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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/413,941	03/07/2012	Robert J. McKinnon	3170-62-CIP	1043
22442	7590	12/12/2016	EXAMINER	
Sheridan Ross PC 1560 Broadway Suite 1200 Denver, CO 80202			STUART, COLIN W	
			ART UNIT	PAPER NUMBER
			3771	
			NOTIFICATION DATE	DELIVERY MODE
			12/12/2016	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* ROBERT J. McKINNON and JAMES DALE  
BICKLEY

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Appeal 2014-003126  
Application 13/413,941  
Technology Center 3700

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Before MICHAEL L. HOELTER, THOMAS F. SMEGAL,  
and GORDON D. KINDER, *Administrative Patent Judges*.

KINDER, *Administrative Patent Judge*.

DECISION ON APPEAL  
STATEMENT OF THE CASE

Robert J. McKinnon and James Dale Bickley (Appellants) appeal under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1–5, 7–17, and 19–21.<sup>1</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM and enter a NEW GROUND OF REJECTION under 37 C.F.R. § 41.50(b).

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<sup>1</sup> Appellants identify the real party in interest as Westmed, Inc., an Arizona corporation.

## THE INVENTION

The invention is directed to a nasal cannula. Claims 1, 12, and 21 are independent; Claim 1, reproduced below, illustrates the claimed subject matter.

1. A nasal cannula assembly designed for contact with the nasalabidial area of a patient's nose and comprising:

a hollow tubular member having an oxygen supply opening at each end and having a pair of spaced tubular extensions projecting therefrom that terminate in gas-directing orifices;

a first tube interconnected at a first end to one end of said hollow tubular member, said first tube is made of a material that stretches about 1 inch per foot of length when less than about 0.5 lbs of tension is applied thereto; and

a second tube interconnected on a first end to an end of said hollow tubular member opposite from where the first tube is connected, said second tube is made of a material that stretches about 1 inch per foot of length when less than about 0.5 lbs of force is applied.

## THE PRIOR ART

The Examiner relies upon the following as evidence of unpatentability:

Marshall	US 4,699,139	Oct. 13, 1987
Winthrop	US 5,682,881	Nov. 4, 1997
Thompson	US 2005/0033247 A1	Feb. 10, 2005

Appellants' Admitted Prior Art as set forth on pages 9–10 of the Specification (AAPA).

## THE REJECTIONS

The Examiner has entered the following rejections under 35 U.S.C. § 103(a):

Claims 1–3, 5, 7–9, 11–17, 19, and 20 on the basis of Thompson “as evidenced by [Appellants’] admitted prior art (on page 9-10 of [Appellants’] specification).” Ans. 3; Final Act. 2

Claims 4 and 10 on the basis of Thompson “as evidenced by [Appellants’] admitted prior art [on page 9-10 of Appellants’ specification]” and Winthrop. Ans. 8; Final Act. 7.

Claim 21 on the basis of Thompson “as evidenced by [Appellants’] admitted prior art [on page 9-10 of Appellants’ specification],” and Marshall. Ans. 9; Final Act. 9.

## OPINION

### *New Ground: Indefiniteness*

Claims 1–5, 7–11, and 21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention.

The problem to which Appellants have directed their inventive efforts is eliminating the discomfort and injury to a patient’s skin caused when tubing rubs against it. *See* Spec. 1–2. Appellants conducted tests which showed that the problem was alleviated when “[t]he elongation of the left *tube* 18L and/or the right *tube* in response to head tilting and turning are such that elongations of up to 10% of the tubing length,” for “[t]his simulated the amount of *tube* stretch needed to accommodate a patient turning his or her head, which allowed assessment of the amount of *tube*

stretch needed to reduce or eliminate the application of force by left and right *tubing* onto a patient's head due to head turning,” and “[a]s one of skill in the art will appreciate, the amount of tensile force applied to the *tubing* is directly proportional to the force felt by the patient and the associated injury and/or discomfort.” *Id.* at 8–9; emphasis added. “[T]he amount of tensile force *on* the tube 18 is directly proportional to the amount of frictional force felt by the patient. [] That is, a cannula made in accordance with embodiments of the present invention will exert a decreased level of normal force onto a patient's face and/or ear.” *Id.* at 10. Thus, it appears to be clear from these passages in the Specification that it is the degree to which the *tube* can stretch that is the key to solving the stated problem.

However, the Specification does not describe the properties of the tube, but rather of the material from which the tube is made, to wit:

For example, the clear medical grade flexible PVC APEX©3200-50NT manufactured by Teknor Apex may be used []. Further, it is believed that any elastomer that would exert less than 3.0 psi, preferably less than about 1.5 psi, and most preferably less than 0.5 psi, under the test conditions described above would help reduce or eliminate patient discomfort and injury. In addition, although flexible PVC capable of elongation up to 450% of its original length has been described, one of skill in the art will appreciate that a flexible PVC capable of elongation of approximately 250% or more may be used without departing from the scope of the present invention. Further, flexible PVC capable of elongation more than 450% of its original length may be used in some instances.

*Id.* Nowhere in the Specification is the material from which the tube is made directly related to the tension required to be present in the tubing in order to solve the stated problem, except for mention on page 9 that the tests were conducted with a three inch section of “standard tubing.” The Specification

does not include details of the construction of this “standard tubing,” or any other tubing, for that matter, such as diameter and wall thickness.

Likewise, independent claims 1 and 21 recite a nasal cannula comprising first and second tubes “made of a material that stretches about 1 inch per foot of length when less than about 0.5 pounds of tension is applied thereto,” however, no details are provided of the construction of the tubing, nor is there a definite relationship set forth between the cannula tube and the material from which it is made. Thus, Appellants’ Specification establishes that the cited problem is solved by providing cannula tubes that can be stretched 1 inch per foot when about 0.5 pounds of tension is applied, but this is not reflected in the claims, which require only that in some form the material from which the tubes are made meet this test, and not that it be met by the tubes themselves. By way of example, a narrow strand of the selected material, having a small cross-sectional area, could meet this claim provision when tested, whereas a cannula tube constructed of that same material, which has a significant cross-sectional area of material compared to a narrow strand, would not. This being the case, the cited recitation renders independent claims 1 and 21 indefinite for, in our view, the metes and bounds of all of the claims cannot be determined.

However, notwithstanding the new rejection of indefiniteness, in the interest of judicial economy we shall consider the rejections set forth by the Examiner.

*Claims 1–3, 5, 7–9, 11–17, 19, and 20  
Obviousness - Thompson and Appellants' Admitted Prior Art*

Appellants argue claims 1–3, 5, 7–9, 11–17, 19, and 20 as a group. Appeal Br. 14–31. We select claim 1 as representative, and claims 2, 3, 5, 7–9, 11–17, 19, and 20 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner's Position

The Examiner has found that Thompson discloses all of the subject matter recited in independent claim 1, except that

Thompson is silent as to explicitly disclosing that the first and second tubes are made of a material that stretches about 1 inch per foot of length when less than about 0.5 [pounds] of tension is applied thereto. However, as evidenced by Applicant's admitted prior art, Applicant discloses a previously provided material APEX 3200-50NT manufactured by Teknor Apex as being used as a material which provides the various properties found in the claimed invention as well as disclosing that “flexible PVC capable of elongation of approximately 250% or more may be used without departing from the scope of the present invention” (see pages 9-10 of specification).

Final Act. 2–3. However, the Examiner then notes that Thompson also “discusses material choice for providing a cannula assembly that bends freely with head movements as well as elongates under tensile stress and discloses that Teknor Apex series 3300 is prior art knowledge within the field of [the] invention,” and concludes that it would have been an obvious matter of design choice to utilize the material disclosed by Appellants in the cannula disclosed by Thompson. *Id.* The Examiner's rationale for this conclusion is that “one of ordinary skill in the art would have expected the Thompson device to perform equally as well with the material which stretches to about 1 inch per foot of length when less than about 0.5 [pounds] of tension is applied (Teknor Apex 3200-50NT)[]” (*id.*), which is, in the

rejection, the “admitted prior art” material disclosed by Appellants on page 10 of their Specification.

In response to Appellants’ arguments in the Appeal Brief, the Examiner points out that Thompson recognizes in paragraph 50 the same problem to which Appellants’ invention is directed and, as set forth in paragraphs 52–54 seeks to solve the problem in the same manner as Appellants, that is “by providing flexible tubing made of a material which elongates easier or to a greater degree than [the] current prior art tubing material.” Ans. 13. The Examiner goes on to state that Thompson notes in paragraph 52 that Teknor-Apex 3300-82 is an example of the prior art material, that “[t]he only difference is the choice of the tubing material.” *Id.* The Examiner asserts that “there is no structure in Thompson that would prevent one of ordinary skill in the art from choosing another well-known material, such as the material disclosed in Appellant's specification, Teknor-Apex 3200-50NT, to further reduce or eliminate patient skin irritation or injury,” and that “one of ordinary skill in the art, reading para. 0050 and 0052-0054 of Thompson would appreciate that Thompson’s [sic] was attempting to solve the problem of pressure sores by providing tubing capable of elongation at lower forces as compared to the prior art.” *Id.*

The Examiner further explains the rejection in the following manner:

Regardless of the interpretation of the exact meaning of the 10% tensile modulus, or any equations or force values derived therefrom, one of ordinary skill in the art, reading para. 0050 and 0052-0054 of Thompson would appreciate that Thompson's was attempting to solve the problem of pressure sores by providing tubing capable of elongation at lower forces as compared to the prior art. This is shown through Thompsons [sic] explanation of the tensile test performed: suspending weights from a 13 inch length of tubing and adding weight until

the length increased to 14.3 inches (see para. 0053). In light of this explanation of the tensile test used, one of ordinary skill in the art would appreciate that the Thompson tubing material, having the 10% tensile modulus of 200 psi or less (para. 0052), provides elongation at lower forces than the prior art tubing.

*Id.* at 13–14.

The modification to the Thompson reference in view of Applicant's admitted prior art of the material Teknor Apex 3200-50NT, which exhibit[s] properties claimed such as the ability to stretch about 1 inch per foot of length when less than about 0.5 [pounds] of force is applied (see specification page 9 line 22 through page 10 line 16 for example), is based on the following KSR rationale: Substitution of one know[n] element (Teknor Apex 3200-50NT) for another (Thompson's tubing material of para. 0052) to obtain predictable results, further reducing occurrence of pressure sores by providing tubing material capable of elongation at even lower forces; obvious to try/choose a material from a finite number of choices with a reasonable expectation of success as one of ordinary skill would have found it obvious to try Teknor Apex 3200-50NT, made by the same company as the prior art of para. 0054 of Thompson, which provides greater elongation and would therefore provide even less pressure sores; and one of ordinary skill in the art would have found motivation to choose a well-known material such as Teknor Apex 3200-50NT based on the fact that Thompson addresses the problem of pressure sores/ulcers via a tubing material which exhibits elongation at lower forces than the prior art of Thompson.

*Id.* at 14–15.

With regard to the evidence of secondary considerations, the Examiner takes the position that:

There does not appear to be a nexus between the evidence of secondary considerations and the claimed invention which would overcome the obviousness rejections. MPEP section 716.03(a)I

states that affidavits or declarations attributing commercial success to a product according to the claims does not establish a nexus between the invention *as claimed* and the commercial success as it is not known that the product sold corresponds to the claims or that whatever commercial success may have occurred is attributable to the claims.

*Id.* at 16.

#### Appellants' Arguments

The initial argument presented by Appellants is that the Examiner failed to present “a convincing line of reasoning” as to why the claimed features in claim 1 would have been obvious on the basis that it was a matter of design choice. App. Br. 14. They continue with a comparison of the differences between the information disclosed in Thompson’s paragraphs 52–54 and Appellants’ invention, focusing on Young’s Modulus and Hooke’s law. In the course of this discussion, Appellants assert that the Examiner’s position as to what one of ordinary skill in the art would have been taught by the cited portion of Thompson is refuted by the explanations in the declaration of Dr. Braun. *See id.* at 5–22. Appellants assert that Thompson is a non-enabling reference, for it “omits information that would allow identification of a material that can be used to satisfy Thompson’s cannula requirements” or meet the limitations in the independent claims in their application, and because paragraphs 50–55 “are scientifically inaccurate, incomplete, and contain numerous and significant errors.” *Id.* at 22.

Appellants also argue that “the direction provided by Thompson would discourage rather than encourage one of ordinary skill in the art from using, testing, experimenting, and selecting a material having the properties identified by Thompson, especially when that material is to be used for low margin, disposable medical cannula,” and, thus, “would be left to conduct

extensive experimentation, using Thompson’s inaccurate, incomplete, and questionable disclosure as a guide.” *See id.* at 23–25. Arguments also are presented that the Examiner has utilized impermissible hindsight in arriving in formulating the rejection, and has improperly “deemed the affidavits submitted in support of non-obviousness insufficient to overcome rejection of the pending claims.” *Id.* at 26.

Appellants also have presented evidence of secondary considerations in the form of declarations attesting to commercial success, comparisons with prior art cannula, criticism of the information presented in paragraphs [0052]–[54] in Thompson, and opinions as to the success of Appellants’ invention in solving the stated problem, as well as extensive discussions thereof. *See id.* at 28–31.

In the Reply Brief, Appellants again challenge the Examiner’s logic in arriving at the position that one of ordinary skill in the art would have been motivated by Thompson to search for the claimed material from a finite number of choices with a reasonable expectation of success, in particular, asserting that “it is not reasonable to expect one of skill in the art to try all combinations of materials to identify one that meets the pending claims as there would be little hope for success and many failures.” Reply Br. 3.<sup>2</sup>

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<sup>2</sup> Appellants also request that the Board consider evidence that was not allowed entry by the Examiner. Reply Br. 3. However, this is a matter which is not subject to appeal to the Patent Trial and Appeal Board, but is petitionable under 37 C.F.R § 1.181, and, therefore, is not before us.

*Analysis*

It is clear that the problem to which Appellants and Thompson have directed their inventive efforts is the same. Appellants state that one aspect of the invention is to provide a nasal cannula

*made at least partially of a flexible material that readily elongates without restricting air flow. [] capable of stretching approximately 1 inch per foot of length when less than about 0.5 pounds of force is applied. The length increase reduces tube tension and associated pressure, thereby reducing or eliminating patient irritation. One embodiment of the present invention is made of an elastomer, such as flexible polyvinyl chloride (PVC), polyurethane, or similar material which elongates when tensioned without reducing the internal diameter to such a degree that would constrict the gas flow.*

*Id.* at 4–5 (emphasis added). Appellants explain that they conducted tests using “a three inch section of standard tubing” that “yielded an average *tube* length increase of 10% associated with a full head rotation” of the patient (*id.* at 9; emphasis added).

Thompson is directed not only to nasal cannula tubing, but also to an entire nasal cannula assembly, and explains that “[t]he combination of *flexible tubing* and the form fitting shape and light weight of the cannula keeps it in place with *almost no tubing tension that, all at once, reduces sores on the ears, nose and neck and eliminates grooves across the cheeks.*” *Id.* at [0050] (emphasis added). Thompson teaches that the problem is solved by the use of “[e]xtremely flexible support tubing that reliably orients and positions the cannula with little or no tension on the face” (*id.* at [0019]), “with special properties that work in concert with the shape of the cannula *to reduce tubing tension* to a bare minimum yet secure the placement,” and is made of an *ultra-high molecular weight PVC resin* that

gives it *rubber-like qualities* such as resilience [and] *extreme flexibility*” (*id.* at [0022]) (emphasis added in all).

Thompson also states that “the special support tubing used with the cannula of the present invention was chosen after *extensive experimentation with a number of different materials and variations of materials*. The considerations included flexibility, manufacturability, service life, packaging, smell, skin compatibility, medical compatibility, toxicity, cost and availability” (*id.* at [0051] emphasis added), that among the desirable properties for the cannula tubes is “10% *tensile modulus of 200 psi or less*,” as established by a tensile test in which a 13 inch length of tubing was suspended and subjected to weights until the length increased to 14.3 inches (*id.* at [0052]).

Thompson contrasts this value with one exhibited by a typical prior art tubing, stating that “[t]ypical values for *prior art tubing* extruded from Teknor-Apex 3300-82 PVC compound are a 10% tensile strength modulus of 450 psi.” *Id.* at [0054]. We take note here that the term “tensile modulus” is synonymous with “modulus of elasticity,” “elastic modulus,” and “Young’s modulus”, and is “a number that measures an object or substance’s resistance to being deformed elastically (i.e. non-permanently) when a force is applied to it, and that a stiffer material will have a higher elastic modulus.”<sup>3</sup>

As set forth in MPEP § 2141, the Supreme Court in *KSR Int’l v. Teleflex, Inc.*, 550 U.S. 398 (2007), reiterated that the framework for the

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<sup>3</sup> See [www.wikipedia.org/Elastic\\_modulus](http://www.wikipedia.org/Elastic_modulus) See also [www.thefreedictionary.com/Tensile+Modulus](http://www.thefreedictionary.com/Tensile+Modulus), and [www.engineeringtoolbox.com/young-modulus-d\\_417.html](http://www.engineeringtoolbox.com/young-modulus-d_417.html).

objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 86 (1966). Obviousness is a question of law based on underlying factual inquiries which, as enunciated by the Court are: determining the scope and content of the prior art; ascertaining the differences between the claimed invention and the prior art; and resolving the level of ordinary skill in the pertinent art. In the present case, Thompson provides evidence that a known problem in the prior art to which the invention is directed is preventing nasal cannula support tubing from causing pain and tissue irritation and damage to a patient's face and ears, and represents that the present state of the art is exemplified by utilization of Teknor-Apex 3300-82 PVC compound.

It is significant that Thompson states: "Perhaps the most important feature of the cannula of the present invention is that it can be used with extremely flexible support tubing that bends freely with head movements without disturbing the position of the cannula on the face," (*id.* at [0050]), which focuses on the same result as Appellants' cannula. Significantly, Thompson also teaches that the amount of extension under tension required in order to provide for this movement is the same as that set forth in Appellants' claims, that is, "about 1 inch per foot of length," which is supported by Thompson's recitation of "suspending weights from a 13" length of tubing and adding weights until the length increased to 14.3"." *Id.* at [0053]. Thompson also teaches that the composition of cannula support tubing that solves the stated problem is a thermoplastic material such as PVC, which is quite pliable and extremely flexible so that it bends freely with the patient's head movements, and has a 10% tensile modulus of 200 psi or less. The terms used by Thompson to describe the desired cannula

tubing are “extremely flexible,” “almost no tubing tension,” and “rubber-like qualities.”

Thompson does not explicitly disclose that the desired amount of stretching of the tubes is accomplished “when less than about 0.5 lbs of tension is applied thereto,” as is set forth in Appellants’ claim 1. However, it is our view that in the paragraphs cited by the Examiner, Thompson’s teaching that a 10% extension of the cannula under tension solves the problem, along with the adjectives used to describe the required PVC material, provide one of ordinary skill in the art with sufficient information to direct the attention of one of ordinary skill in the art to a finite number of tubing materials from which to choose ones which perform in such a manner as to solve the problem, thus supporting the conclusion that and it would have been a matter of design choice to select one in which the claimed degree of extension is accomplished by “less than about 0.5 lbs of tension.” We regard the clear medical grade flexible PVC APEX 3200-50NT manufactured by Teknor Apex as being an example of the types of material that would come to the attention of one of ordinary skill in the art.

We also note here that, as explained *supra*, in the new rejection, Appellants’ independent claim 1 can be interpreted as being very broad, requiring only that, in some form, the material from which the cannula tubing is made be capable of stretching about 1 inch per foot when about 0.5 pounds of tension is applied, and not that the tubing made from the material meet this limitation. We find that, in view of the teachings of Thompson and, in particular, the adjectives used by Thompson to describe the characteristics of the tubing, that it would have been obvious to one of

ordinary skill in the art to utilize a material which, in some form, meets the requirements of the claims.

Therefore, although we have carefully considered all of the arguments presented by Appellants, it is our view that the Examiner has established a prima case of obviousness on the basis of the cited prior art with regard to independent claims 1 and 12, and dependent claims 2, 3, 5, 7–9, 11–17, 19 and 20.

#### *The Secondary Considerations*

The Appellants bear the burden of proving commercial success. *In re Huang*, 100 F.3d 135, 139–40 (Fed. Cir. 1996). Objective evidence of nonobviousness including commercial success must be commensurate in scope with the claims. *In re Tiffin*, 448 F.2d 791 (CCPA 1971) (evidence showing commercial success of thermoplastic foam “cups” used in vending machines was not commensurate in scope with claims directed to thermoplastic foam “containers” broadly). “[The] inventor's statement that his commercial [product] is “constructed according to the disclosure and claims of my patent application” does not constitute probative evidence that the [product] which has been sold corresponds to the [product] defined by the appealed claims or that whatever commercial success may have occurred is attributable to the construction defined by the appealed claims.” *Ex Parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. July 26, 1988).

The declaration of co-inventor McKinnon states that the Comfort Soft Plus cannula “practices the invention set forth in the claims of this application”, “elongates in the manner articulated in independent claims 1 and 12” and “meets [the] limitations of at least Claims 1–5, 7–17, and 19–20.” *Id.* at 4–5. The declaration states that sales of cannula have risen from

3 million units per year before the introduction of Comfort Soft Plus to approximately 30 million units per year since “without any increase in sales or marketing effort.” McKinnon Dec. ¶¶ 8, 16.

The statements of Mr. McKinnon are the kind that this Board’s predecessor and reviewing court have found not probative of commercial success. They offer broad conclusory claims that the commercial product, “Comfort Soft Plus,” conforms to the claims of the pending application<sup>4</sup> and allege that growth occurred without any change in marketing. But no specifics are provided. We have no evidence that the increase on sales was not generated by a drop in price, or by an increase in price by competitors. For example, we have no evidence that the market conditions had not changed, such as a competitor changing its product line, or dropping out altogether, in a manner that favored Appellants. In addition, the McKinnon declaration identifies five properties of a suitable cannula material in ¶ 13, only one of which appears in claim 1. There is no evidence that one or more of the other four properties are not the causative factors for Appellants’ increase in sales.

Appellants also present declarations from three nursing professionals who attest to the utility of the Comfort Soft Plus cannula. We do not consider these declarations probative of non-obviousness because they are not tied in any way to the language of the appealed claims. We note that discovery of the problem preceded the Appellants’ application, as evidenced by Thompson, and the material Appellants used was readily available, per

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<sup>4</sup> The declaration of Mr. Bickley is no more specific stating that the Comfort Plus “is covered by pending Claim 1–5, 7–17, 19, and 20.” Bickley Declaration, ¶ 6.

Appellants' admission. There is no evidence that despite knowledge of the problem and the material, one of ordinary skill in the art still would not have found the invention obvious. To hold otherwise would reward those taking advantage of disparate knowledge rather than meeting the statutory standard of non-obviousness.

Finally, Appellants offer the declaration of Dr. Braun. Dr. Braun is of the view that Thompson is misleading and incomplete. As noted above, the Examiner relied on Thompson for its recognition of the problem and its qualitative statements of the requirements for a material useful in solving the problem. Dr. Braun's statements are not persuasive because they challenge portions of Thompson on matters that are irrelevant insofar as our decision is concerned.

*Claims 4 and 10*

*Obviousness – Thompson, Appellants' Admitted Prior Art,  
and Winthrop*

*Claim 21*

*Obviousness – Thompson, Appellants' Admitted Prior Art,  
and Marshall*

Appellants have chosen not to argue separately the rejections of dependent claims 4 and 10, but to allow them to stand or fall with the independent claims from which they depend. App. Br. 32. Likewise, Appellants have offered no separate argument in support of independent claim 21, incorporating the arguments made in support of claim 1. App. Br. 33. Therefore, the rejections of these claims also are sustained.

DECISION

All three rejections are sustained.

The decision of the Examiner is affirmed.

Claims 1–5, 7–11, and 21 also stand newly rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

37 C.F.R. § 41.50(b) provides that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED; 37 C.F.R. § 41.50(b)