiner relied upon the following prior art references:

Fein	US 5,645,059	Jul. 8, 1997
Knapp	US 5,855,609	Jan. 5, 1999
Sun	US 6,122,536	Sept. 19, 2000

Rejections

Appellants seek review of the following rejections (App. Br. 5)[2]:

[1] Mallinckrodt Inc.is the real party in interest. App. Br. 2.

Claims 1, 3, 5, 7, 9–13, and 15 rejected under 35 U.S.C. § 102(b) as being unpatentable in view of Fein;

Claims 2, 6, and 8 rejected under 35 U.S.C. § 103(a) as being unpatentable over Fein in view of Sun; and

Claim 14 rejected under 35 U.S.C. § 103(a) as being unpatentable over Fein in view of Knapp.

ANALYSIS

Claims 1, 3, 5, 7, 9–13, and 15 Rejected Under 35 U.S.C. § 102(b)

Appellants present argument only for the independent claims 1, 5, 7, 10, 11, 12. App. Br. 7; Reply Br. 2-3[3]. The failure of Appellants to separately argue claims which Appellants has grouped together is a waiver of any argument that the Board must consider the patentability of any grouped claim separately. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2011). Thus, the claims not specifically argued stand or fall with the independent claim from which they depend.

Claim 1, 3, 13, 14, and 15

Claim 1 is directed to a "sensor." The sensor includes a "memory." The memory stores two types of data. One type of data stored by the memory is "sensor model identification data" (which we will refer to as "sensor ID data"). The sensor memory provides "access" to an oximeter

[2] Citations to "App. Br. ___" are to the indicated page in the Appeal Brief filed June 29, 2009.
[3] Citations to "Reply Br. ___" are to the indicated page in the Reply Brief filed January 5, 2010.

monitor[4] for this data, that is, the sensor memory is configured to allow a monitor to read the sensor ID data stored in the memory.

The second type of data stored by the sensor memory is data "relating to an action to be performed by the oximeter monitor in response to reading the senor (sic) model identification data" (which we will refer to as "future action data"). The quoted clause from claim 1 only requires the sensor memory to store "data relating to" an action to be performed; it does not require that the "action" itself to be stored in the sensor memory.

As found by the Examiner, claim 1, in relevant part, merely identifies where data is stored (in a sensor memory) and what data is stored (sensor ID data and future action data). Ans. 8.[5]

Regarding claim 1 and the other independent claims, it is Appellants position that "Fein does not disclose or suggest storing a sensor model identification code along with *instructions* or *data relating to an action to be performed by an oximeter monitor in response to the sensor model identification data* in a sensor memory, as generally set forth in the present independent claims." App. Br. 7. Appellants argue that the "instrument" in Fein "is not receiving instructions from a sensor relating to the performance of any type of action. Rather, the instrument is merely receiving data (i.e., a number of LEDs) and performing a preprogrammed function based on the

---

[4] Whether the oximeter monitor is or is not an element of claim 1 is not an issue in this appeal and thus we make no determination on that issue. Also to avoid any confusion in terminology, the phrase "oximeter monitor" refers to a device used to measure various blood flow characteristics, and not to a computer monitor or other display. Information from the sensor memory is displayed on a display screen when the sensor is connected to an oximeter monitor. Spec. [07].

[5] Citations to "Ans. ___" are to the indicated page in the Examiner's Answer mailed November 13, 2009.

data." *Id.* at 8. Appellants sum up their argument by stating that "the instrument [in Fein] is operating based on instructions found within the instrument, not instructions received from the sensor." *Id.*

Based on well-established legal principles, we determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims "their broadest reasonable interpretation consistent with the specification" and "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (citations omitted). It is the appellants' burden to precisely define the invention, not the PTO's. *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997).

Based on our analysis of claim 1 and the Examiner's findings and conclusions, Appellants' argument based on the source of "instructions," that is, whether instructions are found within the instrument or received from the sensor memory is misplaced. Claim 1 has no limitations regarding how the oximeter monitor, which Appellants refer to as the "instrument," performs or receives instructions. Claim 1 also does not call for anything related to the source of instructions "relating to an action to be performed," as recited in claim 1.

Contrary to the implication in Appellants' arguments, the fact that the claim may call for the future action of the monitor to be in response to sensor ID data stored in the sensor memory does not mean that the instructions for that future action also must be stored in the same memory. There is no requirement in claim 1 that "instructions" for taking a future action be stored in the sensor memory.

Appellants appear to confuse, or use interchangeably, the words "instructions" and "actions" in their arguments. Claim 1 refers to "actions" not "instructions." Appellants argue that Fein "is not receiving *instructions* from a sensor *relating to* the performance of any type of *action*" (App. Br. 8, emphasis added), thus suggesting that "instructions" and "actions" are not synonymous, since "instructions" relate to "actions".[6] The word "instructions" does not appear in claim 1. Appellants have not directed us to any language in claim 1 or the Specification that requires that the monitor operates based on instructions received from a sensor memory rather than from instructions received from the monitor, the "instrument," or elsewhere.

Appellants argue that the Examiner's analysis "makes absolutely no sense." Reply Br. 3. We disagree. The Examiner merely analyzed the language of the claim and, as we have stated above, reached the right conclusion. We, and the Examiner, interpret the claim drafted by Appellants. *See*, *Chef America, Inc. v. Lamb-Wesson, Inc.*, 358 F.3d 1371, 1374 (Fed. Cir. 2004) holding that a court construes the claims "based on the patentee's version of the claim as he himself drafted it," even if that "results in a nonsensical construction of the claim."

Applying the disclosure in Fein to the properly interpreted claim, the Examiner found, in relevant part, that Fein teaches storing sensor model identification data. Ans. 3-4, 8. The Examiner also found that this same memory stores data relating to an action to be performed by the oximeter monitor in response to reading the sensor model identification data. *Id.* at 4.

---

[6] We also note that independent claims 5, 7, 10, 11, and 12 use both the words "instructions" and "actions" to refer to different events, further establishing that they are not intended to be synonymous in the context of this application.

Based on these and other findings, the Examiner determined that Fein anticipated the claimed invention in claim 1 as well as the other claims in this group.

Appellants also argue that Fein does not disclose a sensor memory storing "sensor model identification data," as recited in the present claims. App. Br. 7; Reply Br. 5. According to Appellants, Fein merely discloses encoding a "brand or type" of sensor. *Id.* Appellants state that a "brand" is merely a trade name (such as a company name), and a "type" is merely a broad indication of the sensor's manner of use (e.g., finger sensor or nose sensor). *Id.*

Appellants have not directed us to anything in the Specification that establishes a specific or unique definition of the phrase "sensor model identification data" as used in the claims. The Specification provides an example of the future actions the monitor can take based on reading sensor ID data. One example of such a future action is that the identification code can be displayed in human readable form on a display screen connected to the oximeter monitor, such as displaying what sensor model is being used, e.g. "Nellcor OXISENSOR I1 D-25." Spec. [12]. Thus, in this example, the identification code is simply the brand or model name ("Nellcor OXISENSOR") and the model number ("I1-D-25").

We find unpersuasive Appellants' argument that Fein does not store "sensor model identification data" in the sensor memory in light of the example used in the Specification and in light of the express teachings in Fein. Fein provides an example of the identification data that can be stored. One example is that a manufacturer could design an instrument so that it would not operate unless it recognized the code corresponding to a sensor

made by the same manufacturer. Fein teaches that this could be a useful means of ensuring only sensors with certain characteristics are used, or to ensure sensor quality control, patient safety, and efficacy of performance.[7] Fein stores ID data in a sensor memory as called for in the claims.

Appellants have not pointed to any evidence or stated any persuasive reasoning to apprise us that the Examiner erred in his findings and conclusions regarding the rejection of claim 1. Accordingly, we affirm the rejection of claim 1. Claims 3, 13, 14, and 15 fall with claim 1.

Claims 5 and 6

Independent claim 5 relates to a method of manufacturing an oximeter sensor. The method includes the "manufacturing" steps of "storing sensor model identification data in *a* memory" and "storing instructions in *the* memory (emphasis added)."

As argued by Appellants, independent claim 5 calls for, in relevant part, storing "instructions" in the same memory which also stores sensor model ID data, and that this memory is part of the manufactured sensor. App. Br. 7; Reply Br. 2-3, 4.

Appellants' Specification provides no specific meaning for the word "instruction."[8] If the specification does not assign or suggest a particular definition to a claim term, it is appropriate to consult a general dictionary definition of the word for guidance in determining the ordinary and customary meaning of the claim term as viewed by a person of ordinary skill

[7] Fein, col. 9, ll. 1-12.

[8] The only place in the Specification where the word "instruction" is used is in paragraph [14], page 4, where Appellants disclose that it may be important to identify a sensor model "so that instructions relating to a particular sensor model in the manufacturer's handbook can be identified."

in the art. *Comaper Corp. v. Antec, Inc.*, 596 F.3d 1343, 1348 (Fed. Cir. 2010). In the context of the relevant technology and the Specification, the broadest reasonable interpretation consistent with the Specification of "instruction" is a "sequence of bits that tells a computer's central processing unit to perform a particular operation. An instruction can also contain data to be used in the operation."[9] We have used this definition of "instruction" in our analysis of claim 5.

As discussed in our analysis of claim 1, Fein discloses storing sensor ID data in the sensor memory. The Examiner found that Fein also discloses that "[m]emory *in the oximeter* is stored with actions to be performed in response to sensor model identification data." Ans. 4 (emphasis added). However, there is no finding that Fein discloses storing in the sensor memory both sensor ID data and instructions that relate to a future action of the oximeter monitor. Thus, Fein does not anticipate the method of manufacturing a sensor called for in claim 5 that requires storing both sensor ID data and instructions that relate to a future action in the same sensor memory.

Claim 6 depends from claim 5. Thus, Fein also does not anticipate the invention recited in claim 6.

Accordingly, we reverse the rejection of claims 5 and 6.

Claims 7 and 9

Claim 7 relates to a method of oximeter sensor operation. The method of sensor operation in claim 7 requires "providing sensor model identification data stored in a memory of the oximeter sensor." The method

[9] Dictionary.com, *The American Heritage® Science Dictionary*. Houghton Mifflin Company. **http://dictionary.reference.com/browse/instruction** (accessed: February 16, 2013).

in claim 7 also requires "providing instructions related to an action to be performed by the oximeter monitor in response to reading the sensor model identification data." Thus, claim 7 calls for providing instructions but is *not* limited to those instructions being stored in and the sensor memory.

As stated in our analysis of claim 1, the fact that claim 7 may call for the future action of the monitor to be in response to sensor ID data stored in the sensor memory does *not* mean that the instructions for that future action also must be stored in the same memory. There is no requirement in claim 7 that "instructions" for taking a future action be stored in the sensor memory.

Accordingly, based on the analysis provided for claim 1 and the Examiner's findings and conclusions as discussed in that analysis, we affirm the rejection of claim 7. Claim 9 falls with claim 7.

Claim 10

Claim 10 is directed to an oximeter system. The system includes an oximeter sensor. Claim 10 requires, in relevant part, that the sensor include "*a memory* storing sensor model identification data *and* instructions related to an action to be performed based on the sensor model identification data (emphasis added)." Thus, in claim 10, the same sensor memory that stores sensor ID data also stores the instructions. Claim 10 also requires "a read circuit" that is "configured to read the sensor model identification data *and* the *instructions* from *the memory* of the oximeter sensor (emphasis added)."

Consistent with our analysis of claim 5, there is no finding that Fein discloses storing in the same sensor memory both sensor ID data and instructions that relate to a future action of the oximeter monitor. Thus, Fein does not anticipate the oximeter system called for in claim 10 that requires

storing both sensor ID data and instructions that relate to a future action in the same sensor memory.

Accordingly, we reverse the rejection of claim 10.

Claim 11

Claim 11 relates to an oximeter monitor. Claim 11 requires, in relevant part, "a circuit configured to receive sensor model identification data and instructions *related to* an action to be performed by the oximeter monitor *based on the sensor model identification data from a memory of the oximeter sensor* (emphasis added)." The emphasized language from claim 11 requires that sensor ID data be stored in a memory of the sensor. However, there is no requirement in claim 11 that the instructions related to a future action based on the sensor ID data must also be stored in the same sensor memory.

Accordingly, based on the analysis provided for claim 1 and the Examiner's findings and conclusions as discussed in that analysis, we affirm the rejection of claim 11.

Claim 12

Claim 12 relates to a method of oximeter operation. Claim 12 recites, in relevant part, "receiving ... instructions related to an action to be performed by an oximeter monitor based on the sensor model identification data from a memory of the sensor."

Similar to our analyses for claims 7 and 11, the quoted clause does not require that the instructions be stored in the sensor memory as argued by Appellants. The quoted clause merely requires that a monitor receive instructions based on sensor model ID data from a memory of the oximeter sensor. The source of the instructions is not specified. Contrary to

Appellants' arguments, claim 12 does not require that the instructions also be stored in the sensor memory.

For the reasons stated above in accord with our analyses of claims 1, 7, and 11, we affirm the rejection of claim 12.

Claims Rejected Under 35 U.S.C. § 103(a)

With respect to claims 2, 8, and 14 rejected under 35 U.S.C. § 103(a) as being unpatentable over Fein in view of Sun or Knapp, Appellants argue only that the secondary references do not remedy the alleged deficiencies of Fein. App. Br. 11, 12. Because we have affirmed the rejection of the independent claims from which claims 2, 8, and 14 depend, and thus found unpersuasive the alleged deficiencies of Fein, we also find unpersuasive of error Appellants arguments regarding claims 2, 8, and 14. Accordingly, we affirm the rejection of claims 2, 8, and 14.

DECISION

We AFFIRM the decision of the Examiner to reject claims 1-3 and 7-9, and 11-15.

We REVERSE the decision of the Examiner to reject claims 5, 6, and 10.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2011).

AFFIRMED-IN-PART

MP