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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte HOLLY S. VITENSE, LI WANG, DENISE DIRNBERGER,
MELISSA M. RHODES, DOUGLAS A. HETTRICK, and SHANTANU
SARKAR

Appeal 2014-003133
Application 13/570,858¹
Technology Center 3700

Before THOMAS F. SMEGAL, LISA M. GUIJT, and
PAUL J. KORNICZKY, *Administrative Patent Judges*.

SMEGAL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Holly S. Vitense et al. (Appellants) seek our review under 35 U.S.C.
§ 134 of the Examiner's Final Rejection² of claims 1–6,³ and specifically, of

¹ According to Appellants, the real party in interest is Medtronic, Inc. Br. 2.

² Appeal is taken from the adverse decision of the Examiner as set forth in the Final Action, dated March 15, 2013 (“Final Act.”).

³ Appellants attempted to cancel claim 6 by an amendment submitted with the Appeal Brief. While the record before us does not reflect that Appellants' amendment was entered, Appellants confirm that only claims 1–5 are being appealed. *See* Br. 2. Therefore, we treat the rejection of claim 6 as not appealed and the Examiner is advised to cancel this claim in any further prosecution. *See Manual of Patent Examining Procedure* (MPEP) § 1215.03 (8th Ed., Rev. 8, Jul. 2010); *see also Ex parte Ghuman*, 88 USPQ2d 1478, 1480 (BPAI 2008) (precedential).

(1) claim 1 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; (2) claims 1–5 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; and (3) claim 1–5 under 35 U.S.C. § 102(b) as anticipated by Stadler (US 2004/0172080 A1, pub. Sept. 2, 2004).⁴ We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

CLAIMED SUBJECT MATTER

Claim 1, the sole independent claim, is reproduced below and illustrates the claimed subject matter, with disputed limitations emphasized.

1. An apparatus for selectively deactivating a notification function in an implantable medical device (IMD), comprising:
 means for monitoring a physiologic parameter of a patient;
 means for determining when the physiologic parameter one of exceeds a threshold and departs from a desired range;
 means for energizing a notification function to the patient responsive to one of the parameter exceeding the threshold and departing from the desired range; and
 means for preventing, for a preset period of time subsequent to the patient receiving one of a corrective and a palliative therapy under guidance of a clinician, energization of the notification function responsive to one of the parameter exceeding the threshold and departing from the desired range during the preset period of time.

⁴ Claims 7–12 were previously canceled. *See* Br. 15, Claims App.

ANALYSIS

First Ground of Rejection: Lack of Written Description

We are not persuaded that the Examiner erred in finding that claim 1 fails “to comply with the written description requirement” of 35 U.S.C. § 112, first paragraph, because claim 1 “contains 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(s), at the time the application was filed, had possession of the claimed invention.” Final Act. 4–5. More specifically, the Examiner determined that “[c]laim 1 recites ‘means-plus-function’ limitation[s]” that are “not supported by a clear correlation and identification of a corresponding structure, materials or acts described in the instant specification for performing or achieving such specific function as recited.” *Id.* at 5 (citing MPEP § 2181).

Among the “means plus function” limitations recited by claim 1, for which the Examiner finds no support, is the

means for preventing, for a preset period of time subsequent to the patient receiving one of a corrective and a palliative therapy under guidance of a clinician, energization of the notification function responsive to one of the parameter exceeding the threshold and departing from the desired range during the preset period of time.

Br. 14, Claims App.; Ans. 2–4.

The purpose of the written description requirement in 35 U.S.C. § 112, first paragraph, is to “clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.” *Ariad Pharms., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) (quoting *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991)). “[T]he test for sufficiency is whether the disclosure of the application relied upon

reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Id.* This test “requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art.” *Id.* “Based on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.” *Id.*

Appellants contend that means plus function d)⁵ “is accomplished by the graphical user interface 500 illustrated in Figure 5[] and described at page 13, line 25 to page 14, line 11 [of the Specification], which programs the processor 224 to so perform by means of the telemetry circuit 330 as described at page 9, line 14 [] to page 10, line 6,⁶” so that “[t]he preset period of time is illustrated at 506 as the ‘suspend Optivol Alert’ time, typically a period of days, which exceeds the time it would take for the device to detect a significant change in impedance.” Br. 6.

The Examiner first responds generally that

MPEP 2181 (II)(C) and (D) teaches that the structure disclosed in the written description of the specification is the corresponding structure only if it the written description of the specification or the prosecution history **clearly links or associates** that structure to the function recited in a means-plus function claim limitation under 112, sixth Paragraph.

Ans. 2.

⁵ Appellants identify this “means plus function” limitation as “d),” and we will do likewise. *See* Br. 6.

⁶ This portion of Appellants’ Specification is a copy of Stadler ¶ 58.

The Examiner continues by explaining, regarding means plus function “d),” that “[Appellants’] description does not clearly link or associate any structure to the function recited in [that] means-plus function claim limitation under 112, sixth paragraph,” and for that reason, the Examiner finds that “[i]t is unclear what [structure] is preventing [energization of the notification function] based on the written disclosure and [Appellants’] remarks.” *Id.* at 4. Appellants have not apprised us that the Examiner’s finding is in error.⁷

Accordingly, we sustain the Examiner’s rejection of claim 1 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Second Ground of Rejection: Indefiniteness

We are not persuaded that the Examiner erred in finding claims 1–6 to be indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, in reciting “means for: monitoring, determining, energizing, and preventing.” Final Act. 5. As the Examiner points out, claim 1 “fails to distinctly claim appropriate, tangible, useful, subject matter,” so that “[i]t is unclear to the examiner *the intended use and appropriate utility* to which the applicant regards as the invention for going about the ‘means plus function’ limitations.” *Id.* (emphasis added).

We are instructed by our reviewing court that “the corresponding structure(s) of a means-plus-function limitation must be disclosed in the

⁷ Appellants did not file a Reply Brief.

written description in such a manner that one skilled in the art will know and understand what structure corresponds to the means limitations. Otherwise, one does not know what the claim means.” *Atmel Corp. v. Info. Storage Devices, Inc.*, 198 F.3d 1374, 1382 (Fed. Cir. 1999). We are also admonished that a claim fails to comply with 35 U.S.C. § 112, second paragraph, “when it contains words or phrases whose meaning is unclear.” *In re Packard*, 751 F.3d 1307, 1310, 1322 (Fed. Cir. 2014) (approving, for pre-issuance claims, the standard from MPEP § 2173.05(e)). A “satisfactory response” to an indefiniteness rejection “can take the form of a modification of the language identified as unclear, a separate definition of the unclear language, or, in an appropriate case, a persuasive explanation for the record of why the language at issue is not actually unclear.” *Id.* at 1311.

Appellants’ Appeal Brief includes the heading “VI. Grounds of rejection to be reviewed on appeal,” and the subheading “A. Rejections under Section 112,” which is followed by the statement that “*Claims 1–5 are rejected under 35 U.S.C. § 112, first paragraph.* These rejections are respectfully traversed.”⁸ Br. 4. (emphasis added). Thus, Appellants make no specific reference to the Examiner’s rejection under 35 U.S.C. § 112, second paragraph.⁹ Furthermore, Appellants have not amended the claims or offered any argument that we find responsive to the rejection of claims 1–5 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to

⁸ Most of the same text appears again at page 5 of the Appeal Brief.

⁹ We note being admonished by our reviewing court that “applicant can waive appeal of [any] ground of rejection.” *Hyatt v. Dudas*, 551 F. 3d 1307, 1314 (Fed. Cir. 2008).

particularly point out and distinctly claim the subject matter which applicants regard as the invention. *See generally* Br. 5–13.

However, for the sake of completeness, we will consider Appellants’ arguments at pages 5–7 as if they also were identified as being responsive to the Examiner’s rejection under 35 U.S.C. § 112, second paragraph. Having done so, we agree with the Examiner that “a rejection under 112 second paragraph, is appropriate [where] one of ordinary skill in the art cannot identify what structure, materials, or acts disclosed in the written description of the specification perform the claimed function.” Ans. 2. We find that Appellants’ reliance on the written description, as described on page 4 of the Appeal Brief as support for means plus function “d)”, “does not clearly link or associate any structure to the function recited in [that] means-plus function claim limitation under 112, sixth paragraph,” and for that reason, “[i]t is unclear what [structure] is preventing [energization of the notification function] based on the written disclosure and [Appellants’] remarks.” *Id.* at 4. Thus we agree with the Examiner that the claims are “indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention,” and that Appellants have not complied with the requirements of 35 U.S.C. § 112, second paragraph.

Accordingly, we sustain the Examiner’s rejection of claims 1–5 under 35 U.S.C. § 112, second paragraph.

Third Ground of Rejection; Anticipation by Stadler

We do not sustain the Examiner’s rejection of claims 1–5 as anticipated by Stadler because that ground of rejection is necessarily based on speculative assumptions as to the meaning of the claims. *See In re Steele*,

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305 F.2d 859, 862–63 (CCPA 1962). It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter and does not reflect on the adequacy of the prior art evidence applied in support of the Examiner’s rejection.

DECISION

We AFFIRM the Examiner’s rejections of claims 1–5 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, and under 35 U.S.C. § 112, second paragraph, as being indefinite.

We REVERSE the Examiner’s rejection of claims 1–5 as anticipated by Stadler.

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