

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK LADLOW and ADRIAN WALTER MITCHELL

Appeal No. 2004-2052
Application 09/509,147

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 3 through 20, which are all of the claims remaining in this application. Claim 2 has been canceled (see Paper No. 13, filed October 28, 2002).

As noted on pages 1 and 2 of the specification, appellants' invention provides an adapter which permits the use of an

Appeal No. 2004-2052
Application 09/509,147

existing laboratory magnetic stirrer, normally only capable of accommodating and effectively stirring the contents of one reaction vessel, for parallel synthesis where a plurality of reaction vessels are correctly and effectively located in a magnetic field generated by the laboratory magnetic stirrer and receive essentially equivalent stirring with respect to the magnetic field. Independent claims 1, 11 and 13 are representative of the subject matter on appeal and a copy of those claims can be found in the Appendix to appellants' brief.

The references of record relied upon by the examiner in rejecting the appealed claims are:

Landsberger	3,356,346	Dec. 5, 1967
Jones	3,594,129	Jul. 20, 1971
Baker et al. (Baker)	WO 97/09353	Mar. 13, 1997

Claims 1 and 3 through 20 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the now claimed invention.

Appeal No. 2004-2052
Application 09/509,147

Claims 1 and 3 through 20 additionally stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim that which appellants regard as their invention.

Claims 1, 3 through 5 and 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Jones.

Claims 1, 3 through 5, 7 through 9 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Landsberger in view of Jones.

Claims 6, 10 and 12 through 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Landsberger and Jones as applied above, and further in view of Baker.

Rather than reiterate the examiner's full commentary with respect to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we make reference to the examiner's answer (Paper No. 17, mailed October 22, 2003) for the examiner's

Appeal No. 2004-2052
Application 09/509,147

reasoning in support of the rejections, and to appellants' brief (Paper No. 16, filed August 11, 2003) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions set forth by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

We turn first to the examiner's rejection of claims 1 and 3 through 20 under 35 U.S.C. § 112, first paragraph, wherein the examiner contends that the specification, as originally filed, fails to provide written descriptive support for the invention as now claimed. In considering this rejection, we note that as stated in In re Bowen, 492 F.2d 859, 864, 181 USPQ 48, 52 (CCPA 1974), the description requirement of 35 U.S.C. 112, first paragraph, "is that the invention claimed be described in the specification as filed." It is not necessary that the claimed subject matter be described identically, i.e., in haec verba, but

Appeal No. 2004-2052
Application 09/509,147

the disclosure originally filed must convey to those skilled in the art that the applicant had invented the subject matter later claimed. See In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984). In addition, we note that our Court of review has also informed us that the drawings included in the application may aid in the interpretation of claim limitations, in that "drawings alone may provide a 'written description' of an invention as required by § 112." Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1556, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Thus, in those instances where a visual representation can flesh out words, drawings can and should be used like the written specification to provide evidence relevant to claim interpretation and used to interpret what the inventor(s) intended by the claim terms.

Applying those precepts to the present application, we find ourselves in agreement with the examiner that the language added to claim 1 in the amendment filed October 28, 2002 (Paper No. 13) concerning the adapter block being "structurally removable from the laboratory magnetic stirrer without removing a fastener" finds no support in the application disclosure as originally filed. Even though we have looked to both the discussion in the

Appeal No. 2004-2052
Application 09/509,147

specification regarding the background information of the invention and the specific description of appellants' invention therein, we find nothing which provides clear support for the negative limitation regarding the adapter block being "structurally removable from the laboratory magnetic stirrer without removing a fastener," which was belatedly added to claim 1 in Paper No. 13. Nor does a review of the drawings of the present application provide any particular insight concerning this negative limitation. As the examiner has noted in the answer, a negative limitation must have basis in the original disclosure, and the mere absence of a positive recitation or showing concerning a securement device or fastener for appellants' adapter does not provide a basis for an exclusion of such a fastener. Thus, we agree with the examiner that the negative limitation added to claim 1 violates the description requirement and that the disclosure of the application as originally filed would not have reasonably conveyed to one skilled in the art that the inventors herein had possession of the subject matter now claimed at that time. Accordingly, we will sustain the examiner's rejection of independent claim 1, and claims 3 through 10, 17 and 18 which depend therefrom, under 35 U.S.C. § 112, first paragraph.

Appeal No. 2004-2052
Application 09/509,147

However, we will not sustain the examiner's rejection of claims 11 through 15 and 19 under 35 U.S.C. § 112, first paragraph, since independent claims 11 and 13, and claims 12, 14, 15 and 19 which depend therefrom, do not include the negative limitation discussed above, and the examiner has expressed no other basis for rejection of these claims under 35 U.S.C. § 112, first paragraph.

Nor will we sustain the examiner's rejection of claims 16, 18 and 20 under 35 U.S.C. § 112, first paragraph, based on the assertion of new matter therein set forth on page 4 of the answer. In this instance, we agree with appellants that a collective consideration of drawing Figures 1 and 3 of the application provide a reasonable basis for the recitation in claims 16, 18 and 20 that a base portion of each reaction vessel (3) may be held by the adapter "substantially at the level of the recess" (5a), i.e., wherein the bottom of the reaction vessel is located outside the periphery of the recess (5a) but at a level within the vertical extent of the recess. However, as noted *supra*, claim 18 depends from claim 1 and as a result thereof will fall with claim 1.

Appeal No. 2004-2052
Application 09/509,147

We next consider the examiner's rejection of claims 1 and 3 through 20 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim that which appellants regard as their invention. The first issue raised by the examiner is that appellants' reference to "a recess in the base" in independent claims 1 and 11 has no clear antecedent basis, since no "base" of the adapter block has been positively recited in these claims. It appears to us from footnote 2 on page 5 of the brief that appellants have acquiesced in this aspect of the examiner's rejection and intend to correct the lack of antecedent basis in claims 1 and 11 at some later date. Thus, the examiner's rejection of independent claims 1 and 11 under the second paragraph of 35 U.S.C. § 112, and of claims 3 through 10, 12 and 17 through 20 which depend therefrom, is sustained. The recitation of "a recess in the base" in claim 14 on appeal also renders that claim indefinite and the examiner's rejection of claim 14 is likewise sustained.

The examiner further rejects independent claims 11 and 13 under 35 U.S.C. § 112, second paragraph, because of the lack of any proper antecedent basis for the recitation "each and every socket," set forth therein. Finding no argument in appellants'

Appeal No. 2004-2052
Application 09/509,147

brief specifically addressing this aspect of the examiner's indefiniteness rejection, we will summarily sustain. It follows that claims 14 through 16 which depend from independent claim 13 are also indefinite as a result of their dependency, and that the examiner's rejection of those claims under the second paragraph of 35 U.S.C. § 112 will also be sustained.

As a result of the foregoing, it is clear that at least one basis for the examiner's rejection of claims 1 and 3 through 20 under 35 U.S.C. § 112, second paragraph, has been sustained. Thus, the decision of the examiner rejecting those claims as being indefinite is affirmed.

We have also looked to the additional aspects of purported indefiniteness noted by the examiner in the paragraphs bridging pages 5 and 6 of the answer and specifically concerning dependent claims 3, 4, 12, 13, 17 and 19 on appeal, but find that we do not agree with the examiner's position concerning those aspects of the rejection. Regarding the examiner's assertion that claim 1 cannot be limited by claim 3, we agree with appellants' argument on page 3 of the brief that the "guide means" of claim 3 includes both the rim and the recess, as generally stated in the second

full paragraph on page 2 of the specification. Thus, the recitations of claim 3 do to some extent further limit claim 1. Regarding claims 4, 5, 17 and 19, we find nothing intrinsically wrong with appellants' recitation of a "fixing means for holding a plurality of reaction vessels" in independent claims 1 and 11, and the subsequent recitation in dependent claim 4 that such fixing means specifically "comprise [sic] a plurality of sockets," while in dependent claims 17 and 19 it is recited that such fixing means "comprises a plurality of holders." In that regard, we note that Figures 1-3 of the drawings of the present application show one form of socket or holder (2), while Figure 4 shows another form of socket/holder (13). As for the recitation in claim 12 concerning a hotplate operatively connected to the magnetic stirrer, and of claims 12 and 13 concerning a condenser unit operatively connected to the adapter block, although we find the language employed in these claims to be somewhat awkward and cumbersome, we are of the view that one of ordinary skill in the art reading the specification and viewing the drawings of the present application would be reasonably apprised of the fact that the magnetic stirrer, or magnetic stirrer assembly, includes a hotplate operatively connected to the magnetic stirrer and a condenser unit (12) operatively connected to or associated with

the adapter block (see page 2, lines 22-27 and page 4, lines 20-30 of the specification, and Figure 4 of the drawings).

We now turn our attention to the prior art rejections, beginning with the rejection of claims 1, 3 through 5 and 8 under 35 U.S.C. § 102(b) as being anticipated by Jones. In this instance, the examiner's urges (answer, pages 6-7) that the chemical analyzer of Jones comprises a turntable (12) (adapter block) that has a series of openings (16) (fixing means) in a ring (17) (guide means) on its periphery for holding vessels (18), and further contends that the turntable (12) "rotates above the platform which is fitted via a recess (see figures)." On page 12 of the answer, the examiner specifically points to Figures 9 and 10 of Jones, urging that the turntable (12) as seen therein clearly comprises a recess with a rim that allows the upper portion of the turntable to fit over a second portion of the device.

Like appellants' (brief, pages 6-8), we fail to see that Jones describes, teaches or suggests a removable adapter block that is capable of being seated on a laboratory magnetic stirrer and which includes a recess in the base thereof for receiving an

upper portion of the stirrer, and fixing means for holding a plurality of reaction vessels, "wherein when the adapter block is co-operatively positioned on a magnetic stirrer, each and every position for holding a reaction vessel is effectively located for stirring with respect to the magnetic field," as required in independent claim 1 on appeal. Nor do we see that Jones teaches an adapter block that is "removable from the laboratory magnetic stirrer without removing a fastener," as set forth in claim 1. Moreover, we note that the examiner has not in any way established that the ring (17) of Jones is capable of acting as a guide means "to ensure that each and every position for holding a reaction vessel is effectively located for equivalent stirring" when the adapter block is seated on a laboratory magnetic stirrer, as required in claim 3 on appeal. Contrary to the examiner's apparent belief, we see the above-noted limitations as being more than mere statements of intended use, and instead perceive those limitations as requiring both a structural relationship and functional interaction with a laboratory magnetic stirrer clearly not present in, nor in any way apparent from, Jones.

With particular regard to the requirement in claim 1 on appeal that the adapter block be "removable from the laboratory magnetic stirrer without removing a fastener," we note that the turntable of Jones is described (col. 3, lines 9-22) and shown in Figure 6 as being rotatably mounted on an upstanding hollow shaft (24) which is threaded at its upper end (26) so that it can receive a nut (27) that is used to securely hold the turntable (12) in position on the base (11) of the chemical analyzer and to exert a downward force of selected magnitude against the turntable so that an effective fluid-tight seal is maintained between the bearing surface (31) of the reaction tubes (21) of the turntable and the contact or sealing surface (30) on the platform (14) of the analyzer base. There is no teaching or suggestion in Jones of any other form of mounting for the turntable and clearly no basis, other than that afforded by speculation and conjecture, which would have led one of ordinary skill in the art to conclude that the turntable of Jones is somehow adapted for seating on a laboratory magnetic stirrer so as to achieve the functional requirements of claim 1 and also mountable in such a way as to be structurally removable from a laboratory magnetic stirrer without removing a fastener.

Appeal No. 2004-2052
Application 09/509,147

In light of the foregoing, we will not sustain the examiner's rejection of independent claim 1, and claims 3 through 5 and 8 which depend therefrom, under 35 U.S.C. § 102(b) as being anticipated by Jones.

We next look to the examiner's rejection of claims 1, 3 through 5, 7 through 9 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Landsberger in view of Jones. Independent claims 1 and 11 on appeal both require an adapter block having a recess in the base thereof for receiving an upper portion of a laboratory magnetic stirrer and fixing means for holding a plurality of reaction vessels with the center of each reaction vessel distributed around the recess in the adapter block "outside the periphery of the recess." Contrary to the examiner's position as set forth on page 8 of the answer, we must agree with appellants (brief, page 9) that it would not have been obvious to one of ordinary skill in the art to modify the magnetic stirrer of Landsberger such that the plurality of reaction vessels (12) therein would be located outside the periphery of the recess used for seating the adapter/support block (10) on the laboratory magnetic stirrer (14). In that regard, it is apparent to us that the reaction vessels (12) and

Appeal No. 2004-2052
Application 09/509,147

stirring magnets (26) provided therein must be located in the particular manner shown in Figure 4 of Landsberger, i.e., as close as possible above an end portion of rotary magnetic bar (18) of the stirrer, in order for the stirring magnets (26) to be moved in a vertical direction and thereby provide vertical agitation of the fluid within each vessel, as expressly required by Landsberger (see col. 1, lines 54-57, col. 2, lines 39-53 and col. 3, lines 3-13). Simply stated, the stirring machine of Landsberger would be inoperative if modified in the manner urged by the examiner. Thus, we will not sustain the examiner's rejection of claims 1, 3 through 5, 7 through 9 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Landsberger in view of Jones.

We have also reviewed the Baker reference, applied by the examiner along with Landsberger and Jones in the rejection of claims 6, 10 and 12 through 20 under 35 U.S.C. § 103(a). However, we find nothing in Baker which would overcome the serious deficiency in the combination of Landsberger and Jones as noted above. Thus, the examiner's rejection of claims 6, 10 and 12 through 20 under 35 U.S.C. § 103(a) based on Landsberger in view of Jones and Baker will not be sustained.

Appeal No. 2004-2052
Application 09/509,147

To summarize our decision, we note that a) the examiner's rejection of claims 1 and 3 through 20 under 35 U.S.C. § 112, first paragraph, has been sustained with regard to claims 1, 3 through 10, 17 and 18, but not with regard to claims 11 through 16, 19 and 20; b) the examiner's rejection of claims 1 and 3 through 20 under 35 U.S.C. § 112, second paragraph, has been sustained, but not with regard to all aspects urged by the examiner; c) the examiner's rejection of claims 1, 3 through 5 and 8 under 35 U.S.C. § 102(b) as being anticipated by Jones has not been sustained; d) the rejection of claims 1, 3 through 5, 7 through 9 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Landsberger in view of Jones has not been sustained, and e) the examiner's rejection of claims 6, 10 and 12 through 20 under 35 U.S.C. § 103(a) based on Landsberger in view of Jones and Baker has not been sustained.

However, since at least one rejection posited by the examiner has been sustained with regard to all claims on appeal, it follows that the decision of the examiner is affirmed.

Appeal No. 2004-2052
Application 09/509,147

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

AFFIRMED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JOHN P. McQUADE)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

CEF:pgc

Appeal No. 2004-2052
Application 09/509,147

Foley & Lardner
321 North Clark Street
Suite 2800
Chicago, IL 60610-4764