



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/278,113	09/28/2016	Doug M. Birkholz	279.J75US3	1000
45458	7590	10/31/2019	EXAMINER	
SCHWEGMAN LUNDBERG & WOESSNER/BSC			KABIR, ZAHED	
PO BOX 2938			ART UNIT	PAPER NUMBER
MINNEAPOLIS, MN 55402			3792	
			NOTIFICATION DATE	DELIVERY MODE
			10/31/2019	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

SLW@blackhillsip.com
uspto@slwip.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DOUG M. BIRKHOLZ, DOUGLAS J. BRANDNER,
DOUGLAS J. GIFFORD, DAVID J. TERNES, and
WILLIAM J. LINDER

Appeal 2019-000270
Application 15/278,113
Technology Center 3700

BEFORE EDWARD A. BROWN, JAMES P. CALVE, and
LEE L. STEPINA, *Administrative Patent Judges*.

STEPINA, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Appellant¹ filed a Request for Rehearing (“Request”) of the Decision on Appeal dated July 1, 2019 (“Decision”) in this Application. The Request

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 Cardiac Pacemakers, Inc. Appeal Br. 2.

Appeal 2019-000270
Application 15/278,113

seeks reconsideration of the Board's entry of a new ground of rejection against claims 2 and 17.² We GRANT THE REQUEST.

OPINION

The Decision entered a new ground of rejection against claims 2 and 17, under 35 U.S.C. § 103(a), as unpatentable over Moffit³. Dec. 11–13. Appellant contends that, based on a Statement of Common Ownership included in the Request, Moffit is disqualified as a reference for the purposes of 35 U.S.C. § 103. Req. Reh'g 1–2; *see also* 35 U.S.C. § 103(c).

Moffit was filed on May 13, 2012 and published on November 15, 2012. Moffit claims the benefit of an earlier filing date, under 35 U.S.C. § 119(e), from provisional application number 61/486,120, which was filed on May 13, 2011.⁴

The present application was filed on September 28, 2016, and claims the benefit of provisional application number 61/612,833 (hereinafter “Appellant's provisional application”), which was filed on March 19, 2012.⁵

Appellant asserts Appellant's provisional application adequately supports the claims on appeal because “[t]he specification and drawings of

² The only other standing rejection against the claims is an obviousness-type double patenting (ODP) rejection of claims 2–21 based on claims 1, 9, 11, and 16–18 of Birkholz '521 and Gandhi that is not contested as part of this Request. *See* Decision 13; Request 3.

³ US 2012/0290040 A1, published November 15, 2012.

⁴ Appellant does not contest that Moffit qualifies as prior art based on the filing date of provisional application number 61/486,120.

⁵ The present application is a continuation application of another application (U.S. serial number 14/612,799), itself a continuation application of another application (U.S. serial number 13/780,903), which claims the benefit of (and was filed within one year of) provisional application number 61/486,120.

Appeal 2019-000270
Application 15/278,113

the provisional application are the same as the specification and drawings of the present application, but for the claim of priority found in paragraph [0001].” Appellant’s assertion that the specifications and drawings in these two applications are practically identical appears correct. Accordingly, based on the present Application receiving the benefit of Appellant’s provisional application filing date, Moffit qualifies as prior art only under 35 U.S.C. § 102(e), i.e., by virtue of its filing date.

In the Request, Appellant submitted a Statement of Common Ownership indicating that, at the time the claimed invention was made, the subject matter of Moffit and the claimed invention were owned by Boston Scientific Corporation. *See* Req. Reh’g 2. Based on the submission of the Statement of Common Ownership, we agree with Appellant that Moffit is disqualified as a reference for the purposes of 35 U.S.C. § 103. *See* 35 U.S.C. § 103(c). Accordingly, the Request is granted, and we withdraw the rejection of claims 2 and 17 as unpatentable over Moffit.

DECISION

We grant Appellant’s Request.

CONCLUSION SUMMARY

In summary:

Outcome of Decision on Rehearing:

Claims	35 U.S.C §	Reference(s)/Basis	Denied	Granted
2, 17	103	Moffit		2, 17
Overall Outcome				2, 17

Appeal 2019-000270
Application 15/278,113

Final Outcome of Appeal after Rehearing:

Claims	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
2-6, 16-20	102(e)	Moffit		2-6, 16-20
2, 17	103(a)	Moffit		2, 17
7-15, 21	103(a)	Moffit and Gandhi		7-15, 21
2-21	ODP	Claims 1, 9, 11, 16-18 of Birkholz '521 and Gandhi	2-21	
2-21	ODP	Claims 1, 5, 9-11, 13-18 of Birkholz '521 and Gandhi		2-21
Overall Outcome			2-21	

GRANTED