

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte D. CRAIG EDWARDS

Appeal 2008-0436
Application 10/378,001
Technology Center 3700

Decided: April 16, 2008

Before WILLIAM F. PATE, III, JOSEPH A. FISCHETTI, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

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DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-10, 33-42, 75-77, 79, and 92-96. Claims 11-32, 43-74, 78, and 80-91 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We AFFIRM.

THE INVENTION

The Appellant's claimed invention is directed to the management of status information from emergency medical devices, such as automatic emergency defibrillators. The system may include one or more medical devices and docking stations. The medical device and docking station may each acquire status information and communicate the information to a remote unit. The remote unit may be a status monitor that receives status information from a plurality of medical devices and docking stations in the system. (Spec. 0009).

Claim 1, reproduced below, is representative of the subject matter of appeal.

1. A method comprising:
 - acquiring at a local device that communicates with an emergency medical device first status information of the local device from a self-diagnostic routine of the local device;
 - acquiring at the local device second status information from the emergency medical device; and
 - communicating the first status information and the second status information from the local device to a remote unit.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Morgan	US 5,593,426	Jan. 14, 1997
Cronin	US 6,301,501 B1	Oct. 9, 2001
Kraus	US 6,434,429 B1	Aug. 13, 2002
Lebel	US 6,571,128 B2	May 27, 2003

The following rejections are before us for review:

1. Claims 1-5, 7-8, 33-37, 39-40, and 75-76 are rejected under 35 U.S.C. § 102(e) as anticipated by Kraus.
2. Claims 1-2, 5, 7-10, 33-34, 37, 39-42, 75-76, and 92-96 are rejected under 35 U.S.C. § 103(a) as unpatentable over Morgan in view of Lebel.
3. Claims 6, 38, and 77 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kraus and Official Notice.
4. Claims 6, 38, and 77 are rejected under 35 U.S.C. § 103(a) as unpatentable over Lebel in view of Morgan and Official Notice.
5. Claim 79 is rejected under 35 U.S.C. § 103(a) as unpatentable over Morgan in view of Lebel, and further in view of Cronin.

THE ISSUES

The first issue is whether the Appellant has shown that rejections made under U.S.C. § 102(e) and 35 U.S.C. § 103(a) using the Kraus reference are proper. This issue turns on whether the electro medical implant of Kraus is an “emergency device.”

The second issue is whether the Appellant has shown that the rejections made under 35 U.S.C. § 103(a) using the Lebel and Morgan references are proper. This issue turns on whether the Lebel and Morgan disclose an “emergency device.”

The third issue is whether the Appellant has shown that the rejection of claim 79 made under 35 U.S.C. § 103(a) using the Lebel, Morgan, and Cronin references is proper. This issue turns on whether there are theft and alert considerations in the proposed combination of references.

FINDINGS OF FACT

We find the following enumerated findings of fact are supported at least by a preponderance of the evidence¹:

1. *Webster's Third New International Dictionary* (1971), lists the primary definition of "emergency" as: 1) an unforeseen combination of circumstances or the resulting state that calls for immediate action.
2. Kraus discloses that the electromedical implant may be a pacemaker, defibrillator, cardioverter, or other controlled implant. (Col. 1, ll. 6-9).
3. *Webster's Third New International Dictionary* (1971), lists as an appropriate definition of "pacemaker" as: 2b) an emergency device for stimulating the heart with an alternating current to steady the beat or to reestablish the rhythm of an arrested heart.
4. Morgan discloses using defibrillators (14) and communication stations (24) in Fig. 1. Morgan discloses that external defibrillators may be used (Col. 2, ll. 29).
5. Lebel discloses a ambulatory medical apparatus in which an implantable device can self test (Col. 35, ll. 9-11).

¹ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

6. Lebel discloses that the device may include implantable pacemakers, defibrillators, and neural stimulators. (Col. 2, ll. 26-31).

7. Cronin discloses a defibrillator storage device (10) capable of protecting the defibrillator from wear and tear and theft. The device also alerts others when a cardiac arrest incident is in progress (Col. 2, ll. 5-11).

PRINCIPLES OF LAW

Principles of Law Relating to Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

Principles of Law Relating to Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. The Court also stated “[i]f a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 1740.

ANALYSIS

The Appellant argues that the rejection of claims 1, 33, and 75 as anticipated by Kraus is improper because Kraus fails to disclose “an emergency medical device” as recited in the claims (Br. 6-7). The Appellant argues that Kraus discloses an “electromedical implant” which is intended for long-term use and is not an “emergency medical device.”

We disagree. When construing claim terminology in the United States Patent and Trademark Office, claims are to be given their broadest reasonable interpretation consistent with the specification, reading claim language in light of the specification as it would be interpreted by one of

ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Kraus discloses using an electromedical implant or pacemaker (FF 2). Pacemakers are considered to be “emergency devices” (FF 3). The definition of “emergency” includes a “resulting state that calls for immediate action” (FF 1). We thus consider the time period where the heart is not working properly and correspondingly, when the pacemaker is required to be used, “a state that calls for immediate action” or emergency, making a pacemaker and “emergency medical device.” The Specification does not provide a definition of “emergency medical device” that is inconsistent with our definition, and we decline to read a specific embodiment of “emergency medical device” from the detailed description into the rejected claims.

For the above reasons, the rejection of claims 1, 33, and 75 as anticipated by Kraus is affirmed. As the Appellant has not separately argued the rejection of claims 2-5, 7-8, 34-37, 39, 40, and 76, as anticipated by Kraus, the rejection of these claims is also affirmed.

The Appellant has argued that the rejection of claims 6, 38, and 77 under 35 U.S.C. § 103(a) as unpatentable over Kraus and Official Notice is improper only for the same reason that Kraus does not disclose an “emergency medical device.” For the reasons addressed above, we have determined that Kraus does disclose an “emergency medical device” and this rejection of claims 6, 38, and 77 is also affirmed.

The Appellant argues that the rejection of claims 1-2, 5, 7-10, 33-34, 37, 39-42, 75-76, and 92-96 under 35 U.S.C. § 103(a) as unpatentable over Morgan in view of Lebel is improper because Lebel does not disclose an emergency medical device (Br. 8). The Appellant also argues that there is

no motivation to combine Morgan with the teachings of Lebel since Lebel does not show an “emergency medical device.”

We disagree. Lebel discloses using “pacemakers, implantable defibrillators, [and] implantable neural stimulators” (FF 6). For the reasons set forth above, devices such as pacemakers are considered to be “emergency medical devices.” Regardless, the disclosure of Lebel was not used to teach “emergency medical devices,” but only for the teaching of using self-diagnostic equipment. The predictable use of the self-diagnostic testing of the device of Lebel for its known function of monitoring equipment status in the device of Morgan is considered to be clearly obvious. For this reason, the rejection of claims 1, 33, and 75 as unpatentable over Morgan in view of Lebel is sustained.

As the Appellant has not separately argued the rejection of claims 2, 5, 7-10, 34, 37, 39-42, 76, and 92-96 as unpatentable over Morgan in view of Lebel the rejection of these claims is also affirmed.

The Appellant has argued that the rejection of claims 6, 38, and 77 under 35 U.S.C. § 103(a) as unpatentable over Morgan in view of Lebel and Official Notice is improper only for the same reason that Lebel does not disclose an “emergency medical device.” For the reasons addressed above, we have determined that Lebel does disclose an “emergency medical device” and this rejection of claims 6, 38, and 77 is also affirmed.

The Appellant argues that the rejection of claim 79 as unpatentable over Morgan in view of Lebel and Cronin is improper because the “theft and damage considerations of Cronin are entirely absent from Lebel” (Br. 12) since Lebel is “implanted or worn on the body” (Br. 11).

We disagree. We note again that the rejection only uses the Lebel reference as a teaching of using self-diagnostic equipment. Morgan discloses that an external defibrillator may be used (FF 4) and Cronin discloses that the storage device is capable of protecting the defibrillator from theft and alerting others when a cardiac arrest incident is in progress (FF 7). The predictable combination of the protective device of Cronin with the defibrillator of Morgan and self diagnostic testing of Lebel for the known benefit of protecting the defibrillator from theft and providing alerts to others when a cardiac arrest incident is in progress is considered obvious. The rejection of claim 79 as unpatentable over Morgan in view of Lebel and Cronin is sustained.

CONCLUSIONS

We conclude that Appellant has failed to show that the Examiner erred in rejecting claims 1-5, 7-8, 33-37, 39-40, and 75-76 under 35 U.S.C. § 102(e) as anticipated by Kraus.

We conclude that Appellant has failed to show that the Examiner erred in rejecting claims 1-2, 5, 7-10, 33-34, 37, 39-42, 75-76, and 92-96 under 35 U.S.C. § 103(a) as unpatentable over Morgan in view of Lebel.

We conclude that Appellant has failed to show that the Examiner erred in rejecting claims 6, 38, and 77 under 35 U.S.C. § 103(a) as unpatentable over Kraus and Official Notice

We conclude that Appellant has failed to show that the Examiner erred in rejecting claims 6, 38, and 77 under 35 U.S.C. § 103(a) as unpatentable over Lebel in view of Morgan and Official Notice.

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We conclude that Appellant has failed to show that the Examiner erred in rejecting claim 79 under 35 U.S.C. § 103(a) as unpatentable over Morgan in view of Lebel, and further in view of Cronin.

DECISION

The Examiner's rejection of claims 1-10, 33-42, 75-77, 79, 92-96 is sustained.

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) (2007).

AFFIRMED

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