

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YOSHITSUGI HOKAMA, JOANNE S.M. EBESU,
WARREN E. TAKENAKA, ROBERT E. BOURKE, and PATRICK K. SULLIVAN

Appeal No. 2002-0426
Application No. 09/115,797

ON BRIEF

Before ADAMS, GREEN and SCHEINER, Administrative Patent Judges.
ADAMS, Administrative Patent Judge.

VACATUR and REMAND TO THE EXAMINER

On consideration of the record we find this case is not in condition for a decision on appeal. For the reasons that follow, we vacate¹ the pending rejections under 35 U.S.C. § 102(b) and § 103, and remand the application to the examiner to consider the following issues and to take appropriate action.

¹ Lest there be any misunderstanding, the term "vacate" in this context means to set aside or to void. When the Board vacates an examiner's rejection, the rejection is set aside and no longer exists. Therefore the issues set forth herein cannot be satisfied by a Supplemental Examiner's Answer. See Ex parte Zambrano, 58 USPQ2d 1312, 1313 (Bd. Pat. App. & Int. 2000).

Claims 2-27 and 33 are pending. Independent claim 33 is illustrative of the subject matter on appeal and is reproduced below:

21. A portable kit for in situ detection of toxins in fish tissue comprising a first container, a solvent in the first container for extracting toxins from fish tissue and for facilitating toxin binding to the membrane, a second container, a solution in the second container, a suspension of plural detectors in the solution for detecting the toxins, at least one support element, a membrane on a portion of the at least one support element, and a data standard for comparing data indicated by the membrane and determining ciguatoxin concentration.

Claims 2-27 depend from claim 33, either directly or through another dependent claim.

The references relied upon by the examiner are:

Hokama ('392)	4,816,392	Mar. 28, 1989
Park	5,206,141	Apr. 27, 1993
Hokama ('525)	5,525,525	Jun. 11, 1996

GROUND OF REJECTION

Claims 2-6, 8-17, 19, 22-26 and 33 stand rejected under 35 U.S.C. § 102(b) as anticipated by '525.

Claims 2-7, 9, 11-20, 22-26 and 33 stand rejected under 35 U.S.C. § 102(b) as anticipated by Park.

Claims 2-8, 11, 17-24, 26, 27 and 33 stand rejected under 35 U.S.C. § 103 being unpatentable over Park in view of '392.

We vacate the pending rejections and remand the application to the examiner for further consideration.

DISCUSSION

Claim construction:

We begin by construing the claim. “[N]ot unlike a determination of infringement, a determination of anticipation, as well as obviousness, involves two steps. First is construing the claim, . . . followed by, in the case of anticipation or obviousness, a comparison of the construed claim to the prior art.” Key Pharms. Inc. v. Hercon Labs. Corp., 161 F.3d 709, 714, 48 USPQ2d 1911, 1915 (Fed. Cir. 1998).

As we understand the claimed invention (see e.g., claim 33), the kit comprises four elements:

1. A first container, containing a solvent for extracting toxins from fish tissue and for facilitating toxin binding to the membrane;
2. A second container, containing a a suspension of plural detectors in solution for detecting toxins;
3. At least one support element, wherein a membrane is on a portion of at least one support element; and
4. A data standard for comparing data and determining ciguatoxin concentration.

According, we will compare the prior art to the claimed invention to determine whether the prior art teaches a kit comprising the elements identified above.

The rejection over ‘525:

According to the examiner (Answer, page 3), ‘525 teaches a kit for the detection of ciguatoxin, “which includes at least one support element with a nylon membrane covering, an antibody coated mixture of latex beads to act as detectors of a toxin, a testing container, a supply of solvent, and a biopsy tool (abstract).” The examiner also finds (Answer, page 4) that ‘525 teaches the use of a data standard “prepared from other tabulated data for known ciguatoxin concentration and corresponding latex bead

separation distance determined for a range of ciguatoxin concentrations by ascending chromatographic technique.”

On the surface, the examiner’s characterization of the ‘525 patent suggest that each element of appellants’ claimed invention is taught by the ‘525 patent. However, upon closer inspection we find that the elements disclosed in the ‘525 patent are not arranged in the manner set forth in appellants’ claims. As appellants point out (Brief, pages 9-10), ‘525 requires that the coated latex beads (plural detectors) be disposed on a membrane, not in solution in a “second” container as required by the claims on appeal. See e.g., ‘525, column 3, lines 38-39, “[t]he latex-antibody mixture is spotted on a nylon membrane near the bottom end of a support”; and ‘525, claim 11, “[a] kit ... comprising: a support having a surface, a porous membrane provided on said surface, first latex beads of a first color and first diameter and second latex beads of a second color and second diameter being disposed at a common position on said membrane....”

In response to appellants’ argument the examiner argues (Answer, page 10), “the claims drawn to the kit do not recite any details about the mode of bead suspension....” To the contrary, appellants’ claims require that a suspension of plural detectors (e.g., latex beads) be present in the second container. We remind the examiner, “[u]nder 35 U.S.C. § 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim.” Gechter v. Davidson, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997). “Every element of the claimed invention must be literally present, arranged as in the claim.” Richardson v. Suzuki Motor Co., Ltd., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Since the examiner misinterpreted the claimed invention we are compelled to vacate the rejection of claims 2-6, 8-17, 19, 22-26 and 33 under 35 U.S.C.

§ 102(b) as anticipated by '525 and remand the application to the examiner for further consideration.

The rejection over Park:

According to the examiner (Answer, pages 5-6):

Park teaches a kit for the detecting the [sic] presence of ciguatoxin ... which comprises supports for binding toxin, a fixer for fixing toxin to the support, an assay reagent, and a buffer solution for washing the fixed toxin-bound supports. The fixation reagent, assay reagent and wash solution inherently are supplied in separate containers. ... The LIQUID PAPER-coated end or membrane end of a "test" support is inserted into the incision to contact the fish sample (col. 4[,] lines 3-5).

According to appellants' claimed invention, the first container contains a solvent for extracting toxins from fish tissue and for facilitating toxin binding to the membrane. In this regard, the examiner finds (Answer, page 11), "Park teaches the use of absolute methanol^[2] for fixing. Park teaches the incorporation of an organic solvent into the preparation to reduce the amount of oil left on the support and aids in drying of the support after impregnation with the okadaic acid composition." The examiner is correct in that Park teaches the use of absolute methanol as a fixation reagent. See Park, column 8, lines 30-31. The examiner is also correct in that Park teaches the use of mixtures of oil in butanol, or oil in hexane, as a carrier. However, what the examiner appears to have missed is that appellants' claimed invention comprises a first container, containing a solvent for both extracting toxins from fish tissue and for facilitating toxin binding to the membrane. It appears that the examiner has misinterpreted the claimed

² We note that the '525 patent teaches the use of absolute methanol as an extraction reagent. See '525, column 4, lines 40-54, "[t]he solvent is preferably absolute methanol ... the fish tissue is immersed in the methanol for a sufficient amount of time to form a fish extract."

invention to include a fixation reagent and an extraction reagent in separate containers. This, however, is not appellants' claimed invention.

We find nothing in Park, and the examiner does not identify any disclosure in Park wherein a solvent is identified as being useful for both extracting toxins from fish tissue and for facilitating toxin binding to the membrane. Since the examiner misinterpreted the claimed invention we are compelled to vacate the rejection of claims 2-7, 9, 11-20, 22-26 and 33 under 35 U.S.C. § 102(b) as anticipated by Park and remand the application to the examiner for further consideration.

The rejection over Park in view of '392:

The examiner relies on Park as discussed above. The examiner recognizes, however, that "Park does not teach the use of sodium azide." Answer, page 8. To make up for this deficiency the examiner relies on '392. According to the examiner (*id.*), '392 teaches, *inter alia*, a kit consisting of a tissue sampling bamboo stick used to collect a tissue sample, a vial containing a fixation reagent preferably methanol, and a vial B containing a Tris/sodium azide buffer.

However, as discussed above, we find nothing in Park, and the examiner does not identify any disclosure in Park wherein a solvent is identified as being useful for both extracting toxins from fish tissue and for facilitating toxin binding to the membrane. The same is true of '392. Instead, the examiner appears to read the limitations of Park and '392 as teaching separate containers of, *inter alia*, fixation reagents, and carriers. This, however, is not appellants' claimed invention.

Since the examiner misinterpreted the claimed invention we are compelled to vacate the rejection of claims 2-8, 11, 17-24, 26, 27 and 33 under 35 U.S.C. § 103 as

being unpatentable over Park in view of '392 and remand the application to the examiner for further consideration.

FURTHER PROCEEDINGS

Upon return of the application, we encourage the examiner to take a step back and carefully consider each limitation of the claimed invention together with the available prior art. If the examiner remains of the opinion that the claims on appeal are unpatentable, the examiner should issue an appropriate Office Action that clearly addresses each limitation of the claimed invention together with the facts and reasons used in support of such a rejection.

We are not authorizing a Supplemental Examiner's Answer under the provisions of 37 CFR § 1.193(b)(1). Any further communication from the examiner that contains a rejection of the claims should provide appellants with a full and fair opportunity to respond.

VACATED and REMANDED

Toni R. Scheiner)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
Donald E. Adams)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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Lora M. Green)	
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