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WILSON, SONSINI, GOODRICH & ROSATI
650 PAGE MILL ROAD
PALO ALTO, CA 94304-1050

EXAMINER

PORTER, JR, GARY A

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANDRES M. LOZANO

Appeal 2015-001288^{1,2}
Application 14/034,336
Technology Center 3700

Before PHILIP J. HOFFMANN, TARA L. HUTCHINGS, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

HOFFMANN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1–16, 19, and 20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

According to Appellant, “[t]he present invention relates to techniques for providing treatment therapy to improve cognitive function within a brain

¹ Our decision references Appellant’s Specification (“Spec.,” filed Sept. 23, 2013), Appeal Brief (“Appeal Br.,” filed July 24, 2014), and Reply Brief (“Reply Br.,” filed Nov. 3, 2014), as well as the Examiner’s Answer (“Answer,” mailed Sept. 12, 2014).

² According to Appellant, Functional Neuromodulation, Inc. is the real party in interest. Appeal Br. 3.

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of a human by way of brain stimulation and/or drug infusion.” Spec. ¶ 2.
Claim 1 is the only independent claim. *See* Appeal Br., Claims App. We
reproduce claim 1 in the Analysis section, below, as representative of the
appealed claims.

REJECTIONS AND PRIOR ART

The Examiner rejects claims 1, 4, 5, 7, 19, and 20 under 35 U.S.C.
§ 102(e) as anticipated by Shafer (US 2005/0119712 A1, pub. June 2, 2005).

The Examiner rejects claims 2 and 3 under 35 U.S.C. § 103(a) as
unpatentable over Shafer and Ridder (US 2006/0100671 A1, pub. May 11,
2006).

The Examiner rejects claims 6 and 8 under 35 U.S.C. § 103(a) as
unpatentable over Shafer.

The Examiner rejects claims 9–15 under 35 U.S.C. § 103(a) as
unpatentable over Shafer and Osorio (US 2004/0138711 A1, pub. July 15,
2004).

The Examiner rejects claim 16 under 35 U.S.C. § 103(a) as
unpatentable over Shafer and Armstrong (US 2006/0173494 A1, pub.
Aug. 3, 2006).

See Answer 2–6.

ANALYSIS

Independent claim 1 recites the following:

1. A method for treating a human cognitive disorder selected from the group consisting of Alzheimer's disease and mild cognitive impairment (MCI) by means of an implantable signal generator and a lead having a proximal end coupled to the signal generator and a distal portion having at least one electrode, *the method consisting essentially of:*

(a) implanting a stimulation portion of the at least one electrode in a position chosen to stimulate the nucleus basalis of Meynert of a brain;

(b) coupling the proximal end of the lead to the signal generator; and

(c) *treating the cognitive disorder by operating the signal generator to stimulate the nucleus basalis of Meynert.*

Appeal Br., Claims App. (emphases added).

We agree with Appellant (and the Examiner) that Shaffer teaches “the nucleus of basalis of Meynert is treated with both electrical stimulation and chemical stimulation to . . . achieve the accumulation of stem cells in that region.” *Id.* at 7–8; *see also* Answer 8–9. Thus, we are left to decide whether Shaffer's teaching that the nucleus basalis of Meynert is treated with *both* chemical and electrical stimulation anticipates the claimed method *consisting essentially of* treatment by electrical stimulation. For the below reasons, we determine that the Examiner establishes that Shaffer anticipates claim 1.

By using the term “consisting essentially of,” the drafter signals that the invention necessarily includes the listed ingredients and is open to unlisted ingredients that do not materially affect the basic and novel properties of the invention. A “consisting essentially of” claim occupies a middle ground between closed claims that are written in a “consisting of” format and fully open claims that are drafted in a “comprising” format.

PPG Indus. v. Guardian Indus., 156 F.3d 1351, 1354 (Fed. Cir. 1998).

Absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, we interpret “consisting essentially of” as equivalent to “comprising.” *See id.* at 1355. In this case, based on our review, we determine that Appellant fails to clearly indicate that the invention is novel for omitting chemical stimulation, or, restated, that the invention is novel for relying on electrical stimulation without chemical stimulation. As stated by the Examiner, for example, “Appellant’s [S]pecification includes the addition of chemical agents rather than excluding them.” Answer 8, citing Spec. ¶¶ 19, 20; *see also* Answer 9, citing Spec. ¶ 33. Further, we are not convinced by Appellant’s argument that “while the present specification recognizes that treatment with chemical agents might have been employed in some embodiments, [Appellant] ha[s] limited the claims to the primary embodiment where the electrode stimulation is performed without the delivery of chemical agents or other secondary treatments.” Appeal Br. 8–9. We note that Appellant does not direct our attention to anything in the Specification, for example, which establishes persuasively that Appellant’s Specification describes more than one embodiment, or that the claims under appeal are directed to an embodiment that excludes chemical treatment.

Thus, based on the foregoing, we sustain the anticipation rejection of independent claim 1, and the anticipation rejection of claims 4, 5, 7, 19, and 20 that depend from claim 1. Further, we sustain the obviousness rejections of claims 2, 3, and 6–16 that depend from claim 1, inasmuch as Appellant does not separately argue the patentability of these claims.

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DECISION

We AFFIRM the Examiner's anticipation and obviousness rejections of claims 1–16, 19, and 20.

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). *See* 37 C.F.R. § 1.136(a)(1)(iv)(2010).

AFFIRMED