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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO. Includes application details for Vanessa Tolosa and examination information.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte VANESSA TOLOSA, SATINDERPALL S. PANNU,
HEERAL SHETH, ANGELA C. TOOKER, KEDAR G. SHAH, and
SARAH H. FELIX

Appeal 2019-001895
Application 15/637,995
Technology Center 1700

BEFORE BEVERLY A. FRANKLIN, N. WHITNEY WILSON, and
WESLEY B. DERRICK, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–4. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as Lawrence Livermore National Security, LLC and the United States of America as represented by the Department of Energy. Appeal Br. 2.

CLAIMED SUBJECT MATTER

Claim 1 is illustrative of Appellant's subject matter on appeal and is set forth below:

Claim 1. An implantable device, comprising:

a cylindrical base, wherein said cylindrical base has a cylindrical base surface providing a base surface level and a protective coating over said cylindrical base surface providing a protective coating level above said base surface level;

four in-line electrode sensors on said cylindrical base surface, wherein said four in-line electrode sensors are longitudinally aligned on said cylindrical base surface and wherein said four in-line electrode sensors are located at said base surface level below said protective coating level;

four individual electrically conducting leads on said cylindrical base surface at said base surface level below said protective coating level, wherein each individual electrically conducting lead has

a lead body portion that is longitudinally aligned on said cylindrical base surface but offset from said longitudinally aligned electrode sensors,

wherein each individual electrically conducting lead has a lead connecting portion that is curved from said longitudinally aligned lead body portion so that said lead connecting portion is connected to one of said electrode sensors, and wherein said electrically conducting lead has a feature size of <10 micrometers, and

four individual openings in said protective coating, wherein there is one of said individual openings located above one of said in-line electrode sensors enabling said inline electrode sensors to be exposed through said protective coating.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Swanson '172	US 8,099,172	Jan. 17, 2012
Jaax	US 2008/0206165 A1	Sept. 14, 2006
McMorrow	US 2010/0114278 A1	May 6, 2010
Swanson '659	US 2011/0072659 A1	Mar. 31, 2011

REJECTIONS

1. Claims 1–3 are rejected under pre-AIA 35 U.S.C. §103(a) as being unpatentable over Swanson '659 in view of Swanson '172 and McMorrow.

2. Claim 4 is rejected under pre-AIA 35 U.S.C. §103(a) as being unpatentable over Swanson '659 in view of Swanson '172 and McMorrow, as applied to claim 1 above, and further in view of Jaax.

OPINION

For purposes of this appeal, we address separately argued claims, and the remaining claims stand or fall with the argued claims, consistent with 37 C.F.R. § 41.37(c)(1)(iv) (2017). We select claim 1 as representative.

Upon consideration of the evidence and each of the respective positions set forth in the record, we find that the preponderance of evidence supports the Examiner's findings and conclusion that the subject matter of Appellant's claims is unpatentable over the applied art. Accordingly, we sustain each of the Examiner's rejections on appeal for the reasons set forth

in the Final Office Action and in the Answer (which we adopt as our own), and affirm, with the following emphasis.

We refer to pages 5–14 of the Appeal Brief and to pages 2–9 of the Reply Brief regarding Appellant’s stated position in the record. We are unpersuaded by such arguments for the reasons provided on pages 6–7 of the Answer, and additional reasons set forth here. We agree with the Examiner that because Appellant essentially argues the references individually, the arguments are unpersuasive of error. The test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art; one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991); *In re Merck & Co.*, 800 F.2d 1091, 1097–98 (Fed. Cir. 1986); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). Each reference must be read for what it fairly teaches in combination with the prior art as a whole. *In re Merck & Co.*, 800 F.2d at 1097.

We also agree with the Examiner, for the reasons set forth on pages 6–7 of the Answer, that there would have been a reasonable expectation of success in making the proposed combination for the reasons stated therein.

We thus affirm Rejection 1. We also affirm Rejection 2 for the same reasons we discussed for Rejection 1 because Appellant relies upon similar arguments (Appeal Br. 15–24).

CONCLUSION

We affirm the Examiner’s decision.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1-3	103	Swanson '659, Swanson '172, and McMorrow.	1-3	
4	103	Swanson '659, Swanson '172, and McMorrow, Jaax.	4	
Overall Outcome			1-4	

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED