

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DENNIS E. OCHS and DANIEL J. POWERS

Appeal No. 2003-1339
Application No. 09/810,813

ON BRIEF

Before ABRAMS, STAAB, and BAHR, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 21-24. Claims 25 and 26 stand objected to as containing allowable subject matter but depending from a rejected claim. Claims 1-20 and 39-58 have been canceled, and claims 27-38 have been withdrawn as being directed to a non-elected invention.

We AFFIRM.

BACKGROUND

The appellants' invention relates to a method for performing electrotherapy on a patient. An understanding of the invention can be derived from a reading of exemplary claim 21, which has been reproduced below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Niemi	4,088,141	May 9, 1978
Lerman	4,771,781	Sep. 20, 1988

Claims 21 and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Niemi.

Claims 23 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Niemi in view of Lerman.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to Paper No. 18 (the Examiner's Answer) for the examiner's complete reasoning in support of the rejections, and to Paper No. 17 (the Substitute Brief) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the

respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Claim 21

In an electrotherapy apparatus including an energy source and a controller, a method for performing electrotherapy on a patient comprising:

coupling the energy source to the patient;

measuring a first parameter related to energy supplied to the patient;

performing an operation upon the first parameter using the controller; and

decoupling the energy source from the patient based upon the operation.

The Rejection Under Section 102

Claims 21 and 22 stand rejected as being anticipated by Niemi. The examiner points out on pages 3 and 4 of the Answer where each of the method steps recited in claim 21 is found in Niemi. The only argument set forth by the appellants is that in their invention a first parameter, which may be voltage or current, is measured and operated upon, and that in contrast to this Niemi teaches that the stimulator is turned off by two parameters (Substitute Brief, page 5).

The guidance provided by our reviewing court with regard to the matter of anticipation is as follows: Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and

every element of the claimed invention. See, for example, In re Paulsen, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). Anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference. See Verdegaal Brothers Inc. v. Union Oil Co. of California, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987). Nor does it require that the reference teach what the applicant is claiming, but only that the claim on appeal "read on" something disclosed in the reference, *i.e.*, all limitations of the claim are found in the reference. Kalman v. Kimberly-Clark Corp, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984).

While the appellants argue that the parameter that is "related to the energy supplied to the patient" must be either voltage or current, claim 21 merely requires "a parameter." Voltage and current are not recited in claim 21, and therefore the appellants' argument is based upon limitations that are not present in the claim, which makes it unpersuasive on its face.¹ In the Niemi method, an impedance comparison unit "i.e., voltage and current comparator," is used to disable the pulse generator when

¹See In re Self, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CPA 1982).

the output impedance² exceeds a predetermined threshold (column 3, line 21 et seq.). From our perspective, impedance constitutes a “parameter related to energy supplied to the patient,” as is required by the claim, and we agree with the examiner that the language recited in claim 21 therefore reads on the Niemi method and the reference anticipates the claimed subject matter. We further point out that claim 21 is cast in comprising format, which means that it is not limited only to the subject matter recited therein.³ This being the case, the fact that a reference measures more than one parameter would not, in and of itself, cause claim 21 to be unreadable thereon.

The rejection of claim 21 is sustained, as is the like rejection of claim 22, which the appellants have chosen to group with claim 21 (Substitute Brief, page 4).

The Rejection Under Section 103

Claims 23 and 24, which depend from claim 22, stand rejected as being obvious in view of the combined teachings of Niemi and Lerman. Since the appellants have chosen to group all of the claims together (Substitute Brief, page 4), claims 23 and 24 fall with claims 21 and 22, and the rejection is sustained on this basis.

CONCLUSION

²The common applicable definition of “impedance” is the apparent opposition in an electrical circuit to the flow of alternating current that is analogous to the actual electrical resistance to a direct current and that is the ratio of effective electromotive force to the effective current. See, for example, Merriam Webster’s Collegiate Dictionary, Tenth Edition, 1996, page 581.

³See In re Hunter, 288 F.2d 930, 932, 129 USPQ 225, 226 (CCPA 1961).

Both rejections are sustained.

The decision of the examiner is affirmed.

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

AFFIRMED

NEAL E. ABRAMS
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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