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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEFAN B. NIELSEN¹

Appeal 2018-005808
Application 14/768,779
Technology Center 3700

Before BRETT C. MARTIN, ANNETTE R. REIMERS, and
WILLIAM A. CAPP, *Administrative Patent Judges*.

REIMERS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner’s decision to reject under 35 U.S.C. § 102(b) claims 2–5, 11, 12, and 15–17 as anticipated by Gibson ’156 (US 7,937,156 B2, issued May 3, 2011) and under 35 U.S.C. § 103(a): (1) claims 6–10, 13, and 14 as unpatentable over Gibson ’156 and Hakansson (US 2009/0209806 A1, published Aug. 20, 2009); (2) claim 9 as unpatentable over Gibson ’156, Hakansson, and

¹ Med-El Elektromedizinische GmbH (“Appellant”), is the applicant as provided under 37 C.F.R. § 1.46 and is identified as the real party in interest. Appeal Brief 2 (“Appeal Br.”), filed Dec. 11, 2017.

Gibson '058 (US 8,255,058 B2, issued Aug. 28, 2012); and (3) claim 18 as unpatentable over Gibson '156 and Osorio (US 7,346,391 B1, issued Mar. 18, 2008). Appellant presents additional evidence in the Declaration of Stefan B. Nielsen (“Nielsen Declaration”) filed under 37 C.F.R. § 1.132 on June 30, 2017.² Claim 1 has been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

CLAIMED SUBJECT MATTER

The claimed subject matter “relates to hearing implant systems such as cochlear implant systems.” Spec. ¶ 2, Figs. 3A–3E.

Claim 2, the sole independent claim on appeal, is representative of the claimed subject matter and recites:

2. A cochlear implant arrangement comprising:

an implant housing containing a stimulation processor for processing externally produced communications signals to generate electrical stimulation signals for the cochlea of an implant patient, the implant housing lying substantially in a plane and having an outer perimeter adapted to fit within a surgically prepared housing recess in skull bone of the implant patient; and

a plurality of housing fixation features located on the outer perimeter, the housing fixation features being adapted to cooperate to develop lateral force in the plane of the implant housing between the implant housing and radially adjacent skull bone of the housing recess to fixedly secure the implant housing within the housing recess,

wherein the housing fixation features include one or more fixed contact features located toward one side of the outer

² The Declarant, Stefan B. Nielsen, is also the inventor in the subject application.

perimeter and one or more elastic spring features located towards another side of the outer perimeter.

ANALYSIS

Anticipation by Gibson '156

Claims 2–5, 11, 12, and 15–17

Independent claim 2 is directed to a cochlear implant including an implant housing having fixation features “adapted to cooperate to develop lateral force in the plane of the implant housing between the implant housing and radially adjacent skull bone of the housing recess,” “wherein the housing fixation features include one or more fixed contact features located toward one side of the outer perimeter [of the implant housing] and one or more elastic spring features located towards another side of the outer perimeter [of the implant housing].” Appeal Br. 10, Claims App. The Examiner takes the position that “Gibson is able to meet the intended use recitations presented in the claims and that Gibson is able to do this by being used differently than how Gibson intended his device to be used.” *See* Final Act. 8–9; *see also id.* at 3–5; Ans. 3–5.³ In particular, the Examiner finds:

If Gibson’s housing was placed in a skull recess that was no wider than the flanges, but no less than the housing, Gibson’s elastomeric/springy flanges would develop lateral forces in the plane of the housing to secure the implant within the recess due to the location of the flanges and elastomeric/springy flanges being squeezed.

Final Act. 3–4; *see also id.* at 8–9; Ans. 3–5.

³ Final Office Action (“Final Act.”), dated July 24, 2017; Examiner’s Answer (“Ans.”), dated Mar. 22, 2018.

Claim 2 requires at least one fixed contact feature “located toward *one side* of the outer perimeter” of the implant housing and at least one elastic spring feature “located towards *another side* of the outer perimeter” of the implant housing be “adapted to cooperate to develop lateral force in the plane of the implant housing between the implant housing and radially adjacent skull bone of the housing recess.” *See* Appeal Br. 10, Claims App. (emphasis added).

In the subject application, fixed feature 204, located on “one side” of the outer perimeter of implant housing 201, “cooperates” with elastic feature 203, located on “another side” of the outer perimeter of implant housing 201, “to develop lateral force” in the plane of implant housing 201 between implant housing 201 and radially adjacent skull bone 301 of housing recess 302. *See* Spec. ¶ 38, Figs. 3A–3E; *see also* Appeal Br. 5–6. Although the phrase “adapted to” can mean “capable of” or “suitable for,” here the written description in the Specification indicates “adapted to” means that the fixed feature and the elastic feature of the subject device are “designed to” or “constructed to” perform the claimed function, i.e., “cooperate to develop lateral force in the plane of the implant housing between the implant housing and radially adjacent skull bone of the housing recess.” *In re Giannelli*, 739 F.3d 1375, 1379 (Fed. Cir. 2014); *Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.*, 672 F.3d 1335, 1349 (Fed. Cir. 2012); *see also* Reply Br. 1–2; Appeal Br. 10, Claims App. (emphasis added).⁴

⁴ Reply Brief (“Reply Br.”), filed May 21, 2018.

In Gibson '156, “shafts **404** are threadedly mounted to respective flanges **405A**, **405B**.” Gibson '156, 7:24–26, Figs. 4A–4C. In other words, shafts (fixed features) 404 and flanges (elastic features) 405 are located on the “same side” of the implant housing. Given that shafts (fixed features) 404 and flanges (elastic features) 405 of Gibson '156 are located on the “same side” of the outer perimeter of implant housing 400, we fail to see and the Examiner fails to adequately explain *how* shafts (fixed features) 404 and flanges (elastic features) 405 are adapted to “cooperate to develop lateral force” in the plane of implant housing 400 between implant housing 400 and radially adjacent skull bone 206 of housing recess 414. *See* Final Act. 3–5, 8–9; *see also* Ans. 3–5; Reply Br. 2; Appeal Br. 5–7; Nielsen Declaration ¶ 10; Gibson '156, Figs. 4A–4C. Thus, the Examiner fails to establish by a preponderance of the evidence that Gibson '156's cochlear implant device anticipates the cochlear implant device of claim 2 of the subject application.

For these reasons, we do not sustain the Examiner's rejection of independent claim 2 and its dependent claims 3–5, 11, 12, and 15–17 as anticipated by Gibson '156.

Obviousness over Gibson '156 and Hakansson, Gibson '156, Hakansson, and Gibson '058, or Gibson '156 and Osorio
Claims 6–10, 13, 14, and 18

The Examiner's obviousness rejections of claims 6–10, 13, 14, and 18 are each based on the same unsupported findings discussed above with respect to independent claim 2. *See* Final Act. 5–7. The Examiner does not rely on Hakansson, Gibson '058, or Osorio to remedy the deficiencies of

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Gibson '156. Accordingly, for reasons similar to those discussed above for claim 2, we do not sustain the Examiner's obviousness rejections of claims 6–10, 13, 14, and 18.

DECISION

We REVERSE the decision of the Examiner to reject claims 2–5, 11, 12, and 15–17 under 35 U.S.C. § 102(b).

We REVERSE the decision of the Examiner to reject claims 6–10, 13, 14, and 18 under 35 U.S.C. § 103(a).

REVERSED