

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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL J. MOTTI, JAMES P. REVARD,
and RANDY E. BERLIN

Appeal No. 1997-1479
Application No. 08/418,579

HEARD: OCTOBER 11, 2000

Before COHEN, NASE, and JENNIFER D. BAHR, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This appeal addresses the rejection of claims 2 through 7 and 9 through 16, all of the claims remaining in the application.

Appellants' invention pertains to an automatic defibrillator simulator and to a method for enabling an instructor to train a subject in learning steps and conditions of a defibrillation procedure. A basic understanding of the

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invention can be derived from a reading of exemplary claims 15 and 16, respective copies of which appear on pages 1 and 2 of the brief (Paper No. 19).

As evidence of obviousness, the examiner has applied the documents listed below:

Parker et al. 1986 (Parker)	4,588,383	May 13,
Morgan et al. 1986 (Morgan)	4,610,254	Sep. 9,

The following rejection is before us for review.

Claims 2 through 7 and 9 through 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Parker in view of Morgan.

The examiner's rejection, as it pertains in particular to independent claims 15 and 16, and the response to the argument presented by appellants appears in the answer (Paper No. 20), while the complete statement of appellants' argument can be found in the brief (Paper No. 19).

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OPINION

In reaching our conclusion on the obviousness issue raised in this appeal, this panel of the board has carefully considered appellants' specification, drawings, and claims 15 and 16, the applied teachings,¹ the declaration of Michael J. Motti dated August 28, 1996 incorporating therein appended purchase orders, the declaration of Roberta Leichtz dated September 2, 1996, the declaration of Matt Anderson dated August 13, 1996, the declaration of William E. Kriegsman, Jr. dated August 12, 1996, the declaration of George Angus, Jr. dated August 13, 1996, the declaration of Eric T. Van Cise dated August 8, 1996, the declaration of David J. Vastola dated August 9, 1996, the declaration of Katherine G. Lewis dated August 8, 1996, the declaration of Alice Kerr dated August 8, 1996, the declaration of Michael W. Lary dated

¹ In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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August 8, 1996, the undated declaration of Susan Coffland filed August 16, 1996, and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determination which follows.

We reverse the examiner's rejection of appellants' claims.

Independent claim 15 addresses an automatic defibrillator simulator and claim 16 sets forth a method for enabling an instructor to train a subject in learning steps and conditions of a defibrillation procedure comprising the step of providing an automatic defibrillator simulator. In each of claims 15 and 16, it is required that the simulator eliminate any danger of electrical shock to the subject being trained otherwise incidental to a working automatic defibrillator.²

² As best as we can discern from the underlying disclosure, an automatic defibrillator simulator is configured such that it can not effect pulses of energy at electrode pads.

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The Parker patent does not address an automatic defibrillator simulator or method that provides an automatic defibrillator simulator. As to the Morgan reference, it does not specifically concern itself with an automatic defibrillator simulator but instead teaches a portable defibrillator which produces a medically appropriate defibrillation shock (pulses of energy at electrode pads).

From our perspective, akin to appellants' point of view (brief, page 9), the rejection on appeal is not sound in that it clearly requires reliance upon appellants' own teaching of an automatic defibrillator simulator and impermissible hindsight to combine the Parker and Morgan disclosures such that an automatic defibrillator simulator and method (requiring an automatic defibrillator simulator) is effected, as now set forth in respective claims 15 and 16. Since the evidence itself would not have been suggestive of the claimed subject matter, the rejection of appellants' claims must be reversed.

REMAND TO THE EXAMINER

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We remand this application to the examiner to address the following matters.

1. Considering 35 U.S.C. § 112, first and second paragraphs, the examiner should ascertain and specify what structure of the disclosed automatic defibrillator simulator and method corresponds to each claim limitation, e.g., what is the means for enabling an instructor to provide a different alternative sequence? There is no express antecedent basis for "said sequence" (claims 15 and 16, line 9).

2. Considering the acknowledged prior art specified on page 2 of appellants' specification (for example, U.S. Patent No. 5,137,458) which reflects the knowledge, prior to appellants' invention, of a defibrillation training system (simulator) wherein a pulse is discharged within a defibrillator/monitor rather than being actually applied to a manikin, and the interactive trainer/prompter device of the reasonably pertinent Parker patent of record, recognized (column 2, lines 59 through 64) for employment in training or prompting of skills, other than CPR, which might be critical,

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but infrequently used (note instructor control; column 8, line 61 to column 9, line 5), the examiner should evaluate the claimed subject matter relative to these teachings, collectively assessed under 35 U.S.C. § 103.

In summary, this panel of the board has reversed the rejection of claims 2 through 7 and 9 through 16 under 35 U.S.C. § 103, and remanded the application to the examiner for consideration of the matters discussed, supra.

The decision of the examiner is reversed.

REVERSED AND REMANDED

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IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JENNIFER D. BAHR)	
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APPEAL NO. 1997-1479 - JUDGE

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APJ COHEN

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APJ BAHR

DECISION:

Prepared By:

DRAFT TYPED: 23 Jan 02

FINAL TYPED: