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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/739,142	01/11/2013	Jae-young EOM	7200-1-008	4949

33942 7590 06/11/2020

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ART UNIT	PAPER NUMBER
3793	

MAIL DATE	DELIVERY MODE
06/11/2020	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAE-YOUNG EOM and JEONG CHO

Appeal 2019-003012
Application 13/739,142
Technology Center 3700

Before JEREMY M. PLENZLER, LISA M. GUIJT, and ARTHUR M. PESLAK, *Administrative Patent Judges*.

GUIJT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant[1] seeks our review under 35 U.S.C. § 134(a) of the rejection of claims 1–4, 6–13, 15–22, 25–28, and 34. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART, and we designate our affirmance of claims 1–4 under 35 U.S.C. § 112, first paragraph, for failing to comply with the

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[1] We use the word "Appellant" to refer to "Applicant" as defined in 37 C.F.R. § 1.42. Appellant identifies Samsung Electronics Co., Ltd. as the real party in interest. Appeal Br. 3.

written description requirement, as a NEW GROUND OF REJECTION, and we enter a NEW GROUND OF REJECTION of claims 6–13, 15–22, 25–28, and 34 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement, pursuant to our authority under 35 U.S.C. § 41.50(b).

CLAIMED SUBJECT MATTER

Appellant's invention relates to "a probe device, a server, a system for diagnosing an ultra sound image, and a method of processing an ultrasound image." Spec. 1:13–14. Claims 1, 6, 17, and 34 are the independent claims on appeal. Claim 1, reproduced below with disputed limitations italicized for emphasis, is illustrative of the subject matter on appeal.

> 1. An ultrasound probe device comprising:
>
> a pulse generator configured to generate an electrical pulse signal;
>
> a transducer configured to convert the generated electrical pulse signal into ultrasonic waves for transmission toward a patient body, and to convert ultrasonic waves that are reflected back from the body into a response electrical signal;
>
> a signal processor configured to generate an echo signal comprising an echo electrical signal derived from the response the response electrical signal; and
>
> *a probe communicator communication interface configured to*:
>
> transmit the echo signal directly through the Internet or directly through a mobile network to a remote server along with an identification information of the ultrasound probe device, to enable the server to generate an ultrasound image therefrom by executing an ultrasound image diagnostic application requested by an electronic device located remotely from the ultrasound probe device; and
>
> *receive probe control data for controlling the ultrasound probe device by setting an ultrasound*

operating mode for the ultrasound probe device, directly from the remote server through the Internet or the mobile network,
wherein,
the ultrasound probe device operates in accordance with the set ultrasound operating mode according to the probe control data,
the ultrasound operating mode is one of a B mode, a D mode, a C mode, an M mode and an elastic mode, and the transducer produces the ultrasonic waves in accordance with the ultrasound operating mode.

REFERENCE(S)

The prior art relied upon by the Examiner is:

Name	Reference	Date
Berger	US 2004/0015079 A1	Jan. 22, 2004
McMorrow	US 2005/0288584 A1	Dec. 29, 2005

REJECTIONS[2]

The following rejections are before us on appeal:

I. Claims 1–4 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

II. Claims 1–4, 6–13, 15–22, 25–28, and 34 stand rejected under 35 U.S.C. § 103(a) as unpatentable over McMorrow and Berger.

[2] The Examiner has withdrawn the rejections of the claims related to means-plus-function limitations and also claims 6–13, 15–22, 25–28, and 34 under 35 U.S.C. § 112, first paragraph, as reciting new matter not supported by the Specification. Ans. 3; Final Act. 8–12.

OPINION

Rejection I

Appellants argue claims 1–4 as a group. Appeal Br. 13–14. We select independent claim 1 as representative, with claims 2–4 standing or falling therewith. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Regarding independent claim 1, the Examiner finds that the Specification does not provide written description support for a probe communicator communication interface that receives probe data for controlling the ultrasound probe device by setting an ultrasound operating mode (i.e., one of a B mode, a D mode, a C mode, an M mode and an elastic mode) for the ultrasound probe device, as claimed; rather, the Examiner finds that the Specification discloses that the electronic device (i.e., electronic device 502), which is separate and distinct from the ultrasound probe device, is "used by the operator to set an ultrasound imaging mode." Final Act. 8–9 (citing Spec. ¶ 116[3]); *see also* Ans. 4, 9, 10.

Appellant argues that the Examiner is misconstruing claim 1, because "[t]he clause 'for controlling the ultrasound probe device by setting an ultrasound operating mode for the ultrasound probe device" modifies the subject, "probe control data" as opposed to the "probe communicator communication interface." Appeal Br. 13; Reply Br. 12. Appellant submits that, according to claim 1, "it is the 'probe control data' that controls the ultrasound probe device." Appeal Br. 13. Appellant also submits that

[3] We refer to the paragraphs of the Specification as published as US 2013/0184587 A1.

"'controlling the ultrasound probe device" is achieved by "setting an ultrasound operating mode.'" Reply Br. 12.

"During examination, 'claims ... are to be given their broadest reasonable interpretation consistent with the specification, and . . . claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.'" *Id.* (quoting *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)). Here, we construe claim 1 as requiring the probe communicator communication interface of the ultrasound probe device to be configured to receive probe control data directly from the remote server through the Internet or the mobile network, *and* that: (i) the probe control data is for controlling the ultrasound probe device by setting an ultrasound operating mode for the ultrasound probe device; (ii) the ultrasound probe device operates in accordance with the set ultrasound operating mode according to the probe control data; (iii) the ultrasound operating mode is one of a B mode, a D mode, a C mode, an M mode and an elastic mode; and (iv) the transducer of the probe device produces the ultrasonic waves in accordance with the ultrasound operating mode.[4] In other words, we do not construe claim 1 as requiring the probe communicator communication interface to function *to set* the ultrasound mode, but merely to function *to receive* the ultrasound operating mode data, wherein the transducer of the probe device *produces* the ultrasonic waves *in accordance with the ultrasound operating mode*.

Appellant argues that the Specification provides written description support for the disputed claim limitation because the Specification discloses

[4] Notably, the claims as originally filed do not include *any* limitations reciting *an ultrasound image processing mode*.

that "[w]hen the user input unit 530 [of the electronic device 500] uses an input method such as a touch screen method, menus for the information 522 [about the user], [information] 523 [about an ultrasound image processing mode], and [information] 524 [about probe device 100] may be directly manipulated to manipulate the image diagnostic application including *the ultrasound image processing mode or to control the probe device 100*." Appeal Br. 14 (quoting Spec. ¶ 82); Reply Br. 11 (citing Spec., Fig. 5). Appellant submits that "[s]ince the probe communicator communication interface communicates with the first network 200 . . . , it would also inherently have to receive signals that set the ultrasound operating mode of probe device 100." Appeal Br. 14 (citing, *e.g.*, Fig. 1) (emphasis added); Reply Br. 11. Appellant also submits that "'controlling the ultrasound probe device' is achieved by 'setting an ultrasound operating mode.'" Reply Br. 12.

The specification of a patent, as filed, must "contain a written description of the invention." 35 U.S.C. § 112. A specification has an adequate written description when it "reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date" of the patent. *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). "[T]he test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art .... [to] show that the inventor actually invented the invention claimed." *Id.* When a written description cannot be found in the specification, as filed, the only thing the PTO can reasonably be

expected to do is to point out its non-existence. *Hyatt v. Dudas*, 492 F.3d 1365, 1370 (Fed. Cir. 2007).

Here, the Specification discloses—expressly and consistently—that the ultrasound image processing mode data is received by *the server*, for example, *via the electronic device* (wherein both the server and the electronic device are claimed separately from the ultrasound probe device comprising the probe communicator communication interface), and also that the ultrasound image processing mode data is used by *the server* to execute an ultrasound image diagnostic application and to process an ultrasound image *according to the selected ultrasound image processing mode*. In particular, the Specification discloses that "[a]n ultrasound image mode *of the ultrasound image diagnostic application* may be selected through the electronic device." Spec. ¶¶ 26, 37 (emphasis added); *see also id.* ¶¶ 27, 116. The Specification discloses that

> display unit 520 [of electronic device 500] displays the screen of *the image diagnostic application executed in the server 300*. For example, the screen of the image diagnostic application may be a user interface displayed with an ultrasound image processed by the server 300 and *a manipulation menu for selecting a mode* (for example, a brightness (B) mode, a Doppler (D) mode, a color (C) mode, a motion (M) mode, and an elastic mode) *for processing an ultrasound image*.

Spec. ¶ 80 (emphasis added); *see also id.* ¶ 97 ("the ultrasound image diagnostic application may process the ultrasound image in at least one of a B mode, a D mode, a C mode, an M mode, and an elastic mode").

The Specification further discloses, as referenced by Appellant, that

> display unit 520 may display an ultrasound image 521 obtained by outputting ultrasound image data generated by the server 300, information 522 about a user, information 523 about an ultrasound image processing mode, and identification

> information 524 about the probe device 100. When the user input unit 530 is activated with an input method such as a touch screen method, menus for the information 522, 523, and 524 may be directly manipulated *to manipulate the image diagnostic application including the ultrasound image processing mode or to control the probe device 100*.

Spec. ¶ 82 (emphasis added).

We do not read paragraph 82 of the Specification as supporting Appellant's argument that the Specification discloses that the ultrasound image processing mode is used to control the probe device 100, and therefore, the ultrasound image processing mode must necessarily be received by the probe device 100 (or a probe communicator communication interface of probe device 100). We find that paragraph 82 of the Specification discloses to a person of ordinary skill in the art that a user may manipulate the information menus of user input unit 530 of electronic device 500 *either* (i) to manipulate the image diagnostic application, which is executed *by the server*, including selection of the ultrasound image processing mode; *or* (ii) to control of probe device 100. A preponderance of the evidence does not support Appellant's argument that paragraph 82 of the Specification discloses that selection of the image processing mode controls probe device 100, or further, that the image processing mode must necessarily be received by probe device 100.

Similarly, the Specification distinguishes between ultrasound image processing mode data and probe control data in paragraph 99 of the Specification, by disclosing that

> server 300 transmits the various modes for processing the ultrasound image *or* manipulation menu information about controlling the probe device 100 to the electronic device 500 so that the user selects a mode for processing the ultrasound image

> *and* controls the probe device 100 by manipulating the electronic device 500.

Spec. ¶ 99 (emphasis added). Thus, the Specification discloses that the various ultrasound image processing modes are distinct information as compared to information about controlling the probe device.

Finally, the Specification defines the various modes, which are recited in claim 1:

> the B mode provides a black and white image used to examine tissue structure and organs. The D mode provides a speed of moving object in a Doppler spectrum image by using a Doppler effect. The C mode provides a speed of a moving object in a color image by using a Doppler effect. The M mode provides bio-information (such as luminance information) of certain part of the object changing according to time in an image in the B mode. The elastic mode provides an image of a reaction difference when compression is applied and not applied to the object.

Spec. ¶ 98. Similar to the disclosures *supra*, we cannot determine from these definitions that the ultrasound operating mode is *probe control* data for controlling the ultrasound probe device, rather than data selected through the electronic device and used *by the server* for executing an ultrasound image diagnostic application and processing an ultrasound image.

Moreover, the Specification does not disclose that the ultrasound probe device operates in accordance with the set ultrasound operating mode according to the probe control data, whereby *the transducer produces the ultrasonic waves in accordance with the ultrasound operating mode*, as required by claim 1. Rather, the Specification discloses generally that the transducer "converts the pulse signal generated by the pulse generator to

ultrasonic waves, and converts received ultrasonic waves to an electrical signal." Spec. ¶ 10; *see also id.* ¶ 63.

When an explicit claim limitation is not present in the written description it must be shown that a person of ordinary skill would have understood that the description requires that limitation. *Hyatt v. Boone,* 146 F.3d 1348, 1353 (Fed. Cir. 1998). However, Appellant has not provided any evidence in the Appeal Brief or the Reply Brief that a person of ordinary skill would have understood that a transducer produces ultrasonic waves in accordance with an ultrasound operating mode (i.e., B, C, D, M, and elastic modes), such that the ultrasound operating mode is necessarily probe control data that is received by a probe communication interface of an ultrasound imaging system rather than data used by the server to execute an ultrasound image diagnostic application and to process an ultrasound image according to the selected ultrasound image processing mode, as expressly disclosed in the Specification.[5]

In sum, although the Specification discloses generally that "[t]he probe device may be controllable by the electronic device" (Spec. ¶ 25), we

[5] Appellant does not rely on the Declaration of Steve S. Cha as evidence that using ultrasound operating mode data (i.e., B, C, D, M, and elastic modes) to control an ultrasound probe device by producing ultrasonic waves via the transducer in accordance with the ultrasound operating mode is known by a person of ordinary skill in the art. *See* Steve S. Cha Declaration dated April 24, 2014. Mr. Cha attests that, with respect to control data and control commands being transferred between a probe 100 and main unit 130, or other devices, Randall (US 8,490,489 B2; July 23, 2013) discloses that "[s]uch control commands may serve various purposes, including for example, *instructing a mode of operation* and/or various imaging parameters such as maximum imaging depth, sampling rate, element multiplexing configuration, etc." Steve S. Cha Declaration, p. 6 (emphasis added).

cannot find written description support in the Specification, or evidence that a person of ordinary skill in the art would have understood, that controlling the ultrasound probe device is achieved by setting an ultrasound operating mode, namely, B, D, C, M, and elastic modes, such that the ultrasound operating mode is necessarily or inherently received by the probe communicator communication interface, as argued by Appellant *supra*, and further, that the transducer produces the ultrasonic waves in accordance with the ultrasound operating mode (namely, B, D, C, M, and elastic modes), as claimed. Thus, the Specification fails to reasonably convey to those skilled in the art that the inventor had possession of the subject matter of claim 1 as of the filing date.

Accordingly, we sustain the Examiner's rejection of independent claim 1, and claims 2–4 fall therewith, pursuant to 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. To the extent our analysis relies on a construction of claim 1 that is different from the Examiner's claim construction, we designate our affirmance as a new ground of rejection to give Appellant an opportunity to respond.

NEW GROUND OF REJECTION

Independent claim 6 recites, in relevant part,

> the terminal controller generates and transmits control messages for controlling the image diagnostic application executed in the server according to user input, so as to control the particular probe device to operate according to an ultrasound operating

---

However, Mr. Cha's Declaration does not identify the mode of operation as B, D, C, M, and elastic modes. We decline, without argument or evidence from Appellant, to make presumptions about Mr. Cha's statements.

> mode selected at the electronic device, through the server, wherein . . . the transducer of the particular probe device produces the ultrasonic waves in accordance with the ultrasound operating mode.

Appeal Br. 22, (Claims App.). Independent claim 17 recites, in relevant part, "controlling the probe device through the server by means of probe control data . . . that sets an ultrasound operating mode according to which the probe device operates." *Id.* at 24 (Claims App.). Independent claim 34 recites, in relevant part, "controlling the probe device to operate according to the selected ultrasound operating mode." *Id.* at 27 (Claims App.).

For essentially the same reasons set forth *supra* in Rejection I of claim 1, we find that the limitations of independent claims 6, 17, and 34 set forth *supra* also fail to comply with the written description requirement of 35 U.S.C. § 112, first paragraph, and therefore, we enter a new ground of rejection of claims 6, 17, and 34, and claims 7–13, 15, 16, 18–22, and 25–28 depending therefrom, pursuant to 35 U.S.C. § 112, first paragraph.

Rejection II

Claims 1–4

Regarding independent claim 1, the Examiner finds that McMorrow discloses, *inter alia*, an ultrasound probe device (i.e., data collection devices, or DCDs 12, with conventional ultrasound transducers 14) that transmits an echo signal (i.e., raw ultrasound data) through the Internet to a remote server (i.e., server 25 of system ultrasound web database and server 18), as claimed. Final Act. 13 (citing, *e.g.*, McMorrow, Abstract, ¶¶ 20, 21, Figs. 1, 2); *see also* Ans. 13 (citing McMorrow ¶ 23, Fig. 1A (disclosing "transmission of selections via the Internet"). The Examiner determines that

although McMorrow's "DCDs are controlled and data is processed remotely," McMorrow fails to disclose "a probe communicator communication interface for setting[6] an ultrasound operating mode from the remote server," and the Examiner relies on Berger for teaching "an ultrasound application server which includes a user interface which enable[s] setting various application controls including image mode selection." Final Act. 13–14 (citing Berger ¶¶ 34, 418, 430). The Examiner reasons that it would have been obvious "to incorporate selection of the imaging mode over the server via a probe communication user interface," as taught in Berger, "to allow a clinician at a remote site to select the diagnostic application." *Id.* at 14.

Appellant does not dispute the Examiner's findings relative to McMorrow and Berger *supra*. Appeal Br. 16–17. However, Appellant argues that

> Berger describes a hand-held ultrasound system that communicates with a host computer using an industry standard high speed serial bus and *standard* interface. The ultrasonic imaging system is operable on a *standard*, commercially available, user computer device without specific hardware modifications, and is adapted to interface with an external application "*without modification* to the ultrasonic imaging system to allow a user to gather ultrasonic data on a standard user computing device such as a PC, and employ the data so gathered via an independent external application without requiring a custom system. . . . Therefore, Berger teaches the advantages and use of a standard interface between an ultrasound system and a

[6] Notably, as discussed *supra*, claim 1 requires the probe communicator communication interface of the probe device *to receive* probe control data directly from the remote server through the Internet, but not to be configured *for setting* the ultrasound operating mode.

> computer so that any computer is usable. This is fundamentally different to the claimed arrangement.

Appeal Br. 16–17; *see also* Reply Br. 13. Appellant also submits that, in Berger, the probe devices are directly coupled to computers for processing echo signals into images, and the selection of ultrasound operating modes (i.e., B, M modes) are performed at an electronic device (i.e., a laptop) and not at a server. Appeal Br. 17 (citing Berger ¶¶ 418, 431); *see also* Reply Br. 13. Appellant concludes that because Berger's goal is "to avoid specific hardware modifications to the ultrasonic image system, which "appears to be achieved specifically using a IEEE 1394 Firewire interface, which is a high-speed serial bus, . . . **one of ordinary skill in the art in the art would not be motivated to somehow involve the internet and wireless technologies.**" Appeal Br. 17; *see also* Reply Br. 13.

We are not persuaded by Appellant's argument, which does not address the Examiner's rejection as set forth *supra*. *See, e.g.*, Ans. 11 ("Appellant does not appear to contest the limitations McMorrow has been cited to disclose and instead argues secondary reference individually").

The Examiner proposes adding the selection of an imaging mode, which is requested by an electronic device located remotely from the ultrasound probe device, as probe control data to be received by McMorrow's DCD directly from McMorrow's server 25 through the Internet. McMorrow's system architecture already employs a direct connection between the DCD and the server via the Internet. *See, e.g.*, McMorrow, Fig. 1A; *id.* ¶ 30 ("server 25 connected to the internet 21 has a capability of communicating with a large plurality of DCD devices"). Further, McMorrow discusses the advantages of incorporating the Internet into an ultrasound system, notwithstanding Berger's presumed preference

for a high-speed seral bus connection: "[t]he cost of connection to the internet for the DCD, such as through a PDA as shown in FIG. 1 or by some other arrangement, is quite small," and "[h]ence, it is relatively easy for a physician-user to fund his/her part of the system." *See id.* ¶ 31. A reference does not teach away from an Examiner's proposed modification if the reference merely expresses a general preference for an alternative invention but does not "criticize, discredit, or otherwise discourage" investigation into the invention claimed. *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

In sum, Appellant's argument does not apprise us of error in the Examiner's reasoning.

Accordingly, we sustain the Examiner's rejection of independent claim 1. Appellant chose not to present separate arguments for the patentability of claims 2–4, and therefore, for essentially the same reasons set forth *supra*, we also sustain the Examiner's rejection of claims 2–4.

Claims 6–13, 15–22, 25–28, and 34

Independent claims 6, 17, and 34 recite, in relevant part, that "the electronic device [is] configured to . . . receive a user selection of a particular probe device from the plurality of probe devices using the ultrasound probe device identification information." Appeal Br. 21–22, 24, 26–27 (Claims App.).

The Examiner finds that because McMorrow discloses that a plurality of probe devices (i.e., DCDs 23) are connected to remote server 25, remote server 25 must have the capability of receiving identification information

from each probe device. Final Act. 15 (citing McMorrow ¶¶ 22, 30, 55).[7] The Examiner also finds that McMorrow discloses that "[a]n electronic device is provided in the form of an Internet-connected device" for accessing ultrasound data by a physician-user (*Id.* (citing McMorrow ¶ 55)) and that "selection of the program related to control of the operation of the particular probe (DCD)" is displayed on a personal digital system (PDA), which is connected to a DCD (*id.* ¶ 22). *See also id.* ¶¶ 21, ¶ 22. The Examiner further finds that, in McMorrow, "[t]he electronic instrument used which is received by the server is necessarily a 'user selection,' as claimed." Ans. 14.

Appellant argues that McMorrow fails to disclose that server 25 receives a user selection of a particular probe, as claimed, but rather, "a user *at the DCD* selects software from [server 25] for use for a particular application," which Appellant further submits still does not meet the claim limitation of an electronic device that is configured to receive *a user selection of a particular probe device* from the plurality of probed devices. Appeal Br. 17. Appellant submits that "the simple act of a user using a DCD cannot be considered a user selection of a particular probe device from a plurality because the DCD devices are positioned at various physical

[7] To the extent the Examiner finds certain claim language indefinite, a rejection is made correctly under 35 U.S.C. § 112, second paragraph. *See, e.g.*, Final Act. 15 ("[s]election of a program (i.e., ultrasound image diagnostic application, as claimed) to control the individual probe would necessitate 'interlocking the probe device' to the ultrasound image diagnostic application, as best understood based on limitations *which are indefinite*." Final Act. 15 (emphasis added)).

locations, such as at clinics or doctor's offices." Reply Br. 14–15 (citing McMorrow ¶ 30.

McMorrow discloses, with reference to Figure 1, that

> [probe device] DCD 12 is used in combination with an internet-connected . . . off-the-shelf personal digital system (PDA). . . . PDA 17 includes a conventional web browser and through the internet 16 can log onto a system ultrasound web database and server, generally indicated at 18. Web database and server 18 will, among other data, maintain a list of patients for the physician using the DCD and PDA combination.

McMorrow ¶ 21. McMorrow discloses that "[t]he operator will select one from the list of programs available, which will then be downloaded into the data collection device 12" (i.e., the probe device) and that "[t]he specific selected program selection is then transmitted through PDA 17 form the system database 18 through the internet." *Id.* ¶ 23.

McMorrow also discloses, with reference to Fig. 1A, that "a plurality of DCD devices 23-23" may be used (McMorrow ¶ 29), and that

> [i]n the overall system, the central database and server 25 connected to the internet 21 has a capability of communicating with a large plurality of DCD devices positioned at various physical locations, such as at various clinics or doctor's office, each of which is separately maintained and accounted for by the physician-user at that location.

Id. ¶ 30; *see also id.* ¶ 52 ("[i]n the system of the present invention, a single web database server 18 can respond to many DCDs"). McMorrow discloses that "[d]atabase 18 will eventually be able to link the DCD instrument to a specific location and a list of possible users" and that "[w]hen convenient, the operator will access the database, where the list of 'exam incidents',

connected with their facility/user name, is listed," whereby "[t]he operator can then connect the appropriate patient to the exam." *Id.* ¶ 57

McMorrow discloses that "[t]he processing of the ultrasound image collected by the DCD occurs in the web database server 25," and "[t]he processed output from database server 25 is then fed back to the practitioner through the internet 21 to the practitioner's [intelligent electronic device (IED)]." McMorrow ¶ 31. McMorrow further explains that "[t]he user's browser makes continuous inquiries . . . as to the availability of results produced by the [ultrasound processing system]." *Id.* ¶ 46.

Thus, although McMorrow discloses that the physician's electronic device, or PDA 17 or IED, may receive the physician's selection of a program related to control of a particular probe, a preponderance of the evidence does not support a finding that the physician's electronic device is also configured to receive the physician's selection of a particular probe device from the plurality of ultrasound probe devices. Rather, in McMorrow's system, each physician's electronic device appears to be associated with a single probe device, such that selection of a probe device from a plurality of probe devices is not a functionality that is discussed in McMorrow.

Accordingly, we do not sustain the Examiner's rejection of independent claims 6, 17, and 34, and claims 7–13, 15, 16, 18–22, and 25–28 depending therefrom.

CONCLUSION

The Examiner's rejection of claims 1–4 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is AFFIRMED, and designated a NEW GROUND OF REJECTION.

The Examiner's rejection of claims 1–4 under 35 U.S.C. § 103(a) is AFFIRMED.

The Examiner's rejection of claims 6–13, 15–22, 25–28, and 34 under 35 U.S.C. § 103(a) is REVERSED.

We enter a NEW GROUND OF REJECTION of claims 6–13, 15–22, 25–28, and 34 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/ Basis	Affirmed	Reversed	New Ground
1–4	112, first paragraph	failing to comply with the written description requirement	1–4		1–4 (designated)
1–4		103(a)	1–4		
6–13, 15–22, 25–28, 34		103(a)		6–13, 15–22, 25–28, 34	
6–13, 15–22, 25–28, 34	112, first paragraph	failing to comply with the written description requirement			6–13, 15–22, 25–28, 34
Overall Outcome			1–4	6–13, 15–22, 25–28, 34	1–4 (designated), 6–13, 15–22, 25–28, 34

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.

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)