



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/386,574	04/20/2009	Roderick A. Hyde	SE1-1000-US	9722
80118	7590	09/13/2016	EXAMINER	
Constellation Law Group, PLLC P.O. Box 580 Tracyton, WA 98393			ARCHER, MARIE	
			ART UNIT	PAPER NUMBER
			3769	
			MAIL DATE	DELIVERY MODE
			09/13/2016	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RODERICK A. HYDE, ROBERT LANGER,
ERIC C. LEUTHARDT, ROBERT W. LORD,
ELIZABETH A. SWEENEY, CLARENCE T. TEGREENE,
and LOWELL L. WOOD, JR.

Appeal 2013-001454
Application 12/386,574
Technology Center 3700

Before JOHN C. KERINS, CHARLES N. GREENHUT, and
GEORGE R. HOSKINS, *Administrative Patent Judges*.

KERINS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Roderick A. Hyde et al. (Appellants) seek our review under 35 U.S.C. § 134(a) of the Examiner's final rejection of claims 1, 36–50, 52, 55, 59–64, and 66–78. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

THE CLAIMED SUBJECT MATTER

Appellants' invention is directed to a method and system for presenting an inhalation experience. Spec. 1. Independent claims 1 and 36, reproduced below, are illustrative:

1. A computer-implemented method, comprising:

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 an inhalation device-dispensed bioactive agent or the artificial sensory experience at least partially based on associating a characteristic of the artificial sensory experience with the at least one health attribute of the individual.

36. A system, comprising:

means for monitoring at least one health attribute of an individual during an artificial sensory experience;

means for associating a characteristic of the artificial sensory experience with the at least one health attribute of the individual; and

means for modifying at least one of an inhalation device-dispensed bioactive agent or the artificial sensory experience at least partially based on associating a characteristic of the artificial sensory experience with the at least one health attribute of the individual.

THE REJECTIONS ON APPEAL

The Examiner has rejected:

- (i) claims 1, 36–48, 55, 61–64, 66, and 71–78¹ under 35 U.S.C. § 103(a) as being unpatentable over Braspenning (US 2011/0004047 A1, published Jan. 6, 2011) in view of Berg (US 2008/0065468 A1, published Mar. 13, 2008);
- (ii) claims 49 and 50 under 35 U.S.C. § 103(a) as being unpatentable over Braspenning in view of Berg and Rovira (US 6,795,972 B2, issued Sept. 21, 2004);
- (iii) claims 52, 59, 60, and 67–69 under 35 U.S.C. § 103(a) as being unpatentable over Braspenning in view of Berg, King,² and Trueba (US 7,198,044 B2, issued Apr. 3, 2007);
- (iv) claim 70 under 35 U.S.C. § 103(a) as being unpatentable over Braspenning in view of Berg and Krijn³; and
- (v) claims 72–75 under 35 U.S.C. § 101 as directed to non-statutory subject matter, in a new ground of rejection entered in the Answer (pages 3, 4–5).

ANALYSIS

Claims 1, 36–48, 55, 61–64, 66, and 71–78--Braspenning/Berg

Claims 1, 36–40, 43–48, 55, 61–64, 66, and 71–78

¹ Claims 48 and 71 were omitted from the listing of claims subject to this rejection in the Final Action. This is seen as being a clerical error, in that the detailed grounds of rejection address claims 48 and 71.

² “Some Effects of Drugs on Rats in Varying Conditions of Sensory Stimulation,” *Psychopharmacologia* 6, pp. 338–346 (1964).

³ “Virtual Reality Exposure Therapy of Anxiety Disorders: A Review,” *Clinical Psychology Review* 24, pp. 259–281 (2004).

Appellants first present arguments directed to independent claim 36. Appeal Br. 43–83. The general thrust of the majority of the arguments advanced is a challenge that the Examiner has failed to establish a prima facie case of unpatentability for claim 36. Reply Br. 3–7.

Appellants maintain that the Examiner has not provided a broadest reasonable interpretation of claim 36 consistent with their Specification, and does not explain how the references are applied to the claim language under an appropriate broadest reasonable interpretation. Appeal Br. 44–48. The Examiner, however, properly determined that each of the limitations set forth in claim 36 invokes 35 U.S.C. § 112, sixth paragraph, and has explained what structure in the Specification is regarded as corresponding to claimed “means plus function” limitations, namely that the disclosed structure corresponding to the recited means involves modules employing the use of a processor or processors. Final Act. 13; Ans. 28–31. Appellants do not point to any alleged Examiner error in this determination.

Appellants further argue, in more than one instance, that the portions of the Braspenning and Berg references relied on by the Examiner do not include the identical language used in claim 36, and that the Examiner does not provide objectively verifiable evidence supporting a position that, despite the differences in the terminology used, the claim limitations are taught by the references. Appeal Br. 48–57. According to Appellants, this alleged deficiency results in an absence of establishment of a prima facie case of unpatentability. Appeal Br. 49, 57.

It is well settled that:

[The USPTO] satisfies its initial burden of production by adequately explain[ing] the shortcomings it perceives so that the applicant is properly notified and able to respond. In other

words, the PTO carries its procedural burden of establishing a prima facie case when its rejection satisfies 35 U.S.C. §132, in notify[ing] the applicant . . . [by] stating the reasons for [its] rejection . . . together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.

In re Jung, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (internal citations and quotation marks omitted).

The Examiner provides detailed information, including an annotated version of Figure 9b of Braspenning, as to the portions of Braspenning and Berg asserted to disclose the claimed “means for monitoring,” “means for associating,” and “means for modifying,” recited in claim 36. Final Act. 13–18. The Examiner additionally explains how the features relied on in Braspenning and Berg are considered as meeting those limitations. *Id.* These findings and explanations would have put any reasonable applicant on notice of the basis for the Examiner’s rejection, and would have given such applicant ample information to judge the propriety of continuing prosecution, as well as to be in a position to assign alleged error to the Examiner’s position in traversing the rejection. In accordance with *Jung*, that is all that is required of a prima facie case of unpatentability.

In order to rebut a prima facie case of unpatentability, Appellants must distinctly and specifically point out any alleged Examiner errors. *See* 37 C.F.R. § 41.37(c)(iv). Appellants have not done so here. Appellants’ various arguments include recitations of the limitations found in claim 36, quotations from the Examiner’s statement of rejection, and quotations from the cited references, followed by contentions that the exact language in the

cited references does not literally match the language in claim 36.⁴ Appeal Br. 48–57. While Appellants baldly assert that the Examiner has not bridged the gap between the verbiage in claim 36 and the verbiage in the references with objectively verifiable evidence or arguments based on such evidence, Appellants do not point to a single, specific instance where a statement made by the Examiner is not supported by evidence in the form of the references themselves, as well as Appellants’ Specification, nor do they identify any other alleged error in the Examiner’s reasoning. *See id.*

Appellants additionally argue that, given the differences in terminology between the claim limitations and the references, “it follows that the USPTO is interpreting Braspenning through the lens of Appellant[s’] application, which is impermissible hindsight use.” Appeal Br. 58. The use of Appellants’ Specification to aid in interpreting claim 36 is not an impermissible use of hindsight; it is a necessary step in proper claim construction. The application of the disclosure of Braspenning to the limitations in claim 36 is neither impermissible use of hindsight; it is a necessary aspect of establishing the unpatentability of the claim. Appellants do not allege, and we do not see, any other action taken by the Examiner that would amount to impermissible use of hindsight reconstruction.

Appellants also argue that, due to the terminology differences, “the USPTO is relying on ‘personal knowledge’ and/or is taking ‘official notice’ of one or more factors” regarding what the references teach. Appeal Br. 58. No specific instance of this has been identified by Appellants. We view the Examiner’s position instead as properly evaluating or interpreting the

⁴ *See In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990) (whether a reference teaches a claim limitation “is not an ‘ipsissimis verbis’ test”).

references as would a person of ordinary skill in the art, and we conclude that the Examiner's position is supported by evidence in the form of the references.

Appellants further argue that Berg does not disclose the limitations set forth in claim 36. Appeal Br. 58–67. Not only is Berg not relied upon as teaching all of the limitations of claim 36, Appellants' arguments do not apprise us of error in the Examiner's findings relative to Berg. In that regard, Appellants quote several passages that are asserted to be from the Berg reference. See Appeal Br. 62–64. It is apparent from those excerpts that Appellants' arguments are drawn to a reference different than Berg, in that at least several of the excerpts are not present in the Berg reference.

Appellants repeat the arguments directed to the use of impermissible hindsight and reliance on either personal knowledge or taking official notice, relative to the Berg reference. Appeal Br. 67. For the same reasons noted above with respect to these arguments and the Braspenning reference, we are not apprised of Examiner error in these respects.

Appellants reproduce the Examiner's position originally set forth at pages 13–18 of the Final Action, and state that “[f]or the reasons set forth above” the Examiner's position is “unsupported and erroneous, and appear[s] to mischaracterize the Braspenning and Berg references,” and that the rejection is founded on “mere conclusory statements.” Appeal Br. 68–72. The “reasons set forth above,” referred to by Appellants appear to be that there is no literal correspondence between language of claim 36 and the disclosures of Braspenning and Berg. Absent identification of any specific alleged error or mischaracterization, Appellants' argument fails to apprise us of Examiner error.

Appellants additionally maintain that the combination of Braspenning and Berg would result in a change in the principle of operation of Braspenning, in that such would result in Braspenning “no longer hav[ing] a method for modifying a psychological state of a subject.” Appeal Br. 76. This argument appears to be based upon a full bodily incorporation of Berg into Braspenning, which is not commensurate with the Examiner’s rejection. *Id.* (“were one to incorporate the ‘Personalized audio controlled shopping information service for a mobile device’ as taught by Berg”). Further, we note, as above, that Appellants appear to be referring to a reference different than Berg, in that Berg does not disclose a “personalized audio controlled shopping information service.” The argument does not apprise us of Examiner error.

Appellants continue this line of argument, asserting that the proposed modification of Braspenning in view of Berg would require substantial reconstruction and redesign of the elements in Braspenning, and would result in a change in the basic principle of operation of the Braspenning device. Appeal Br. 76–77. Appellants, once again, fail to identify even one specific aspect that would require substantial reconstruction or redesign, nor is there any indication as to what exactly would change in the way of principle of operation. The arguments do not apprise us of Examiner error.

Appellants again assert that “the direct disclosures of Braspenning and Berg are radically different from the recitations of clauses [a], [b], and [c]” of claim 36. Appeal Br. 81. The statement is accompanied by no analysis as to why a person of ordinary skill in the art would regard the disclosures in general as being radically different from the three claimed means limitations.

Similarly, Appellants proffer bald statements that the Examiner “has provided no evidence that an apparent reason to modify/combine” the teachings existed at the time of the invention, and that “such modification/composition would apparently render the technologies of Braspenning unsatisfactory for one or more of its intended purposes.” Appeal Br. 81. The Examiner has noted that the means for association disclosed in Berg would be advantageous to use in the Braspenning system as well, in that it would provide information with respect to the specific aspect of the stimulus which is relevant to the user. Final Act. 18. Appellants’ argument does nothing to undermine this reason to combine, nor does the reason to combine appear to render any part of Braspenning unsatisfactory for its intended use.

Finally, Appellants note that one intended purpose of Braspenning is for assessing and modifying a psychophysiological state of a person to aid in reaching a relaxed state, and that a system having the three claimed means limitations “would frustrate this purpose,” and thus render Braspenning unsatisfactory for its intended purpose. Appeal Br. 82. Again, absent any detailed reasoning supporting such an assertion, we are not apprised of error in the Examiner’s position.

We have considered the remainder of Appellants’ arguments, including those advanced in the Reply Brief and Supplemental Reply Brief, and none of these arguments apprise us of Examiner error. In particular, the positions taken by Appellants in the Supplemental Reply Brief, i.e., that the arguments should be treated as though directed to the merits of the rejection, in addition to the “no evidence, no prima facie case” position, by-and-large devolve to the same arguments regarding the absence of literal

correspondence between the claim language and the language employed in the cited references. Supplemental Reply Br. 3–15. To the extent that any arguments touch on the actual merits of the rejection, they have been addressed above.

For the foregoing reasons, as well as for the reasons and explanations provided in the “Response to Argument” section of the Examiner’s Answer, none of the arguments advanced by Appellants for claim 36 apprises us of Examiner error in rejecting that claim over Braspenning and Berg. Accordingly, the rejection is sustained as to claim 36.

Appellants expressly rely on the arguments presented with respect to claim 36 for the patentability of independent claims 1, 71, 72, and 76. Appeal Br. 83. The rejection as to those claims is therefore sustained.

Appellants also rely solely on the dependency of claims 37–40, 43–48, 55, 61–64, 66, 73–75, 77, and 78, from one of independent claims 36, 72, and 76, for the patentability of those claims. Appeal Br. 83. The rejection as to these claims is thus also sustained.

Claim 41

Appellants maintain that claim 41, which depends from claim 36, is independently patentable, in that, in addition to the reasons advanced with respect to claim 36, Braspenning does not recite “means for recording at least one monitored health attribute of the individual.” Appeal Br. 85. The Examiner responds that paragraph 35 and item 28 in Figure 3 of Braspenning discloses a memory to store ECG data, and regards this as being encompassed by the recited means for recording at least one monitored health attribute. Ans. 50.

Appellants' arguments do not apprise us that this finding made by the Examiner is in error. The rejection of claim 41 is sustained.

Claim 42

Appellants additionally maintain that claim 42, which depends from claim 36, is independently patentable, in that, in addition to the reasons advanced with respect to claim 36, neither Braspenning nor Berg recites “means for observing at least one indication of an expected behavior pattern proximate in time to a characteristic of the artificial sensory experience.” Appeal Br. 88, emphasis omitted. Appellants appear to recognize that the Examiner relies on Berg, and not Braspenning, as disclosing this limitation. Appellants cite to what are asserted to be paragraphs 60, 97, 102, 105, and 21 in Berg, arguing that these disclosures do not amount to a teaching of the recited claim limitation. *Id.* at 88–89. The excerpts presented in the Appeal Brief are not, however, excerpts from the cited Berg reference.

A review of actual paragraphs 21, 97, 102, and 105 of Berg, relied on by the Examiner, reveals that Berg discloses subject matter falling within the scope of the means limitation set forth in claim 42. As such, Appellants' arguments do not apprise us of error in the Examiner's position. The rejection of claim 42 is sustained.

Claims 49 and 50--Braspenning/Berg/Rovira

Appellants rely solely on the dependency of claims 49 and 50 from independent claim 36 for their patentability. Appeal Br. 83. The rejection as to these claims is sustained for the same reasons presented above.

Claims 52, 59, 60, and 67–69--Braspenning/Berg/King/Trueba

Appellants rely solely on the dependency of claims 52, 59, 60, and 67–69, from independent claim 36 for their patentability. Appeal Br. 83. The rejection as to these claims is thus also sustained.

Claim 70--Braspenning/Berg/Krijn

Appellants rely solely on the dependency of claim 70 from independent claim 36 for its patentability. Appeal Br. 83. The rejection of this claim is sustained for the same reasons presented above.

Claims 72–75—Non-Statutory Subject Matter

The Answer enters a new ground of rejection, that claims 72–75 are unpatentable under 35 U.S.C. § 101 as directed to non-statutory subject matter. Ans. 3, 4–5. Appellants fails to address this rejection in the Reply Brief or in the Supplemental Reply Brief. We, accordingly, summarily sustain this rejection.

DECISION

The rejection of claims 1, 36–48, 55, 61–64, 66, and 71–78 under 35 U.S.C. § 103(a) as being unpatentable over Braspenning in view of Berg is affirmed.

The rejection of claims 49 and 50 under 35 U.S.C. § 103(a) as being unpatentable over Braspenning in view of Berg and Rovira is affirmed.

The rejection of claims 52, 59, 60, and 67–69 under 35 U.S.C. § 103(a) as being unpatentable over Braspenning in view of Berg, King, and Trueba is affirmed.

Appeal 2013-001454
Application 12/386,574

The rejection of claim 70 under 35 U.S.C. § 103(a) as being unpatentable over Braspenning in view of Berg and Krijn is affirmed.

The rejection of claims 72–75 under 35 U.S.C. § 101 as directed to non-statutory subject matter is 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).

AFFIRMED