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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEPHEN D. HEINRICH and WARD M. BROWN

Appeal 2016-002486
Application 13/476,940
Technology Center 3700

Before CHARLES N. GREENHUT, PATRICK R. SCANLON, and
MICHELLE R. OSINSKI, *Administrative Patent Judges*.

OSINSKI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Stephen D. Heinrich and Ward M. Brown (Appellants)¹ appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1, 2, 4–6, 11, 15–35, 37, 42–51, 60, 63–71, 74, 79–84, 90–92, 100, 102–104, 110, 111, 116, and 120–128.² We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Appellants identify the real party in interest as Medtronic, Inc. Appeal Br. 3.

² Claims 3 and 10 are cancelled, and claims 7–9, 12–14, 36, 38–41, 52–59, 61, 62, 72, 73, 75–78, 85–89, 93–99, 101, 105–109, 112–115, and 117–119 are withdrawn from consideration. Amendment (Aug. 19, 2014), 2–29.

THE CLAIMED SUBJECT MATTER

Claims 1, 11, 15–23, 37, 120, and 123–128 are independent. Claim 1, reproduced below, is illustrative of the claimed subject matter on appeal.

1. A system for providing arrhythmia therapy to a patient, comprising:

a can having a surface to deliver high voltage shocks;

an implantable pulse generator housed in the can and configured to generate electrical therapy including high voltage shocks;

a sensing circuit coupled to the implantable pulse generator and configured to sense arrhythmia; and

a subcutaneous electrode array coupled to the implantable pulse generator to deliver electrical therapy to the patient without a transvenous, intracardiac, or epicardial electrode upon detection by the sensing circuit of an arrhythmia.

EVIDENCE

The Examiner relied on the following evidence in rejecting the claims on appeal:

Dahl	US 5,342,407	Aug. 30, 1994
Fischell	US 6,272,379 B1	Aug. 7, 2001
Bardy	US 6,721,597 B1	Apr. 13, 2004

THE PRIORITY ISSUE³

The Examiner determines that prior-filed Application Nos. 11/981,410; 10/949,877; 09/990,045; and 60/252,811 fail to provide

³ The Examiner's determination that prior-filed Application Nos. 11/981,410; 10/949,877; 09/990,045; and 60/252,811 fail to provide adequate written descriptive support or enablement for the limitations relating to "a 'substantially' pliant and directable cannula/means/lead" and

adequate written descriptive support or enablement for one or more of the present claims, namely, those that include (i) “‘without a transvenous, intracardiac, or epicardial electrode’ or similar limitation”; (ii) “sensing electrodes interfacing with low voltage and high impedance circuitry”; and (iii) “a concentrated electrically conductive surface defined about a surface of the housing adapted to face the heart,” such that these claims are not entitled to the benefit of the filing date of the prior-filed applications. Final Act. 2–4.

THE REJECTIONS⁴

- I. Claims 1, 2, 4–6, 11, 15–35, 37, 42–51, 60, 63–71, 74, 79–84, 90–92, 100, 102–104, 110, 111, 116, and 120–128 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. *Id.* at 4–5.
- II. Claims 1, 2, 4–6, 11, 15–35, 37, 42–51, 60, 63–71, 74, 79–84, 90–92, 100, 102–104, 110, 111, 116, and 120–128 stand rejected under 35 U.S.C. § 102(e) as anticipated by Bardy. *Id.* at 7.
- III. Claims 1, 2, 4–6, 11, 15–35, 37, 42–51, 60, 63–71, 74, 79–84, 90–92, 100, 102–104, 110, 111, 116, and 120–128 stand rejected under

“an electrically isolated connector block on a proximal end of the housing” (Non-Final Act. 3) is withdrawn (Ans. 2).

⁴ The Examiner’s rejection of claims 123–128 under 35 U.S.C. § 101 as directed to non-statutory subject matter appears to be moot in view of the indication in the Advisory Action mailed August 26, 2014 that Appellants Reply filed August 19, 2014 has overcome this rejection. Adv. Act. (Aug. 26, 2014), 1.

- 35 U.S.C. § 102(f) because Appellants did not invent the subject matter claimed. *Id.*
- IV. Claims 1, 2, 5, 11, 16–18, 37, 42, 43, 48, 51, 79, 80, 84, 90–92, 100, 103, 104, 111, 120, and 123–128 stand rejected under 35 U.S.C. § 102(e) as anticipated by Fischell. *Id.* at 8.
- V. Claims 1, 2, 4–6, 11, 15–35, 37, 42–51, 60, 63–71, 74, 79–84, 90–92, 100, 102–104, 110, 111, 116, 120 and 123–128 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Fischell and Dahl. *Id.* at 9–14.
- VI. Claims 121 and 122 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bardy or Fischell, either alone or in view of Dahl. *Id.* at 14.

OPINION

The Priority Issue

*“without a transvenous, intracardiac, or epicardial electrode”
or similar limitation*

The Examiner finds that prior-filed Application Nos. 11/981,410; 10/949,877; 09/990,045; and 60/252,811 fail to provide adequate written descriptive support or enablement for the limitation “without a transvenous, intracardiac, or epicardial electrode” or similar limitation, such that one or more of the present claims⁵ are not entitled to the benefit of the filing date of the earlier filed applications. Final Act. 3.

⁵ The Examiner does not identify which claims are not entitled to the benefit of the filing date of the prior-filed applications because of the identified language, but it appears that claims 1, 2, 4–6, 11, 15–35, 37, 42–51, 60, 63–71, 74, 79–84, 90–92, 100, 102–104, 110, 111, 116, and 121–125 are

As we sustain the Examiner’s rejection of claims 1, 2, 4–6, 11, 15–35, 37, 42–51, 60, 63–71, 74, 79–84, 90–92, 100, 102–104, 110, 111, 116, and 121–125 under 35 U.S.C. § 112, second paragraph, as indefinite based on the inclusion, either directly or indirectly, of the phrase “transvenous, intracardiac, or epicardial electrode” or similar limitation (*see infra*), we find it imprudent to speculate as to whether the prior-filed Application Nos. 11/981,410; 10/949,877; 09/990,045; and 60/252,811 provide adequate written descriptive support or enablement for the limitation “without a transvenous, intracardiac, or epicardial electrode” or similar limitation so as to entitle the relevant claims to the benefit of the filing date of the prior-filed applications. *See In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962) (holding that the Board erred in affirming a rejection of indefinite claims because the rejection was based on speculative assumptions as to the meaning of the claims). We find the reasoning in *In re Steele* to be applicable because reaching a decision regarding the priority claim requires that we first understand the metes and bounds of the claims. *Cf. In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971) (One is not in a position to determine whether a claim is enabled under the first paragraph of 35 U.S.C. § 112 until the metes and bounds of that claim are determined under the second paragraph of this section of the statute.).

Because we do not know the metes and bounds of the claims reciting “without a transvenous, intracardiac, or epicardial electrode” or similar limitation, we cannot determine if the subject matter of these claims is

implicated by virtue of their inclusion, either directly or indirectly, of “without a transvenous, intracardiac, or epicardial electrode” or similar limitation.

disclosed in prior-filed Application Nos. 11/981,410; 10/949,877; 09/990,045; and 60/252,811 in the manner provided by 35 U.S.C. § 112, first paragraph, so as to entitle the claims to the benefit of the prior-filed applications' filing dates. *See Ariad Pharm., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (“[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.”).

Consequently, we are constrained to find that the Examiner has failed to adequately show that claims 1, 2, 4–6, 11, 15–35, 37, 42–51, 60, 63–71, 74, 79–84, 90–92, 100, 102–104, 110, 111, 116, and 121–125 are not entitled to the priority of the filing dates of Application Nos. 11/981,410; 10/949,877; 09/990,045; and 60/252,811 based on lack of support for a system “without a transvenous, intracardiac, or epicardial electrode” or similar limitation. We emphasize, 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 evidence or reasoning applied by the Examiner.

*“sensing electrodes interfacing with low voltage
and high impedance circuitry”*

The Examiner finds that prior-filed Application Nos. 11/981,410; 10/949,877; 09/990,045; and 60/252,811 fail to provide adequate written descriptive support or enablement for “sensing electrodes interfacing with

low voltage and high impedance circuitry” “[i]n regards to claims 49 and 50.” Final Act. 3.⁶

As we sustain the Examiner’s rejection of claim 50 under 35 U.S.C. § 112, second paragraph, as indefinite based on the phrase “high voltage and low impedance circuitry” being inferentially included (*see infra*), we find it imprudent to speculate as to whether the prior-filed Application Nos. 11/981,410; 10/949,877; 09/990,045; and 60/252,811 provide adequate written descriptive support or enablement for the this limitation so as to entitle claim 50 to the benefit of the filing date of the prior-filed applications.

Because we do not know the metes and bounds of claim 50 reciting “high voltage and low impedance circuitry,” we cannot determine if the subject matter of this claim is disclosed in prior-filed Application Nos. 11/981,410; 10/949,877; 09/990,045; and 60/252,811 in the manner provided by 35 U.S.C. § 112, first paragraph, so as to entitle claim 50 to the benefit of the prior-filed applications’ filing dates.

⁶ Dependent claim 49 recites that the “electrode [for delivering an electrical therapy to the heart of a patient in a cardioverter-defibrillator] interfaces with high voltage and low impedance circuitry.” Appeal Br. 67 (Claims App.). We agree with Appellants that “claim 49 does not recite sensing electrodes interfacing with low voltage and high impedance circuitry” and that “[t]he Examiner has not asserted . . . that a person skilled in the art would not recognize in Appellants’ disclosure a description of the . . . recitation of claim 49.” *Id.* at 41 n.142. Consequently, we find that the Examiner has failed to adequately show that claim 49 is not entitled to the priority of the filing dates of Application Nos. 11/981,410; 10/949,877; 09/990,045; and 60/252,811 based on lack of “support for sensing electrodes interfacing with low voltage and high impedance circuitry.” Final Act. 3.

Consequently, we are constrained to find that the Examiner has failed to adequately show that claim 50 is not entitled to the priority of the filing dates of Application Nos. 11/981,410; 10/949,877; 09/990,045; and 60/252,811 based on lack of “support for sensing electrodes interfacing with low voltage and high impedance circuitry.” We emphasize, 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 evidence or reasoning applied by the Examiner.

“a concentrated electrically conductive surface defined about a surface of the housing adapted to face the heart”

Dependent claim 92 recites “[a] subcutaneous cardioverter-defibrillator . . . further comprising: a concentrated electrically conductive surface defined about a surface of the biocompatible housing [enclosing and containing cardioversion-defibrillation circuitry] adapted to face the heart.” Appeal Br. 70–71 (Claims App.). The Examiner finds that prior-filed Application Nos. 11/981,410; 10/949,877; 09/990,045; and 60/252,811 fail to provide adequate written descriptive support or enablement for “a concentrated electrically conductive surface defined about a surface of the housing adapted to face the heart” “[i]n regards to claim 92.” Final Act. 3.

Appellants argue that:

the prior-filed applications disclose that the surface of the can or housing of the implantable pulse generator may be divided into different portions, including a shocking surface on one side of the housing that faces muscle tissue, and a different surface including sensing electrodes on the opposite side of the housing, which faces subcutaneous tissue. Because the housing is configured to be implanted subcutaneously between the muscle and subcutaneous tissue, the shocking surface that faces muscle tissue, and is opposite the other surface that faces subcutaneous tissue, is necessarily defined about a surface of the housing that

is adapted to face the heart. Additionally, the shocking surface is concentrated relative to the housing as a whole, because the shocking surface is a defined portion of the housing, electrically isolated from other portions of the housing, such that electrical energy is concentrated or focused at the shocking surface of the housing.

Appeal Br. 34 (citing Application No. 60/252,811, Figs. 1–4; 3:19–26, A-6).

The Examiner replies that “the claimed phrase . . . is not directed to how the electrical energy is concentrated, but directed to the electrically conductive surface.” Ans. 6. We find Appellants’ argument to be persuasive in that the concentration of electrical energy at a particular defined portion of the surface of the housing, relative to the housing as a whole, makes it reasonable for that portion of the surface of the housing to be considered a concentrated electrically conductive surface.

Consequently, we find that the Examiner has failed to adequately show that claim 92 is not entitled to the priority of the filing dates of Application Nos. 11/981,410; 10/949,877; 09/990,045; and 60/252,811 based on lack of “support for a concentrated electrically conductive surface defined about a surface of the housing adapted to face the heart.” Final Act. 3.

Rejection I

Indefiniteness

The Examiner rejects claims 1, 2, 4–6, 11, 15–35, 37, 42–51, 60, 63–71, 74, 79–84, 90–92, 100, 102–104, 110, 111, 116, and 120–128 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Final Act. 4–5. In determining whether a claim is definite under 35 U.S.C. § 112, second paragraph, “[t]he USPTO, in examining an

application, is obliged to test the claims for reasonable precision.” *In re Packard*, 751 F.3d 1307, 1313 (Fed. Cir. 2014). “[A] claim is indefinite when it contains words or phrases whose meaning is unclear.” *Id.* at 1322 (citing MPEP § 2173.05(e)).

Claims 1, 2, 4–6, 11, 15–35, 37, 42–51, 60, 63–71, 74, 79–84, 90–92, 100, 102–104, 110, 111, 116, and 120–122

The Examiner finds that “it is unclear what a ‘transvenous, intracardiac, or epicardial’ electrode exactly is, since all electrodes are conductive pieces of material.” Final Act. 4.⁷ Appellants argue that the identified phrase is “no less definite, nor less able to particularly point out and distinctly claim the subject matter which Appellants regard as the invention than [it was] in the applications that granted as the Bardy . . . patent[]” from which the claims were copied. Appeal Br. 47 (citing *Andrew Corp. v. Gabriel Electronics*, 847 F.2d 819, 822 (Fed. Cir. 1988)).

We understand the problem with the identified language of the claims to be that it is unclear, for example, in the context of independent claims 1 and 11, whether the subcutaneous electrode array coupled to the implantable pulse generator to deliver electrical therapy to the patient without a transvenous, intracardiac, or epicardial electrode is intended to be a specific structural limitation on the electrode array (e.g., the subcutaneous electrode array lacks a structurally unique electrode used exclusively for transvenous, intracardiac, or epicardial placement) or a functional limitation of the

⁷ The Examiner does not identify which claims are rendered indefinite because of the identified phrase, but it appears that claims 1, 2, 4–6, 11, 15–35, 37, 42–51, 60, 63–71, 74, 79–84, 90–92, 100, 102–104, 110, 111, 116, 121, and 122 are implicated by virtue of their inclusion, either directly or indirectly, of the identified phrase (or similar phrase).

electrode array, (e.g., the subcutaneous electrode array is functional to deliver electrical therapy to the patient without the need to place any electrode transvenously, intracardially, or epicardially). Similar problems arise with respect to independent claims 15–23 and 37, which recite “the absence of a transvenous, intracardiac, or epicardial electrode”; or “without a transvenous, intracardiac or epicardial electrode.” Stated differently, it is not clear on the evidentiary record before us precisely why or when an electrode may be characterized as a “subcutaneous electrode” as compared to a “transvenous, intracardiac, or pericardial electrode.” One possibility is that an electrode may be characterized as being of one of the mentioned types based on its placement in the patient. In such a case the potential infringer would not know whether the claim is infringed until the method of using the system is practiced. Including what effectively amounts to a requirement to practice a particular method in a system claim seemingly directed to a machine, a different statutory class of subject matter, obfuscates the scope of the claim and renders it unclear to the potential infringer precisely when the claim is infringed. Another possible interpretation of the language in question is that there are some inherent structural meanings that are implied by using terms like “subcutaneous,” “transvenous,” “intracardiac,” and “pericardial” when those terms modify the term “electrode.” The problem with this possibility is that, on the record presently before us, no such meanings are evident. *See* Final Act. 15 (Where the Examiner is unable to discern what structurally distinguishes electrodes for transvenous, intracardiac, and epicardial placement from electrodes for subcutaneous placement, stating, “both are merely conductive pieces of metal.”) (emphasis omitted). Further clarification of the meaning of these

terms is required before we can proceed to analyze this limitation for purposes of satisfying the disclosure requirements.

As to the case law cited by Appellants, that case dealt with different claim language and is not dispositive on the issue before us. *Andrew Corp.*, 847 F.2d at 821 (court finding that the terms “substantially equal” and “closely approximate” were “ubiquitous in patent claims”). Moreover, *Andrew Corp.* was a patent infringement case, where claims are entitled to a presumption of validity, whereas no such presumption attaches in prosecution of patent applications before the U.S. Patent and Trademark Office. *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). “An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.” *In re Zletz*, 893 F.2d 319, 322 (Fed. Cir. 1989).

Accordingly, we do not find that the Examiner erred in finding that the scope of the claim is not reasonably ascertainable by those skilled in the art. We sustain the rejection of claims 1, 2, 4–6, 11, 15–35, 37, 42–51, 60, 63–71, 74, 79–84, 90–92, 100, 102–104, 110, 111, 116, 121, and 122 under 35 U.S.C. § 112, second paragraph, based on the inclusion of the phrase “transvenous, intracardiac, or epicardial electrode” either directly or indirectly.

The Examiner further determines that “[i]n claim 120, ‘without venous or epicardial access’ is vague since this is directed to how the lead is implanted and not directed to a[] particular structure of the lead.” Final Act. 4. The Examiner also finds the phrases (i) “electrical therapy” in claims 16, 17, 19, 21, 22, 37, 90, 120; (ii) “an electrically isolated connector block” in

claims 17, 19, 20–22, 120; (iii) “internal interfacing means” of claim 18; (iv) “anti-arrhythmic waveform” of claim 20; (v) “sensing circuitry” of claims 21, 22, 91; and (vi) “high voltage and low impedance circuitry” of claims 49, 50 to be vague and/or inferentially included. *Id.* at 5. The Examiner also finds the phrases (i) “an autonomously detected arrhythmic condition” of claims 18, 20–22 and (ii) “upon detection of a certain event” of claims 45, 46, 82, 83, to make the claim incomplete for omitting an element to do this. *Id.*

Despite differences in the limitations in question, Appellants rely on the same argument based on *Andrew Corp.* case law that we found unpersuasive in connection with the rejection based on the inclusion of the phrase “transvenous, intracardiac, or epicardial electrode.” Appeal Br. 45–47. It is noted that arguments must address the Examiner’s action with particularity. 37 C.F.R. § 41.37(c)(1)(iv) (“The arguments shall explain why the examiner erred as to each ground of rejection contested by appellant”). The Board will not advocate for Appellants by scouring the record to see if the Board can identify some flaw in the Examiner’s findings of fact, articulated reasoning, or legal conclusions. *See, e.g., Halliburton Energy Services, Inc. v. M-ILLC*, 514 F.3d 1244, 1250 n.2 (Fed. Cir. 2008). Accordingly, we do not find that the Examiner erred in finding that the scope of the claim is not reasonably ascertainable by those skilled in the art, and we sustain the rejection of claims 16–22, 37, 45, 46, 49, 50, 82, 83, 90, 91, 120 under 35 U.S.C. § 112, second paragraph, based on the inclusion of the various phrases identified above.

Claims 123–125

Claims 123–125 recite “the absence of a transvenously-implanted electrode, an intracardially-implanted electrode, or an epicardially-implanted electrode.” Appeal Br. 73–75 (Claims App.). The Examiner determines that “claims 123–12[5] have limitations directed to ‘implanted’ electrodes and how the lead is implanted and not to a particular structural limitation.” Final Act. 5. Appellants argue that “claim language that is not a structural limitation is not *per se* indefinite.” Appeal Br. 48. Appellants further argue that the applicable standard is not whether “the Examiner believes the claim could be more clear,” but rather whether the claim is reasonably precise. *Id.*

Similar to analysis of the phrase “transvenous, intracardiac, or epicardial electrode,” we find it unclear whether the phrase “the absence of a transvenously-implanted electrode, an intracardially-implanted electrode, or an epicardially-implanted electrode” is intended to be a specific structural limitation on the cardioverter-defibrillator (e.g., it lacks a structurally unique electrode used exclusively for transvenous, intracardiac, or epicardial implantation) or a functional limitation of the cardioverter-defibrillator (e.g., it is functional to deliver electrical cardioversion-defibrillation energy without the need to implant any electrode transvenously, intracardially, or epicardially).

Accordingly, we do not find that the Examiner erred in concluding that the scope of the claim is not reasonably ascertainable by those skilled in the art. We sustain the rejection of claims 123–125 under 35 U.S.C. § 112, second paragraph, based on the inclusion of the phrase “the absence of a transvenously-implanted electrode, an intracardially-implanted electrode, or an epicardially-implanted electrode.”

Claims 126–128

Claim 126 recites that “each electrode of the subcutaneous implantable cardioverter-defibrillator . . . is configured to be implanted subcutaneously on one of the chest, left chest, back, or side of a patient.” Appeal Br. 75 (Claims App.). Claims 127 and 128 recite similar limitations. *Id.* at 75–76. The Examiner determines that “claims 12[6]–128 have limitations directed to ‘implanted’ electrodes and how the lead is implanted and not to a particular structural limitation.” Final Act. 5. Appellants argue that “the configuration of the electrodes to be implanted as recited in claims 126–128 is a structural limitation of the electrodes.” Appeal Br. 48–49.

We agree that the phrase “configured to” denotes a state of configuration that makes possible the subcutaneous implantation on one of the chest, left chest, back, or side of patient. We do not consider the identified claim phrasing to raise the same questions regarding the scope of the claim as the related previously-identified phrasing of the earlier claims.

Accordingly, we find that the Examiner erred in concluding that the scope of the claim is not reasonably ascertainable by those skilled in the art. We do not sustain the rejection of claims 126–128 under 35 U.S.C. § 112, second paragraph, based on the inclusion of the phrase “electrode . . . configured to be implanted subcutaneously on one of the chest, left chest, back, or side of a patient.”

Rejection II

Anticipation by Bardy

Claims 1, 2, 4–6, 11, 15–35, 37, 42–51, 60, 63–71, 74, 79–84, 90–92, 100, 102–104, 110, 111, 116, and 120–125

Claims 1, 2, 4–6, 11, 15–35, 37, 42–51, 60, 63–71, 74, 79–84, 90–92, 100, 102–104, 110, 111, 116, and 120–125 stand rejected under 35 U.S.C.

§ 102(e) as anticipated by Bardy. Final Act. 7. We do not sustain the Examiner's rejection of these claims. For the reasons discussed above, claims 1, 2, 4–6, 11, 15–35, 37, 42–51, 60, 63–71, 74, 79–84, 90–92, 100, 102–104, 110, 111, 116, and 120–125 are indefinite. Before a proper review of this rejection can be performed, the subject matter encompassed by the claims on appeal must be reasonably understood without resort to speculation. Therefore, since these claims fail to satisfy the requirements of 35 U.S.C. § 112, second paragraph, we are constrained to reverse the prior art rejection because it necessarily is based on speculative assumptions as to the scope of the claims. *See In re Steele*, 305 F.2d at 862–63 (CCPA 1962). We emphasize, 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 rejection.

Claims 126–128

Claims 126–128 also stand rejected under 35 U.S.C. § 102(e) as anticipated by Bardy. Final Act. 7. These claims do not include any of the phrasing that the Examiner found lacked support in the prior-filed applications. *See* Final Act. 2–3; Appeal Br. 75–76 (Claims App.). Because the Examiner has failed to adequately show that claims 126–128 are not entitled to the priority of the filing dates of Application Nos. 11/981,410; 10/949,877; 09/990,045; and 60/252,811, the Examiner has failed to show that Bardy qualifies as prior art under 35 U.S.C. § 102(e). Therefore, we cannot sustain the rejection of claims 126–128 as anticipated by Bardy.

Rejection III

Derivation

Claims 1, 2, 4–6, 11, 15–35, 37, 42–51, 60, 63–71, 74, 79–84, 90–92, 100, 102–104, 110, 111, 116, and 120–128 stand rejected under 35 U.S.C. § 102(f) because Appellants did not invent the subject matter claimed. Final Act. 7. The basis for the Examiner’s rejection is that Bardy has an earlier effective filing date and meets the limitations of the claims. *Id.*

Our finding that the Examiner has failed to adequately show that claims 1, 2, 4–6, 11, 15–35, 37, 42–51, 60, 63–71, 74, 79–84, 90–92, 100, 102–104, 110, 111, 116, and 120–125 are not entitled to the priority of the filing dates of Application Nos. 11/981,410; 10/949,877; 09/990,045; and 60/252,811 because of the indefiniteness of the claimed subject matter also constrains us to reverse the rejection of these claims under 35 U.S.C. § 102(f) because it necessarily is based on speculative assumptions as to the scope of the claims when analyzing priority.

As to claims 126–128, the Examiner has failed to adequately show that these claims are not entitled to the priority of the filing dates of Application Nos. 11/981,410; 10/949,877; 09/990,045; and 60/252,811 because these claims do not include any of the phrasing that the Examiner found lacked support in the prior-filed applications. *See* Final Act. 2–3; Appeal Br. 75–76 (Claims App.). This is dispositive as to the rejection of these claims under 35 U.S.C. § 102(f).

Rejections IV–VI

*Anticipation by, or Obviousness over, Fischell
(Either Alone or With Other References)*

The Examiner rejects claims 1, 2, 5, 11, 16–18, 37, 42, 43, 48, 51, 79, 80, 84, 90–92, 100, 103, 104, 111, 120, and 123–128 under 35 U.S.C.

§ 102(e) as anticipated by Fischell. Final Act. 8. The Examiner also rejects claims 1, 2, 4–6, 11, 15–35, 37, 42–51, 60, 63–71, 74, 79–84, 90–92, 100, 102–104, 110, 111, 116, and 123–128 under 35 U.S.C. § 103(a) as unpatentable over Fischell and Dahl. *Id.* at 9–14. The Examiner rejects claims 121 and 122 under 35 U.S.C. § 103(a) as unpatentable over Bardy or over Fischell, either alone or in view of Dahl. *Id.* at 14.

We do not sustain the Examiner’s rejections of claims 1, 2, 4–6, 11, 15–35, 37, 42–51, 60, 63–71, 74, 79–84, 90–92, 100, 102–104, 110, 111, 116, and 120–125. For the reasons discussed above, these claims are indefinite. Before a proper review of these rejections can be performed, the subject matter encompassed by the claims on appeal must be reasonably understood without resort to speculation. Therefore, since these claims fail to satisfy the requirements of 35 U.S.C. § 112, second paragraph, we are constrained to reverse the prior art rejections because they necessarily are based on speculative assumptions as to the scope of the claims. *See In re Steele*, 305 F.2d at 862–63 (CCPA 1962). We emphasize, 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 rejections.

With respect to claims 126–128, we are not precluded from addressing the prior art rejections because we do not sustain the rejection of claims 126–128 under 35 U.S.C. § 112, second paragraph, as indefinite. Thus, we need not speculate about the meaning of the language of the claims to consider the merits of the rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a). Appellants’ sole argument as to the prior art rejection is that the “claims are no less novel when presented in the present application

by Appellants . . . than they were when presented in the . . . granted Bardy . . . patents” from which they were copied. Appeal Br. 51, 52. The allowability of other patents is irrelevant to the merits of the Examiner’s rejection in this case and does not persuade us of error by the Examiner. *See, e.g., In re Gyurik*, 596 F.2d 1012, 1016 n.15 (CCPA 1979) (“Each case is determined on its own merits. In reviewing specific rejections of specific claims, this court does not consider allowed claims in other applications or patents.”).

For the foregoing reasons, we do not find that the Examiner erred in finding that Fischell anticipates claims 126–128 or in concluding that Fischell and Dahl render obvious claims 126–128. We sustain the rejection of claims 126–128 under 35 U.S.C. § 102(b) as anticipated by Fischell and the rejection of claims 126–128 under 35 U.S.C. § 103(a) as unpatentable over Fischell and Dahl.

DECISION

The Examiner’s decision that prior-filed Application Nos. 11/981,410; 10/949,877; 09/990,045; and 60/252,811 do not provide adequate written descriptive support or enablement for the claimed invention such that one or more of the present claims are not entitled to the benefit of the filing date of the prior-filed applications is reversed.⁸

⁸ The Examiner does not identify which claims purportedly are not entitled to the benefit of the filing date of the prior-filed applications, but it appears that claims 1, 2, 4–6, 11, 15–35, 37, 42–51, 60, 63–71, 74, 79–84, 90–92, 100, 102–104, 110, 111, 116, and 121–125 are implicated by virtue of their inclusion, either directly or indirectly, of the language identified as lacking support in the Priority Section of the Final Action (i.e., “without a

The Examiner's decision to reject claims 1, 2, 4-6, 11, 15-35, 37, 42-51, 60, 63-71, 74, 79-84, 90-92, 100, 102-104, 110, 111, 116, and 120-125 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention is affirmed.

The Examiner's decision to reject claims 126-128 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention is reversed.

The Examiner's decision to reject claims 1, 2, 4-6, 11, 15-35, 37, 42-51, 60, 63-71, 74, 79-84, 90-92, 100, 102-104, 110, 111, 116, and 120-128 under 35 U.S.C. § 102(e) as anticipated by Bardy is reversed.

The Examiner's decision to reject claims 1, 2, 4-6, 11, 15-35, 37, 42-51, 60, 63-71, 74, 79-84, 90-92, 100, 102-104, 110, 111, 116, and 120-128 under 35 U.S.C. § 102(f) because Appellants did not invent the subject matter claimed is reversed.

The Examiner's decision to reject claims 1, 2, 5, 11, 16-18, 37, 42, 43, 48, 51, 79, 80, 84, 90-92, 100, 103, 104, 111, 120, and 123-125 under 35 U.S.C. § 102(e) as anticipated by Fischell is reversed.

The Examiner's decision to reject claims 126-128 under 35 U.S.C. § 102(e) as anticipated by Fischell is affirmed.

The Examiner's decision to reject claims 1, 2, 4-6, 11, 15-35, 37, 42-51, 60, 63-71, 74, 79-84, 90-92, 100, 102-104, 110, 111, 116, 120, and

transvenous, intracardiac, or epicardial electrode' or similar limitation"; "sensing electrodes interfacing with low voltage and high impedance circuitry"; or "a concentrated electrically conductive surface defined about a surface of the housing adapted to face the heart"). Final Act. 3.

Appeal 2016-002486
Application 13/476,940

123–125 under 35 U.S.C. § 103(a) as unpatentable over Fischell and Dahl is reversed.

The Examiner’s decision to reject claims 126–128 under 35 U.S.C. § 103(a) as unpatentable over Fischell and Dahl is affirmed.

The Examiner’s decision to reject claims 121 and 122 under 35 U.S.C. § 103(a) as unpatentable over Bardy or over Fischell, either alone or in view of Dahl is reversed.

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)(iv).

AFFIRMED⁹

⁹ “The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed.” 37 C.F.R. § 41.50(a)(1).