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was not written for publication and is not
binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN C. WARDLAW

Appeal No. 2004-1944
Application No. 09/255,673

ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 32-47. Claims 1-31, which are all of the remaining claims pending in this application, have been withdrawn from further consideration by the examiner as drawn to a non-elected invention.

BACKGROUND

Appellant's invention relates to a method for testing biologic fluid samples. An understanding of the invention can be

derived from a reading of exemplary claim 32, which is reproduced below.

32. A method for testing a sample of biologic fluid, comprising the steps of:

providing a container for holding the sample, said container having a chamber with a first wall and a transparent second wall, one or more features operable to enable the testing of the biologic fluid sample at least one of which is located at a known spatial location within said chamber, and a label attached to said container, said label containing information which is used in the performance of one or more tests, wherein said information includes said known spatial location of said feature;

providing a reader module that includes a label reader for reading said label and a field illuminator for selectively illuminating one or more fields of the sample, each sample field having a known or ascertainable area;

depositing said sample within said chamber, wherein said sample quiescently resides in said chamber thereafter during the testing;

reading said label with said label reader, thereby communicating to said reader module said information which is used in the performance of said one or more tests, including said known spatial location of said feature; and

selectively imaging one or more of said fields of the sample using said field illuminator, including said field of the sample in which said feature is disposed at said known spatial location within said chamber.

The sole prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Merkh et al. (Merkh)

5,281,540

Jan. 25, 1994

Claims 32-47 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failure to particularly point out and distinctly claim that which applicant regards as his invention. Claims 32-36 and 40-47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Merkh.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer and to appellant's briefs for a complete exposition thereof.

DECISION

We reverse the examiner's stated § 112, second paragraph, rejection and the examiner's § 103(a) rejection as expressed in the answer. Our reasoning follows.

Rejection under 35 U.S.C. § 112, second paragraph

The relevant inquiry under 35 U.S.C. § 112, second paragraph, is whether the claim language, as it would have been interpreted by one of ordinary skill in the art in light of appellant's specification and the prior art, sets out and

circumscribes a particular area with a reasonable degree of precision and particularity. See In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

Here, the examiner has taken the position that the appealed claims run afoul of the second paragraph of § 112 because "[i]t is unclear as to what are the features operable which enable the testing of the biological fluid samples" (answer, page 3). In arguing against appellant's considerable opposition to the examiner's stated rejection, the examiner (answer, page 5) inexplicably states that:

35 U.S.C. § 112, second paragraph, does not permit the examiner to study the applicant's disclosure, formulate a conclusion as to what the examiner regards as the broadest invention supported by the disclosure, and then determine whether the claims are broader than the examiner's conception of what "the invention" is.

Nonetheless, the examiner, after an apparent review of at least a portion of appellant's specification with respect to the claim language in question, goes on to state, at pages 6 and 7 of the answer, that:

No specific and clear definition of the "features" are given. In view of the specification, the myriad examples of the "features" are so varied and broadly defined, that it is unreasonable to assume th[at] one of ordinary skill in the art in reading and interpreting [sic] the claim language would be able to pinpoint, with any degree of accuracy, just what the appellant is intending to precisely claim, and

including the metes and bounds of the limitations of the claim.

However, we find ourselves in agreement with appellant's basic position that the examiner has not convincingly explained why the claim language at issue, as it would have been interpreted by one of ordinary skill in the art in light of appellant's specification and the prior art, fails to set out and circumscribe a particular area with a reasonable degree of precision and particularity.

In other words, the examiner has simply not met the initial burden of establishing why one of ordinary skill in this art would not be apprised of the scope of the claims. While the claim limitations concerning the "one or more features" that are variously worded in the appealed claims as being operable to enable the testing of the biological fluid sample may be viewed as relatively broad in scope, breadth does not equate with indefiniteness. See In re Gardner, 427 F.2d 786, 788, 166 USPQ 138, 140 (CCPA 1970).

Additionally, the examiner's rejection fails because appellant's original application does set forth guidance as to what is meant by those claim terms. The examiner's concern about

"the myriad examples of the 'features'" that are furnished in the specification does not prove that the claim language is not reasonably definite or that the claimed subject matter is not directed to what applicant regards as the invention. Consequently, we will not sustain the rejection under 35 U.S.C. § 112, second paragraph, on this record.

Rejection under 35 U.S.C. § 103(a)

In a rejection under 35 U.S.C. § 103(a), it is basic that all limitations recited in a claim must be considered and given appropriate effect in judging the patentability of that claim against the prior art. See In re Geerdes, 491 F.2d 1260, 1262-63, 180 USPQ 789, 791 (CCPA 1974). Here, all of the so rejected appealed claims are drawn to a method wherein a sample of biological fluid is deposited in a chamber and quiescently resides therein during subsequent testing.

Appellant maintains that Merkh describes a method wherein a biological fluid sample is not quiescently retained in a chamber during analysis. In support, appellant (brief, pages 13-15) refers to passages in the Exemplary Mode Of Operation section of the applied Merkh patent for showing that Merkh programs a carousel drive interface to provide agitation of containers

including reaction chambers for containing the deposited biological fluid samples and thereafter subjects the fluid samples to other steps including washing and drying.

In rejecting claims 32-36 and 40-47 as being obvious over Merkh, the examiner asserts that Merkh provides for testing a fluid sample deposited within a chamber (reaction well labeled 86) and for the quiescent residing of the sample during the analysis (test). However, the examiner refers to select sections of the disclosure of Merkh concerned with the apparatus without addressing the portions of the disclosure of Merkh that relate to the operation or testing method as relied upon by appellant in the arguments in the brief. Our review of column 9, lines 50-61 and column 13, lines 38-43 of Merkh, as referred to by the examiner, reveals that those sections of the applied patent generally describe the reaction cartridge employed as being one which includes reaction well portion (86) that contains a test array (82) and "which is adapted to hold a patient sample and selected reagents in contact with the test array (82) during a test" (column 13, lines 41-43). However, the examiner has not pointed to any teaching of Merkh which indicates that a biologic fluid sample is quiescently residing in a chamber (well) during the testing.

Moreover, we note that the examiner's attempt to correlate the teachings of Merkh with the claimed subject matter is further flawed by the examiner's position in equating the well (86) of Merkh with both appellant's claimed chamber and appellant's claimed "features". See the sentence bridging pages 3 and 4 of the answer and the following sentence on page 4 of the answer. Of course, the features referred to in appellant's claims represent an additional limitation and not merely a redundant recitation of the chamber. Accordingly, on this record, the rejection fails for lack of a sufficient factual basis upon which to reach a conclusion of obviousness. In re Fine, 837 F.2d 1071, 1073-74, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). It follows that we reverse the examiner's stated § 103(a) rejection for failure to make out a prima facie case of obviousness for substantially the reasons as set forth above and in the briefs.

CONCLUSION

The decision of the examiner to reject claims 32-47 under 35 U.S.C. § 112, second paragraph, as being indefinite for failure to particularly point out and distinctly claim that which

applicant regards as invention and to reject claims 32-36 and 40-47 under 35 U.S.C. § 103(a) as being unpatentable over Merkh is reversed.

REVERSED

Bradley R. Garris)	
Administrative Patent Judge)	
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)	
)	
)	BOARD OF PATENT
Thomas A. Waltz)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
Peter F. Kratz)	
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