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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRISTOPHER N. DALY

Appeal 2019-001953
Application 13/293,758
Technology Center 3700

Before JENNIFER D. BAHR, JOHN C. KERINS, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

PESLAK, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Appellant¹ filed a Request for Rehearing (“Request” or “Req. Reh’g”) in response to our Decision of May 27, 2020 (“Decision” or “Dec.”). We have jurisdiction under 35 U.S.C. § 6(b).

After consideration of Appellant’s Request, we grant the Request for Rehearing of claim 20, deny the Request for Rehearing of claims 15 and 26, and do not reach the Request for Rehearing of claim 31.

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 Cochlear Limited. Appeal Br. 2.

OPINION

Rehearing is limited to matters misapprehended or overlooked by the Board in rendering the initial decision. 37 C.F.R. § 41.52(a)(1).

“Arguments not raised, and Evidence not previously relied upon. . . are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) through (a)(4) of this section.” *Id.*

Claim 20

Appellant contends that “[c]laim 20 depends from claim 19, and the rejection of claim 19 was reversed. We submit that by default the rejection of claim 20 should also be reversed.” Req. Reh’g 2. Claim 19 is rejected as unpatentable over Haubrich and claim 20 is rejected as unpatentable over Haubrich and Faltys. Final Act. 6, 9. The Examiner’s reliance on Faltys fails to cure the deficiencies in the rejection of claim 19 stated in our Decision. Dec. 15–16; Final Act. 9. Therefore, we grant Appellant’s Request for Rehearing and reverse the Examiner’s rejection of claim 20.

Claim 26

Claim 26 depends from claim 15 and recites “wherein the operating parameters are stored in the implantable memory.” Appeal Br. 159 (Claims App.). First, Appellant argues that “Claim 26 is a claim that is completely incompatible with any interpretation of claim 15 . . . that covers the prior art . . . because claim 26 affirmatively recites that the operating parameters are stored in the implantable memory.” Req. Reh’g 3. Second, Appellant argues that our findings concerning claim 26 are incompatible with the rejection of claim 15 because we determined that “claim 15 does not affirmatively require that the operating parameters be stored in the memory

module of the internal component” but the claim “only requires that the implantable component be configured to receive and store the operating parameters.” *Id.* at 4 (quoting Dec. 17). Third, Appellant argues that we overlooked certain arguments made in the Appeal Brief directed to claim 26. *Id.* at 5–7. In connection with this argument, Appellant quotes part of the Final Rejection and its argument that the limitation of claim 26 was not disclosed in Haubrich at column 11, line 66, to column 13, line 21. *Id.* at 6.

In the Decision, we affirmed the rejection of claim 15 because, *inter alia*, Appellant did not “address[ed] the disclosure of Haubrich at column 3 line 41 to column 4 line 25, which . . . supports a finding that Haubrich stores operating parameters in the implantable memory.” Dec. 17. This disclosure of Haubrich was also cited by the Examiner in the Final Rejection. Final Act. 8. In connection with claim 15, we noted that the Appeal Brief did not make any argument “addressing, let alone demonstrating, that the disclosure of Haubrich column 3, line 41 to column 5, line 25 does not correspond to ‘operating parameters . . . specific to a recipient of the implantable component.’” *Id.* at 9. After reviewing the referenced portion of Haubrich, we found that “Haubrich, thus, discloses an internal component with a memory that stores data relating both to the patient (the ‘recipient’) and to operating commands for controlling the function and operation of the IMD implanted in the patient.” *Id.* at 10–11. In the Request, Appellant instead directs us to where it argued that column 11, line 66, to column 13, line 21 of Haubrich does not disclose the limitation of claim 26. Appellant, however, has not shown that we misapprehended or overlooked an argument in the Appeal Brief asserting that column 3, line 41, to column 5, line 25, of Haubrich does not disclose

this limitation. This portion of Haubrich is the basis for our affirmance of the rejections of claims 15 and 26. Therefore, we decline to modify our prior decision regarding claim 26 because Appellant has not shown that we misapprehended or overlooked any argument.

Claim 15

Appellant argues that “[n]othing that is stored in the implantable portion of Haubrich can ‘configure the external component using said operating parameters’ where the operating parameters are stored in the implantable component.” Req. Reh’g 8. Appellant then repeats essentially the same argument in an expanded format and argues that it traverses our decision on claim 15 “for all the reasons we previously articulated in the Appeal Brief and Reply Brief.” *Id.* at 11(citing Dec. 13). Appellant makes a similar argument that “very few of our arguments presented in the Appeal Brief, and our arguments in the Reply Brief (and there were a myriad of new grounds of rejection in the Examiner’s Answer), are addressed in the Decision.” *Id.* at 14.

Appellant’s substantive argument concerning Haubrich’s alleged lack of disclosure of the limitations of claim 15 does not point to anything we misapprehended or overlooked but merely disagrees with our finding that Haubrich, in fact, discloses recipient specific operating parameters stored in Haubrich’s implantable device as required by claim 15. Dec. 10–11. Further, the argument about the configuration of the external device ignores our determination that the limitation in claim 15 of “configur[ing] the external component using said operating parameters” is a conditional limitation because the claim only requires that the external component be configured “upon the internal component verifying compatibility” but, claim

15 does not require the internal component to do so. *Id.* at 12–13. Appellant’s attempt to rely on all the arguments set forth in their Appeal Brief and Reply Brief without citing any particular arguments that we misapprehended or overlooked is improper. *See* 37 C.F.R. § 41.50(a)(1)(“The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board.”). Likewise, Appellant fails to show what we misapprehended or overlooked in connection with any allegedly new grounds of rejection by the Examiner in the Answer. For all of these reasons, we decline to modify our prior decision regarding claim 15.

Claim 31

Appellant contends that claim 31 was part of an “amendment filed on September 26, 2017” that was not entered by the Examiner. Req. Reh’g 9–10. Based on the alleged failure to enter the Amendment, Appellant argues that we should reverse a rejection of claim 31 that was never made by the Examiner, because we reversed a rejection of claim 1 that was actually made by the Examiner. *Id.* However, the Examiner issued an Advisory Action on January 2, 2019 stating that the Amendment was not entered. 1/2/19 Adv. Act. 1. Consequently, we do not reach claim 31 because the claim has not been entered and, consequently, no rejection is before us for review.

CONCLUSION

Appellant’s Request for Rehearing is granted with respect to claim 20 and denied with respect to claims 15 and 26.

DECISION SUMMARY

Outcome of Decision on Rehearing:

Claims	35 U.S.C. §	Reference(s)/Basis	Denied	Granted
15, 20, 26 31 ²	103(a)	Haubrich	15, 26	20
Overall Outcome			15, 26	20

Final Outcome of Appeal after Rehearing:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 3, 5, 7, 15, 16, 18, 19, 22, 25, 26	103(a)	Haubrich	15, 16, 18, 26	1, 3, 5, 7, 19, 22, 25
8, 10, 11, 13, 14, 20, 21, 23, 24, and 27–30	103(a)	Haubrich, Faltys		8, 10, 11, 13, 14, 20, 21, 23, 24, 27–30
Overall Outcome			15, 16, 18, 26	1, 3, 5, 7, 8, 10, 11, 13, 14, 19, 20– 25, 27–30

² As noted, we do not reach the issue of claim 31.

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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).

GRANTED IN PART