

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte KAREN SHANNON

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Appeal No. 2004-0727  
Application No. 09/690,173

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ON BRIEF

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Before SCHEINER, ADAMS and GREEN, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 32-48, which are all the claims pending in the application.

Claims 38 and 41 are illustrative of the subject matter on appeal and are reproduced below:

38. A kit for use in linearly amplifying mRNA, said kit comprising:
  - an oligonucleotide promoter-primer comprising an RNA polymerase promoter sequence; and
  - instructions to convert the mRNA to cDNA, and to then transcribe the cDNA into RNA in the presence of a reverse transcriptase that is rendered incapable of RNA-dependent DNA polymerase activity during this transcription step.
  
41. A kit for use in linearly amplifying mRNA, said kit comprising:



## DISCUSSION

Anticipation under 35 U.S.C. § 102 requires that a single prior art reference disclose each and every limitation of the claimed invention. Electro Med. Sys. S.A. v. Cooper Life Sci., 34 F.3d 1048, 1052, 32 USPQ2d 1017, 1019 (Fed. Cir. 1994). As we understand the rejection of record, Wang discloses kits comprising containers of various reagents, including those set forth in appellant's claim 41. Accordingly, the examiner concludes (Answer, page 4), Wang "teach each and every aspect of the instant invention thereby anticipating [a]ppellant's claimed invention."

While claim 41 does not include a limitation drawn to "printed matter," such as instructions, appellant spends the bulk of the Brief and Reply Brief discussing "printed matter." According to appellant (Brief, page 14),

Wang fails to teach a kit containing the instructional element of the present claims because Wang is concerned with an entirely different method.... As such, Wang fails to teach each and every element of the claims. Because Wang fails to teach each and every element of the claimed kit, e.g., the instructions, Wang fails to anticipate [c]laims 38 and 41-48....

Apart from appellant's argument concerning "printed matter," which is not a limitation of claim 41, appellant identifies no other error in the rejection of claim 41 over Wang. Accordingly, we are compelled to affirm the rejection of claim 41 under 35 U.S.C. § 102(e) as anticipated by Wang. As set forth above, claims 32-40 and 42-48 fall together with claim 41.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

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

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