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EXAMINER	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CARL D. WAHLSTRAND

Appeal 2017-009543
Application 14/693,088
Technology Center 3700

Before MICHAEL L. HOELTER, JEREMY M. PLENZLER, and BRANDON J. WARNER, *Administrative Patent Judges*.

PLENZLER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant[1] appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1–12. Non-Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE and enter a NEW GROUND OF REJECTION in accordance with 37 C.F.R. § 41.50(b).

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[1] We use the word "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Medtronic, Inc. Appeal Br. 3.

THE CLAIMED SUBJECT MATTER

Claims 1 and 6 are independent. Claims 2–5 depend from claim 1. Claims 7–12 depend from claim 6. Claim 1 is reproduced below.

> 1. A tissue stimulation system, comprising:
>
> at least one implantable neurostimulation lead; and
>
> an implantable neurostimulator comprising a header having at least one connector assembly configured for respectively receiving the at least one neurostimulation lead, a circuit board having programming circuitry, a flex circuit coupled between the at least one connector assembly and the circuit board, and a case to which the header is coupled, the case including a hermetically sealed compartment enclosing the circuit board and the flex circuit.

REJECTIONS[2]

References	Basis	Claims
Hornfeldt[3]	§ 102(a)(1)	1–12
Funderburk Patent[4]	§ 102(a)(2)	1–12
Funderburk PGPUB[5]	§ 102(a)(1)	1–12

OPINION

The claims each recite a "flex circuit." Much of the dispute between Appellant and the Examiner concerns the meaning of the term "flex circuit." The Examiner, for example, determines that "[a] flex circuit is considered to

[2] A number of rejections were withdrawn in the Examiner's Answer. Ans. 3.
[3] US 2005/0228456 A1, published Oct. 13, 2005.
[4] US 8,738,138 B2, issued May 27, 2014.
[5] US 2012/0221074 A1, published Aug. 30, 2012.

be an electrical circuit that is flexible." Non-Final Act. 3. Appellant faults the Examiner for "provid[ing] no evidence of record to support the assertion that 'a flex circuit is considered to be an electrical circuit that is flexible.'" Appeal Br. 10. Appellant contends that "one of ordinary skill in the art would understand the flexible tape interconnect 66 [from its Specification] is a 'flex circuit.'" *Id.* at 9. Appellant, however, is guilty of the same offense alleged against the Examiner (i.e., providing no record evidence to support its proposed construction of how one of ordinary skill in the art would understand the term "flex circuit").

Appellant's Specification does not use the term "flex circuit." There is also no evidence in the record, from the Examiner or Appellant, supporting either proposed construction of "flex circuit." Based on the record before us, both constructions seem equally plausible. Accordingly, we reject claims 1–12 under 35 U.S.C. § 112(b) as indefinite. *See Ex parte Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008) (precedential) ("[I]f a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112[(b)], as indefinite.").

Because we determine the claims to be indefinite, and addressing the disputed "flex circuit" limitation would require speculation on our part, we do not reach the merits of the anticipation rejections. Instead, we reverse those rejections *pro forma*. *See In re Aoyama*, 656 F.3d 1293, 1300 (Fed. Cir. 2011) (holding that the Board erred in affirming an anticipation rejection of indefinite claims); *In re Steele*, 305 F.2d 859, 862 (CCPA 1962) (holding that the Board erred in affirming a rejection of indefinite claims

under 35 U.S.C. § 103(a), because the rejection was based on speculative assumptions as to the meaning of the claims).

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	References/ Basis	Affirmed	Reversed	New Ground
1–12	102(a)(1)	Hornfeldt		1–12	
1–12	102(a)(2)	Funderburk Patent		1–12	
1–12	102(a)(1)	Funderburk PGPUB		1–12	
1–12	112(b)	Indefiniteness			1–12
Overall Outcome				1–12	1–12

Pursuant to our authority under 37 C.F.R. § 41.50(b), we enter a new ground of rejection of claims 1–12 under 35 U.S.C. § 112(b).

Section 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." Section 41.50(b) also provides that Appellant, 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.

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

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

REVERSED; 37 C.F.R. § 41.50(b)