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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte EDWARD M. GILLIS, CRAIG ARTHUR PURDY,
JOE PARASCHAC, SCOTT ANTHONY MCGILL, RYAN P. BOUCHER,
and LIONEL M. NELSON

Appeal 2011-007483
Application 11/645,918
Technology Center 3700

Before: JOHN C. KERINS, WILLIAM V. SAINDON, and
NEIL T. POWELL, *Administrative Patent Judges*.

SAINDON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1-6, 8, and 9. We have jurisdiction under 35 U.S.C. § 6(b).

The Claimed Subject Matter

Claim 1, reproduced below, is illustrative of the claimed subject matter.

1. An implant system comprising
 - a first magnetic component sized and configured to be implanted in the back of the tongue,
 - a second magnetic component sized and configured to be implanted across an airway from the first magnetic component in a posterior or posterior-lateral pharyngeal wall,
 - the airway having a midline, a first section and a second section, each of the first and second magnetic components having a first portion disposed on a first side of the midline and a second portion disposed on a second side of the midline opposite the first portion,
 - the second portions of the first and second magnetic components magnetically repelling each other to open the first section of the airway on the second side of the midline, and
 - the first portions of the first and second magnetic components magnetically attracting each other to narrow or close the second section of the airway on the first side of the midline, thereby stabilizing the magnetic repulsion force between the second portions of the first and second magnetic components and the open first section of the airway.

References

The Examiner relies upon the following prior art references:

Freedman	US 5,176,618	Jan. 5, 1993
Shaoulian	US 2006/0241746 A1	Oct. 26, 2006

Rejections

- I. Claim 1 is rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. Ans. 5.
- II. Claim 8 is rejected under 35 U.S.C. § 101 for not meeting the utility requirement. Ans. 3.
- III. Claim 8 is rejected under 35 U.S.C. § 112, fourth paragraph, for being an improper dependent claim. Ans. 4.
- IV. Claims 1-6 and 9 are rejected under 35 U.S.C. § 102(e) as anticipated by Shaoulian. Ans. 6.
- V. Claim 8 is rejected under 35 U.S.C. § 103(a) as unpatentable over Shaoulian and Freedman. Ans. 8.

SUMMARY OF DECISION

We REVERSE.

OPINION

Rejection III presents a unique issue that we wish to highlight. Thus, we address Rejection III first and then continue with the remaining rejections.

Rejection III – 35 U.S.C. § 112, fourth paragraph

Claims 1-4 are independent claims that recite similar implant systems. Claim 8 recites, “[a] method of treating an airway using an implant system as defined in claim 1, 2, 3, or 4.” The Examiner rejected claim 8 under the fourth paragraph of section 112 for “failing to include all the limitations of the claims upon which it depends and for failing to further limit the subject matter of the claims upon which it depends.” Ans. 4.

We cannot sustain the Examiner's 35 U.S.C. § 112, fourth paragraph, rejection of claim 8 for being an improper dependent claim because claim 8 is written as an independent claim. Claim 8 recites a statutory class ("A method"), a preamble ("... treating an airway"), and at least one step ("using ..."). Claim 8 refers to claims 1-4 as shorthand for the structure *to use in* the method, not *to further define* the structure claims. Such are clues that a claim is independent.

Accordingly, claims that refer to other claims are not necessarily dependent claims.¹ 35 U.S.C. § 112, fourth paragraph, states two requirements of dependent claims:

- (1) it "shall contain a reference to a claim previously set forth" and
- (2) it shall "then specify a further limitation."

Such claims "shall be construed to incorporate by reference all the limitations of the claim to which it refers." *Id.* Notably, the statute does not say that a dependent claim is one that contains a reference to another claim, merely that a dependent claim shall have a reference to another claim.² It is common Office practice to consider such claims dependent *for fee purposes*, but the *Manual of Patent Examining Procedure* (MPEP) acknowledges that not all claims referencing another claim are dependent:

¹ Two law review articles address this issue in depth: Jason M. Nolan, *Formalism and Patent Claim Drafting: The Status of De Facto Independent Claims Under the Fourth Paragraph of 35 U.S.C. § 112*, 19 *Tex. Intell. Prop. L.J.*, 263-06 (2011); and Tony A. Gayoso and Irving N. Felt, *Can a Patent Claim that Refers to Another Claim be Independent?*, 89 *JPTOS* 9 (2007).

² This point was made in *Ex parte Moelands*, 3 USPQ2d 1474, 1476 (BPAI 1987) (Spencer, Examiner-in-Chief, dissenting).

Appeal 2011-007483
Application 11/645,918

The initial determination, for fee purposes, as to whether a claim is dependent must be made by persons other than examiners; it is necessary, at that time, to accept as dependent virtually every claim which refers to another claim, without *determining whether there is actually a true dependent relationship*.

MPEP § 608.01(n)(II) (emphasis added).

The MPEP also instructs Examiners:

A claim which makes reference to a preceding claim to define a limitation is an acceptable claim construction which should not necessarily be rejected as improper or confusing under 35 U.S.C. 112, second paragraph.

MPEP § 2173.05(f) (citing *Ex parte Porter*, 25 USPQ2d 1144 (BPAI 1992)).

It would make little sense to include this section of the MPEP if every claim referencing another claim was deemed to be a dependent claim. Perhaps most tellingly, the MPEP acknowledges, “there is no set statutory form for claims.” MPEP § 608.01(m).

In *Porter*, the case cited in MPEP § 2173.05(f), the Board considered claims like the present claim 8 “an acceptable format for years” and hinted that such a claim “could be construed as an independent claim, drafted in a short-hand format.” *Porter* at 1147 (citing *In re Kuehl*, 475 F.2d 658 (CCPA 1973)).

We are aware of one analogous Federal Circuit case, *Pfizer, Inc. v. Ranbaxy Labs., Ltd.*, 457 F.3d 1284 (Fed. Cir. 2006). In *Pfizer*, the following claims were relevant:

1. [R-(R*,R*)]-2-(4-fluorophenyl)- β , δ -dihydroxy-5-(1-methyle thyl)-3-phenyl-4-(phenylamino)-carbonyl]-1H-pyrrole-1-heptanoic

acid or (2R-trans)-5-(4-fluorophenyl)-2-(1-methylethyl)-N,4-diphenyl-1-[2-(tetrahydro-4-hydroxy-6-oxo-2H-pyran-2-yl)ethyl]-1H-pyrrole-3-carboxamide; or pharmaceutically acceptable salts thereof.

2. A compound of claim 1 which is [R-(R*R*)]-2-(4-fluorophenyl)-β-δ-dihydroxy-5-(1-methylethyl)-3-phenyl-4-[(phenylamino)carbonyl]-1H-pyrrole-1-heptanoic acid.

6. The hemicalcium salt of the compound of claim 2.

Claim 6 in *Pfizer* ostensibly raises the issue currently before us.

Claim 1 recites an acid and a salt thereof. Claim 2 depends from claim 1 and recites the acid. Claim 6 recites the salt of the acid of claim 2. In *Pfizer*, the Federal Circuit held that claim 6 failed to further limit claim 2 and that it was invalid under 35 U.S.C. § 112, fourth paragraph. *Id.* at 1292. Their reasoning was that claim 2 narrowed claim 1 and no longer included the salt, such that claim 6 could not then reference a salt. *Id.* at 1291. The court acknowledged claim 6 “could have been properly drafted either as dependent from claim 1 or as an independent claim – i.e., ‘the hemicalcium salt of atorvastatin acid,’” (*id.* at 1292) but declined to “rewrite claims to preserve validity” (*id.*, citing *Nazomi Commc’ns, Inc. v. Arm Holdings, PLC*, 403 F.3d 1364, 1368 (Fed. Cir. 2005)).

Notably, in *Pfizer*, the Federal Circuit took as a given that claim 6 was dependent.³ Indeed, the issue in *Pfizer* was not whether a particular claim was dependent, but whether section 112, fourth paragraph, was an

³ Both parties appear to have asserted that claim 6 was dependent. *See Pfizer, Inc. v. Ranbaxy Labs, Ltd.*, 405 F.Supp.2d 495, 507 (D.Del. 2005).

Appeal 2011-007483
Application 11/645,918

invalidating provision. *Pfizer* at 1291-92 (“at the time the district court wrote its opinion, there was no applicable Federal Circuit precedent [on whether a violation of section 112, fourth paragraph, renders a patent invalid]”). Accordingly, the holding in *Pfizer* does not preclude us from interpreting claim 8 of the present application as independent.

Consequently, we interpret claim 8 as an independent claim, and as such, cannot sustain the Examiner’s section 112, fourth paragraph, rejection for being an improper dependent claim.

Rejection I – 35 U.S.C. § 101, non-statutory subject matter

Claim 1 recites two magnetic components “to be implanted across an airway” and further describes certain characteristics of that airway. The Examiner rejected claim 1 for “claim[ing] the body” and thus for being directed to non-statutory subject matter. Ans. 5. However, as Appellants point out (App. Br. 11-12), the claim specifies magnetic components are “*to be* implanted across an airway” (emphasis added). Thus, the sections of the airway are recited to indicate the future location of the magnetic components and not to claim the body. Accordingly, the Examiner’s basis for rejecting claim 1 under section 101 is in error and we do not sustain Rejection I.

Rejection II – 35 U.S.C. § 101, lack of utility

The Examiner rejected claim 8 for lack of utility because it “doesn’t provide any positive method steps and it is unclear as to what the claim intends.” Ans. 3. Lack of clarity in claim scope, however, is addressed under section 112, second paragraph. As to the lack of method steps, we agree with Appellants that the Examiner has failed to meet the burden of showing “why the claimed invention has no specific and substantial credible

Appeal 2011-007483
Application 11/645,918

utility.” Reply Br. 2 (citing MPEP § 2107). Depending on the context, single steps such as “using” may be considered proper method steps, and if not, rejection under section 112, second paragraph is appropriate. *See* MPEP § 2173.05(f). In either case, the Examiner has failed to set forth sufficient reasoning in support of why the claimed invention has no specific and substantial credible utility, and as such, we do not sustain Rejection II.

Rejection IV – 35 U.S.C. § 102(e), anticipation

The Examiner found that Shaoulian describes the claimed magnetic components implanted in a tissue body. Ans. 6. Shaoulian is directed to magnets primarily used in heart tissue, as opposed to the airway as claimed. *See, e.g.*, Shaoulian, Abstr. The Examiner found that the majority of the claim language was intended use (*id.*) or functional language not given patentable weight (Ans. 7). *See also* Ans. 9-11.

Appellants argue that the Examiner’s interpretation of the claim language (i.e., giving no patentable weight to certain limitations) is erroneous. App. Br. 13. Appellants allege that the claimed invention requires a different structure than the heart valve reshaping implants of Shaoulian. App. Br. 14.

We do not reach the issue of whether the implanted magnetic components of Shaoulian satisfy the limitations of the claims. It is well established that claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *See, e.g., In re Schreiber*, 128 F.3d 1473, 1477-78 (Fed. Cir. 1997). However, functional language must be considered for what it conveys to one of ordinary skill in the art. In order to satisfy the functional limitations in an apparatus claim, the prior art apparatus *must be capable of performing the claimed function*.

Appeal 2011-007483
Application 11/645,918

Id. at 1478. Thus, functional and intended use language must be evaluated to the extent it conveys structural requirements. *See, e.g., K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1363 (Fed. Cir. 1999) (“The functional language is, of course, an additional limitation in the claim”). The Examiner’s evaluation of claim language is typically apparent in view of the art recited and the rejection made in view of it; the Examiner need not perform a claim construction. *In re Jung*, 637 F.3d 1356, 1362-63 (Fed. Cir. 2011).

In the present appeal, the Examiner incorrectly states that intended use language “does not differentiate” and that functional recitations “must be expressed as a ‘means’ for performing the specified function ... to warrant the presence of the functional language.” Ans. 6-7. The error in the Examiner’s rejection is that there is no basis, express or implied, to find by a preponderance of the evidence that the magnetic structures in Shaoulian are capable of performing the intended uses and functions claimed. The Examiner’s finding that “magnetic components sized and configured to be implanted in an airway ... is no different than [those] ... in the tissue of a coronary sinus” is speculative and not based on factual findings or technical analysis. *See* Ans. 10. The Examiner does make a finding that Shaoulian’s magnets can be located in other tissue that requires reshaping or reforming, but the Examiner does not explain how this finding applies to the anticipation of a structure having the specific uses and functions claimed. *See* Ans. 11 (citing Shaoulian, para. [0056]); *but see* Shaoulian, para. [0051] (explaining how magnet strength and orientation are variables *modifiable* to affect the deformation of the tissue). Accordingly, we cannot sustain Rejection II.

Appeal 2011-007483
Application 11/645,918

Rejection V – 35 U.S.C. § 103(a), obviousness

The Examiner found that “Shaoulian fails to explicitly disclose utilization of implant system to treat an airway,” as required by claim 8. The Examiner found that Freedman discloses an apparatus and method that “utilize[s] either the attracting forces of dissimilar pole magnets, or the repelling forces of similar pole magnets.” Ans. 8 (citing Freedman, col. 4, ll. 55-60).

Appellants argue that the Examiner’s rejection fails to address the claim requirements of both attracting and repelling forces. App. Br. 17.

Each of claims 1-4, referenced by claim 8, includes limitations requiring both attraction and repulsion. The Examiner’s rejection fails to address these limitations and instead focuses on Freedman’s disclosure of *either* attracting or repelling. As such, we do not sustain Rejection V.

DECISION

We REVERSE the Examiner’s decision regarding claims 1-6, 8, and 9.

REVERSED

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