

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte THOMAS B. HARVEY, III

Appeal No. 2005-0549
Application No. 09/946,424

ON BRIEF

Before WILLIAM F. SMITH, ELLIS, and MILLS, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1-3, 5-10, 14-20, and 28. Claims 4, 11-13, and 21-27 are pending but have been withdrawn from consideration by the examiner.

Claim 1 is representative of the subject matter on appeal and read as follows:

1. An apparatus for detecting one or more analytes is [sic, in] a sample, comprising:

a substrate having a test site identifiable by its position on the substrate;

a microsphere in proximity with the test site and attached to a ligand that specifically binds with one of said analytes; and

at least one attachment point disposed on the test site, which retains the microsphere in proximity to the test site.

The references relied upon by the examiner are:

Lough et al. (Lough)	5,900,481	May 4, 1999
Köster et al. (Köster)	6,133,436	Oct. 17, 2000

Claims 1-3, 5-10, 14-20, and 28 stand rejected under 35 U.S.C. § 102(b) as anticipated by Lough and Köster. We affirm.

Discussion

Appellant states that the rejected claims stand or fall together. Appeal Brief, page 3. Accordingly, we decide the issues raised in this appeal based upon independent claim 1. See the then existing provisions of 37 CFR § 1.192(c)(7).

In addition, as the examiner noted, Köster is a continuation-in-part of Lough and contains the same relevant disclosure. Examiner's Answer, page 14. Since we agree with the examiner's conclusion that Lough anticipates claim 1 on appeal, we see no reason to further burden the record with an analysis of Köster.

We commend the examiner for the thorough explanation of the facts and reasons relied upon in support of the rejection of the claims based upon Lough as well as the thorough response to the arguments presented by appellant in the Appeal Brief. We affirm the examiner's rejection of claim 1 based upon Lough essentially for the reasons set forth in the Examiner's Answer and add the following comments for emphasis.

Anticipation is a question of fact that must be supported by substantial evidence of record. In re Hyatt, 211 F.3d 1367, 1371, 54 USPQ2d 1664,1667 (Fed. Cir. 2000).

That substantial evidence of record supports the examiner's decision in rejecting claim 1

as anticipated by Lough is readily seen when the breadth of claim 1 is recognized. Claim 1 in its broadest sense merely calls for a substrate having a test site identifiable by its position on the substrate, a single microsphere in proximity with the test site attached to a ligand that specifically binds with one of the analytes and at least one attachment point disposed on the test site which retains the microsphere in proximity to the test site. When it is understood that the substrate may have a single test site, it is seen that the substrate itself becomes the test site. In this embodiment, claim 1 simply reduces to a substrate having a microsphere attached thereto wherein the microsphere has a ligand attached to it that specifically binds with one of the analytes. Lough clearly describes such an apparatus as seen from viewing Figure 1 of the patent that figuratively illustrates a test apparatus comprising a surface/substrate, a bead attached to the surface and a ligand attached to the bead that will specifically bind with one of the analytes.

The main argument presented by appellant in response to the rejection based upon Lough is that the examiner has misapplied Lough as describing supports to which the beads are attached that form spatially defined arrays. Appeal Brief, page 5. However, this argument is more specific than claim 1 on appeal. Claim 1 does not require a spatially defined array. As set forth above, claim 1 reads upon a substrate having a single microsphere attached thereto having a ligand that specifically binds with one of the analytes. Lough clearly describes such an apparatus.

The examiner's decision is affirmed.

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

AFFIRMED

William F. Smith
Administrative Patent Judge

Joan Ellis
Administrative Patent Judge

Demetra J. Mills
Administrative Patent Judge

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