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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte IGOR IGOREVICH STUKANOV

Appeal 2012-001722
Application 11/650,556
Technology Center 3700

Before DONALD E. ADAMS, ERIC GRIMES, and
MELANIE L. McCOLLUM, *Administrative Patent Judges*.

McCOLLUM, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a healing substance delivery method. The Examiner has rejected the claims as lacking written descriptive support. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Claims 1-8 are on appeal (App. Br. 2). The claims have not been argued separately and therefore stand or fall together. 37 C.F.R. § 41.37(c)(1)(vii). Claim 1 is representative and reads as follows:

1. A method for delivery of a healing substance to a target place in gastrointestinal tract or blood system, comprising the following steps:
 - a) a healing substance, excluding a drug, or a source of a healing substance, excluding laser, is placed into a mobile wireless controlled capsule with sensors;
 - b) the capsule enters into the gastrointestinal tract via mouth of a patient with food or water and moves toward the targeted place;
 - c) the capsule is directed to the targeted place via control signals sent from a control unit wirelessly;
 - d) the capsule sends signals from the sensors to a monitor connected to the control unit;
 - e) when the capsule reaches the targeted place, the control unit sends signal to release the healing substance and this healing substance is released from the capsule and directed to the targeted place via signals from the control unit.

Claims 1-8 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement (Ans. 4).¹ The Examiner finds:

The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the

¹ The claims are also objected to (Final Rej. 3). Appellant argues that the claim objections are improper (App. Br. 6). However, as noted by the Examiner (Ans. 4), this Board has jurisdiction to determine the validity of a decision of the Examiner *rejecting* a claim. *In re Hengehold*, 440 F.2d 1395, 1403 (CCPA 1971) (“There are a host of various kinds of decisions an examiner makes in the examination proceeding—mostly matters of a discretionary, procedural or nonsubstantive nature—which have not been and are not now appealable to the board . . . when they are not directly connected with the merits of issues involving rejections of claims, but traditionally have been settled by petition to the Commissioner.”). Thus, we have not considered the Examiner’s objection to the claims, or Appellant’s arguments thereto, which are petitionable rather than appealable issues. *See* Manual of Patent Examining Practice § 1201 and § 1002.02(c).

application was filed, had possession of the claimed invention. Specifically, independent claim 1 was amended to include the negative claim limitations “excluding laser” and “excluding a drug,” which are not supported by the original disclosure.

(*Id.* at 4-5.)

PRINCIPLES OF LAW

A negative limitation that does not appear in the Specification as filed may “introduce new concepts and violate the description requirement of the first paragraph of 35 U.S.C. 112.” *Ex parte Grasselli*, 231 USPQ 393, 394 (BPAI 1983), *aff’d mem.* 738 F.2d 453 (Fed. Cir. 1984). However,

[t]he notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species therewithin, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of those species, and has thus failed to satisfy the requirements of §112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute.

Application of Johnson, 558 F.2d 1008, 1019 (CCPA 1977).

ANALYSIS

With regard to the exclusion of “a drug,” the Specification states that this “invention relates to oral controlled high precision drug and healing substances/agents delivery methods in humans and animals” (Spec. 1). The Specification also states that the “purpose of the current invention is to suggest a . . . method for oral delivery of new drugs, big molecules, proteins, and other healing substances to the targeted place in the body” (*id.* at 2). Thus, we conclude that the Specification sufficiently describes drugs, so as to support their exclusion. *See Application of Johnson, supra.*

However, with regard to the exclusion of a laser, the Examiner finds that “[t]here is no evidence to indicate that at the time of filing, the Appellant considered the inventive concept to include the set of all sources of electromagnetic waves *except* lasers” (Ans. 5). Appellant has not adequately explained why this finding is in error. Specifically, Appellant has not pointed to a description in the Specification of lasers as an example of “a source of a healing substance,” as recited in claim 1, which would provide a basis for excluding lasers from such sources. As the Examiner pointed out, “[t]he term laser does not appear at all in the original disclosure” (*id.*).

Appellant argues that “[t]he phrase ‘excluding laser’ is a limitation of the originally filled [sic] claims” (App. Br. 4). Originally filed claims 1-8, however, do not include any limitations requiring or excluding a laser.

Appellant also argues that “because it is a limitation it CAN NOT (by definition) add new elements or functionalities to the invention, therefore it CAN NOT introduce a new matter” (*id.*). Adding a limitation to a claim that is not supported by the original Specification, however, is a proper basis for rejecting the new or amended claim for lack of adequate written description. *See Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1348 (Fed. Cir. 2010) (“[P]rohibiting adding new matter to the claims has properly been held enforceable under § 112, first paragraph.”).

Finally, Appellant argues that the “phrase ‘excluding laser’ is quite clear and does not present uncertainty or ambiguity with respect to the question of scope or clarity of the claims” (App. Br. 5). The rejection on appeal, however, is based on the written description requirement of the first

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paragraph of 35 U.S.C. § 112, while Appellant's argument addresses the definiteness requirement of the second paragraph of that section.

We therefore affirm the rejection of claims 1-8 under 35 U.S.C. § 112, first paragraph.

TIME PERIOD FOR RESPONSE

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

AFFIRMED

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