

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WILLIAM B. ALBERY and LLOYD D. TRIPP

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Appeal No. 1998-2854  
Application No. 08/500,278<sup>1</sup>

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ON BRIEF

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Before McCANDLISH, Senior Administrative Patent Judge,  
ABRAMS and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 1 through 7, as amended subsequent to the final rejection.

Claims 8 and 9, the other claims pending in this application, were not rejected in the final rejection.<sup>2,3</sup>

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<sup>1</sup> Application for patent filed July 10, 1995.

<sup>2</sup> While the Office Action Summary of the final rejection  
(continued...)

We REVERSE and enter a new rejection pursuant to 37 CFR § 1.196(b).

BACKGROUND

The appellants' invention relates to a system for enhancing blood flow to and from the heart during cardiopulmonary resuscitation of a patient. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner (i.e., the applied prior art) in rejecting the appealed claims are:

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<sup>2</sup>(...continued)  
(Paper No. 5, mailed November 26, 1996) states that claims 1-9 are rejected, the detailed action (pp. 2-4) thereof only sets forth rejections of claims 1 -7.

<sup>3</sup> While the examiner has approved entry of the amendment after final rejection (Paper No. 6, filed March 3, 1997), we note that this amendment has not been clerically entered.

Arkans 1983	4,396,010	Aug. 2,
Zheng et al. 1988 (Zheng)	4,753,226	June 28,
Halperin et al. 1990 (Halperin)	4,928,674	May 29,
Newman 1994	5,370,603	Dec. 6,

Claims 1, 2, 4 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Newman in view of Arkans.

Claim 3 stands rejected under 35 U.S.C. § 103 as being unpatentable over Newman in view of Arkans and Zheng.

Claims 6 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Newman in view of Arkans and Halperin.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the first Office action (Paper No. 3, mailed June 11, 1996) and the examiner's answer (Paper No. 11, mailed September 2, 1997) for the examiner's

complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 10, filed June 2, 1997) and reply brief (Paper No. 12, filed November 4, 1997) 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, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 through 7 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28

USPQ2d 1955, 1956 (Fed. Cir. 1993). The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

The appellants argue (brief, pp. 4-12, and reply brief, pp. 2-4) that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims under appeal require an air pressure regulator capable of automatically cycling the output air pressure between a lower preselected pressure and a higher preselected pressure wherein the lower preselected pressure is preselected from a range of pressures having a lower limit at least sufficient to maintain peripheral vascular resistance in the body areas of the patient covered by the encircling bladders.

It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

In applying the above-noted guidance we reach the conclusion that the claimed phrase "at least sufficient to maintain peripheral vascular resistance in the body areas of the patient covered by the encircling bladders" means a pressure of about 25 mm Hg as set forth on page 10, lines 12-18, of the appellants' specification.

The above-noted limitation is not suggested by the applied prior art since none of the applied prior art teaches or suggests cycling air pressure between a lower pressure of about 25 mm Hg or higher and a higher pressure.

In our view, the only suggestion for modifying the applied prior art to meet the above-noted limitation would stem from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Additionally, all the claims under appeal require a plurality of leg and body encircling bladders connected in pneumatic series from encircling bladders furthestmost from the heart to encircling bladders innermost toward (i.e., closest to) the heart. It is our opinion, that this limitation is also not suggested by the applied prior art. In that regard, we note that Arkans' bladders are not **connected in pneumatic series** and that Newman's bladders while connected in pneumatic series are not connected in pneumatic series from the bladders furthestmost from the heart to the bladders closest to the heart.

For the reasons stated above, the decision of the examiner to reject claims 1 through 7 under 35 U.S.C. § 103 is reversed.

New ground of rejection

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claim 8 is rejected under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim.

35 U.S.C. § 112, fourth paragraph, states

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

Claim 8 depends on independent claim 1 and recites that "the lower preselected pressure and the higher preselected pressure are preselected **to be the same.**" [Emphasis ours]. Independent claim 1 recites that the air pressure regulator is capable of automatically cycling the output air pressure between "a lower preselected pressure and a higher preselected pressure."

In our opinion, claim 8 is not a proper dependent claim under the fourth paragraph of 35 U.S.C. § 112. A claim that is not broader in any respect from its parent claim complies

with the fourth paragraph of 35 U.S.C. § 112. See Ex parte Porter, 25 USPQ2d 1144 (Bd. Pat. App. & Int. 1992) and Ex parte Moelands, 3 USPQ2d 1474 ((Bd. Pat. App. & Int. 1987)). In this instance, it is our determination that parent claim 1 requires the higher preselected pressure to be a higher pressure than the lower preselected pressure. We base this determination on the appellants use of the relative terms "higher" and "lower" in claim 1 and the recitation in claim 1 that the air pressure regulator automatically cycles the output air pressure between the lower preselected pressure and the higher preselected pressure. If the lower preselected pressure and the higher preselected pressure were to be the same pressure (as set forth in claim 8) there would be no cycling of air pressure. Accordingly, we find that dependent claim 8 is not in compliance with the fourth paragraph of 35 U.S.C. § 112.

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 7 under 35 U.S.C. § 103 is reversed and a new

rejection of claim 8 under 35 U.S.C. § 112, fourth paragraph, has been added pursuant to provisions of 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

REVERSED; 37 CFR § 1.196(b)

HARRISON E. McCANDLISH	)	
Senior Administrative Patent Judge	)	
)	)	
	)	
	)	
	)	BOARD OF PATENT
NEAL E. ABRAMS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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APPEAL NO. 1998-2854 - JUDGE NASE  
APPLICATION NO. 08/500,278

APJ NASE

SAPJ McCANDLISH

APJ ABRAMS

DECISION: **REVERSED;**  
**37 CFR § 1.196(b)**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 10 May 99

**FINAL TYPED:**