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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARC STEIN and JAMES ELLIS

Appeal 2015-001293
Application 12/825,736
Technology Center 3700

Before DONALD E. ADAMS, JEFFREY N. FREDMAN, and TIMOTHY G. MAJORS, *Administrative Patent Judges*.

PER CURIAM

DECISION ON APPEAL[1]

This Appeal[2] under 35 U.S.C. § 134(a) involves claims 10, 12–16, and 21–34 (Br. 5). Examiner entered rejections under 35 U.S.C. § 112, second paragraph, 35 U.S.C. § 102(b), and 35 U.S.C. § 103(a). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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[1] Appellants identify the real party in interest as Orthosensor Inc. (Br. 4.)
[2] This Appeal is related to Appeal No. 2015-001333, Application No. 12/825,724. Decision affirming the rejections of record entered Oct. 17, 2016.

STATEMENT OF THE CASE

Appellants' invention relates "generally to measurement of physical parameters, and particularly to, but not exclusively to, a hermetically encapsulated sensing module for communicating sensor data and measurements in real-time" (Spec. ¶ 2). More particularly, Appellants' invention relates to "sensing platforms that include [] sensing assemblies [that] can be placed on or within a body" (*id.* ¶ 18). Independent claim 10 is representative and reproduced in the Claims Appendix of Appellants' Brief.

Claims 26–34 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 10, 12–16, 21, 24–30, 33, and 34 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Amirouche.[3]

Claims 22 and 31 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Amirouche and Hershberger.[4]

Claims 23 and 32 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Amirouche and Martinson.[5]

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[3] Amirouche et al., US 2007/0234819 A1, published Oct. 11, 2007.
[4] Hershberger et al., US 5,470,354, issued Nov. 28, 1995.
[5] Martinson et al., US 2006/0271112 A1, published Nov. 30, 2006.

Definiteness:

ISSUE

Should the rejection under 35 U.S.C. § 112, second paragraph be summarily affirmed?

ANALYSIS

Appellants "request[] reconsideration of the arguments and claim amendments of the response of 4 Mar. 2014 to the final office action of 4 Dec 2013" (Br. 6). Examiner explains that "the claim amendments [of Mar. 4, 2014] could not be entered" (Ans. 11).

To the extent that Appellants are contending that the Amendment filed March 4, 2014 should have been entered as a matter of right, Examiner's refusal to enter the amendment at issue is a petitionable matter under 37 C.F.R. § 1.181 and not within the jurisdiction of the Board. 37 C.F.R. § 1.127; *In re Berger*, 279 F.3d 975, 984 (Fed. Cir. 2002) (citing *In re Hengehold*, 440 F.2d 1395, 1403 (CCPA 1971)).

Therefore, we deny Appellants' request to consider their March 4, 2014 amended claims. (Br. 16.) Appellants do not otherwise contest the merits of the rejections under 35 U.S.C. § 112, second paragraph. Therefore, we summarily affirm this rejection.

CONCLUSION OF LAW

The rejection of claims 26–34 under 35 U.S.C. § 112, second paragraph, as being indefinite is affirmed.

Anticipation:

ISSUE

Does the preponderance of evidence on this record support Examiner's finding that Amirouche teaches Appellants' claimed invention?

FACTUAL FINDINGS (FF)

We adopt Examiner's findings concerning the scope and content of the prior art (Ans. 2–20), and repeat the following findings for emphasis.

FF 1. Amirouche suggests

> A system monitors dynamic forces between bearing surfaces. Based on sensed data, the system may model the forces on the bearing surfaces, analyze these forces, store data relating to these forces, and/or transmit data to an external data gathering device. The system includes a first body piece and a second body piece which mate together. The first and second body pieces comprise bearing surfaces that contact a material that may exert a force. A protrusion, such as a pole, post, or beam, extends from first body piece's bearing surface. At least one sensor is disposed on a pole. The at least one sensor detects a mechanical motion of the pole resulting from a force imposed on the body pieces, and generates data indicative of this force. A computer communicates with the at least one sensor and processes the sensed and/or modeled data.

(Amirouche Abstract; *see also* Ans. 5–6.)

FF 2. Amirouche's Figure 3 is reproduced below:

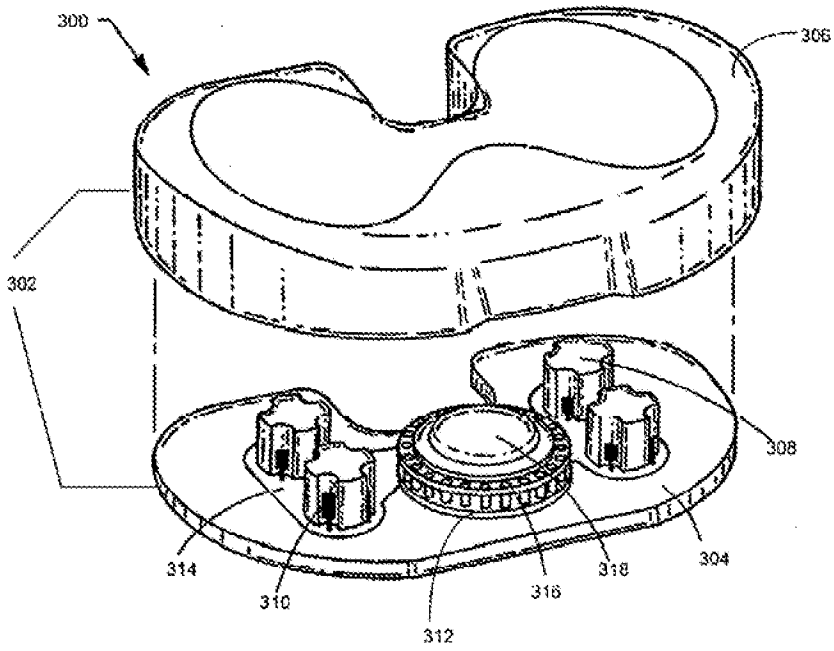

Figure 3

Figure 3 shows that "[a]pplication of a force to first and/or second body pieces **304** and **306** may cause the second body piece **306** to push against the poles **308** thereby causing the poles **308** to undergo a detectible mechanical motion" (Amirouche ¶ 59; *see also* Ans. 5–6), and that "[o]ne or more sensors **310** may comprise a plurality of strain ga[u]ges adapted to generate a voltage in response to dynamic contact forces transferred from the bearing surfaces to poles **308**" (Amirouche ¶ 61; *see also* Ans. 5–6).

FF 3. Amirouche suggests that "[t]he sensed electrical signals generated by the one or more sensors **200** may be supplied to conditioning logic **202** through a signal medium, such as a flexible signal medium" (Amirouche ¶ 52; *see also* Ans. 7).

FF 4. Appellants' Specification suggests that "a final insert device is designed to mimic the function of the natural component it is replacing" (Spec. 6:5–6).

ANALYSIS

Claim 10:

Appellants' independent claim 10 requires, *inter alia*, (a) "a final insert," (b) a "first component [that] has a bearing surface," and (c) a "sensing module" that includes a "sensor," in which "the contacting surface of the sensor is substantially parallel to the bearing surface" (*see* Appellants' claim 10).

We adopt Examiner's findings of fact and reasoning regarding the scope and content of the prior art (Ans. 2–20; FF 1–4) and agree that the claims are anticipated by Amirouche. We address Appellants' arguments below.

Appellants contend that "the contacting surface of [Amirouche's] sensor 310 is clearly not parallel to the bearing surface which would arguably be second body 306" (Br. 18). Appellants argue that "308 in Amirouche is a pole, not a contacting surface of a sensor" (*id.*). Appellants contend that "[t]he sensor 310 is clearly parallel to the post 308, hence any contacting surface of the sensor 310 is parallel to the post length, which is clearly not remotely parallel to the bearing surface (306)" (*id.*).

These arguments are unpersuasive. As Examiner explains, "the claimed contacting surface is not referring to an explicit surface of the sensor, but instead is a surface that has some general relationship with the claimed sensor" (Ans. 18). Examiner further explains that

> Amirouche teaches that the poles (308) act as a medium to receive an applied load and generate a strain, which is then picked up by the sensor (310) to generate a voltage in response to this force (see paragraphs [0060] and [0061]). Therefore, Amirouche's poles (308) and one or more sensors (310) work interdependently with one another, thereby permitting the top surface(s) of poles (308) to be considered a surface of the sensor (310) since the sensor (310) is dependent on the top surface(s) of poles (308) to receive a dynamic force or load and generate a voltage in response. Consequently, Amirouche's top surface(s) of poles (308) may still be considered a surface "of the sensor" because the top surface(s) of the poles (308) are the surface that allows Amirouche's sensor (310) to detect the load.

(*Id.* at 18–19; FF 1–3.)

Appellants argue that "the system of Amirouche is not intended to be a final insert" (Br. 19).

This argument is also unpersuasive. As Examiner explains,

> Final insert appears to mean a structure that can be inserted into the body and that this structure is the final structure to be inserted into the body, instead of a prototype or test structure. Appellants have not provided any rationale as to why Amirouche's enclosure (302) cannot be inserted into the body as a final structure instead of a prototype or test structure.

(Ans. 19; FF 4.) "[C]laims in an application are to be given their broadest reasonable interpretation consistent with the specification and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Sneed*, 710 F.2d 1544, 1548 (Fed. Cir. 1983).

Claims 12 and 26:

> Appellants contend that
>
> since the system of Amirouche does not have an independent load bearing surface, the actual load value and position (claims 12 and 26) can not be determined by the system in Amirouche, instead it determines relative loading. This is clear since part of the load is transferred from the second body 306 directly to the first body 304 and thus that portion is not measured by any sensor. Therefore the system of Amirouche would underestimate any actual value, suggesting the system in Amirouche is more concerned with a balance of forces.

(Br. 18–19).

We are not persuaded. Independent claims 10 and dependent claims 12, and 26 do not require an independent load bearing surface, and do not differentiate between actual load value and position and relative loading. "[L]imitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993). *See also In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) ("[A]ppellant's arguments fail from the outset because . . . they are not based on limitations appearing in the claims."). "Attorney's argument in a brief cannot take the place of evidence." *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974).

Claims 14 and 28:

Examiner finds that "Amirouche further discloses where the sensing assemblage comprises: a compressible waveguide ('flexible signal medium') (paragraph [0052]); and at least one transducer (200, 310) to emit an energy wave into the compressible waveguide and detect a propagated energy wave (paragraphs [0052] and [0061])" (Ans. 7; FF 3).

Appellants contend that

> Amirouche does not show, suggest or teach a sensor comprised of a compressible waveguide with a transducer emitting energy into the waveguide (claims 14 and 28) where this configuration generates a signal related to detected load values. Amirouche discusses using a flexible conductor to carry detected electrical signals where the flexible conductor is not part of the sensor that generates the signals.

(Br. 19–20.)

The Examiner has the better position (*see* Ans. 20). Claims 14 and 28 do not require the compressible waveguide to be separate and distinct from the sensor. *See In re Van Geuns*, 988 F.2d at 1184 and *In re Self*, 671 F.2d at 1348.

CONCLUSION OF LAW

The preponderance of the evidence relied upon by Examiner supports a finding of anticipation.

The rejection of claims 10, 12–16, 21, 24–30, 33, and 34 under 35 U.S.C. § 102(b) as being anticipated by Amirouche is affirmed.

Obviousness:

ISSUE

Does the preponderance of evidence relied upon by Examiner support a conclusion of obviousness?

ANALYSIS

The combination of Amirouche and Hershberger:

Appellants contend that

> Hershberger is directed to a non-final sensor system with bearing elements 88 and 90 have convex curved rocker members 130, 132 on their lower surface. The rocker elements rest on the upper surface 92 of the base member 84 and allow the bearing elements to rock or move angularly relative to the base member when forces are applied at various parts of the upper surfaces of the bearing elements. Therefore the contacting surface of the sensor can not be substantially parallel to the bearing surface since the sensor is stationary while the bearing element can rotate.

(Br. 21.)

We are not persuaded. Appellants' contentions fail to account for Amirouche's contributions to the combination of Amirouche, and Hershberger. "Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references. [The reference] must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole." *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

The combination of Amirouche and Martinson:

Appellants contend that "Martinson is directed to a therapeutic energy propagating or medication delivery system, it is not directed to an orthopedic system" (Br. 22).

We are not persuaded. Appellants' contention fails to account for Amirouche's contributions to the combination of Amirouche and Martinson. *See In re Merck & Co.*, 800 F.2d at 1097.

CONCLUSION OF LAW

The preponderance of the evidence relied upon by Examiner supports a conclusion of obviousness.

The rejection of claims 22 and 31 under 35 U.S.C. § 103(a) as unpatentable over the combination of Amirouche and Hershberger is affirmed.

The rejection of claims 23 and 32 under 35 U.S.C. § 103(a) as unpatentable over the combination of Amirouche and Martinson is affirmed.

TIME PERIOD FOR RESPONSE

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