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COOK ALEX LTD./FENWAL, INC.  
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SUITE 2850  
CHICAGO, IL 60606

EXAMINER
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KLEIN, BENJAMIN JACOB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* RICHARD I. BROWN

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Appeal 2014-006606  
Application 12/861,974  
Technology Center 3700

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Before MICHAEL L. HOELTER, JILL D. HILL, and  
GORDON D. KINDER, *Administrative Patent Judges*.

HOELTER, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Appellant filed a Request for Rehearing (“Req. Reh’g.”) dated August 23, 2016, under 37 C.F.R. § 41.52, regarding the Decision on Appeal mailed July 21, 2016 (“Decision”). As stated in this Decision, a New Ground of Rejection was entered as to all of claims 1–7 and 24 due to a lack of support for a negative limitation in sole independent claim 1. *See* Req. Reh’g. 2.

We withdraw that portion of our Decision entering the New Ground of Rejection. The remainder of our Decision addressing the Examiner’s rejections under 35 U.S.C. §§ 102(b) and 103(a) is unaffected.

### THE REQUEST FOR REHEARING

A request for rehearing “must state with particularity the points believed to have been misapprehended or overlooked by the [Patent Trial and Appeal Board (“Board”)].” *See* 37 C.F.R. § 41.52(a)(1). This section also states that arguments not raised in the briefs before the Board and evidence not previously relied upon in the briefs “are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) through (a)(4) of this section.” Also, a request for rehearing is not an opportunity to merely express disagreement with a decision without setting forth points believed to have been misapprehended or overlooked. The proper course for an appellant dissatisfied with a Board decision is to seek judicial review, not to file a request for rehearing to reargue issues that have already been decided. *See* 35 U.S.C. §§ 141, 145.

### BACKGROUND AND ANALYSIS

Sole independent claim 1 is reproduced below.

1. A method for anticoagulating blood, comprising:  
drawing whole blood from a blood source at a draw flow rate; and  
adding anticoagulant to the whole blood at an anticoagulant flow rate that is independent of the draw flow rate.

Appellant does not dispute our discussion in the Decision where it is stated:

Accordingly, we understand Appellant’s usage of the claim term “independent” to mean not dependent, thus seeking to distinguish Appellant’s system from prior systems. Appellant’s usage of this claim term in such a manner is a negative claim limitation.

Decision 3.

Thereafter, was a discussion of the 2012 case of *Santarus, Inc. v. Par Pharm., Inc.*, 694 F.3d 1344 (Fed. Cir. 2012). Decision 3. In *Santarus*, our reviewing court stated: “Negative claim limitations are adequately supported when the specification describes a reason to exclude the relevant limitation.” *Id.* at 1351; *see also* Decision 3. It is our reliance on that case which is the basis for Appellant’s Request for Rehearing because Appellant contends that the Decision:

erroneously applies an unduly strict standard of disclosure that is inconsistent with current Federal Circuit authority and, accordingly, is erroneous and reaches an erroneous conclusion.

Req. Reh’g. 2. Instead, Appellant states:

The ‘reason to exclude’ standard of *Santarus* is discussed by the Federal Circuit in *Inphi Corp. v. Netlist, Inc.*, 805 F.3d 1350 (Fed. Cir. 2015), which emphasizes that there is no heightened disclosure standard for negative claim limitations.

Req. Reh’g. 5.

*Inphi* discusses negative claim limitations and states:

Whether a patent claim satisfies the written description requirement of 35 U.S.C. § 112, paragraph 1 depends on whether the description “clearly allow[s] persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.

*Inphi*, 805 F.3d at 1355, referencing *Vas–Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562–63 (Fed.Cir.1991); *see also* Req. Reh’g 5. The *Inphi* Court further stated:

The question that remains is whether properly describing alternative features—without articulating advantages or disadvantages of each feature—can constitute a ‘reason to exclude’ under the standard articulated in *Santarus*. We hold that it can.

*Inphi*, 805 F.3d at 1355; *see also* Req. Reh’g. 6.

In short, Appellant states (and we agree):

*Inphi* notes that *Santarus* found express recitation of (dis)advantages to be sufficient to provide a reason to exclude the claim limitation at issue, but specifically states that *Santarus* does not require the specification to include such recitations to provide adequate support for a negative limitation. *Id.* at 1356.<sup>1</sup>

Req. Reh’g. 5.

The *Inphi* court clarified the requisite support necessary for a negative claim limitation stating:

When viewed in its proper context, *Santarus* simply reflects the fact that the specification need only satisfy the requirements of § 112, paragraph 1 as described in this court's existing jurisprudence, including through compliance with MPEP § 2173.05(i) (“If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims.”) and *In re Johnson*, 558 F.2d at 1018 (“It is for the inventor to decide what bounds of protection he will seek.”).

*Inphi*, 805 F.3d at 1356.

Based on the above, Appellant contends, “the specification of the present application clearly allows one of ordinary skill in the art to recognize that the inventor invented the claimed subject matter.” Req. Reh’g. 6. The Board, via its Decision, did not assert that one skilled in the art would not have recognized or understood that which was claimed. Instead, the Decision focused on Appellant’s Specification and whether a sufficient

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<sup>1</sup> “The *Santarus* court found that the patent-at-issue’s express recitation of (dis)advantages was sufficient to provide a reason to exclude the claim limitation at issue. That court did not hold, however, that such recitations were required to satisfy the written description requirements of § 112, paragraph 1 for negative claim limitations. Nor do we see any reason to now articulate a new and heightened standard for negative claim limitations.” *Inphi*, 805 F.3d at 1356.

“reason to exclude” was expressed as per the teachings of *Santarus*. See Decision 3. The Board found no such reason and hence concluded that Appellant’s Specification fails to adequately support the above negative claim limitation “because Appellant’s Specification fails to ‘describe[] a reason to exclude the relevant limitation.’” Decision 4, referencing *Santarus*, 694 F.3d at 1351. In *Inphi*, however, we are instructed by our reviewing Court to instead ascertain “whether the description ‘clearly allow[s] persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.’” *Inphi*, 805 F.3d at 1355 citing *Vas-Cath*, 935 F.2d at 1562–63.

Additionally, Appellant contends that Appellant’s Specification “describe[s] alternative features of the inventive approach that differ from features of the conventional approach.” Req. Reh’g. 7. Appellant notes that the Decision addressed paragraphs 24, 25, and 31 of Appellant’s Specification where alternative features and advantages of the invention were discussed. Req. Reh’g. 7; *see also* Decision 3–4. Nevertheless, the Board was not swayed that these paragraphs met the threshold of a “reason to exclude” as per *Santarus*, and hence the Board entered a New Ground of Rejection. Now, however, Appellant correctly points out that, in view of the more recent *Inphi* decision, the threshold applied in the Decision was not the proper threshold to apply when ascertaining a reason to exclude.

Accordingly, Appellant is persuasive that the Board erred in rendering the New Ground of Rejection as expressed in the Decision. We agree with Appellant “that there is adequate support for the limitation of claim 1 under the *Inphi* / *Vas-Cath* standard.” Req. Reh’g. 8. In summation, the New Ground of Rejection stated in the Decision is withdrawn. However, such

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withdrawal does not affect the remainder of the Decision directed to the Examiner's prior art rejections.

#### DECISION

Appellant's Request for Rehearing has been granted. We have reconsidered our Decision in light of the arguments in Appellant's Request for Rehearing. We make the above noted modifications to our Decision.

GRANTED