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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/846,142	08/28/2007	Kevin J. Kelly	151P24378USU1	9888
54228	7590	02/14/2013	EXAMINER	
IPLM GROUP, P.A. POST OFFICE BOX 18455 MINNEAPOLIS, MN 55418			KIMBALL, JEREMIAH T	
			ART UNIT	PAPER NUMBER
			3766	
			NOTIFICATION DATE	DELIVERY MODE
			02/14/2013	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KEVIN J. KELLY

Appeal 2010-010609
Application 11/846,142
Technology Center 3700

Before KARL D. EASTHOM, JENNIFER S. BISK, and
MICHAEL J. FITZPATRICK, *Administrative Patent Judges*.

FITZPATRICK, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Kevin J. Kelly (Appellant) filed a request for rehearing under 37 C.F.R. § 41.52 (hereinafter “Request”), dated January 29, 2013, of our decision mailed November 29, 2012 (hereinafter “Decision”).

In that Decision, we affirmed-in-part the Examiner’s rejection of claims 1-25. Appellant requests rehearing of only that portion of our Decision sustaining the rejection of claims 6 and 7 under 35 U.S.C. § 103(a) as unpatentable over Meadows (US 2005/0107841, pub. May 19, 2005) and Jorgenson (US 2002/0120307, pub. Aug. 29, 2002).

Upon rehearing, we deny Appellant’s request to reverse the rejection of claims 6 and 7.

OPINION

The Request is based on two erroneous premises: (1) that we did not consider any limitations of claim 6 beyond those recited in claim 1 from which it depends (*see* Request p. 2); and (2) that we considered arguments set forth only in Appellant’s Reply Brief (*see* Request p. 6).

Claim 6 depends from claim 1. As set forth in our Decision (pp. 6-7), claim 6 additionally requires that the “controller conducts said plurality of measurements of impedance values for fewer than all of said plurality of electrodes.” As set forth in our Decision (p. 7), the Examiner found this limitation taught by Meadows at page 26, paragraphs 239-244 and, in particular, paragraph 240, which states:

The most common of the above functions that is performed is the impedance voltage sweep on all the electrodes indicated by a mask value. (A “mask value” is just a way of defining which electrodes are available for use with a given patient, inasmuch

as not all patients will have all sixteen electrodes available for their use.)

As set forth in our Decision (p. 7), we concluded that Meadows, thus, “teaches conducting measurements of impedance values for fewer than all of the electrodes.” Appellant fails to explain why this conclusion does not flow from Meadows and thus fails to explain that the Board overlooked or misapprehended a material point.

In reaching that conclusion, we did consider the arguments set forth in the Appeal Brief (as well as the Reply Brief) but we did not find them persuasive. For the sake of completeness, Appellant’s Appeal Brief arguments with respect to claims 6 and 7¹ are quoted in their entirety below:

Claims 6 and 7

The above discussion of claim 1 and of Meadows et al ‘841 and of Jorgenson et al ‘307 is incorporated in its entirety.

Claims 6 and 7 depend from claim 1, and as such incorporates all of the subject matter of claim 1. In addition, claim 6 recites that the controller conducts the plurality of measurements of impedance values for fewer than all of the plurality of electrodes while claim 7 recites that the controller conducts the plurality of measurements of impedance values only for those of the plurality of electrodes that are in use for the therapeutic stimulation. The Office Action asserts that “the feature of conducting impedance measurements for fewer than all of the electrodes, and specifically for only those in use for stimulation would have been a matter of obvious design choice

¹ Contrary to Appellant’s assertion, claim 7 was not separately argued from claim 6 because they were argued under the same heading. *See* 37 C.F.R. § 41.37(c)(1)(vii) (“Any claim argued separately should be placed under a subheading identifying the claim by number.”) Regardless, Appellant failed to apprise us of error in the rejection of either claim.

to one of ordinary skill in [t]he art at the time of the invention since Applicant has asserted no specific purpose, nor any inherent advantage in the claimed feature, and one of ordinary skill in the art would be inclined to choose various impedance measurement configurations based on suitability of purpose, absent criticality or unexpected results.”

As noted above, “[w]hen determining whether a claim is obvious, an examiner must make ‘a searching comparison of the claimed invention - including all its limitations - with the teaching of the prior art.’ In re Ochiai, 71 F.3d 1565, 1572 (Fed. Cir. 1995). “Thus, ‘obviousness requires a suggestion of all limitations in a claim.’ CFMT, Inc. v. Yieldup Intern Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing In re Royka, 490 F.2d 981, 985 (C.C.P.A. 1974). Here, the Examiner disclaims any need to find a teaching of the limitations of claims 6 and 7. It is respectfully submitted that such a failure is plainly improper. Further, neither Meadows et al '841 nor Jorgenson et al '307, alone or in combination, show, disclose or suggest such subject matter.

Moreover, it is respectfully submitted that it is not a burden which may be placed on the Applicant to be forced to recite with particularity a “specific purpose” or “inherent advantage” of a claimed feature in order to be entitled to claim such a feature, and to reject claims 6 and 7 on that basis is, again, plainly improper. Further, even assuming *arguendo* that such a requirement were on the Applicant, the advantages of testing fewer than all electrodes is reviewed at length in the specification of the instant application, such as in paragraphs [16]-[19], and the advantages of limiting testing to the conditions claimed in figures 6 and 7 flow from those rationales. Thus, the rejections of claims 6 and 7 are rendered further improper on that basis.

Neither Meadows et al '841 nor Jorgenson et al '307, alone or in combination, show, disclose or suggest all of the subject matter of claims 6 and 7. Thus, the rejections of claims 6 and 7 under 35 USC § 103(a) as being unpatentable over

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Meadows et al '841 in view of Jorgenson et al '307 are improper and should be reversed.

(App. Br. 16-17.)

Nothing in these Appeal Brief arguments (or in the Reply Brief arguments) apprised us of any error in the rejection of claims 6 or 7.

Appellant's Request does not convince us that we "misapprehended or overlooked" a material point in affirming the Examiner's rejection of claims 6 and 7. *See* 37 C.F.R. § 41.79 (b).

DECISION

Appellant's Request has been granted to the extent that we have reconsidered our Decision in light of the Request, but it is denied with respect to our making any modification to the Decision.

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

DENIED

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