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LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			DIXON, ANNETTE FREDRICKA	
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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MICHAEL BERTHON-JONES and STEVEN PAUL FARRUGIA

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Appeal 2010-011382  
Application 11/237,278  
Technology Center 3700

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Before: PHILLIP J. KAUFFMAN, WILLIAM V. SAINDON, and JOHN  
W. MORRISON, Administrative Patent Judges.

MORRISON, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's decision rejecting claims 46-63. An oral hearing was held on December 4, 2012. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

## THE INVENTION

Appellants' claimed invention relates to the administration of continuous positive airway pressure (CPAP) treatment for partial or complete upper airway obstruction. Spec. 1. Claims 46 and 51 are the independent claims on appeal. Claim 46 is representative and is reproduced below:

46. A method for the administration of CPAP treatment pressure comprising the steps of:
  - supplying breathable gas to a patient's airway at an initial treatment pressure, and repeatedly:
    - determining a measure of respiratory airflow;
    - determining the occurrence of an apnea from a reduction in said measure of respiratory airflow below a threshold;
    - determining the duration of said apnea; and
    - increasing the treatment pressure by an amount which is an increasing function of the duration of said apnea, and a decreasing function of the treatment pressure immediately before said apnea,
  - wherein no increase in pressure is made for apneas of less than approximately 10 seconds duration, or for apneas where the treatment pressure immediately prior to the apnea is more than approximately 10 cmH<sub>2</sub>O, but otherwise, the

lower the treatment pressure immediately prior to the apnea, and the longer the apnea, the greater the increase in treatment pressure, up to a maximum of approximately 8 cmH<sub>2</sub>O per minute of apnea.

#### THE REJECTIONS

Claims 51-55 and 60-62 are rejected under 35 U.S.C. § 103(a) over Estes (US 5,823,187, iss. Oct. 20, 1998).

Claims 46-50, 56-59 and 63 are rejected under 35 U.S.C. § 103(a) over Berthon-Jones (US 5,704,345, iss. Jan. 6, 1998).

#### ANALYSIS

##### *Obviousness over Estes*

Addressing claim 51, the Examiner reasons

Based upon the controller, the inspiration/expiration decision circuitry, ramp circuitry, sensor means (Figs. 1, 2, 3, 5-7B, 10-15) the device of Estes is fully capable of being operable to receive the input signals to meet the functional limitations of the claims.

Ans. 4.

Appellants counter that

The Examiner has presented no reason why one aware of Estes would be led to provide a system dependent upon the duration of an apnea and with the particular form of dependence that is claimed. Further, there is no suggestion in Estes for the elements of claim 51, particularly determining the duration of the apnea and increasing the treatment pressure by an amount which is an increasing function of the duration of the apnea and a decreasing function of the treatment pressure immediately before the apnea.

App. Br. 11.

The key issue is whether Estes is “capable of” performing all of the function of claim 51. The “capable of” test requires that the prior art structure be capable of performing the function without further programming. *Typhoon Touch Technologies, Inc. v. Dell, Inc.*, 659 F.3d 1376, 1380 (Fed. Cir. 2011) (discussing *Microprocessor Enhancement Corp. v. Texas Instruments, Inc.*, 520 F.3d 1367 (Fed. Cir. 2008)). When the functional language is associated with programming or some other structure required to perform the function, that programming or structure must be present in order to meet the claim limitation. *Id.* While in some circumstances generic structural disclosures may be sufficient to meet the requirements of a “controller,” see *Ergo Licensing, LLC v. CareFusion 303, Inc.*, 673 F.3d 1361, 1364 (Fed. Cir. 2012) (citing *Telcordia Techs., Inc. v. Cisco Sys., Inc.*, 612 F.3d 1365, 1376–77 (Fed. Cir. 2010), that is not the case here. In this case, the Appellants contend that nothing in the Estes disclosure teaches “determining the duration of the apnea and increasing the treatment pressure by an amount which is an increasing function of the duration of the apnea and a decreasing function of the treatment pressure immediately before the apnea.” App. Br. 11

In this case, the Examiner has not adequately addressed whether the device is capable of performing the functions required by claim 51, none of which appear to be disclosed in Estes. As such, we cannot sustain the rejection of claim 51. Nothing in the Examiner’s arguments against dependent claims 52-55 and 60-62, cures the underlying deficiency in the rejection of claim 51. As such, we cannot sustain the rejection of claims 52-55 and 60-62.

*Obviousness over Berthon-Jones*

Addressing claim 46, the Examiner reasons that

Berthon- Jones discloses the claimed method steps but does not specifically state the apnea s where the treatment pressure immediately prior the apnea is more than approximately 10 cm H<sub>2</sub>O, but otherwise, the lower the treatment pressure immediately prior to the apnea, and the longer the apnea, the greater the increase in treatment pressure, up to a maximum of approximately 8 cm H<sub>2</sub>O per minute of apnea. It would have been obvious to one of ordinary skill in the art based upon the tables disclosed (Col. 16, lines 33-40).”

Ans. 6-7. The Appellants respond that

While the prior art recognized that the response to an apnea was to increase CPAP pressure, it did not relate that to the pre-apnea pressure (as a way to treat differently central apneas and obstructive apneas). What are crucial to the present invention are the claimed elements that determine the factors that are used to determine the amount of pressure increase or decrease.

App. Br. 15. We agree with Appellants. It is not apparent to us how the tables of Berthon-Jones, col. 16, ll. 33-65, disclose a method with “no increase in pressure is made for apneas of less than approximately 10 seconds duration” or treatments that “lower the treatment pressure immediately prior to the apnea, and the longer the apnea, the greater the increase in treatment pressure” as required by claim 46. The Examiner offers no cogent explanation. As such, we cannot sustain the rejection of claim 46 or of claims 47-50, 56-59 and 63, which depend therefrom.

#### DECISION

The Examiner’s decision rejecting claims 46-63 is reversed.

REVERSED

Appeal 2010-011382  
Application 11/237,278

JRG