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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN STAPHANOS

Appeal No. 2004-1887
Application No. 09/430,469

ON BRIEF

Before GARRIS, WALTZ, and MOORE, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

Decision on appeal

This is a decision on an appeal from the final rejection of claims 1-19 and 21-25. On pages 3 and 4 of the answer (i.e., Paper No. 15, mailed March 4, 2004 in response to a remand by this panel of the Board), the Examiner states that the prior art final rejection of claims 12-14 is withdrawn whereby these claims are now objected to but otherwise allowable. We therefore dismiss the appeal as to claims 12-14 thereby leaving claims 1-11, 15-19 and 21-25 before us on this appeal. These are all of the claims remaining in the application.

The subject matter on appeal relates to a process analytic system comprising a sample handling system and a process analyzer wherein the process analyzer is operably coupled to the sample handling system to modify at least one sample handling parameter based upon diagnostic information related to the sample handling system. The appealed subject matter also relates to a process analytic system comprising a sample handling system and a process analyzer wherein the process analyzer is operably coupled to the sample handling system to communicate digitally with the sample handling system. This appealed subject matter is adequately illustrated by independent claims 1 and 19 which read as follows:

> 1. A process analytic system, comprising
> a sample handling system having a sample output, and a sample input, the sample input being couplable to a process container to extract a sample from the container and convey the sample to the sample output;
>
> a process analyzer coupled to the sample output of the sample handling system, and adapted to analyze the sample to provide an analytical output based upon a characteristic of the sample; and
>
> wherein the process analyzer is operably coupled to the sample handling system to modify at least one sample handling parameter based upon diagnostic information related to the sample handling system.
>
> 19. A process analytic system, comprising
> a sample handling system having a sample output, and a sample input, the sample input being couplable to a process container, and wherein the sample handling system

is adapted to extract a sample from the container and convey the sample to the sample output;

a process analyzer coupled to the sample output of the sample handling system, and adapted to analyze the sample to provide an analytical output based upon a characteristic of the sample; and

wherein the process analyzer is operably coupled to the sample handling system to communicate digitally with the sample handling system.

The prior art set forth below, as listed by the Examiner on page 4 of the answer, is relied upon as evidence of anticipation in the § 102 rejections before us:

Sittler et al. (Sittler)	WO 97/12239	Apr. 3, 1997
Hikosaka et al. (Hikosaka)	6,004,514	Dec. 21, 1999

"Rosemount Analytical, 'Model DCX [sic, GCX] Gras [sic, Gas] Chromatograph Transmitter' [,Operator Manual] (July 1999), pp. 1-1 thru [sic] 3-2 [sic; see footnote 2 infra)]" (answer, page 4)[1]

Claims 1-4, 16, 19 and 21-25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sittler.

Claims 1-11, 15-19 and 21-25 stand rejected under 35 U.S.C. § 102(a) as being anticipated by GCX.

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[1] The Examiner has inappropriately used a variety of differing nomenclatures in identifying this reference including "GCX Manual on the HMI Software (July 1999)" (answer, page 4) and "'Model DCX [sic, GCX] Gas Chromatograph Transmitter' (July 1999)" (answer, page 5 et. seq.) and "GCX" (answer, page 5 et. seq.). Hereinafter, we identify this reference with the nomenclature GCX.

Finally, claims 1-4, 15 and 21-25 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Hikosaka.

We refer to the brief filed August 30, 2002 and to the answer mailed March 4, 2004 for an exposition of the respective positions advocated by the Appellant and by the Examiner concerning the above noted rejections.

Opinion

Based on the record before us, it is quite clear that none of the Examiner's § 102 rejections can be sustained for the reasons set forth by the Appellant in his brief. We add the following comments for emphasis.

The Section 102 rejection based on Sittler

The Examiner's finding that independent claims 1 and 19 are anticipated by Sittler is based on her belief that Sittler's controller 84 transmits a digital signal (indicative of the gas species being analyzed) to the timing and control circuit 86 for timing and actuation of valves 30, 32, 34 and 44-50 (e.g., see pages 7-9 of the answer). As explained by the Appellant in the brief, however, the aforementioned digital signal is transmitted to display/storage circuit 92 rather than timing and control circuit 86. While we recognize that this timing and control circuit is provided with an output from controller 84, the Sittler reference

contains no teaching whatsoever that the aforementioned output constitutes a digital signal indicative of the gas species. See the first full paragraph on page 14 of the Sittler reference. In fact, Sittler's use of the indefinite article "an" in referring to this output quite clearly reflects that this output is distinct from the previously recited digital signal.

For these reasons and those set forth in the brief, it is apparent that we cannot sustain the Examiner's § 102 rejection of claims 1-4, 16, 19 and 21-25 as being anticipated by Sittler.

The Section 102 rejection based on GCX

Our study of the application file record including the advisory Action mailed June 21, 2002 reflects that the Examiner regards the manual control feature disclosed on page 3-38[2] of GCX as satisfying the appealed independent claim 1 requirement "wherein the process analyzer is operably coupled to the sample handling system to modify at least one sample handling parameter based upon diagnostic information related to the sample handling system."

[2] Notwithstanding her explicit reliance on page 3-38, the Examiner, for some unknown reason, has referred only to pages 1-1 through 3-2 in listing this reference on page 4 of the answer. Despite this limited page referral, we have included page 3-38 in our assessment of the GCX reference.

In responding to the Appellant's nonanticipation viewpoint, the Examiner further elucidates her position on pages 9-10 of the answer in the following manner:

> With respect to the previous rejection of claims 1-19, 21-25 [sic] under 35 U.S.C. 102(a) as being anticipated by Model DCX [sic] Gas Chromatograph Transmitter (July 1999), Appellant argues that the manual control provided by the GCX does not teach or suggest actually modifying sample parameters of the sample handling system based upon diagnostic information of the sample handling system itself. Examiner contends that the claim does not require the diagnostic information to be supplied by the sample handling system itself, but rather the sample parameters are modified based upon diagnostic information related to the sample handling system. How the diagnostic information is supplied to the process analyzer is not recited in the claims. Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

The Examiner's position is not well taken in a number of respects. In the first place, the Examiner's above quoted comments reflect a potential misunderstanding of the claim 1 requirement under review (e.g., the Examiner seems to believe the Appellant's specification teaches that the sample handling system supplies the

diagnostic information, which is incorrect). Secondly, we perceive no rational basis for the Examiner's proposition that the manual control taught by GCX would result in the process analyzer being "operably coupled to the sample handling system to modify at least one sample handling parameter based upon diagnostic information related to the sample handling system" as required by the Appellant's independent claim 1. Thirdly, while it is true that, during examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification (see In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000)), the Examiner's interpretation of the aforementioned claim 1 requirement as being anticipated by the manual control feature of GCX is neither reasonable nor consistent with the subject specification.

As for appealed independent claim 19, the Examiner has not identified, and we do not independently find, any disclosure in the GCX reference which satisfies the here claimed requirement "wherein the process analyzer is operably coupled to the sample handling system to communicate digitally with the sample handling system." Indeed, the answer contains no specific discussion concerning the requirements of this claim or of any other claim on appeal beyond the aforequoted remarks by the Examiner on pages 9-10. It

necessarily follows that, for this reason alone, the Examiner has failed to carry her initial burden of establishing a prima facie case of anticipation. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Under the circumstances set forth above and in the brief, we also cannot sustain the Examiner's § 102 rejection of claims 1-11, 15-19 and 21-25 as being anticipated by GCX.

The Section 102 rejection based on Hikosaka

We have fully considered all of the comments expressed by the Examiner in her answer concerning this rejection. However, absent from the answer is any meaningful and rational explanation as to why the Examiner considers specifically identified disclosure in the Hikosaka reference to satisfy the requirement set forth in the last clause of appealed independent claim 1. For example, no support for an anticipation finding relative to this claim requirement is provided by the Examiner's statements that "the electrical control unit 21 [of Hikosaka] is disclosed as operatively coupled to the analyzer and is for driving and controlling analyses of the gas component by the system" (answer, page 10) or that "the selector switch 47, (i.e. sample handling system component) is switched in response to a signal from the controller, which is coupled to the analyzer" (answer, pages 10-11)

or that “the electrical control unit 21 comprises printed circuit boards 101 mounted with electrical circuits for driving and controlling the whole system 20, i.e. provide communication between the analyzer and sample handling portions” (answer, page 11).

None of these or any other statements made by the Examiner in the answer provide a basis for finding that Hikosaka anticipates the claim 1 requirement “wherein the process analyzer is operably coupled to the sample handling system to modify at least one sample handling parameter based upon diagnostic information related to the sample handling system.” Thus, the Examiner again has failed to carry her initial burden of establishing a prima facie case of anticipation. See Oetiker, 977 F.2d at 1445, 24 USPQ2d at 1444.

In light of the foregoing and for the reasons expressed in the brief, the § 102 rejection of claims 1-4, 15, and 21-25 as being anticipated by Hikosaka likewise cannot be sustained.

Conclusion

The decision of the Examiner is reversed.

Reversed

BRADLEY R. GARRIS Administrative Patent Judge	)	
THOMAS A. WALTZ Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JAMES T. MOORE Administrative Patent Judge	)	

BRG/jrg

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