Docket No.: 000309.0077
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
William J. CARROLL

Application No.: 11/198,386 | Confirmation No.: 8339

Filed: August 8, 2005 | Art Unit: 3766

For: SWITCHABLE AND PROGRAMMABLE ELECTRODE CONFIGURATION | Examiner: Y. H. N. Lee

REPLY BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

In response to the Examiner's Answer mailed June 10, 2009, the Appellant, through undersigned counsel, submits the present Reply Brief.

The Examiner's Answer has reiterated the rejection and, beginning on page 4, has provided a response to the arguments which the Appellant presented in the Appeal Brief. The Appellant will take up each part of the response set forth in the Examiner's Answer in turn.

In the paragraph spanning pages 4 and 5, the Examiner's Answer asserts that the rule in *In re Venner,* 262 F.2d 91, 120 U.S.P.Q. 192 (C.C.P.A. 1958), is a *per se* rule that the automation of a previously manually performed step would have been obvious. The Appellant respectfully disagrees with that reading of the decision and submits that there is no such *per se* rule. Rather, the decision states that "it is not 'invention' to *broadly* provide a mechanical or automatic means to replace manual activity which has accomplished the same result." *Id.,* 262 F.2d at 94, 120 U.S.P.Q. at 194 (emphasis added). The fact that that decision does not provide a *per se* rule is evidenced by the immediately following paragraph, which discusses whether the

timing device imparts patentability and which would be entirely unnecessary if the reading of the decision in the Examiner's Answer were correct:

> With respect to the paramount contention of appellants that the timing device of their combination establishes patentability, we are of the opinion that the prior art and the logical deductions of anyone skilled in the art would preclude the determination that the recitation of "time-controlled means set to the period between the completion of the pouring of the metal in the mold and solidification of the metal of the piston therein" constitutes "invention." The need for withdrawal of the middle core section upon solidification is recognized by Flammang et al.; Waldie and Stern teach the advantages of timing devices used in conjunction with pressure valves to cause the withdrawal of various parts at predetermined times after pouring in the operation of molding devices. Therefore it would be obvious to any person skilled in this art to equip the mold structure of Flammang et al. with the timing devices of Waldie or Stern.

Id., 262 F.2d at 94, 120 U.S.P.Q. at 194-195. That is, contrary to the reading of the decision given in the Examiner's Answer, the court in *Venner* in fact needed to consider the issue of the timing device on its merits.

Moreover, the rejection from which the present appeal is taken is distinguishable on its facts from the rejection at issue in *Venner*. Whereas in *Venner*, the applied prior art taught the very problem to be addressed by the invention and also taught the advantages of timing devices which would be readily seen to overcome that problem, in present case, the reference applied in the rejection does not acknowledge the problem sought to be solved by the present claimed invention, which is noted in paragraph [0008] of the specification and in the third full paragraph of page 3 of the Appeal Brief, namely, that patient compliance with instructions to change electrode configuration manually is very low, nor does the Examiner's Answer make any representation that such a problem was at all known in the prior art.

Accordingly, the Appellant respectfully submits that the present claimed invention is patentable, notwithstanding *Venner*.

The Examiner's Answer then asserts that claim 12 does not claim a sequence of stimulation. However, as explained in the Appeal Brief in the paragraph spanning pages 3 and 4, the applied reference does not teach the two stimulation modes as applied in the present claimed invention, in either order.

Finally, the comments in the Examiner's Answer on page 5, beginning with line 2, on the changing of connections in the applied reference have already been answered in that same paragraph in the Appeal Brief.

For the reasons set forth above and in the Appeal Brief, the Appellant respectfully urges reversal of the rejection of all claims.

Dated: August 6, 2009

Respectfully submitted,

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