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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/017,790	02/08/2016	Anthony John Ujhazy	RESMED 3.9-050 CCC (1271)	4349

147311 7590 03/24/2020

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EXAMINER	
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ART UNIT	PAPER NUMBER
3792	

NOTIFICATION DATE	DELIVERY MODE
03/24/2020	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANTHONY JOHN UJHAZY,
JONATHAN CALDWELL WRIGHT, GLENN RICHARDS,
DAVID JOHN BASSIN, and MICHAEL BERTHON-JONES

Appeal 2018-006939
Application 15/017,790
Technology Center 3700

Before JOHN C. KERINS, WILLIAM A. CAPP and
GEORGE R. HOSKINS, *Administrative Patent Judges*.

KERINS, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant[1] appeals from the Examiner's decision to reject claims 1–6, 8–11, 14–35, 37–40, and 43–58. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE, and enter a NEW GROUND OF REJECTION under 37 C.F.R. § 41.50(b).

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[1] The term "Appellant" is used herein to refer to "applicant" as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as ResMed Limited. Appeal Br. 2.

THE CLAIMED SUBJECT MATTER

Appellant's invention relates to a method and apparatus for evaluating heart failure in a patient. Claim 1 is illustrative, and is reproduced below:

> 1. A method for evaluating heart failure in a patient comprising steps of:
>
> delivering, by a blower, breathable gas at a pressure above atmospheric to a patient;
>
> detecting, by a controller, obstructive events experienced by the patient;
>
> varying, by the blower, the pressure of the breathable gas responsive to obstructive events detected by the controller;
>
> calculating a heart failure indicator from said responsive pressure variations, said heart failure indicator representing information about the patient's heart condition; and
>
> comparing said heart failure indicator to a prior heart failure indicator determined during a previous treatment session,
>
> > wherein said heart failure indicator is analysed to determine a change in said heart failure indicator over time,
> >
> > wherein said change is a difference between said prior heart failure indicator of said previous treatment session and said heart failure indicator.

THE REJECTIONS

The Examiner rejects:

(i) claims 1–3, 5, 6, 8–11, 14–16, 25–32, 34, 35, 37–40, 43–45, and 54–58 under 35 U.S.C. § 103(a) as being unpatentable over Estes (US 5,794,615, issued Aug. 18, 1998) in view of Cho (US 2004/0134496 A1, published July 15, 2004);

(ii) claims 17–24 and 46–53 under 35 U.S.C. § 103(a) as being unpatentable over Estes in view of Cho and Greenhut (US 6,454,719 B1, issued Sept. 24, 2002);

(iii) claims 4 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Estes in view of Cho and Foulkes (US 5,846,720, issued Dec. 8, 1998); and

(iv) claims 1–6, 8–11, 14–35, 37–40, and 43–58 on the ground of nonstatutory double patenting as being unpatentable over claims 1–31 of Ujhazy (US 9,283,341 B2, issued Mar. 15, 2016).

ANALYSIS

Claims 1–3, 5, 6, 8–11, 14–16, 25–32, 34, 35, 37–40, 43–45, and 54–58--35 U.S.C. § 103(a)--Estes/Cho

We agree with Appellant that the Examiner has not adequately shown how the combined teachings of Estes and Cho disclose, suggest, or render obvious the limitations in independent claims 1 and 30 requiring the calculation of a heart failure indicator from pressure variations produced by a blower in response to detected obstructive events. Indeed, it appears that the Examiner does not regard these claims as including such a limitation, as evidenced by the reasoning in the Answer that, "[e]ven if the claims required calculating a heart failure indicator from the air pressure applied to the patient, the pressure delivered to the patient is a function of the patient flow rate, as mentioned supra." Ans. 7. It is possible that, in the Examiner's mind, because pressure delivered and patient flow rate have such a

relationship,[2] it would have been obvious to calculate a heart failure indicator from blower pressure changes instead of from measurements of patient flow rate, but the Examiner has not sufficiently closed that loop in the Final Action or Answer.

Accordingly, the rejection of the above-listed claims as being unpatentable over Estes and Cho is not sustained.

Claims 17–24 and 46–53--35 U.S.C. § 103(a)--Estes/Cho/Greenhut

The Examiner does not rely on Greenhut in any manner that cures the deficiency noted above with respect to the combination of Estes and Cho. Accordingly, the rejection of claims 17–24 and 46–53 as being unpatentable over Estes, Cho, and Greenhut is not sustained.

Claims 4 and 33--35 U.S.C. § 103(a)--Estes/Cho/Foulkes

The Examiner does not rely on Foulkes in any manner that cures the deficiency noted above with respect to the combination of Estes and Cho. Accordingly, the rejection of claims 4 and 33 as being unpatentable over Estes, Cho, and Foulkes is not sustained.

Claims 1–6, 8–11, 14–35, 37–40, and 43–58--Nonstatutory Obviousness-type Double Patenting over claims 1–31 of Ujhazy

Appellant responds to the obviousness-type double patenting rejection by requesting that a decision on the rejection be held in abeyance until such time, if any, an indication of allowable subject matter is made of record. *See*

[2] The Examiner continues the line of reasoning by characterizing pressure delivered and patient flow rate to be analogous to each other. Ans. 7.

Appeal Br. 12. In the Answer, the Examiner does not withdraw the rejection, but also does not respond to Appellant's request that the decision on the rejection be held in abeyance. Ans., *passim*. The rejection is lacking in a detailed comparison of the limitations appearing in any of claims 1–31 of Ujhazy to limitations appearing in any of the claims on appeal. Final Act. 6. In addition, the outcome of this appeal involves a rejection of all claims, with no allowable subject matter currently indicated. The scope of any allowable claim is therefore yet to be determined. We therefore find it appropriate to not reach the merits of this rejection at this time.

NEW GROUND OF REJECTION

Claims 1–6, 8–11, 14–35, 37–40, and 43–58--35 U.S.C. § 112, first paragraph, written description

Claims 1–6, 8–11, 14–35, 37–40, and 43–58 are rejected under the first paragraph of 35 U.S.C. § 112, as failing to comply with the written description rejection. This is a New Ground of Rejection pursuant to 37 C.F.R. § 41.50(b).

> Independent claim 1 includes the limitations:
>
> varying, by the blower, the pressure of the breathable gas responsive to obstructive events detected by the controller; and
>
> calculating a heart failure indicator from said responsive pressure variations . . .

Appeal Br. 14 (Claims Appendix).

Independent claim 30 includes similar limitations, presented in apparatus form, as

> a controller adapted and configured to

> detect obstructive events experienced by the patient;
>
> control said blower such that the pressure varies responsive to detected obstructive events;
>
> calculate a heart failure indicator from said responsive pressure variations . . .

Appeal Br. 17 (Claims Appendix)

Appellant's Specification and drawings do not evidence that, at the time the application was originally filed, Appellant was in possession of an invention that included calculating a heart failure indicator from a blower pressure variation responsive to obstructive events, as claimed.

The purpose of the written description requirement is to prevent an applicant from later asserting that he invented that which he did not; the applicant for a patent is therefore required "'to recount his invention in such detail that his future claims can be determined to be encompassed within his original creation.'" *Amgen Inc. v. Hoechst Marion Roussel Inc.*, 314 F.3d 1313, 1330 (Fed. Cir. 2003) (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1561 (Fed. Cir. 1991)). An applicant shows possession of a claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). That a person skilled in the art might realize from reading the disclosure that such a feature is possible is not a sufficient indication that the feature is a part of the invention. *Application of Barker*, 559 F.2d 588 (CCPA 1977). An applicant need not "describe exactly the subject matter claimed," but "the description must clearly allow persons of ordinary skill in the art to recognize that [the

applicant] invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989) (citations omitted); *see also Barker*, 559 F.2d at 589, 591.

Appellant's Specification, in pertinent part, discloses generally that "the preferred device determines or calculates one or more heart failure indicators or indices to indicate a change in heart failure condition." Spec. ¶ 78. That same paragraph notes that, "[t]he changing value of such an indicator or index may provide a diagnostic tool for the physician to assess the state of the patient's health." *Id.* The Specification somewhat more specifically states that:

> The heart failure indices are determined from an analysis of the patient's breathing characteristics or by the machines' responses to the patient's breathing patterns. The indices may be determined in conjunction with a protocol for delivering treatment pressure or without such treatment pressure, for example, by simply monitoring patient respiratory airflow. Such indices serve as heart failure indicators to show patient improvement or relapse as detailed below.

Spec. ¶ 82.

Paragraph 83 of the Specification sets forth that Figure 12 illustrates "such a methodology," but discloses only that the respiratory airflow is measured, and then, "[i]n a determining or calculating step 1206, a heart failure indicator . . . is derived from the respiratory airflow." Spec. ¶ 83.

No additional disclosure exists concerning what is meant by "determined . . . by the machines' responses to the patient's breathing patterns" in paragraph 82, especially in the sense that a pressure change initiated by the blower (as controlled by the controller) in response to an obstructive event is not identified in the Specification as one of the types of machine responses from which a heart failure index might be somehow

ascertained. These passages do not evidence in any manner that such a pressure change might be used in "calculating" a heart failure indicator.

The Specification is, additionally, devoid of any formula, equation, or the like, that includes the recited pressure change as a parameter involved in any "calculation" of a heart failure indicator. Further, to the extent that Appellant might assert that "calculate" is used in a different sense such that it is synonymous with "determine," even then, there is no description as to how two different pressure values might somehow represent or serve as a heart failure indicator.

For the above reasons, claims 1 and 30, and all other pending claims, are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

DECISION

The rejections of claims 1–6, 8–11, 14–35, 37–40, and 43–58 under 35 U.S.C. § 103(a) as being unpatentable are reversed.

We do not reach the merits of the rejection of claims 1–6, 8–11, 14–35, 37–40, and 43–58 as being unpatentable for obviousness-type double patenting over claims 1–31 of Ujhazy.

Claims 1–6, 8–11, 14–35, 37–40, and 43–58 are rejected, in a new ground of rejection, under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

CONCLUSION

In summary:

Claim(s) Rejected	35 U.S.C. §	Reference(s) /Basis	Affirmed	Reversed	New Ground
1–3, 5, 6, 8–11, 14–16, 25–32, 34, 35, 37–40, 43–45, 54–58	103(a)	Estes, Cho		1–3, 5, 6, 8–11, 14–16, 25–32, 34, 35, 37–40, 43–45, 54–58	
17–24, 46–53	103(a)	Estes, Cho, Greenhut		17–24, 46–53	
4, 33	103(a)	Estes, Cho, Foulkes		4, 33	
1–6, 8–11, 14–35, 37–40, 43–58		Nonstatutory Obviousness-type Double Patenting[3]			
1–6, 8–11, 14–35, 37–40, 43–58	112, first paragraph	Written Description			1–6, 8–11, 14–35, 37–40, 43–58
Overall Outcome				1–6, 8–11, 14–35, 37–40, 43–58	1–6, 8–11, 14–35, 37–40, 43–58

[3] For reasons provided above, we do not reach this rejection.

TIME PERIOD FOR RESPONSE

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground 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 prosecution 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.

REVERSED; 37 C.F.R. § 41.50(b)