

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 42

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FORREST M. BIRD

Appeal No. 95-3184
Application 07/981,910¹

ON BRIEF

Before CALVERT, FRANKFORT and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

¹ Application for patent filed November 23, 1992. According to appellant, the application is a continuation of Application 07/400,730, filed August 30, 1989, now abandoned, which is a division of Application 07/145,734, filed January 14, 1988, now U.S. Patent No. 5,007,420, issued April 16, 1991, which is a continuation of Application 06/671,491, filed November 14, 1984, now abandoned, which is a continuation-in-part of Application 06/516,133, filed July 21, 1983, now U.S. Patent No. 4,592,349, issued June 3, 1986, which is a continuation-in-part of Application 06/291,622, filed August 10, 1981, now abandoned, which is a continuation-in-part of Application 06/261,929, filed Apr. 3, 1981, which is a continuation-in-part of Application 06/250,586, filed April 3, 1981, now abandoned. The appellant may wish to review the foregoing parent application data which is set forth on page 1 of the specification since it would appear that the reference to Application 06/261,929 instead should be to Application 06/261,629.

Appeal No. 95-3184
Application 07/981,910

b) under 35 U.S.C. § 103 as being unpatentable over Emerson.³

Reference is made to the appellant's main and reply briefs (Paper Nos. 32, 35 and 37) and to the examiner's main and supplemental answers (Paper Nos. 34, 36 and 38) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

The 35 U.S.C. § 112, first paragraph, rejection rests on the examiner's determination that the appellant's originally filed specification "fails to provide support for the phrase 'solely by the successive addition of the small volumes of gas' as recited in claim 33" (main answer, pages 3 and 4). According to the examiner, this claim limitation "states that airway pressure is increased solely by the addition of small volumes of gas" (main answer, page 6).

This explanation indicates that the rejection is based on an alleged failure of the specification to comply with the written

³ In the final rejection (Paper No. 28), the examiner relied upon the combined teachings of Emerson and U.S. Patent No. 4,096,875 to Jones et al. to support the 35 U.S.C. § 103 rejection of claims 33 through 39. It is apparent from the statement and explanation of this rejection in the main answer (Paper No. 34), however, that the examiner is no longer relying on Jones et al. for this purpose.

Appeal No. 95-3184
Application 07/981,910

description requirement of 35 U.S.C. § 112, first paragraph. The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The content of the drawings may also be considered in determining compliance with the written description requirement. Id.

Claim 1 recites a method for ventilating a patient airway comprising, inter alia, the steps of supplying to the airway during the inspiratory phase a plurality of pulses of small volumes of gas and adding these pulses in succession to provide successively greater volumes of gas successively increasing in pulsatile form the pressure of the gas in the airway by adding the successively greater volumes of gas. The claim language at issue, read in context, requires that the successive increase in pulsatile form of the pressure of the gas in the airway be caused "solely" by the successive addition of the small volumes of gas.

Appeal No. 95-3184
Application 07/981,910

This limitation finds support in a number of places in the appellant's originally filed disclosure such as, for example, the graph depicted in Figure 4 (see reference numeral 421) and the corresponding portions of the underlying specification (page 62 et seq.). Contrary to the examiner's interpretation, the word "solely" limits only the successive increase in pulsatile form of the pressure of the gas in the airway and does not exclude other pressure increases such as those involving the constant positive airway pressure (CPAP) and tidal volume deliveries discussed throughout the appellant's specification.

Thus, the disclosure of the instant application as originally filed would reasonably convey to the artisan that the appellant had possession at that time of the method now recited in claim 33 wherein the successive increase in pulsatile form of the pressure of the gas in the airway of the patient is caused "solely" by the successive addition of the small volumes of gas. Accordingly, we shall not sustain the standing 35 U.S.C. § 112, first paragraph, rejection of this claim or of claims 34 through 39 which depend therefrom.

As for the standing 35 U.S.C. § 103 rejection of claims 33 through 39, Emerson discloses a method and apparatus "for

Appeal No. 95-3184
Application 07/981,910

treating a patient by vibrating a column of gas which is in communication with his airway" (column 1, lines 15 through 17). This treatment is said to exercise and massage the airway and associated organs, to loosen and remove mucous therefrom, and to cause the gas to diffuse more rapidly within the airway (see column 1, lines 51 through 57). As explained by Emerson,

[t]he method and apparatus of the present invention may be used to vibrate a column of gas during both the period of a patient's inhalation and the period of his exhalation or during either of said periods. The column of gas which is vibrated may be under positive, negative or atmospheric pressures and it may be either static or in motion inwardly or outwardly of his airway and such motion may be created by his own natural breathing or by the application of positive or negative pressures to the column [column 1, lines 31 through 40].

In essence, the apparatus consists of a face mask A, a pump C, a line, including tube 17 and conduit 11b, for connecting the face mask to the input or output side 42, 43 of the pump, and a vibrating device B. The vibrating device

comprises [a] chamber 25 having a movable wall or diaphragm 26 made of rubberized fabric or other air impervious flexible material and which when moved upwardly and downwardly varies the volume of the chamber and the pressure of the air therein. The chamber 25 opens into the tube 17 through the passage 21 and as the volume of the chamber is varied vibrations or pulsations are created in the gas in the tube 17 causing the gas to move first in one direction and then in the opposite direction. These vibrations are transmitted to the column of gas in the conduit 11b

Appeal No. 95-3184
Application 07/981,910

which communicates with the face mask A and the patient's airway [column 3, lines 55 through 68].

The examiner's conclusion that Emerson teaches or would have suggested a ventilating method meeting the limitations in appealed claim 33 requiring the addition in succession of pulses of small volumes of gas to provide successively greater volumes of gas successively increasing in pulsatile form the pressure of the gas in the patient's airway wherein the successive increase in pulsatile form of the pressure is caused solely by the successive addition of the small volumes of gas is not well taken. While Emerson's vibration of the column of gas in the patient's airway would appear to supply to the airway a plurality of pulses of small volumes of gas, it is not apparent, nor has the examiner explained, how these pulses would be additive in succession to provide successively greater volumes of gas successively increasing in pulsatile form the pressure of the gas in the airway. Indeed, Emerson's teaching that the vibrations or pulses applied to the column of air cause the air to move first in one direction and then in the opposite direction would seem to belie any such conclusion.

Appeal No. 95-3184
Application 07/981,910

In this light, the examiner's determination that the method recited in claim 33, and in claims 34 through 39 which depend therefrom, would have been obvious to one of ordinary skill in the art in view of Emerson must fall. Accordingly, we shall not sustain the standing 35 U.S.C. § 103 rejection of these claims.

The decision of the examiner is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
)	
)	
)	
CHARLES E. FRANKFORT)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

Appeal No. 95-3184
Application 07/981,910

Harold C. Hohbach
4 Embarcadero Center
STE 3400
San Francisco, CA 94111