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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* IVAN E. BROWN, TERYLE L. KOUNKEL, and  
BRANDON RODRIGUEZ

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Appeal 2019-003586  
Application 14/464,762  
Technology Center 3600

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Before BIBHU R. MOHANTY, BRADLEY B. BAYAT, and  
TARA L. HUTCHINGS, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner's decision to reject claims 1–6, 8, 9, and 12. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM.

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<sup>1</sup> 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 Brownmed, Inc. (Appeal Br. 1).

### CLAIMED SUBJECT MATTER

The Appellant's claimed invention relates to a therapeutic eyes mask that provides pain relief with the application of vibratory therapeutics (Spec., para. 1). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A deformable compression eye mask, comprising:
  - a pair of fabric panels one of which contacts the periphery of a user's eye cavity during use, each having an interior surface and an exterior surface, joined to form a closed pouch;
  - a plurality of beads loosely filling said pouch; and
  - a plurality of electro-vibration motors mounted on the interior surface of at least one of said panels, positioned to amplify vibration generated by the motors around the periphery of the eye cavity of a user's eyes during use, in the beads loosely filling said pouch.

### THE REJECTIONS

The following rejections are before us for review:

1. Claim 12 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement and show possession of the claimed invention.
2. Claims 1–6, 8, and 9 are rejected under 35 U.S.C. § 103 as unpatentable over Koby (US 7,601,168 B2, iss. Oct. 13, 2009) and Lin (US 2005/0256433 A1, pub. Nov. 17, 2005).
3. Claims 1–6, 8, 9, and 12 are rejected under 35 U.S.C. § 103 as unpatentable over Koby and Barbera (US 2015/0224019 A1, pub. Aug. 13, 2015).

## FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence.<sup>2</sup>

## ANALYSIS

### *Rejection under 35 U.S.C. § 112, first paragraph*

The Examiner has determined that claim fails to meet the requirements of 35 U.S.C. § 112, first paragraph (Final Act. 2, 3, Ans. 6, 7). Specifically the Examiner has determined that in claim 12 that the limitation of “coin motors” is considered new matter (Final Act. 3).

In contrast, the Appellant argues that support is provided for the coin motors in the drawings at lead lines 26–34 of Figure 3 (Appeal Br. 17, Reply Br. 2). The Appellant also cites to the Specification disclosing using a 3.7 V lithium battery (Appeal Br. 17). The Appellant also provides a Declaration by Brandon Rodriguez which states that one of ordinary skill in the art would recognize that the lead lines represent coin motors (Appeal Br. 17, Reply Br. 3). The Appellant also argues that the Barbera reference at paragraphs 50–52 specifically discloses using coin motors and that Figures 2 and 9 show similar circles (Appeal Br. 17).

We agree with the Examiner. An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures,

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<sup>2</sup> See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997).

Here, it has not been shown that one of ordinary skill in the art would recognize that the motors in lead lines 26–34 specifically included coin motors. The Specification at page 3 for example only refers generally to “motors 26–34” and not specifically to “coin motors”. Further, the drawings at Figure 3 do disclose motors 26–34 as having a circular shape, but it is not specifically disclosed that these are coin motors. The specific battery in the cited in the Specification, the Shenzhen Jingkefka Electronics Co. Limited 3.7 volt lithium battery, has not been shown to be coin motor. While the Appellant cites to the Barbera reference as disclosing coin motors in the drawings at Figures 2 and 9, that Specification, in contrast to Appellant’s Specification, also specifically disclosed in paragraphs 50–52 that coin motors were used. The Declaration provided has been fully considered but is not deemed persuasive, because it provides only opinion evidence that does not overcome the deficiencies in what the Specification actually discloses. The Declaration does not provide sufficient evidence that circles specifically represent coin motors, and not merely motors in a generic manner. For these above reasons, this rejection is sustained.

*Rejection 35 U.S.C. § 103 under  
Koby and Barbera*

The Appellant argues that the rejection of claim 1 under 35 U.S.C. § 103 as unpatentable over Koby and Barbera is improper (Appeal Br. 5–9, Reply Br. 1, 2). The Appellant argues that the prior art fails to show: a motor mounted on the interior surface of eye mask, a plurality of beads

loosely fitting in the pouch, and the motor positioned to amplify the vibration, and the Appellant further argues that there is no motivation for the cited combination (Appeal Br. 5–9).

In contrast, the Examiner has determined that the rejection of record is proper (Final Act. 4–6, Ans. 3, 4).

We agree with the Examiner. Koby in Figure 1 has disclosed an eye pillow 2 that is filled with beads 30 to provide relief to the eye and sinus region. Barbera in Figure 9 and paragraphs 87–93 discloses an eye mask with motors 30 that vibrate to provide therapeutic relief to the region. Here, it would have been a predictable combination of familiar elements and obvious to one of ordinary skill in the art to modify the eye mask of Barbera to include the motors of Koby to provide vibratory therapeutic relief to those regions. Further, in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007), the Court stated that when considering obviousness that “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. *See id.* at 421. Here, one of ordinary skill in the art readily would have inferred that the amount of beads used could be varied based on the desired amount of vibration to be transferred. Similarly, one of ordinary skill in the art would have readily inferred that mounting the motors closer to the inner liner would transfer more vibrations if desired. For these above reasons, the rejection of record for claim 1 under this grounds is sustained.

With regard to the Appellant's arguments regarding claim 3, the location of the motors on the eye region would have been an obvious modification if desired and readily inferred by one of ordinary skill in the art if vibration to that region was desired. Accordingly, the rejection of this claim is sustained.

With regards to the Appellant's arguments regarding claim 6, the use of a material, such as stretchable fabric in the device, would have been an obvious modification and readily inferred by one of ordinary skill in the art if the properties of a breathable, washable, fabric were desired in the combination. Accordingly, the rejection of this claim is sustained.

The Appellant has provided the same arguments for the remaining claims and the rejections of these claims is sustained as well as no specific arguments have been presented for them.

*Rejection 35 U.S.C. § 103 under  
Koby and Lin*

The Appellant argues that the rejection of claim 1 under 35 U.S.C. § 103 as unpatentable over Koby and Lin is improper (Appeal Br. 9–12, Reply Br. 2). The Appellant argues that prior art fails to show: a plurality of beads loosely fitting in the pouch, and the motor positioned to amplify the vibration, and the Appellant further argues that there is no adequate rationale for the cited combination, and that the combination would not be operational (Appeal Br. 9–12).

In contrast, the Examiner has determined that the rejection of record is proper (Final Act. 3, 4, Ans. 4–7).

We agree with the Examiner. Koby in Figure 1 has disclosed an eye pillow 2 that is filled with beads 30 to provide relief to the eye and sinus region. Lin in Figures 5–13, discloses an eye mask 20 with motors 10 that vibrate to provide therapeutic relief to the region. Here, it would have been a predictable combination of familiar elements and obvious to one of ordinary skill in the art to modify the eye mask of Koby to include the motors of Lin to provide vibratory therapeutic relief to those regions. Here, one of ordinary skill in the art would have readily inferred that the amount of beads used could be varied based on the desired amount of vibration to be transferred. Here, the amount of beads could be reduced to still provide room for the motors attached swinging element 13 to move and have an operating device. For these above reasons the rejection of record for claim 1 under this grounds is sustained.

With regard to the Appellant's arguments regarding claim 3, the location of the motors on the eye region would have been an obvious modification if desired, and readily inferred by one of ordinary skill in the art if vibration to that region was desired. Accordingly, the rejection of this claim is sustained.

With regard to the Appellant's arguments regarding claim 6, the use of a material such as stretchable fabric in the device would have been an obvious modification and readily inferred by one of ordinary skill in the art if the properties of a breathable, washable, fabric were desired in the combination. Accordingly, the rejection of this claim is sustained.

The Appellant has provided the same arguments for the remaining claims and the rejections of these claims is sustained as well as no specific arguments have been presented for them.

### CONCLUSIONS OF LAW

We conclude that Appellant has not shown that the Examiner erred in rejecting the claims as listed in the Rejections section above.

### DECISION SUMMARY

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
12	112(a)	Written Description	12	
1-6, 8, 9	103	Koby, Lin	1-6, 8, 9	
1-6, 8, 9, 12	103	Koby, Barbera	1-6, 8, 9, 12	
<b>Overall Outcome</b>			1-6, 8, 9, 12	

### 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**