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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/658,101	03/13/2015	Sarah Chin	SCHIN01	3996

98262 7590 09/25/2019

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EXAMINER	
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ART UNIT	PAPER NUMBER
3792	

NOTIFICATION DATE	DELIVERY MODE
09/25/2019	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SARAH CHIN

Appeal 2019-002062
Application 14/658,101
Technology Center 3700

Before MICHAEL J. FITZPATRICK, WILLIAM A. CAPP, and JILL D. HILL, *Administrative Patent Judges*.

FITZPATRICK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant, Sarah Chin, appeals under 35 U.S.C. § 134(a) from the Examiner's final decision rejecting claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

The Specification

The "disclosure relates generally to a technical field of health-related mobile devices that address or monitor biosignals (e.g. bioelectrical signals) and, in one embodiment, to a method and apparatus of anticipating cardiac arrhythmias." Spec. ¶2.

The Rejected Claims

Claims 1–20 are rejected; no other claims are pending. Final Act. 1. Claim 1 is representative and reproduced below.

> 1. A mobile apparatus for anticipating a cardiac arrhythmia of a user, the apparatus comprising:
>
> a microcontroller; and
>
> a memory communicatively coupled to the microcontroller wherein the memory is configured to store a non-physiological risk factor of the user and a contemporary non-physiological datum of the user, wherein the microcontroller is configured to: compare the risk factor with the contemporary datum, anticipate the cardiac arrhythmia when the risk factor is correlated with the contemporary datum, and *enter a high risk mode when the arrhythmia is anticipated*, wherein anticipating the cardiac arrhythmia comprises predicting the cardiac arrhythmia in advance of the cardiac arrhythmia, *the high risk mode does not comprise timing a blood pressure measurement, the high risk mode does not comprise collecting a blood pressure measurement*, and the high risk mode does not comprise encouraging the user to change their posture.

Appeal Br. 12 (emphasis added).

The Examiner's Rejection

The sole rejection before us for review is: claims 1–20 as failing to comply with the written description requirement set for in 35 U.S.C. § 112(a). Final Act. 2.[1]

DISCUSSION

Claim 1 recites that "the high risk mode does not comprise timing a blood pressure measurement" and that "the high risk mode does not comprise collecting a blood pressure measurement." Appeal Br. 12. Claim 11, the only other independent claim, recites these same limitations. *Id.* at 14. The Examiner found that the Specification as filed fails to describe either limitation and, accordingly, rejected the claims under 35 U.S.C. § 112(a). Final Act. 2.

Section 112(a) states:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.

35 U.S.C. § 112(a). "In order to satisfy the written description requirement, the disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter at issue." *Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000). Nonetheless, the disclosure must convey with reasonable clarity to those skilled in the art that the inventor was in possession of the invention. *See id.* Whether it does is a question of fact. *Id.* at 1329.

[1] The Final Action also included a rejection under 35 U.S.C. § 103, but the Examiner ultimately withdrew that rejection. Final Act. 3; Ans. 3.

> The Examiner explained the rejection as follows:
>
> > The only disclosure which describes what the high risk mode may be is found in paragraph [0019] of the originally-filed disclosure. However, paragraph [0019] does not mention blood pressure at all in any capacity. As such, the specification fails to describe the high risk mode as either comprising or not comprising timing a blood pressure measurement or collecting a blood pressure measurement.
>
> Final Act. 3.

In arguing against this rejection, Appellant points out that paragraph 19 of Specification "states that a 'high risk mode 121 may comprise a mode of the apparatus wherein the apparatus increases data collection frequency.'" Appeal Br. 4 (quoting Spec. ¶19). Appellant next asserts that paragraph 27 "states that data collection may comprise 'time-aligned . . . blood pressure' measurements." *Id.* (quoting Spec. ¶27). Thus, Appellant argues that "the data collection of the high-risk mode may comprise time-aligning and collecting blood pressure measurements." *Id.* Appellant then explains that, "if blood pressure measurements are not collected prior to a high risk mode, then entering the high risk mode may comprise starting to collect and time blood pressure measurements at a frequency greater than zero" because this would constitute an increase in data collection frequency. *Id.* at 4–5.

Appellant's arguments are not persuasive. First, claims 1 and 11 recite that "the high risk mode does <u>*not*</u> comprise timing a blood pressure measurement" and that "the high risk mode does *not* comprise collecting a blood pressure measurement." Appeal Br. 12, 14. Perhaps Appellant implicitly is arguing that a disclosure that the high risk mode *may* comprise timing/collecting a blood pressure measurement would also constitute a

disclosure that it may not comprise the same. *See, e.g., Inphi Corp. v. Netlist, Inc.*, 805 F.3d 1350, 1357 (Fed. Cir. 2015) ("[P]roperly described, alternative features are sufficient to satisfy the written description standard of § 112, paragraph 1 for negative claim limitations."); *Upsher-Smith Labs., Inc. v. Pamlab, L.L.C.*, 412 F.3d 1319, 1322 (Fed. Cir. 2005) ("The European Application's 'optional inclusion' of antioxidants teaches vitamin supplement compositions that both do and do not contain antioxidants."). However, we do not agree, in the first instance, that the Specification discloses that the high risk mode may comprise timing or collecting a blood pressure measurement.

The Examiner is correct that Paragraph 19 is the only portion of the Specification that describes what the risk mode may be. *See* Final Act. 3 ("The only disclosure which describes what the high risk mode may be is found in paragraph [0019] of the originally-filed disclosure."). Paragraph 19 includes fifteen sentences that begin as follows: "A high risk mode [] may comprise . . . ." Spec. ¶19. In none of those sentences is blood pressure mentioned. *Id.* The sentence of Paragraph 19 on which Appellant relies merely discloses that a "high risk mode 121 may comprise a mode of the apparatus wherein the apparatus increases data collection frequency." Spec. ¶19. This sentence refers to "data" generally; it does not specify any particular type of data that is collected.

Elsewhere, the Specification mentions "time-aligned data, such as . . . blood pressure." Spec. ¶27. But it does not mention it as a component of a high risk mode, let alone an optional component of a high risk mode.

In sum, the Specification does not describe a high risk mode as either excluding or including, specifically, the timing or collecting of a blood

pressure measurement. Accordingly, the Specification does not "convey with reasonable clarity to those skilled in the art that [Appellant] was in possession of the invention" now being claimed. *See Purdue Pharma*, 230 F.3d at 1323.

We affirm the rejection of claims 1–20 under 35 U.S.C. § 112(a).

SUMMARY

Claims Rejected	**Basis**	**Affirmed**	**Reversed**
1–20	§112(a); written description	1–20	
Overall Outcome		1–20	

AFFIRMED