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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* RODERICK A. HYDE, ROBERT LANGER, ERIC C. LEUTHARDT, ROBERT W. LORD, ELIZABETH A. SWEENEY, CLARENCE T. TEGREENE, and LOWELL L. WOOD JR.

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Appeal 2013-003305[1]
Application 12/387,151[2]
Technology Center 3600

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Before NINA L. MEDLOCK, BRUCE T. WIEDER, and TARA L. HUTCHINGS, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] Our decision references Appellants' Appeal Brief ("App. Br.," filed August 20, 2012) and Reply Brief ("Reply Br.," filed December 26, 2012), and the Examiner's Answer ("Ans.," mailed October 26, 2012) and Final Office Action ("Final Act.," mailed March 20, 2012).

[2] Appellants identify Searete LLC as the real party in interest. App. Br. 4.

## STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 71–100. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART and enter a NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).

## CLAIMED INVENTION

Appellants' claimed invention "relates to methods and systems for an inhaled bioactive agent combined with an artificial sensory experience" (Spec. 7, ll. 9–10).

Claim 71, reproduced below, is the sole independent claim, and is representative of the subject matter on appeal:

> 71. A system, comprising:
>
> an accepter module configured to accept an indication of an individual's compliance with an artificial sensory experience; and
>
> a presenter module configured to present an indication of an inhalation device dispensed bioactive agent at least partially based on the indication of the individual's compliance with the artificial sensory experience.

## REJECTIONS[3]

Claims 71–77 and 79–100 are rejected under 35 U.S.C. § 102(b) as anticipated by Trueba (US 7,198,044 B2, iss. Apr. 3, 2007).

[3] The provisional rejection of claims 74, 78, 86–88, and 96–99 on the ground of non-statutory obviousness-type double patenting is moot in view of the abandonment of application Serial No. 12/317,934. *See* Notice of Abandonment mailed October 27, 2015.

Claim 78 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Trueba, Epstein (US 7,711,583 B2, iss. May 4, 2010) and Altieri (US 7,373,377 B2, iss. May 13, 2008).[4]

## ANALYSIS

As set forth below, pursuant to our authority under 37 C.F.R. § 41.50(b), we enter a new ground of rejection of claims 71-100 as indefinite under 35 U.S.C. § 112, second paragraph. In light of this new rejection, we do not reach the merits of the rejections of claims 71–100 under 35 U.S.C. §§ 102(b) and 103(a). Before a proper review of the rejections under §§ 102(b) and 103(a) can be conducted, the subject matter encompassed by the claims on appeal must be reasonably understood without resort to speculation. Because the claims fail to satisfy the requirements of 35 U.S.C. § 112, second paragraph, we reverse, *pro forma*, the Examiner's rejections of claims 71–77 and 79–100 under 35 U.S.C. § 102(b) and claim 78 under § 103(a). *See In re Steele*, 305 F.2d 859, 862 (CCPA 1962) (A prior art rejection cannot be sustained if the hypothetical person of ordinary skill in the art would have to make speculative assumptions concerning the meaning of claim language.); *see also In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970) ("If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious-the claim becomes indefinite."). Our decision is based solely on the indefiniteness of claims 71–100, and does not reflect on the merits of the underlying rejections.

[4] We treat as inadvertent error the omission of Trueba from the heading for the rejection of claim 78, noting that this claim depends from claim 77.

*New Ground of Rejection*

We enter the following new ground of rejection of claims 71–100 under 35 U.S.C. § 112, second paragraph, pursuant to our authority under 37 C.F.R. § 41.50(b).

*Indefiniteness*

The patent statute requires that a claim "particularly point[] out and distinctly claim[] the subject matter which the applicant regards as the invention." 35 U.S.C. § 112, ¶ 2. As such, a claim is invalid for indefiniteness if a person of ordinary skill in the art would not understand the scope of the claim, when the claim is read in light of the specification. *See Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1348 (Fed. Cir. 2002). Notably too, when a word of degree or a purely subjective phrase is used in a patent claim, the specification must provide some objective standard for measuring that degree or the scope of that phrase. *See Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1350–55 (Fed. Cir. 2005). "The scope of claim language cannot depend solely on the unrestrained, subjective opinion of a particular individual purportedly practicing the invention." *Id.* at 1350 (citation omitted).

Independent claim 71 recites a system comprising "an accepter module configured to accept an indication of an individual's compliance with an artificial sensory experience; and a presenter module configured to present an indication of an inhalation device dispensed bioactive agent at least partially based on the indication of the individual's compliance with the artificial sensory experience." Our concern is with the phrase "artificial sensory experience," which appears in claim 71, and, therefore, also in each of dependent claims 72–100.

The Specification sets forth examples of an artificial sensory experience:

> [o]ne example of an artificial sensory experience may include a virtual world and/or other computer-simulated experience. Other examples of an artificial sensory experience may include experiences triggering sight, smell, hearing, touch, and/or taste. For example, presenter module 104 may present an indication of an artificial sensory experience including a virtual scent environment, which may include olfactory stimulation for improving memory.

*See*, *e.g.*, Spec. 15, ll. 16–22. However, the Specification provides no objective definition for identifying an "artificial sensory experience" or any objective standard for determining which experiences are "artificial sensory experiences" and which are not. Nor is any such objective standard evident from the examples. In fact, it would seemingly appear that whether a particular experience constitutes an "artificial sensory experience," e.g., whether the experience"[triggers] sight, smell, hearing, touch, and/or taste," depends on the subjective reaction of the individual participant.

The Specification identifies Figure 17 as illustrating "a system related to combining an inhaled bioactive agent and an artificial sensory experience" and identifies Figure 22 as illustrating "an operational flow representing example operations related to combining an inhaled bioactive agent and an artificial sensory experience." Spec. 10, ll. 7–8, 17–19. But Figure 17 merely shows a simulated computer screen and Figure 22 shows a two-step flowchart.

Even if we assume for the sake of argument, that a person of ordinary skill in the art, on reviewing the Specification, were able to determine what constitutes an "artificial sensory experience," as called for in the claims, we find nothing from our review of the Specification that provides any guidance

to a person of ordinary skill in the art in determining what constitutes "an individual's compliance with an artificial sensory experience," e.g., compliance with an experience that triggers "sight, smell, hearing, touch, and/or taste."

In our view, a person of ordinary skill in art, on reviewing the Specification, would not understand what types of "artificial sensory experiences" the claims are intended to cover or what constitutes "compliance with an artificial sensory experience." As such, a person of ordinary skill in the art would not able to determine the metes and bounds of claims 71–100 so as to understand how to avoid infringement. Therefore, rejection of claims 71–100 under 35 U.S.C. § 112, second paragraph, is appropriate. *See Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986).

## DECISION

The Examiner's rejection of claims 71–77 and 79–100 under 35 U.S.C. § 102(b) is reversed *pro forma*.

The Examiner's rejection of claim 78 under 35 U.S.C. § 103(a) is reversed *pro forma*.

A NEW GROUND OF REJECTION has been entered for claims 71–100 as indefinite under 35 U.S.C. § 112, second paragraph.

37 C.F.R. § 41.50(b) provides that "[a] new ground of rejection . . . shall not be considered final for judicial review." 37 C.F.R. § 41.50(b) also provides that the Appellants, 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 the appeal as to the rejected claims:

> (1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the Examiner.
>
> (2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record.

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).

REVERSED; 37 C.F.R. § 41.50(b)

llw