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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/728,215	10/09/2017	George Stefan Golda	SRD0.00202US	4049
81325	7590	08/27/2020	EXAMINER	
Peter B. Scull HDC IP Law, LLP 4818 W. 31st Ave Denver, CO 80212			JIAN, SHIRLEY XUEYING	
			ART UNIT	PAPER NUMBER
			3792	
			NOTIFICATION DATE	DELIVERY MODE
			08/27/2020	ELECTRONIC

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GEORGE STEFAN GOLDA,
DANIEL VAN ZANDT MOYER,
MARK P. MARRIOTT,
SAM ELETR, and
BRUCE O'NEIL

Appeal 2020-004602
Application 15/728,215
Technology Center 3700

Before DANIEL S. SONG, EDWARD A. BROWN, and
MICHAEL L. HOELTER, *Administrative Patent Judges*.

HOELTER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the
Examiner's decision to reject claims 1, 4–9, and 13–18, which constitute all

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as “RHYTHM DIAGNOSTIC SYSTEMS, Inc.” Appeal Br. 2.

the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM the Examiner's rejections of these claims.

CLAIMED SUBJECT MATTER

The disclosed subject matter relates to “medical monitoring devices, systems and/or methods,” and in some instances to “long-term sensing and/or recording of cardiac and/or respiratory data of an individual.” Spec. ¶ 3. Apparatus claims 1 and 13 are independent. Claim 1 is illustrative of the claims on appeal and is reproduced below.

1. A device for monitoring a physiological parameter, the device being configured to be adhered to the skin of a subject for the physiological parameter monitoring; the device comprising:
 - a substrate;
 - a conductive sensor connected to the substrate, and
 - a double-sided composite, very high tack adhesive having two parts:
 - at least one conductive adhesive portion, and
 - at least one non-conductive adhesive portion;the at least one conductive portion being disposed as at least one island within the at least one non-conductive portion and being surrounded thereby;
 - double-sided defining adhesive on two sides of the composite,
 - composite defining the [two]² parts as a composition formed apart from other elements;

² The letter “t” of the word “two” was included in the last set of claims entered by the Examiner. *See* Amendment dated May 20, 2019 and the Final Office Action dated July 11, 2019. It is not made clear how the letter “t” was dropped (thereby forming “wo”) when the last-entered claims were replicated in the Appeal Brief. Thus, as best we can ascertain, the letter “t” (forming the word “two”) is properly before the Examiner.

the double-sided composite adhesive being attached to the substrate and the conductive sensor;
the at least one conductive adhesive portion being disposed in direct contact with and in conductive communicative contact with the conductive sensor, and
being configured to be conductively and securely and directly adhered to the skin and fixed directly to and relative to the skin of the subject for conductive signal communication from the subject to the conductive sensor therethrough; and
thereby being configured to one or both reduce or eliminate sensor movement relative to the skin,
to one or both reduce noise or provide a clean signal.

EVIDENCE

Name	Reference	Date
Lyons	US 5,465,715	Nov. 14, 1995
Menon et al. (“Menon”)	US 2007/0032719 A1	Feb. 8, 2007
Bishay et al. (“Bishay”)	US 2012/0089037 A1	Apr. 12, 2012
Solosko et al. (“Solosko”)	US 2012/0101396 A1	Apr. 26, 2012

REJECTIONS³

Claims 1, 4–9, and 13–15 are rejected on the ground of nonstatutory double patenting over claims 1–10 of U.S. Patent No. 9,782,132.

Claims 1, 4–9, and 13–18 are rejected under 35 U.S.C. § 112(a) as failing to comply with the written description requirement.

³ “Claim 16 is objected to as being dependent upon a rejected base claim, but *would be allowable* if rewritten in independent form including all of the limitations of the base claim and any intervening claims.” Final Act. 25. The Examiner explains that this objection is based on the Examiner’s interpretation of certain claimed components and that “Lyons does not explicitly disclose” certain claim limitations. Final Act. 25.

Claims 1, 4–9, and 13–18 are rejected under 35 U.S.C. § 112(b) as failing to set forth the subject matter which the inventor or a joint inventor, regard as their invention.

Claims 1, 4, 5, 13, and 14 are rejected under 35 U.S.C. § 102(b) as anticipated by Lyons.

Claims 6–9 are rejected under 35 U.S.C. § 103 as unpatentable over Lyons and Solosko.

Claim 15 is rejected under 35 U.S.C. § 103 as unpatentable over Lyons and Menon.

Claims 17 and 18 are rejected under 35 U.S.C. § 103 as unpatentable over Lyons and Bishay.

ANALYSIS

*The rejection of claims 1, 4–9, and 13–18
as failing to comply with the written description requirement*

Both independent claims 1 and 13 were amended to now recite a “composite defining the two parts as a composition formed apart from other elements.”⁴ See Amendment dated May 20, 2019. The Examiner addresses this limitation employing both “composite” and “composition,” stating, “[t]here is no explicit teaching from the Applicant’s Specification that” addresses this limitation. Final Act. 7. “Applicant is required to point out

⁴ The claim term “other elements” is not otherwise employed in either claim 1 or 13. Appellant’s Specification employs the term “other elements” when stating “FIG 1A shows isometrically these in what may here be considered a substantially transparent device *together with some other elements that may be used herewith.*” Spec. ¶ 26 (emphasis added). We thus understand that “other elements” is to be construed as some other device which can be “considered” to be “used herewith” (i.e., “together with”) the substantially transparent device.

explicit support from the original Disclosure, or cancel/amend any non-supported limitations.” Final Act. 8.

Appellant contends, “there is NO ‘*in haec verba*’ requirement” and that “Appellant need not point out any explicit disclosure where there may be non-explicit understanding.” Appeal Br. 39; *see also* Reply Br. 18 (“all that is necessary under the law is sufficient disclosure for a skilled artisan to understand”). Appellant states, “there are various reasons to understand the at least minimal inherency of such from the ‘composite’ disclosure,” and thereafter provides a definition of “composite” (when used as an adjective) as “made up of distinct parts or elements.”⁵ Appeal Br. 10 (referencing www.merriam-webster.com/dictionary/composite); *see also id.* at 39. Relying on this definition, Appellant states, “it doesn’t matter what the other elements are, so long as they are kept separate during the formation of the ‘composite’ thing.” Appeal Br. 40. “As a consequence, the subject matter hereof is appropriately within the disclosure terms and thus it satisfies MPEP [§] 2163 and the written description requirement.” Appeal Br. 40.

The claim limitation in question recites a “composite defining the two parts as a composition formed apart,” thus we need to ascertain that which Appellant deems a “composite” and that which Appellant deems a “composition.” Regarding the latter term “composition,” Appellant’s Specification does not employ this term nor does Appellant provide any indication as to where support for this term can be found therein, but for reliance on the definition of “composite” above. *See* Appeal Br. 39–40.

⁵ Appellant references various dictionary definitions of “composite” for when this term is used as either an adjective, a noun, or a verb. *See* Appeal Br. 10, 12, 13.

However, Appellant contends that “composite” and “composition” are equivalent, and relies on Wikipedia for support, i.e., “[a] composite material (also called a composition material . . .).” Appeal Br. 12, Reply Br. 70 (emphasis omitted). Yet, Appellant’s attempt to equate the meaning of “composite” with that of “composition” is counter-productive in this instance because the limitation in question establishes a transformation of a “composite” (defining the parts) into a “composition formed apart,” thereby establishing a distinction between the two.

Because Appellant’s Specification is silent regarding the claim term “composition,” our reviewing court has provided guidance that when a written description cannot be found in the specification, as filed, the only thing the Examiner can reasonably be expected to do is to point out its non-existence. *See Hyatt v. Dudas*, 492 F.3d 1365, 1370 (Fed. Cir. 2007). As indicated above, the two claim terms “composite” and “composition” cannot be equated, and the inability of Appellant’s Specification to provide guidance as to their differences does not bode well for Appellant when the Examiner questions the written description support of this amended claim limitation. *See Final Act. 7–8.*

In addition to the failure to employ “composition” in Appellant’s Specification, it is also noted that when Appellant’s Specification employs the claim term “composite,” it does not do so as a stand-alone word. Instead, Appellant’s Specification employs such phrases as “composite adhesive 113,” “composite adhesive 113a,” “adhesive composite 113a,” or simply “composite adhesive.”⁶ Spec. ¶¶ 37 46, 47, 49, 50. It may be

⁶ “The Applicant’s original disclosure does not provide a distinct definition to the term ‘composite’ or ‘composite adhesive.’” Ans. 25.

presumed that the recited term “composite” is the same as any of these phrases in Appellant’s Specification. However, this presumption is questionable because claim 1 also recites “composite adhesive” separate from simply reciting “composite.” Thus, this separate usage undermines any implication or assertion that “composite” is the same as any of the above phrases.⁷ Further, Appellant’s original recitation of claims 1 and 13 employ “composite adhesive,” and not simply “composite” as now recited. Hence, again, we do not fault the Examiner for seeking guidance from Appellant as to where support for “composite” can be found in Appellant’s Specification, in order to show that Appellant, indeed, had possession of that which is presently claimed.

“The essence of the written description requirement is that a patent applicant, as part of the bargain with the public, must describe his or her invention so that the public will know what it is and that he or she has truly made the claimed invention.” *AbbVie Deutschland GmbH & Co. v. Janssen Biotech, Inc.*, 759 F.3d 1285, 1298 (Fed. Cir. 2014). While we understand “that claims can be self-describing,” i.e., “composition formed apart,” (*Neology, Inc. v. International Trade Commission*, 767 Fed. Appx. 937, 941 (Fed. Cir. 2019)), our reviewing court has also explained that “[t]he appearance of mere indistinct words in a specification or a claim, even an original claim, does not necessarily satisfy” Section 112, first paragraph matters because such usage may not both put others on notice of the scope of the claimed invention and demonstrate possession of that invention. *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 968–9 (Fed. Cir. 2002).

⁷ Claim 13 recites “composite” in the limitation under investigation and, thereafter, employs “hydrogel adhesive” to refer to that “composite.”

Thus, we have been instructed that “written description is about whether the skilled reader of the patent disclosure can recognize that what was claimed corresponds to what was described.” *Alcon Research Ltd. v. Barr Labs., Inc.*, 745 F.3d 1180, 1191 (Fed. Cir. 2014). In other words, the invention must be disclosed in a way that clearly allows a person of ordinary skill to recognize that the inventor invented what is claimed and possessed the claimed subject matter at the date of filing. *See Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). We conclude that, in view of the above, such a disclosure has not been sufficiently made.

New or amended claims which introduce elements or limitations that are not supported by the as-filed disclosure violate the written description requirement. *See, e.g., In re Lukach*, 442 F.2d 967 (CCPA 1971). The inquiry into whether the description requirement is met is a question of fact. *See In re Wertheim*, 541 F.2d 257, 262, (CCPA 1976). Accordingly, and based on the record presented, we sustain the Examiner’s rejection of claims 1, 4–9, and 13–18 as “failing to comply with the written description requirement.” Final Act. 7.

*The rejection of claims 1, 4–9, and 13–18
as being indefinite*

The Examiner addresses the following limitations of claim 1 (emphasis by the Examiner): “a double-sided composite, very high tack adhesive having two parts: at least one conductive adhesive portion, and at least one non-conductive adhesive portion.”⁸ Final Act. 8. The Examiner states, “it is unclear to the Examiner how a *part* is related to a *portion*” and

⁸ Claim 13 employs similar highlighted language.

provides multiple interpretations of how these limitations can be construed. Final Act. 8; *see also* Ans. 35 (“[s]ince the relationship is unclear, this leads to various interpretations”). The Examiner also states that “[s]ince the relationship between *parts* and *portions* is unclear, the following limitation is further indefinite: ‘*composite defining the two parts as a composition formed apart from other elements.*’”⁹ Final Act. 9.

Appellant disagrees stating that “its chosen approach is not unclear” and that where claim terms are “readily ascertainable by a skilled artisan . . . the claim terms are not indefinite.” Appeal Br. 41 (referencing MPEP §§ 2173.05(h), 2173.04); *see also* Reply Br. 20. Appellant also contends, “these terms must be interpreted as distinguishing at least some adhesives which do not have either two parts or two portions.” Appeal Br. 41. In essence, Appellant is equating “parts” and “portions,” i.e., “[a] ‘composite’ is a **THING** made of or from two or more other things, or parts or portions.” Reply Br. 1; *see also id.* at 4 (“the two parts and/or portions”). However, nowhere does Appellant identify in Appellant’s Specification where the two terms “parts” and “portions” are used in such an equivalent manner as now asserted. Thus, each claim term is provided its own meaning, and especially here where “parts” is recited as containing distinct “portions.”

Appellant further alleges that “where the two respective portions are or at least very reasonably *may be* and *may define* further the two parts – this

⁹ Regarding the claim term “composite,” we note that, with respect to claim 1, this term is employed as a noun (“double-sided composite,” “the composite,” “composite defining”) and also as an adjective (“composite adhesive”). Appellant provides different definitions for this term depending on its usage. *See* Appeal Br. 10, 12. Thus, the same term in claim 1 has different meanings.

is not indefinite.” Reply Br. 20 (emphasis added). We disagree because this contention supports the Examiner’s assertion that the claims are “unclear” (Final Act. 8) as the interpretation desired by Appellant is one based on speculation.

Appellant reinforces this speculative nature by stating that in one case, the two portions “may be” the two parts, but in an alternative case, it is just as well “for the two portions to not necessarily be the two parts,” so long as there is a conductive and a non-conductive “adhesive portion.” Reply Br. 20. Hence, as per Appellant, the two portions may be the two parts or may not be the two parts, which supports the Examiner’s finding that Appellant’s usage of these terms is “unclear.” Final Act. 8.

Consequently, in view of Appellant’s assertions, we concur with the Examiner’s statement that “[w]hen a claim is amenable to two plausible interpretations, a rejection under 35 U.S.C. § 112, second paragraph, for indefiniteness, is appropriate.” Ans. 35 (referencing *Ex parte Miyazaki*, 89 USPQ2d 1207 (BPAI 2008) (precedential)). Accordingly, and based on the record presented, we sustain the Examiner’s rejection of claims 1, 4–9, and 13–18 as being indefinite.

*The rejection of claims 1, 4, 5, 13, and 14
as anticipated by Lyons*

Appellant argues the rejection of claim 1 (*see* Appeal Br. 23–28) separate from the rejection of claim 13 (*see* Appeal Br. 29–33). However, the arguments presented with respect to claim 13 are similar to those presented with respect to claim 1. Additionally, Appellant does not separately argue the remaining claims (i.e., claims 4, 5, and 14) stating instead that “[a]s all the remaining pending claims are thus novel in view of

the citations, the novelty rejections thus fail and must be withdrawn.”

Appeal Br. 34. Accordingly, we select claim 1 for review, with the remaining claims, i.e., claims 4, 5, 13, and 14, standing or falling with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Although the Examiner deems claim 1 indefinite for the reasons expressed above, the Examiner emphasizes that, “[f]or purposes of examination, it is the Examiner’s best guess that the *two parts* refer to a *conductive portion being a first part, and a non-conductive portion being a second part*; since the term ‘composition’ refers to two different elements.” Final Act. 9. We abide by this understanding when contrasting claim 1 with the cited art.

Appellant contends that “Lyons simply does not provide or suggest or motivate or include any KSR-reason for or toward an adhesive ‘composite’ (or even a ‘composite’ adhesive).”¹⁰ Appeal Br. 6; *see also id.* at 14. However, no such “KSR-reason” is needed in the present situation because the Examiner’s rejection is based on anticipation, not obviousness.

Appellant further contends that “Lyons does have several pieces/things placed in nearby but non-touching juxtaposition” and that “being near each other is not forming a composite.” Appeal Br. 6; *see also id.* at 9, 12, 17; Reply Br. 13, 14. First, claim 1 is silent as to any “several pieces/things” of the composite touching. Second, Appellant does not explain how a “composite” necessitates that each piece/thing must touch

¹⁰ *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (“rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).

every other piece/thing therein. *See* Reply Br. 13 (“Lyons never says they touch each other or otherwise act or interact compositely with each other”). Third, Appellant does not explain how different pieces/things placed in close proximity to each other, but not touching, cannot, together, form a “composite.”

Appellant also references the Specification (i.e., drawings and paragraphs) to indicate “what is intended and defined by the ‘composite adhesive’ hereof.” Appeal Br. 6; *see also* Reply Br. 4 (“The drawings can provide all the teaching or definition necessary for a proper understanding of the invention.”). However, Appellant does not explain how the claims are to be interpreted by what was “intended” in contrast to the express language recited by the claims, and as understood from a review of the Specification. In other words, incorporating limitations from Appellant’s Specification into the claims is not permitted. Our reviewing court has repeatedly “cautioned against limiting the claimed invention to preferred embodiments or specific examples in the specification.” *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1346–47 (Fed. Cir. 2015) (quoting *Teleflex, Inc. v. Ficoso N. Am. Corp.*, 299 F.3d 1313, 1328 (Fed. Cir. 2002)).

Appellant also contends that, based on Appellant’s Specification, the “composited thing 113a is clearly a discrete singular separately identifiable/identified entity or element.” Appeal Br. 8; *see also id.* at 14 (Lyons is “never composited as a single combined adhesive”), 23 (“a unitary ‘whole’”), 24; Reply Br. 5, 8–9. However, nowhere does Appellant identify a disclosure where “singular” (or “single” or “unitary”) is a requirement of the composite.

When interpreting claim language, we are instructed that “claims are interpreted with an eye toward giving effect to all terms in the claim.” *Bicon Inc. v. Straumann Co.*, 441 F.3d 945, 950 (Fed. Cir. 2006). *See also Stumbo v. Eastman Outdoors, Inc.*, 508 F.3d 1358, 1362 (Fed. Cir. 2007) (denouncing claim constructions which render phrases in claims superfluous). Here, claim 1 recites “a double-sided composite, very high tack adhesive having two parts.” Substituting Appellant’s definition for the word “composite” would result in “a double-sided ‘something’ ‘made up of distinct parts or elements,’ very high tack adhesive having two parts.” Appeal Br. 10, 12. Thus the phrase “something made up of distinct parts or elements” is distinct from the phrase “having two parts.” The same can be said for the claim 1 limitation discussed above (i.e., “composite defining the two parts”). Substituting Appellant’s definition in that phrase (Appeal Br. 10, 12) would render “‘something’ ‘made up of distinct parts or elements’ defining the two parts.” Again, as best understood, “distinct parts or elements” differs from “two parts.” Hence, Appellants contention above regarding singularity would appear to contradict Appellant’s explicit requirement of the composition being “two parts.”

Thus, as best understood and abiding by guidance from our reviewing court, Appellant’s assertion concerning “singular” (or “single” or “unitary”) with respect to “composite” appears to be the opposite of the actual language of claim 1. Thus, when giving effect to all the terms in the claim, claim 1 conveys that, without further clarification, the “composite” is not, as Appellant asserts above, “singular” (or “single” or “unitary”). Consequently, we find no error by the Examiner in correlating Lyons’ items 156 and 108 (sandwiching a sensor therebetween (*see* Lyons Figs. 1–5)) as

forming the recited “composite.” Final Act. 12. In other words, Appellant chose language for claim 1 that does not preclude “composite” being of “two parts,” i.e., in the manner discussed by the Examiner with respect to the teachings of Lyons. *See* Final Act. 12.

Appellant also addresses a distance “d” inserted by Appellant in an annotation of Figure 1 of Lyons. *See* Appeal Br. 16; Reply Br. 11. Appellant is indicating that “the distance ‘d’ makes clear that the top component 108 and conductive media 156 [both of Lyons] do not form a composite with each other.” Appeal Br. 16; *see also* Reply Br. 12. However, as best we can ascertain, this “distance ‘d’” is merely an indication that the two Lyons elements are not identical in size; but instead one has a greater radius (the addition of the “d” distance) than the other. Lyons also describes how items 156 and 108 are interconnected with each other, i.e., sandwiching a sensor therebetween. *See* Lyons Figs. 1–5 and associated text.

Appellant also contends “that the adhesive is ‘entirely on one side of 116’ of top component 108.” Appeal Br. 19; *see also* Reply Br. 7–8. However, Appellant is disregarding the Examiner’s reference to component 156, which also employs adhesives. Final Act. 12 (“*156 and 108 together form a ‘composite’ structure as shown in Fig. 1*”) (referencing Lyons 9:20–25 which states that item 156 “typically comprises an electrically-conductive cream, gel, adhesive, or other material.”). Further, Appellant contends that in Lyons, “there is no indication of any relation of media 156 to or with die-cut patch/top component 108.” Appeal Br. 19. In this matter, Appellant appears to have completely disregarded Lyons’ teaching that upper component 108 is applied to the patient’s skin along with media 156, which is surrounded and enclosed by 108. *See* Lyons 5:40–43; 9:20–25; Fig. 1.

Appellant further contends that in Lyons, “[t]here is no double-sidedness of the adhesive relative to component 108.” Appeal Br. 20; *see also id.* at 24, 28. However, claim 1 does not recite double-sidedness of the adhesive “relative to [a] component” but, instead, to the whole composite itself, and not one of its parts. Thus, Appellant is arguing a lack of double-sidedness only with respect to one of the “distinct parts” that define the composite, when the claim, instead, recites double-sidedness with respect to the entire composite. Appellant’s mis-interpretation of claim 1 is not persuasive of Examiner error.¹¹

Appellant also contends that the Examiner’s reliance on Lyons as disclosing a composite “would be reading such limitations as having no meaning and thus being ‘superfluous.’” Appeal Br. 22. However, Appellant is disregarding the language expressed by the Examiner when interpreting claim 1 “[f]or purposes of Examination.” Final Act. 9. The Examiner expressly stated what was to be understood by the claim terms “parts” and “portions” so that the following limitation, “a double-sided composite, very high tack adhesive having two parts” can be better understood. Appellant does not explain how Lyons fails to meet this criteria or otherwise causes any term to be “superfluous.”

¹¹ To be clear, the Examiner has identified “156 and 108 together form a ‘composite’ structure.” Final Act. 12. “Composite” is defined by Appellant as “made up of distinct parts or elements.” Appeal Br. 10, 39. Claim 1 recites “a double-sided composite.” Thus, Appellant’s assertion above that there is no double-sidedness “relative to component 108” (Appeal Br. 20) is not commensurate with the scope of claim 1 since clearly the “composite” identified by the Examiner has a top (*see* upper surface of 108) and a bottom (*see* lower surface of 156).

Appellant also proposes yet another definition of “composite” (i.e., “no. 4” (Appeal Br. 22, 24, 25)) and contends that “it is inappropriate to pick in isolation a single dictionary definition that is not consistent with the specification.” Appeal Br. 23. But Appellant has already indicated that the previous definition *proposed by Appellant* is acceptable (*see* Appeal Br. 13) and Appellant does not explain how this new definition (i.e., “no. 4”) would result in a different outcome with respect to the teachings of Lyons in view of the Examiner’s understanding of claim 1.

Accordingly, and based on the record presented, we are not persuaded of Examiner error. We sustain the Examiner’s rejection of claims 1, 4, 5, 13, and 14 as being anticipated by Lyons.

*The rejection of claims 6–9
as unpatentable over Lyons and Solosko*

Appellant argues claims 6–9 together. *See* Appeal Br. 34–36. We select claim 6 for review, with claims 7–9 standing or falling with claim 6.

Claim 6 includes an additional limitation directed to an electrode “configured to be a proxy driven-right-leg electrode.” However, Appellant does not argue this limitation (or any additional limitation cited in claims 7–9), but instead references two limitations found in parent claim 1. *See* Appeal Br. 34–36; *see also* Ans. 33. The first is the “double-sided composite” discussed above (and which we will not re-address here). Appeal Br. 34; *see also* Reply Br. 60. The second is the limitation “configured to one or both reduce or eliminate sensor movement relative to the skin, to one or both reduce noise or provide a clean signal.” Appeal Br. 34. Appellant contends that “Solosko is not cited for and does not cure the failures of Lyons.” Appeal Br. 34. However, Solosko was cited for teaching

the “proxy driven-right-leg electrode” additionally recited in claim 6 (*see* Final Act. 19), *not for the claim 1 limitation above regarding* the reduction or elimination of sensor movement to reduce noise or provide a clean signal. The Examiner relied on Lyons for this teaching and provided citations to Lyons where such teachings can be found to have been anticipated by Lyons.¹² *See* Final Act. 14–15. Hence, Appellant’s contention that Solosko does not cure the claim 1 deficiency is not responsive to the Examiner’s rejection. Therefore, Appellant’s argument regarding a lack of sufficient teaching, suggestion, or motivation, “or otherwise providing a KSR reason” for such claim 1 limitation, is not indicative the Examiner erred when finding, instead, that Lyons anticipated (i.e., discloses) this claim 1 limitation. Appeal Br. 34; *see also id.* at 36; Final Act. 11–15.

Consequently, we do not fault the Examiner for failing to provide “a KSR reason” regarding this limitation when the claim 1 limitation in question was rejected under Section 102, not 103. In other words, under an anticipation analysis, no “KSR reason” need be provided.

Accordingly, we sustain the Examiner’s rejection of claims 6–9 as being obvious over Lyons and Solosko.

The rejection of (a) claim 15 as unpatentable over Lyons and Menon, and (b) claims 17 and 18 as unpatentable over Lyons and Bishay

Claims 15, 17, and 18 each depend, directly or indirectly, from claim 13. Claim 13 recites a “hydrogel composite adhesive.” Appellant contends that the additional recitations to Menon and Bishay do not “cure the failures

¹² Lyons teaches the use of adhesive properties that “both assist in the bonding of the electrode **100** to the patient and to reduce electrical artifacts caused by movement between conductive components.” Lyons 9:29–32; *see also* Final Act. 15.

of Lyons” regarding this “hydrogel” limitation. Appeal Br. 37. Similar to the above, the Examiner did not rely on the additional references to Menon or Bishay to teach this parent claim 13 “hydrogel” limitation because the Examiner relied on Lyons for such teachings. *See* Final Act. 16 (referencing Lyons 9:33–35). Indeed, Lyons teaches the use of “medical grade, electrically-conductive hydrogel with adhesive qualities that is commercially available.” Lyons 9:34–36. Appellant does not explain how Lyons fails to anticipate this limitation, or why, due to being rejected under Section 102, the Examiner erred in not also providing a “rationale” or a “KSR REASON” on this point. Appeal Br. 37.

Accordingly, and based on the record presented, we sustain the Examiner’s rejection of claims 15, 17, and 18 as being obvious over either Lyons and Menon, or over Lyons and Bishay.

Additional Issues

In view of our analysis above, we do not address the Examiner’s “Double Patenting” rejection of claims 1, 4–9, and 13–15. Final Act. 4–7.

We also question the Examiner’s finding that claim 16 “would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.” Final Act. 25. This is because we agree with the Examiner that parent claim 13 lacks written description support, and is indefinite. Any rewriting of claim 16 to merely include the base claim and intervening claims would not affect those determinations.

Additionally, we note that Appellant’s Reply Brief not only re-states arguments previously made, but also addresses several claims and/or arguments for specific claims that were not specifically addressed or argued in Appellant’s Appeal Brief. For example, Appellant presents arguments

regarding claims 4 and 5 in the Reply Brief (*see* Reply Br. 27–28) yet Appellant did not specifically argue these two claims in the Appeal Brief, but instead argued them as part of a larger group of claims (*see* Appeal Br. 23–28, 34). The same can be said for claim 14 (*see* Reply Br. 32–33; Appeal Br. 34) as well as for claims 7–9 (which were argued as a group along with selected claim 6). *See* Reply Br. 36–39, 59–61; Appeal Br. 34–36. Appellant also seeks to re-argue claims 15, 17, and 18 discussed above (*see* Reply Br. 40–43, 61–62), but this time by focusing on other matters beyond just the “hydrogel” matter discussed in the Appeal Brief (*see* Appeal Br. 37; Reply Br. 61–62).

We decline to review these additional arguments made for the first time in Appellant’s Reply Brief because good cause was not shown. *See* 37 C.F.R. §§ 41.37(c)(iv), 41.41(b)(2); *In re Baxter Int’l, Inc.*, 678 F.3d 1357, 1362 (Fed. Cir. 2012); *In re McDaniel*, 293 F.3d 1379, 1383 (Fed. Cir. 2002).

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 4–9, 13–15		Obviousness-type Double Patenting ¹³		
1, 4–9, 13–18	112(a)	Written Description	1, 4–9, 13–18	
1, 4–9, 13–18	112(b)	Indefinite	1, 4–9, 13–18	
1, 4, 5, 13, 14	102(b)	Lyons	1, 4, 5, 13, 14	
6–9	103	Lyons, Solosko	6–9	

¹³ As explained above, we do not reach this rejection.

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15	103	Lyons, Menon	15	
17, 18	103	Lyons, Bishay	17, 18	
Overall Outcome			1, 4-9, 13-15, 17, 18	

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

AFFIRMED