

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 46

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGES BOUSSIGNAC
and JEAN-CLAUDE LABRUNE

Appeal No. 96-1902
Application 08/156,679¹

HEARD: Jan. 12, 1999

Before MEISTER, FRANKFORT, and CRAWFORD, Administrative Patent Judges.

MEISTER, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed November 22, 1993. According to appellants, this application is a continuation of Application 07/963,002, filed October 19, 1992, abandoned; which is a continuation of Application 07/750,232, filed August 20, 1991, abandoned; which is a continuation of Application 07/419,690, filed October 11, 1989, abandoned.

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Georges Boussignac and Jean-Claude Labrune (the appellants) appeal from the final rejection of claims 11-13, 15 and 16, the only claims remaining in the application.

We AFFIRM.

The appellants' invention pertains to a respiratory assistance device. Independent claim 11 is further illustrative of the appealed subject matter and a copy thereof may be found in EXHIBIT A of the brief.

The references relied on by the examiner are:

Baum et al. (Baum '530) 1981	4,270,530	Jun. 02,
McGrail 1986	4,584,998	Apr. 29,
Weerda et al. (Weerda) 1986	4,630,606	Dec. 23,
Brown 1989	4,813,431	Mar. 21,
Baum (Baum '896) 1983 (Great Britain)	2 114 896	Sep. 01,

Claims 11-13, 15 and 16 stand rejected under 35 U.S.C. § 112, first paragraph, as being based upon an original disclosure which fails to provide descriptive support for the subject matter now being claimed.

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Claims 11 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Weerda in view of Baum '896 and McGrail.

Claims 13, 15 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Weerda in view of Baum '896, Brown and Baum '530.²

The rejections are explained on pages 2-4 of the final rejection (Paper No. 33). The arguments of the appellants and examiner in support of their respective positions may be found on pages 2-11 of the brief, pages 1-3 of the reply brief, pages 5 and 6 of the answer, and page 2 of the supplemental answer.

OPINION

At the outset, we note that on page 3 of the brief the appellants state that the rejected claims stand or fall together. Accordingly, dependent claims 12, 13, 15 and 16 will stand or fall with independent claim 11. 37 CFR § 1.192(c)(7).

² It would appear that the examiner also intended to include McGrail.

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We have carefully reviewed the appellants' invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellants in the brief and reply brief, and by the examiner in the answer and supplemental answer. As a consequence of this review, we will sustain the rejections of claims 11-13, 15 and 16 under 35 U.S.C. § 103. We will not, however, sustain the rejection of claims 11-13, 15 and 16 under 35 U.S.C. § 112, first paragraph.

Considering first the rejection of claims 11-13, 15 and 16 under 35 U.S.C. § 112, first paragraph, we initially observe that the description requirement found in the first paragraph of 35 U.S.C. § 112 is separate from the enablement requirement of that provision. **See Vas-Cath, Inc. v. Mahurkar**, 935 F.2d 1555, 1560-64, 19 USPQ2d 1111, 1114-17 (Fed. Cir. 1991) and **In re Barker**, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), **cert. denied**, 434 U.S. 1238 (1978). With respect to the description requirement, the court in **Vas-Cath, Inc. v. Mahurkar** at 935 F.2d 1563-64, 19 USPQ2d 1117 stated:

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35 U.S.C. § 112, first paragraph, requires a "written description of the invention" which is separate and distinct from the enablement requirement. The purpose of the "written description" requirement is broader than to merely explain how to "make and use"; the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession **of the invention**. The invention is, for purposes of the "written description" inquiry, **whatever is now claimed**.

. . . drawings alone **may** be sufficient to provide the "written description of the invention" required by § 112, first paragraph.

Here, the examiner believes that there is no adequate descriptive support in the original disclosure for the recitation of "controlling a cyclic flow of respiratory gas supplied to a patient" as set forth in independent claim 11, apparently because "not all ventilation techniques are cyclic" (see answer, page 3). In our view, however, adequate descriptive support for the limitation in question may be found on page 5, line 28, through page 6, line 21, of the specification. Note in particular the reference to "a complete respiratory cycle," "period of inspiration and the period of expiration whilst observing the idle times" and "the end of the expiration cycle" on page 6 of the specification.

The answer also states that:

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"Where does applicants' original disclosure state that both sensors are used to control normal ventilation?" Nowhere does appellants' original disclosure discuss or define "normal ventilation" and what they mean by these terms. [Page 3.]

We are at a complete loss to understand the examiner's position. The claims on appeal do not require that both sensors be used to control "normal ventilation" or, for that matter, make any reference whatsoever to "normal ventilation."

In view of the above, we will not sustain the rejection of claims 11-13, 15 and 16 under 35 U.S.C. § 112, first paragraph.

Turning to the rejections of claims 11-13, 15 and 16 under 35 U.S.C. § 103, the appellants do not argue that it would have been unobvious to combine the teachings of the references in the manner proposed by the examiner. Instead, the appellants focus on the teachings of Weerda, stating that:

It is evident that in Weerda's system, respiratory ventilation is controlled by the measurement of the intratracheal pressure by pressure probe 5 which, of course, measures the pressure within the trachea rather than within the ballonnet. Only in the case of "disturbances" in the operating conditions of the device (column 4, lines 18-25) is any corrective or remedial action taken, and this action consists only of deflating the balloon sleeve 3 and switching the operation of the respirator 44 until the disturbance has been eliminated (column 4, lines 45-48).

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By contrast, in the present invention, measurement of the pressure within the ballonet is used to control the flow of respiratory gas under normal operating conditions. [Brief, pages 8 and 9.]

With respect to this argument, we must point out that independent claim 11 broadly recites:

electronic control means controlled by said signals for controlling **a cyclic flow** of respiratory gas supplied to a patient.

As the appellants recognize, electronic control signals from pressure receivers 10 (which provide voltage signals in response to the pressure in balloon sleeve 3 via probe 6) and 45 (which provide voltage signals in response to the pressure in the intratracheal space 2 via probe 5) are used to control the flow of respiratory gas in the respirator 44 of Weerda. The appellants have correctly noted that the control signals from the pressure receiver 10 only function to "switch" the operation of Weerda's respirator 44 in the case of "disturbances." What the appellants overlook, however, is that when the control signals from the pressure receiver 10 "switches" the operation of Weerda's respirator, it causes the respirator to switch from one type of **cyclic** flow to **another** type of **cyclic** flow. That is, it switches the respirator from

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"closed" ventilation wherein the tracheal pressure is taken into account in determining the amount of gas supplied during ventilation to "open" ventilation wherein the tracheal pressure is not taken into account in determining the amount of gas supplied during ventilation (see, e.g., column 2, lines 1-7). In either case, the ventilation (and, hence, flow) is "cyclic." Accordingly, giving the above-noted recitation in claim 11 its broadest reasonable interpretation,³ we are of the opinion that the control signals of Weerda can be considered to control "a cyclic flow" of the respiratory gas as broadly claimed. While we appreciate the fact that there are differences in operation between the appellants' device and that of Weerda, these differences simply have not been set forth in claim 11.

In view of the foregoing, we will sustain the rejections under 35 U.S.C. § 103 of claims 11 and 12 based on the

³ It is well settled that the terminology in a pending application's claims is to be given its broadest reasonable interpretation (*In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1028 (Fed. Cir. 1997) and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)) and limitations from a pending application's specification will not be read into the claims (*Sjolund v. Musland*, 847 F.2d 1573, 1581-82, 6 USPQ2d 2020, 2027 (Fed. Cir. 1988)).

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combined teachings of Weerda, Baum '896 and McGrail and of claims 13, 15 and 16 based on the combined teachings of Weerda, Baum '896, Brown and Baum '530.

In summary:

The rejection of claims 11-13, 15 and 16 under 35 U.S.C. § 112, first paragraph, is reversed.

The rejections of claims 11-13, 15 and 16 under 35 U.S.C. § 103 are affirmed.

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

AFFIRMED

	James M. Meister)	
	Administrative Patent Judge)	
)	
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)	
	Charles E. Frankfort)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	Murriel E. Crawford)	
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tdc

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