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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRIAN ALKIRE

Appeal 2019-006924
Application 15/139,810
Technology Center 3700

Before ANTON W. FETTING, MICHAEL C. ASTORINO, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

ASTORINO, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), the Appellant¹ appeals from the Examiner's decision to reject claims 43–50 and 52–54.² We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM IN PART.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. The Appellant identifies the real party in interest as “DIGNITY HEALTH.” Appeal Br. 2.

² Claim 51 is withdrawn. Appeal Br. 4; Ans. 4. Claims 1–42 and 55–58 are cancelled. Amendment 5 (filed July 16, 2019); Advisory Act. (mailed Sept. 4, 2019); Ans. 3, 4.

STATEMENT OF THE CASE

Claimed Subject Matter

Claims 43, 44, and 53 are the independent claims on appeal.

Claim 44, reproduced below, is illustrative of the claimed subject matter.

44. An electroencephalography net for locating electrodes at predetermined positions about a patient's scalp, the electroencephalography net comprising:

a headpiece including a plurality of electrodes and an elastic net configured to space the electrodes on the patient's scalp in the predetermined positions;

a plurality of electrodes, each of the electrodes being mounted at a corresponding electrode mounting location prior to the elastic net being applied to the patient's head, and being distributed around the patient's head and oriented such that, when the elastic net is applied to the patient's head, they are available at the predetermined positions to electrically connect the electrodes to the patient's scalp; and

a plurality of electrical signal transmitting wires, each transmitting wire corresponding to a respective one of the plurality of electrodes.

Rejections

Claims 44–49 and 52–54 are rejected under 35 U.S.C. § 102(b) as clearly anticipated by Price (US 3,998,213, iss. Dec. 21, 1976).

Claim 43 is rejected under 35 U.S.C. § 103(a) as unpatentable over Price and Dikmen (US 3,896,790, iss. July 29, 1975).

Claim 50 is rejected under 35 U.S.C. § 103(a) as unpatentable over Price and Musha (US 6,067,464, iss. May 23, 2000).

ANALYSIS

Anticipated by Price

Independent Claim 44 and Dependent Claims 45–49 and 52

The Appellant points out that independent claim 44 requires: that each electrode is mounted at a corresponding electrode mounting location prior to the elastic net being applied to the patient's head, and the electrodes are distributed around the patient's head and oriented such that, when the elastic net is applied to the patient's head, they are available at the predetermined positions to electrically connect the electrodes to the patient's scalp.

Appeal Br. 5; *see supra* (Claim 44). The Appellant argues that “Price does not disclose sequencing of mounting electrodes on its cap versus placing its cap on the patient.” Appeal Br. 5; *see Reply Br. 2–3*. More specifically, the Appellant argues that the sequencing limitation of claim 44 is not met by Price's claim 14 because the failure to omit prior insertion along with the possibility that it might be permitted “does not equate with Price disclosing it.” Appeal Br. 5–6 (citing *PersonalWeb Technologies, LLC v. Apple, Inc.*, 917 F.3d 1376, 1382 (Fed. Cir. 2019)). The Appellant's argument is not persuasive of error.

At the outset, we note that the disputed recitation of claim 44 does not call for a “sequencing of mounting electrodes on its cap versus placing its cap on the patient,” as asserted by the Appellant. Claim 44 calls for an electroencephalography net in which each of a plurality of electrodes is capable of “being mounted at a corresponding electrode mounting location prior to the elastic net being applied to the patient's head.” Therefore, the Appellant's argument is not commensurate in scope with the requirements of claim 44.

Further, we note that the requirement that “each of the electrodes being mounted at a corresponding electrode mounting location prior to the elastic net being applied to the patient’s head” requires a physical connection between “each of the electrodes” and the “electrode mounting location.” *See* Appeal 2013-001474, page 6 (mailed Oct. 2, 2015).³ This interpretation is consistent with the Specification, which instructs that “[t]he pre-formed [Urgent EEG Net] comprises a headpiece with recording electrodes incorporated therein” and “[t]he electrodes . . . are attached or formed to the straps [of the headpiece] in a manner so as to present the recording head of the electrode to a corresponding recording port.” Spec. ¶ 26; *see id.* ¶ 63 (“headpiece with pre-incorporated five-prong electrodes”).

The Examiner finds that Price’s self-adjustable holder for automatically positioning electroencephalographic electrodes corresponds with the claimed electroencephalography net. *See* Final Act. 4. More specifically, the Examiner finds that “[t]he Price reference discloses an elastic EEG net with electrodes connected to wires as disclosed in the various Figures.” *Id.* (citing Price 4:16–7:41). Price describes the connection between the electroencephalography net and the electrodes as follows:

When the electrode **35** is inserted in the sleeve **27** in the opening of the electrode positioning element **3**, it is retained against the scalp by means of flange portions **39** on the sides of the opening **25** at its outside edge, as viewed when the electrode positioning element **3** is in place on a head.

³ Application No. 12/376,359 is a parent application of the instant application, which includes Appeal 2013-001474.

Price 6:63–68, Figs. 5–10. Accordingly, Price’s electrodes have a physical connection between each of its electrodes and their mounting location.

Additionally, the Examiner references Price’s claim 14 (Ans. 5), which describes “an electrode may be inserted in each of said electrode positioning elements after said cap means has been placed on a head.” Price does not explicitly disclose the capability for performing the oppositely claimed sequence, i.e., “each of the electrodes being mounted at a corresponding electrode mounting location prior to the elastic net [(cap means)] being applied to the patient’s head.” However, we determine that one of ordinary skill in the art would understand that due to the physical relationship between Price’s electrodes and electrode positioning elements there is no impediment to physically connecting the electrodes to the electrode positioning elements before or after the elastic EEG net is applied to the patient’s head. *See id.* (“the skilled artisan would assume the Price net is capable of either prior or post placement insertion of the electrodes.”).

In view of the foregoing, we determine that there is a sound basis for believing that the structure of Price’s electrodes and electrode positioning elements are the same as the claimed electrodes and electrode mounting locations. *See, e.g.,* Spec. ¶26, Fig. 3A; Price, 4:16–7:19, Figs. 1–10; *see In re Spada*, 911 F.2d 705, 709 (Fed. Cir. 1990) (“When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.”); *see also In re Best*, 562 F.2d 1252, 1254–55 (explaining that where claimed and prior art products are identical or substantially identical, the burden is upon Appellants to prove that the prior art products do not inherently possess the characteristics of the claimed product because the PTO is unable

to perform the necessary comparative testing). Therefore, we determine that Price's disclosure adequately supports the finding that each of Price's electrodes has the capability of being mounted at an electrode mounting location prior to the elastic net being applied to the patient's head.

The Appellant does not argue — by using evidence and/or technical reasoning — that each of Price's plurality of electrodes are not capable of being mounted at a corresponding electrode mounting location prior to the elastic net being applied to the patient's head. Additionally, as for the Appellant's reference to *PersonalWeb*, 917 F.3d at 1382 (Appeal Br. 6; Reply Br. 2), we note that the holding of *PersonalWeb* is particular to a rejection under obviousness, and not a rejection under anticipation.

In view of the foregoing, we sustain the Examiner's rejection of independent claim 44 and dependent claims 45–49 and 52 as anticipated by Price.

Independent Claim 53 and Dependent Claim 54

The Examiner's relies on the same findings for the rejection of independent claims 44 and 53. *See* Final Act. 4. As discussed above, each of Price's electrodes have the capability of being mounted at an electrode mounting location prior to the elastic net being applied to the patient's head. However, claim 53 requires more than this capability. *See* Appeal Br., Claims App. Claim 53 recites a method that includes the step of “attaching the flexible net to the scalp after the electrodes have been located in the flexible net.” *Id.* Price does not teach this step of sequencing. *Id.* at 5. Additionally, the Examiner finds “[t]he configuration of the Price net would clearly permit the electrodes to be inserted prior to application of the net to

the head as is standard practice in the art (e.g., see [Musha]).” Ans. 4–5. However, the foregoing does not explain how Price discloses the step of “attaching the flexible net to the scalp after the electrodes have been located in the flexible net,” as recited in claim 53.

Thus, we do not sustain the Examiner’s rejection of independent claim 53 and dependent claim 54 as anticipated by Price.

Obviousness based on Price and Dikmen

The Appellant points out that claim 43 includes a requirement that is nearly identical to the requirement of claim 44. *See* Appeal Br. 6–7. The Appellant’s argument for claim 43 is based on the same reasons as those provided for the rejection of claim 44, i.e., that “Price does not suggest the missing sequencing claim limitation.” *Id.* at 7. The Appellant’s argument is not persuasive.

Notably, the Examiner’s rejection of claim 43 includes a modification of Price’s electrodes in view of Dikmen’s teaching of pronged electrodes. Final Act. 5. For reasons similar to those as discussed above with regard to the rejection of claim 44, we determine that Price’s electrodes, as modified, have the capability of being mounted at an electrode mounting location prior to the elastic net being applied to the patient’s head. Additionally, we note that the Appellant does not argue — by using evidence and/or technical reasoning — that each of Price’s plurality of electrodes, as modified, are not capable of being mounted at a corresponding electrode mounting location prior to the elastic net being applied to the patient’s head.

Thus, we sustain the Examiner’s rejection of independent claim 43 as unpatentable over Price and Dikmen.

Obviousness based on Price and Musha

The Appellant does not separately argue the Examiner’s rejection of claim 50, which depends from claim 44. *See* Appeal Br. 5–6. Therefore, we sustain the Examiner’s rejection of dependent claim 50 as unpatentable over Price and Musha.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	References/Basis	Affirmed	Reversed
44–49, 52–54	102(b)	Price	44–49, 52	53, 54
43	103(a)	Price, Dikmen	43	
50	103(a)	Price, Musha	50	
Overall Outcome			43–50, 52	53, 54

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

AFFIRMED IN PART