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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RODERICK A. HYDE,
MURIEL Y. ISHIKAWA, ERIC C. LEUTHARDT,
ROYCE A. LEVIEN, ROBERT W. LORD,
MARK A. MALAMUD, ELIZABETH A. SWEENEY,
LOWELL L. WOOD, JR., and VICTORIA Y.H. WOOD

Appeal 2012-009430
Application 12/286,751¹
Technology Center 3600

Before LEE E. BARRETT, JOHNNY A. KUMAR, and
CATHERINE SHIANG, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1, 36–39, 41–43, 46–49, 52, 55, and 59–78. Claims 2–35, 40, 44, 45, 50, 51, 53, 54, and 56–58 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Title: “Methods and Systems for Monitoring and Modifying a Combination Treatment.”

THE INVENTION

The invention relates to a method and system for monitoring at least one health attribute of an individual during an artificial sensory experience, associating a characteristic of the artificial sensory experience with the at least one health attribute of the individual, and modifying at least one of a bioactive agent or the artificial sensory experience at least partly based on associating a characteristic of the artificial sensory experience with the at least one health attribute of the individual. Spec. 65:22–69:5; Fig. 36.

Claim 1 is reproduced below.

1. A computer-implemented method, comprising:
 - monitoring at least one health attribute of an individual during an artificial sensory experience;
 - associating, using a microprocessor, a characteristic of the artificial sensory experience with the at least one health attribute of the individual; and
 - modifying at least one of a bioactive agent or the artificial sensory experience at least partly based on associating a characteristic of the artificial sensory experience with the at least one health attribute of the individual.

THE PRIOR ART

deCharms	US 2002/0103428 A1	Aug. 1, 2002
Shachar	US 2004/0078027 A1	Apr. 22, 2004
Trinks	US 6,952,695 B1	Oct. 4, 2005
Khaderi	US 7,513,622 B2	Apr. 7, 2009 (filed Oct. 4, 2007)

THE REJECTIONS²

1. Claims 36, 38, 39, 41–43, 47–49, 52, 55, and 59–71 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.
2. Claims 1, 36–39, 41–43, 46–49, 52, 55, 59, 64, 65, 71, 76, and 77 stand rejected under 35 U.S.C. § 102(b) as anticipated by deCharms.
3. Claims 60, 70, and 72–75 stand rejected under 35 U.S.C. § 103(a) as unpatentable over deCharms.
4. Claims 61–63 and 66 are rejected under 35 U.S.C. 1 03(a) as unpatentable over deCharms and Khaderi.
5. Claims 67–69 stand rejected under 35 U.S.C. § 103(a) as unpatentable over deCharms and Shachar.
6. Claim 78 stands rejected under 35 U.S.C. § 103(a) as unpatentable over deCharms and Trinks.

ANALYSIS

Non-statutory subject matter

The Examiner observes that the independent claim 36 and its dependent claims are directed to a system comprising a series of “means for” limitations and independent claim 71 uses “circuitry for” limitations. Final Act. 3; Ans. 5. The Examiner concludes that the claims are broad enough to cover “software” per se, which is not within one of the § 101 categories of patent-eligible subject matter. Final Act. 3; Ans. 5.

Appellants argue that computer programs that execute on processors are statutory subject matter because they create a new computer, citing

² The rejection of claims 36, 38, 39, 41–43, 47–49, 52, 55, 59–70, and 78 under 35 U.S.C. § 112 ¶ 2 is withdrawn. Ans. 4.

In re Alappat, 33 F.3d 1526 (Fed. Cir. 1994) (en banc). App. Br. 18.

Appellants also argue that “[s]ufficient examples of structure are included in the specification showing that each of the ‘means for’ or ‘circuitry’ claims also encompass the corresponding structure.” *Id.* at. 19.

The most recent Office guidance on § 101 is found in “2014 Interim Guidance on Patent Subject Matter Eligibility,” 79 Fed. Reg. 74618 (Dec. 16, 2014), which supplements the “Preliminary Examination Instructions in view of the Supreme Court Decision in *Alice Corporation Pty. Ltd. v. CLS Bank International, et al.*,” Memorandum to the Examining Corps, June 25, 2014. The first step is to determine if the claim falls within one of the four statutory categories of § 101 of process, machine, manufacture, or composition of matter; if not, the claim is not patent-eligible subject matter. For example, a “transitory, propagating signal” is not patent-eligible subject matter because does not fall within any of the four categories. *See In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007). The second step is to determine if the claim contains a judicial exception and, if so, whether the claim recites a patent-eligible application of the exception.

“Software” per se does not fit within one of the four statutory categories of § 101: It is not a machine, a manufacture, or composition of matter because it has no physical structure, and is not a process because it is not a series of steps. Sometimes “software” per se is evident from the claim language, such as a “program” having “instructions” for performing functions, where a “program” and “instructions” are not physical “things” or “acts” and do not fall within any of the statutory categories. However, the most common situation is when claims recite language like “units,” “modules,” “agents,” “components,” or other words that do not require, or

are unclear as to whether they require, structure, and which, as disclosed, could be implemented by software, hardware, firmware, or a combination of these. In this case, the claims are broad enough to read on software per se that is not within any statutory category and on hardware (that may contain software) that is within one or more categories. Claims that are broad enough to read on statutory and non-statutory subject matter are non-statutory. *Cf. Muniauction, Inc. v. Thomson Corp.*, 532 F.3d 1318, 1328 n.4 (Fed. Cir. 2008) (under a “long-established rule,” “[c]laims which are broad enough to read on obvious subject matter are unpatentable even though they also read on nonobvious subject matter.’ *In re Lintner*, 458 F.2d 1013, 1015 (CCPA 1972) (citing *In re Mraz*, 455 F.2d 1069, 1073 (CCPA 1972)).”). During prosecution, the claims can be amended to clearly fall within a statutory category.

According to *In re Donaldson*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (en banc), the USPTO must construe claims drafted in “means-plus-function” language “to cover the corresponding structure, material, or acts described in the specification and equivalents thereof” under 35 U.S.C. § 112 ¶ 6. Although Appellants have not quite made the right argument in this case, we conclude that the “means-plus-function” language requires the claims to be construed to cover the structure disclosed in the Specification and equivalents thereof. This is not a case where the “means” is not supported by structure. We also interpret “circuitry” in claim 71 to be limited to structure. Accordingly, the claims, as construed, are not broad enough to read on software per se and the claimed subject matter falls within § 101 as a “machine” and/or “manufacture.” Of course, just because a claim nominally falls within one of the four statutory categories does not guarantee

that it is patent eligible under § 101. *See Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S.Ct. 2347, 2360 (2014) (claims to a computer system and a computer-readable medium in patents for mitigating settlement risk in financial transactions through use of a computer system as a third-party intermediary were patent-ineligible); *Content Extraction v. Wells Fargo Bank*, 776 F.3d 1343, 1348 (Fed. Cir. 2014) (use of a generic scanner and computer to recognize and store data in a memory were not sufficient to transform the claims into a patent-eligible application of an abstract idea). However, this is not the basis for the rejection.³ The § 101 rejection of claims 36, 38, 39, 41–43, 47–49, 52, 55, and 59–71 is reversed.

Anticipation

Independent claim 1

The rejection of claim 1 is stated in the Final Office Action and the Examiner's Answer. Final Act. 5–6; Ans. 5, 16.

Appellants do not argue the merits of the rejection. For example, Appellants do not argue why “monitoring at least one health attribute of an individual during an artificial sensory experience” in claim 1 does not read on measuring the resultant activity level in the region of interest in the brain when the subject observes a particular stimulus in deCharms ¶ 203, or why the limitation “associating, using a microprocessor, a characteristic of the artificial sensory experience with the at least one health attribute of the individual” in claim 1 does not read on “diagnosing a condition of a subject associated with a particular activation in one or more regions of interest [in

³ Should there be further prosecution of this application, the Examiner may wish to consider whether the claims pass muster under 35 U.S.C. § 101 in light of the most recent Office and Federal Circuit guidance on § 101.

the brain]” in deCharms ¶ 65 as stated in the rejection. Instead of substantively responding to the merits of the rejection, Appellants argue that the rejection of independent claim 1 should be reversed because the Examiner has failed to establish a *prima facie* case of unpatentability based on a number of alleged defects.

Many of Appellants’ arguments are identical or similar to arguments made in *In re Jung*, 637 F.3d 1356 (Fed. Cir. 2011). This is not surprising because both the application in *Jung* and the present application are owned by the same entity. Appellants argue that until the Examiner has met the burden of establishing a *prima facie* case, Appellants need not substantively respond to the merits of the rejection. For example, it is argued:

Should this case go to appeal, Appellant reserves the right to submit argument, rebuttal evidence, or legal authority in the instance the Board of Patent Appeals and Interferences finds that the PTO has met its burden in establishing a *prima facie* case of unpatentability of the various appealed claims. . . . The fact that argument, rebuttal evidence, or legal authority may not have been explicitly discussed during the course of prosecution should NOT be taken as an admission or waiver of any sort, and Appellant hereby reserves any and all rights to discuss (e.g. make explicit, produce, or explain) such rebuttal evidence at a later time.

App. Br. 83. The Federal Circuit rejected the argument that applicants have the right first to procedurally challenge and appeal the *prima facie* procedural showing before having to substantively respond to the merits of the rejection: “Such a process is both manifestly inefficient and entirely unnecessary. Indeed, *Jung*’s arguments as to why the examiner failed to make out a *prima facie* rejection are the same arguments that would be made on the merits.” *Jung*, 637 F.3d at 1363. Contrary to Appellants’ disclaimer,

arguments that Appellants could have made but chose not to make are considered waived. *See* 37 C.F.R. § 41.67(c)(1)(vii) (2011).

Jung was decided on March 28, 2011, well before Appellants' Appeal Brief was filed January 30, 2012, so it is unknown why Appellants persist in making the arguments. Appellants' Supplemental Reply Brief filed May 30, 2012, requests that the Board read the Appeal Brief vocabulary as consistent with the "newly-announced notice theory of the prima facie case announced in **In re Jung**" (Supp. Reply Br. 4), which misleadingly implies that *Jung* is "new" and represents a change in the law. *Jung* was controlling case law when the Appeal Brief was filed.

Appellants try to justify their failure to address the merits of the Examiner's rejection by saying it would conflict with unspecified post-issuance legal standards and various ethical duties:

Irrespective of a desire to be cooperative, the ability of any patent practitioner to help the Examiner fulfill this burden on the record is tightly curtailed by pre- and post-issuance legal standards and by various ethical duties in tension. *See, e.g.*, 37 C.F.R. § 10.83 ("A practitioner should represent a client zealously within the bounds of the law."); 37 C.F.R. § 10.84 ("[A] practitioner shall not intentionally . . . [p]rejudice or damage a client during the course of a professional relationship, except as required under this [ethics] part."); and 37 C.F.R. § 10.76 ("A practitioner should represent a client competently."). For these and other reasons, this document notes instances in which the USPTO did not follow the prescribed rules rather than seeking to interpret claims and/or to adduce evidence on the USPTO's behalf.

App. Br. 48 n.12. "Arguments by attorneys that stray far afield from the claim language or language of the cited document risk estoppel, loss of equivalents, or worse." Supp. Reply Br. 5. This logic is unpersuasive. It is

not known how Appellants can hope to persuade the Board of error without actually making substantive arguments as to the merits of the rejection.

Appellants argue that merely reciting the claim limitations with the locations in the references in parentheses is insufficient to meet the burden of establishing a prima facie case of unpatentability because it “amounts to a ‘stab in the dark’ rather than requisite claim interpretation and reasoned application of the material(s) to the claims” and because “it is impossible to know whether the examiner is alleging an interpretation of the claim that reaches the cited art, or is alleging some ‘teaching’ of the cited art that reaches the claim language.” App. Br. 45, § VII.B.

The Federal Circuit stated in *Jung* that “the PTO carries its procedural burden of establishing a prima facie case when its rejection satisfies [the notice requirement of] 35 U.S.C. § 132.” *Jung*, 637 F.3d at 1362. The Federal Circuit found that, in the rejection of *Jung*, citation of “the specific column and line cites to the prior art reference would have put any reasonable applicant on notice of the examiner's rejection.” *Id.* The Federal Circuit concluded:

[A]ll that is required of the office to meet its prima facie burden of production is to set forth the statutory basis of the rejection and the reference or references relied upon in a sufficiently articulate and informative manner as to meet the notice requirement of § 132. . . . Here, the examiner's discussion of the theory of invalidity (anticipation), the prior art basis for the rejection (Kalnitsky), and *the identification of where each limitation of the rejected claims is shown in the prior art reference by specific column and line number was more than sufficient to meet this burden.*

Jung, 637 F.3d at 1363. (Emphasis added.) Thus, Appellants' argument that citation of locations in the reference is insufficient to establish a prima facie case is unpersuasive.

The Examiner's rejection in this case clearly satisfies the notice requirement of 35 U.S.C. § 132 to establish a prima facie case of anticipation. The rejection identifies: the theory of unpatentability (anticipation); the prior art basis for the rejection (deCharms); where the limitations of "monitoring," "associating, using a microprocessor," and "modifying" in claim 1 are found in deCharms by specific column and line number. Final Act. 5–6; Ans. 5. The burden of going forward with the evidence shifted to Appellants to rebut the Examiner's prima facie case by distinctly and specifically pointing out the errors in the Examiner's action. *See Jung*, 637 F.3d. at 1365 ("[I]t has long been the Board's practice to require an applicant to identify the alleged error in the examiner's rejections," citing *Ex Parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) ("The panel then reviews the obviousness rejection for error based upon the issues identified by appellant, and in light of the arguments and evidence produced thereon.")). The Board will not make Appellants' arguments for them: This would not only be unfair to an examiner, who has no opportunity to comment, but also entails the risk of an improvident or ill-advised opinion on the legal issues tendered.

Appellants argue that the Examiner failed to make a prima facie case by not making an on-the-record showing of a broadest reasonable claim construction. For example, it is argued: the USPTO failed to make the "requisite claim interpretation" (App. Br. 45); "the USPTO has disregarded its duty to provide the broadest reasonable interpretation consistent with the

specification of Independent Claim 1” (*id.* at 46); “The USPTO Has Not Met Its Duty to Provide a Broadest Reasonable Interpretation of Independent Claim 1 Consistent with the Specification” (*id.*) (emphasis omitted); and “the USPTO has not explained how it reaches such mappings under the framework of the broadest reasonable interpretation consistent with the specification as is the USPTO’s burden” (*id.* at 48, 58).

The Federal Circuit held in *Jung*:

There has never been a requirement for an examiner to make an on-the-record claim construction of every term in every rejected claim and to explain every possible difference between the prior art and the claimed invention in order to make out a prima facie rejection. This court declines to create such a burdensome and unnecessary requirement.

Jung, 637 F.3d at 1363. Thus, an on-the-record claim construction was not required where, as here, the Examiner relies on the plain and ordinary meaning of the words. Appellants do not say that terms in the claim require interpretation, but merely argue the lack of an on-the-record claim construction as a procedural defect in the prima facie case.

Appellants argue that deCharms does not recite the limitations of “monitoring,” “associating, using a microprocessor,” and “modifying” in claim 1. *See, e.g.*, App. Br. 45–51. It appears Appellants’ argument is that in the absence of an express on-the-record claim construction, deCharms does not “recite” the claim limitations because it does recite the identical language of claim 1. For example, Appellants quote the portions of deCharms that the rejection maps to the monitoring, associating, and modifying limitations and then assert that this mapping does not recite or address the limitations. *Id.* at 45–51. Appellants argue that “the USPTO-

identified portions of deCharms do not recite the text of at least Clauses [a], [b], or [c] of Independent Claim 1 [monitoring, associating, and modifying].” *Id.* at 52. It is argued that “Appellant has shown by direct quotations that Independent Claim 1 and the deCharms reference are very different on their faces.” *Id.* It is argued that “the express recitations of deCharms are not as the USPTO alleges.” *Id.* at 53. It is also argued that “[i]nsofar as this alleged disclosure [of the references] is not literally recited in such material, Appellant respectfully asserts that the Examiner must have relied on ‘personal knowledge’ or taken improper ‘official notice’ of one or more factors to reach each of these assertions.” *Id.* at 54 n.12. Appellants argue that “Applicant/Appellant has tried to show patentability by demonstrating mismatches between the claim language and the language of the cited document.” Supp. Reply Br. 5.

It is black letter law that the references do not need to use the exact same language of the claims. *See In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009) (“the reference need not satisfy an *ipsissimis verbis* test”); *Akzo N.V. v. U.S. Int’l Trade Comm’n*, 808 F.2d 1471, 1479 n.11 (Fed. Cir. 1986) (“An ‘*ipsissimis verbis*’ test requires the same terminology in the prior art in order to find anticipation.”); *Standard Havens Prods., Inc. v. Gencor Indus., Inc.*, 953 F.2d 1360, 1369 (Fed. Cir. 1991) (“[A] . . . reference . . . need not duplicate word for word what is in the claims.”). The USPTO does not need to provide an express on-the-record claim construction to explain the differences in language, at least until Appellants address the merits of why the claim limitations do not read on deCharms.

Appellants’ allegations “that the USPTO has apparently not examined the recitations of Appellant’s claims, and appears to have not addressed the

express language of both Appellant’s claims and the cited technical material” (App. Br. 47 n.10), that “several claim terms have not been addressed in its analysis” (*id.* at 48), that “the USPTO has not addressed the language of Appellant’s Independent Claim 1” (*id.* at 49 n.14), and that “[t]he USPTO is characterizing deCharms to ‘teach’ at least some of the text of Independent Claim 1, but does not support its characterization with objectively verifiable evidence” (*id.* at 51) are all evidently based on the fact that deCharms does not use the identical language of claim 1. Appellants’ argument that there is no prima facie case of unpatentability because “direct quotation of the appealed claims and the Patent Office-cited art reveals significant facial differences” (Reply Br. 4) is also based on the difference in language. These arguments are not persuasive. The references do not need to use identical language to establish a prima facie case.

Appellants argue that the Examiner has not provided any “objectively verifiable evidence” supporting the assertion that deCharms teaches some of the text of claim 1 and therefore has failed to establish a prima facie case of anticipation. App. Br. 45–51. It is argued that “the Appellant’s Application is the only objectively verifiable USPTO-cited document of record that shows or suggests what the USPTO purports the references to teach” and “it follows that the USPTO is interpreting deCharms through the lens of Appellant’s application, which is impermissible hindsight use.” *Id.* at 53. Appellants argue that as the Examiner has provided no objectively verifiable evidence, the Examiner must be relying on personal knowledge and/or official notice which requires an affidavit or declaration. *Id.* at 54.

Again, Appellants’ arguments are apparently based on the difference between the language of deCharms and claim 1. This argument is not

persuasive. The cited portions of deCharms are “objectively verifiable evidence” and the references do not need to use identical language.

Appellants argue that where there are differences between what a reference recites and what the asserting party alleges the reference teaches, objective evidentiary support must be provided to “close the gap.” App. Br. 51–52. It is argued that there is a gap between the monitoring, associating, and modifying limitations of claim 1 and teachings of deCharms because, for example, the Abstract of deCharms does not teach the limitations. *Id.* at 52.

In *Jung*, Jung argued that the prima facie case requirement is procedurally flawed unless the examiner provides “a record showing that there is evidence bridging the facial differences between that reasonable claim construction and the purported anticipatory reference.” *Jung*, 637 F.3d at 1362. The Federal Circuit noted that “Jung has failed to articulate what gaps . . . exist . . . that needed filling by examiner explanation.” *Id.* at 1363. The same is true here. Appellants fail to articulate what gaps exist between deCharms and the monitoring, associating, and modifying limitations of claim 1, other than the difference in language, which is not a legally supported argument.

Appellants filed both a Reply Brief and a Supplemental Reply Brief on May 30, 2012. An appellant is only entitled to one reply brief; however, because they were filed the same day they will be treated as one. The Reply Brief reiterates arguments in the main Brief that the evidence does not establish a prima face case of unpatentability. These arguments have all been addressed above. Appellants again do not address the merits of the rejection. In any case, arguments presented for the first time in the reply

brief and not in response to new reasoning in the Examiner's Answer would be untimely and not be considered. *Cf. Kaufman Company, Inc. v. Lantech, Inc.*, 807 F.2d 970, 973 n.* (Fed. Cir. 1986); *McBride v. Merrell Dow and Pharmaceuticals, Inc.*, 800 F.2d 1208, 1210–11 (D.C. Cir. 1986).

The Supplemental Reply Brief requests that the Board read the Appeal Brief vocabulary as consistent with the “newly-announced notice theory of the prima facie case announced in **In re Jung**” (Supp. Reply Br. 4) or, in the alternative, to allow Appellants to file a revised appeal Brief. As previously noted, it is misleading to imply that *Jung* is “new” and represents a change in the law. *Jung* was controlling case law when the appeal brief was filed and Appellants should not be given an opportunity to “redo” the appeal brief. Appellants argue that they have treated the Examiner's rejections as if they were notice theory rejections. *Id.* at 7. This is not convincing in light of the arguments in the Appeal Brief. It is also noted that the Supplemental Reply Brief is almost identical to Supplemental Reply Briefs filed in Applications 12/218,503, 12/150,122, 12/157,922, 12/287,886, and 12/287,686, and is not specific to the facts of this case.

Appellants have failed to carry their burden of showing error in the Examiner's rejection. The rejection of claim 1 is affirmed.

Claims 36–39, 41–43, 46–49, 52, 55, 59, 64, and 65

Appellants argue that claims 36–39, 41–43, 46–49, 52, 55, 59, 64, and 65 depend from independent claim 1 and are patentable for at least the same reasons claim 1 is patentable. App. Br. 54–55. We note that claim 36 is an independent claim and the other claims depend from claim 36 and are rejected as anticipated. Because the “means for” limitations of claim 36

correspond to the steps of claim 1 and Appellants have not made any arguments under 35 U.S.C. § 112 ¶ 6, the rejection of claim 36 and its dependent claims 37–39, 41–43, 46–49, 52, 55, 59, 64, and 65 is affirmed for the reasons stated with respect to claim 1.

Independent claim 71

Appellants argue that independent claim 71 contains similar recitation as claim 1 and is not obvious over deCharms for the same reasons. App. Br. 55. Claim 71 is rejected based on anticipation. In any case, because the rejection of claim 1 is affirmed, the rejection of claim 71 is affirmed.

Obviousness

Independent claim 72

Claim 72 recites a computer program product comprising a non-transitory computer-readable medium bearing one or more instructions for monitoring, associating, and modifying. The monitoring, associating, and modifying steps are the same as in claim 1. The Examiner found that deCharms did not specifically disclose a computer program product comprising a non-transitory computer-readable medium having instructions for monitoring, associating, and modifying, but concluded that it would have been obvious to store instructions for performing the steps on a non-transitory medium because deCharms discloses using computer executable software. Final Act. 12; Ans. 11–12.

Again, Appellants do not address the substantive merits of the rejection. Appellants' arguments regarding claim 72 at App. Br. 55–65 make the same non-substantive arguments as for claim 1 except substituting the limitations of claim 72. For example, it is argued that citation of

locations in the references in parenthesis does not establish a prima facie case, the USPTO has not met its duty to provide a broadest reasonable interpretation, deCharms does not use the exact language of claim 72, the USPTO has not provided any objective evidence, the USPTO must provide evidence to “close the gap,” etc. We refer to the discussion of claim 1 for a response to these arguments.

Because claim 72 is rejected based on obviousness, Appellants make arguments specific to obviousness. Appellants allege that the Examiner’s reason to modify/combine deCharms is based on a conclusory statement without evidentiary support. App. Br. 66–67. However, Appellants merely quote the rejection and assert that “the assertions set forth above are unsupported and erroneous, and appear to mischaracterize the deCharms reference” (*id.* at 67), without attempting to address the actual reasons in the rejection; i.e., Appellants’ argument itself is conclusory. Again, Appellants are simply running through a checklist of possible defects in an obviousness rejection by making generic and non-specific assertions without addressing the merits. Such mode of argument is not persuasive.

Appellants allege that any modification of deCharms would change the principle of operation and require substantial reconstruction or redesign as well as change the basic principle under which deCharms was designed to operate. App. Br. 67–70. Appellants also allege that any modification of deCharms would render it unsatisfactory for its intended purpose. *Id.* at 70–73.

Appellants’ arguments simply fail to address the actual modification of the rejection and are not persuasive.

For the foregoing reasons, the rejection of claim 72 is affirmed.

Independent claim 76

Appellants argue that independent claim 76 contains similar recitation as independent claim 72 and is not obvious over deCharms for at least the same reasons. App. Br. 73. Because the rejection of claim 72 is affirmed, the rejection of claim 76 is affirmed.

Dependent claims 60–63, 66– 70, 73–75, 77, and 78

Appellants argue that dependent claims 60–63, 66– 70, 73–75, 77, and 78 are patentable by virtue of depending from independent claims 36, 72, or 76. App. Br. 73–74. Because the rejections of claim 36, 72, and 76 are affirmed, the rejections of claims 60–63, 66– 70, 73–75, 77, and 78 are affirmed

Dependent claim 42

Appellants argue that dependent claim 42 is independently patentable. It is argued that deCharms does not recite “means for monitoring,” “means for associating, using a microprocessor,”⁴ or “means for modifying,” as recited in parent claim 36, “[n]or does deCharms recite ‘means for observing at least one indication of an expected behavior pattern proximate **in** time to a characteristic of the artificial sensory experience,’ as recited in Dependent Claim 42.” App. Br. 75. (Bolding omitted.) Appellants argue that the portion of deCharms cited by the Examiner “takes place in the context of *a pre-processing filter,* not *means for observing an expected behavior pattern proximate in time to a characteristic of the artificial sensory

⁴ Parent claim 36 does not recite “using a microprocessor.”

experience.* Consequently, *on its face*, deCharms *does not show the text of* Dependent Claim 42.” *Id.* at 76. (Emphasis added.) It is argued:

Appellant has shown that on its face the evidence cited by PTO does not establish a *prima facie* case of unpatentability with respect to Claim 42 or even to its parent claim. Appellant has shown by direct quotations that Appellant's Claims 36 and 42 and the PTO-cited deCharms reference are very different on their faces. . . . Insofar as Appellant has shown that . . . the PTO-cited art is very different from Dependent Claim 42 and its parent claim, and Appellant has noted that PTO has not cited to any objectively verifiable evidence/argument based on same sufficient to remedy such *prima facie* differences, the PTO-cited technical material does not establish a *prima facie* case of the unpatentability of Dependent Claim 42 and its parent claim either under the MPEP or under controlling legal standards.

Id. at 76.

The argument that deCharms does not contain the exact language of claim 42 is not persuasive. *See Gleave*, 560 F.3d at 1334 (“the reference need not satisfy an *ipsissimis verbis* test”). The rejection of claim 42 is affirmed.

Dependent claim 43

Appellants argue that dependent claim 43 is independently patentable. It is argued that deCharms does not recite “means for monitoring,” “means for associating, using a microprocessor,”⁵ or “means for modifying,” as recited in parent claim 36, “[n]or does deCharms recite ‘means for associating a characteristic of the artificial sensory experience with at least one physiological response of the individual,’ as recited in Dependent

⁵ Parent claim 36 does not recite “using a microprocessor.”

Claim 43.” App. Br. 77–78. (Bolding omitted.) Appellants argue that the portion of deCharms cited by the Examiner

takes place in the context of *diagnosing a condition of a subject associated with particular activation in one of more regions of interest,* not *means for associating a characteristic of the artificial sensory experience with at least one physiological response of the individual.* Consequently, *on its face*, deCharms *does not show the text* of Dependent Claim 43.

Id. at 78. (Emphasis added.) Appellants also repeat the paragraph quoted in the discussion of claim 42, replacing the occurrence of claim 42 with claim 43.

The argument that deCharms does not contain the exact language of claim 43 is not persuasive. *See Gleave*, 560 F.3d at 1334 (“the reference need not satisfy an *ipsissimis verbis* test”). The rejection of claim 43 is affirmed.

Dependent claim 46

Appellants argue that dependent claim 46 is independently patentable. It is argued that deCharms does not recite “means for monitoring,” “means for associating, using a microprocessor,”⁶ or “means for modifying,” as recited in parent claim 36, “[n]or does deCharms recite ‘means for accepting a report from the individual of an association of a characteristic of the artificial sensory experience and the at least one health attribute,’ as recited in Dependent Claim 46.” App. Br. 70–80. (Bolding omitted.) Appellants argue that the portion of deCharms cited by the Examiner “takes place in the context of *an ROI Activity panel,* not *means for accepting a report.*”

⁶ Parent claim 36 does not recite “using a microprocessor.”

Consequently, on its face, deCharms does not show the text of Dependent Claim 46.” *Id.* at 80. (Emphasis added.) Appellants also repeat the paragraph quoted in the discussion of claim 42, replacing the occurrence of claim 42 with claim 46.

The argument that deCharms does not contain the exact language of claim 46 is not persuasive. *See Gleave*, 560 F.3d at 1334 (“the reference need not satisfy an *ipsissimis verbis* test”). The rejection of claim 46 is affirmed.

CONCLUSION

The rejection of claims 36, 38, 39, 41–43, 47–49, 52, 55, and 59–71 under 35 U.S.C. § 101 is REVERSED.

The rejection of claims 1, 36–39, 41–43, 46–49, 52, 55, 59, 64, 65, 71, 76, and 77 under § 102(b) is AFFIRMED.

The rejections of claims 60–63, 66–70, 72–75, and 78 under § 103(a) are AFFIRMED.

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).

AFFIRMED

ELD