

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 Herbert F. Cattell and Glenda C. Delenstarr

Appeal No. 2006-0673
Application No. 09/919,555

ON BRIEF

Before JERRY SMITH, BARRY, and GRIMES, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

A patent examiner rejected claims 1, 2, 4-16, and 45-54. The appellants appeal therefrom under 35 U.S.C. § 134(a). We affirm.

I. BACKGROUND

The invention at issue on appeal concerns the manufacture of biopolymer arrays. (Spec., p. 1, ll. 6-7.) Biopolymer arrays of peptides or polynucleotides (e.g., DNA or RNA) are used as diagnostic or screening tools. Such an array includes regions (i.e., "features" or "spots") of usually different sequence biopolymers arranged on a substrate. When exposed to a sample, the array will exhibit a pattern of binding

which is indicative of the presence or concentration of at least one component of the sample (e.g., an antigen) in a peptide array or a particular sequence polynucleotide in a polynucleotide array. The binding pattern can be detected by observing a fluorescence pattern on the array following exposure to a fluid sample in which all potential targets (e.g., DNA) in the sample have been fluorescently labeled. (*Id.* at ll. 12-22.)

To ensure precision and to lower costs, biopolymer arrays are fabricated at a central facility and then shipped to end users. (*Id.*, p. 2, ll. 27-29.) Because of the small size of array features, and depending on the strength to which a target sequence binds to a feature, the detected signal from such a feature may include "noise." A background binding signal may also obscure the signal detected at a feature. Errors in one or more features may also be introduced during the fabrication process. Although computer implemented program routines may be used to process the read data and account for noise using statistical methods or suspected or known array feature errors, the appellants desire a simpler means by which such routines can detect array characteristics that may affect how or whether a program routine is applied and respond accordingly. (*Id.*, p. 3, ll. 1-14.)

Accordingly, the appellants' invention is a method of producing an addressable array of differently sequenced biopolymers on a substrate. More specifically, the biopolymers are deposited onto different regions of the substrate. Data related to the array are saved in a memory. The fabricated array is then shipped to a remote location for use, and the data are also forwarded to the location. (*Id.* at ll. 18-31.)

A further understanding of the invention can be achieved by reading the following representative claim.

1 . A method for generating an addressable array of chemical moieties on a substrate, comprising:

(a) depositing the moieties onto different regions of the substrate so as to fabricate the array;

(b) before the array is exposed to a sample, saving in a memory array related data which comprises instructions for selecting one or more machine readable algorithms for use by a processor on how to read an array or machine readable algorithms for use by a processor on how to process data from an array following reading of the array;

(c) shipping the fabricated array, and forwarding the array related data to a location remote from where the array is fabricated.

Claims 1, 2, 4-16, and 45-54 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,879,915 ("Cattell '915")¹, and claims 1, 2, 4-16, and 47-54 stand rejected as anticipated by U.S. Patent No. 6,180,351 ("Cattell '351"). Claims 1, 2, 4-16, and 47-54 also stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,968,728 ("Perttunen") and U.S. Patent Application Publication No. 2002/0086319A1 ("Ellson"). Claims 45 and 46 further stand rejected under § 103(a) as obvious over Perttunen; Ellson; and U.S. Patent No. 6,215,894 ("Zeleny"). In addition, claims 1, 2, 4-16, and 45-54 stand rejected under the judicially created doctrine of obviousness type double-patenting over claims 1-19 of Cattell '351.

II. OPINION

"Reply briefs are to be used to reply to matter raised in the brief of the appellee." *Kaufman Company, Inc. v. Lantech, Inc.*, 807 F.2d 970, 973 n.*, 1 USPQ2d 1202, 1204 n.* (Fed. Cir. 1986). The term "reply brief" is exactly that, a brief in reply to new rejections or new arguments set forth in an examiner's answer.

¹The examiner had *provisionally* rejected claims 1, 2, 4-16, and 45-54 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application No. 09/775,387 to Cattell. (Examiner's Answer at 4.) Because the Application has matured into U.S. Patent No. 6,879,915, however, we treat the rejection as being *non-provisional* under the Patent (i.e., Cattell '915).

Accordingly, we advise the appellants that copying the Real Party in Interest, Related Appeals and Interferences, Status of the Claims, Status of Amendments, Summary of the Claimed Subject Matter, and Appendix of Appealed Claims sections of their original appeal brief into their reply brief is neither required by, nor helpful to, the Board. The reply brief's reiteration of the identical arguments made in the appeal brief is also neither required by, nor helpful to, the Board. That said, our opinion addresses the rejections in the following order:

- anticipation by Cattell '915
- anticipation by Cattell '351
- obviousness over Perttunen and Ellson
- obviousness over Perttunen, Ellson, and Zeleny
- obviousness type double-patenting over claims 1-19 of Cattell '351.

A. ANTICIPATION BY CATTELL '915

"When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately." 37 C.F.R.

§ 41.37(c)(1)(vii) (Sep. 30, 2004).

Here, the appellants argue claims 1, 2, 4-16, and 45-54, which are subject to the same grounds of rejection, as a group. (Reply Br. at 8-14 and 23.) We select claim 1 as the sole claim on which to decide the appeal of the group.

With this representation in mind, rather than reiterate the positions of the examiner or the appellants *in toto*, we focus on the point of contention therebetween. The examiner asserts, "The instant claims are drawn to methods of array manufacture, not array use." (Examiner's Answer at 21.) "[W]ithin the context of the instant claims . . . the stored data does not provide functionality within the instantly claimed method." (*Id.*) He then makes the following findings.

[Cattell '915] teaches the claimed method of array manufacture including saving in a memory array related data i.e. saving biological data, step 434, Fig. 6[,] which includes information used by the user in reading the array as defined in ¶¶39-40 wherein during array fabrication information required for reading and processing the array (e.g. missing features, misplaced feature, features of incorrect dimension, other physical characteristics) is stored such that the person reading data from the array will interpret the data correctly (¶¶ 5, 11, 15, 41, 45).

(*Id.* at 20.) The appellants argue "that the[ir] [claimed] array related data are not simply a compilation of facts, but are **instructions** (i.e., executable by a processor) for selecting one or more machine readable algorithms for use by a processor on how to read the array or process data from the read array," (Reply Br. at 14); "the instructions

define the 'saving step' of the claimed method. Accordingly, the instructions themselves do carry patentable weight." (*Id.*) They further argue that Cattell '915 "discloses the use of 'biological function information,' such as array layout information, rather than **instructions for selecting one or more** machine readable **algorithms** for use by a processor on how to read an array or how to process data from a read array." (*Id.* at 16.)

"In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the representative claim at issue to determine its scope. Second, we determine whether the construed claim is anticipated." *Ex parte Pittaro*, No. 2005-2057, 2006 WL 1665401, at *2 (Bd.Pat.App & Int. 2006)

1. Claim Construction

"Analysis begins with a key legal question — *what is the invention claimed?*" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "the PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324, 72 USPQ2d 1209, 1211 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000)).

Here, claim 1 recites in pertinent part the following limitations: "saving in a memory array related data **which comprises instructions for selecting one or more machine readable algorithms for use by a processor on how to read an array or machine readable algorithms for use by a processor on how to process data from an array following reading of the array;** . . . and forwarding the array related data to a location remote from where the array is fabricated." (Emphasis added.) Of these limitations, the phrase "which comprises instructions for selecting one or more machine readable algorithms for use by a processor on how to read an array or machine readable algorithms for use by a processor on how to process data from an array following reading of the array" is not entitled to patentable weight for two reasons.

First, we view the "data which comprises instructions for selecting one or more machine readable algorithms for use by a processor on how to read an array or machine readable algorithms for use by a processor on how to process data from an array following reading of the array" as analogous to unpatentable printed-matter. "Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability." *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004) (quoting *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983)). "Although the printed

matter must be considered, in that situation it may not be entitled to patentable weight."

Gulack, 703 F.2d at 1385, 217 USPQ at 404.

Here, because the data that "comprises instructions for selecting one or more machine readable algorithms for use by a processor on how to read an array or machine readable algorithms for use by a processor on how to process data from an array following reading of the array" do not functionally change the (claimed) memory in which the data are saved, the data lack a functional relation thereto. Therefore, the phrase is not entitled to patentable weight.

Second, "[a]n intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates." *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345, 65 USPQ2d 1961, 1965 (Fed.Cir. 2003). Although "[s]uch statements often . . . appear in the claim's preamble," *In re Stencel*, 828 F.2d 751, 754, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987), a statement of intended use or purpose can appear elsewhere in a claim. *Id.*, 4 USPQ2d at 1073.

Here, because the representative claim recites "[a] method for generating an addressable array," we agree with the examiner's aforementioned observation that the

claim recites a method of making an array rather than a method of using the array. Because claim 1 does not specify that the claimed processor actually uses the data to perform any function, the claimed phrase "which comprises instructions for selecting one or more machine readable algorithms **for use** by a processor on how to read an array or machine readable algorithms **for use** by a processor on how to process data from an array following reading of the array" (emphasis added) merely states an intended use of the data by the processor. Therefore, the phrase is not entitled to patentable weight.

As aforementioned, the appellants argue, "that the[ir] [claimed] array related data . . . are **instructions** (i.e., executable by a processor). . . ." (Reply Br. at 14.) The appellants' specification, however, provides no support for their argument that the claimed "data" comprise processor-executable instructions, i.e., microcode.² To the contrary, the specification characterizes the data as merely representing information rather than executable instructions. To wit, the specification explains that "[o]nce processor 162 has retrieved the array related data it can use such data to either control reading of the array or to process information obtained from reading the array." (Spec., p. 18, ll. 1-2.) More specifically, the "retrieved array related data [may]

²Microcode is defined as "the microinstructions esp. of a microprocessor." *Webster's Ninth New Collegiate Dictionary* 750 (1990).

indicate[] that there are no negative control probes on the array," (*id.* at l. 23), or may "indicate[] that one or more deletion control probe carrying features may have errors which may make their use unreliable." (*Id.* at ll. 26-27.) Giving the representative claim its broadest, reasonable construction, the limitations require saving some sort of data in a memory and forwarding the data to a location remote from where an array is fabricated. We will use this interpretation in deciding all the rejections at issue.

2. Anticipation Determination

"Having construed the claim limitations at issue, we now compare the claims to the prior art to determine if the prior art anticipates those claims." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002). "[A]nticipation is a question of fact." *Hyatt*, 211 F.3d at 1371, 54 USPQ2d at 1667 (citing *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 814-15 (1869); *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997)). "A reference anticipates a claim if it discloses the claimed invention 'such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention.'" *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995) (quoting *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962)).

Here, like the appellants' invention,³ Cattell '915 "relates to arrays, particularly biopolymer arrays (such [as] polynucleotide arrays, and particularly DNA arrays). . . ." (Col. 1, ll. 6-7.) "FIG. 4 [of the reference] is a schematic diagram of . . . a central fabrication station," (col. 5, ll. 64-65), for manufacturing the aforementioned arrays on a substrate. During such manufacturing, "[f]or each fabricated array 12, processor 140 will generate a corresponding unique identifier and will save (430) this in memory 141 in association with the following (together forming a first set of feature characteristic data 440): target array layout information (including the location and identity of biopolymers at each feature); quality control data (obtained in step 420); and biological function data (434)." (Col. 12, ll. 44-50.) We find that Cattell '915's saving of the unique identifier or feature characteristic data in the memory 141 anticipates the claimed saving of some sort of data in a memory.

The reference further explains that "[t]he substrate 10 is then sent to a cutter 152 wherein portions of substrate 10 carrying an individual array 12 and its associated local identifier 356 are separated from the remainder of substrate 10, to provide multiple array units 15. The array unit 15 is placed in package 340 along with storage

³Herbert F. Cattell, the patentee of Catell '915, is one of the co-appellants in the instant case.

medium 324b (if used) carrying the first set of feature characteristic data and identifier for that same array unit 15 (and possibly for other array units 15 which are to be sent to the same remote customer location), and the package then shipped (480) to a remote user station." (*Id.* at ll. 57-65.)

"The first set of feature characteristic data 440 for each such array is forwarded (460) to the same remote users, either by shipping to each user in association with the corresponding array identifier on portable storage medium 324b, or by communicating the first set over channel 180 in response to a received communication from the remote station of the corresponding array identifier. An identification of the features in the array to which any data pertains, is included as a part of the feature characteristic data." (Col. 12, l. 67 - col. 13, l. 9.) We find that Cattell '915's forwarding of the feature characteristic data or the corresponding array identifier to remote users anticipates the claimed forwarding of data to a location remote

from where an array is fabricated.⁴ Therefore, we affirm the rejection of claim 1 and of claims 2, 4-16, and 45-54, which fall therewith, as anticipated by the reference.

B. ANTICIPATION BY CATTELL '351

The appellants argue claims 1, 2, 4-16, and 47-54, which are subject to the same grounds of rejection, as a group. (Reply Br. at 14, 15, and 23.) We again select claim 1 as the sole claim on which to decide the appeal of the group.

The examiner finds, "Cattell discloses . . . saving in a memory array related data said data comprising instructions for reading the array or instruction [for] processing the array (Column 5, lines 41-48) . . . and forwarding the array related data to a remote location (Column 3, line 55-Column 4, line 9 and 33-43 and Claims 10- 11). . . ." (Examiner's Answer at 8.) The appellants argue, "the '351 identifier provides layout information that is used by the processor in reading the array, but **not positive**

⁴ Cattell '915 further explains that "[a]t the user station of FIG. 5, the resulting package 340 is then received from the remote fabrication station. A sample, for example a test sample, is exposed to the array 12 on the array unit 15 received in package 340. Following hybridization and washing in a known manner, the array unit 15 is then inserted into holder 161 in scanner 160 for reading of the array. . . ." (Col. 13, ll. 50-56.) More specifically, "[p]rocessor 162 may cause the array to be read, or the data obtained from reading to be processed (which term includes interpretation of data), (510) using the retrieved first and updated feature characteristic sets." (Col. 14, ll. 26-30.)

instructions for the processor on how to read the array or process data from the array." (Reply Br. at 17.)

Like the appellants' invention,⁵ Cattell '351 "relates to arrays, particularly biopolymer arrays (such [as] polynucleotide arrays, and particularly DNA arrays). . . ." (Col. 1, ll. 6-7.) "FIG. 4 [of the reference] represent[s] an apparatus for producing an addressable array, which is sometimes references herein as a 'fabrication station'. FIG. 4 also illustrates an apparatus for receiving an addressable array, in particular a single 'user station', which is remote from the fabrication station. " (Col. 10, ll. 5-9.)

In the fabrication station, a "local identifier is stored in memory 141 in association with the corresponding unique identifier and array layout." (Col. 11, ll. 18-20.) We find that Cattell '351's saving of the local identifier or the unique identifier in the memory 141 anticipates the claimed saving of some sort of data in a memory.

The reference explains that "[p]rocessor 140 then controls the fabricator . . . to generate the one or more arrays on substrate 10 which correspond to the received

⁵Herbert F. Cattell, the patentee of Catell '351, is one of the co-appellants in the instant case.

array layout information and unique identifier." (*Id.* at ll. 21-24.) "The substrate 10 is then sent to a cutter 152 where each individual array 12 and its associated local identifier 356 are separated from the remainder of the substrate 10, as indicated by reference number 10b, to provide multiple array units 15." (*Id.* at ll. 28-33.) A "second copy of the local identifier 356 and corresponding unique identifier 358, are physically associated with the corresponding array," (*id.* at ll. 44-60); "[t]he array unit 15 is placed in package 340," (*id.* at ll. 38-39); and "[t]he resulting package is then shipped to a remote user station. . . ." (*Id.* at ll. 47-48.) We find that Cattell '351's shipping of the local identifier and the unique identifier to the remote user station anticipates the claimed forwarding of data to a location remote from where an array is fabricated.⁶ Therefore, we affirm the rejection of claim 1 and of claims 2, 4-16, and 47-54, which fall therewith, as anticipated by the reference.

⁶ Cattell '351 further explains that "[a]t the user station, the resulting package is then received from the remote fabrication station. . . . A sample, for example a test sample, is exposed to the array 12 on the array unit 15 received in package 340. The array is then inserted into scanner 160 and interrogated" (Col. 11, l. 62 to Col. 12, l. 4 .)

C. OBVIOUSNESS OVER PERTTUNEN AND ELLSON

The appellants argue claims 1, 2, 4-16, and 47-54, which are subject to the same grounds of rejection, as a group. (Reply Br. at 15-19 and 23-24.) We again select claim 1 as the sole claim on which to decide the appeal of the group.

The examiner finds, "Perttunen et al teach . . . saving in a memory array related data said data comprising instructions for reading the array or instruction [for] processing the array (Column 3, lines 54-67) wherein the array and array related data is utilized by an end user (Column 8, lines 38-41 and Column 9, lines 63-Column 10, line [] 2) which clearly suggests that the array is sent from the place of origin. . . ." (Examiner's Answer at 11-12.) He further finds that Ellson teaches "saving in a memory array related data and shipping the array and forwarding the array related data to a remote location i.e. to [a] shipping address contained in the machine readable information (¶ 8)." (*Id.* at 12.) The appellants make the following arguments.

[T]he information saved in memory of Perttunen is simply **array mapping information**, i.e., the identification of each moiety and its specific location on the array. In contrast, the information saved in memory of the claimed invention of present application consists of **instructions for selecting one or more** machine readable **algorithms** for use by the processor on **how to read** an array or **how to process** data from a read array. . . .

...

[T]he disclosure of Ellson is limited to an array of molecular moieties on a substrate, where the substrate also contains machine-readable information, which includes shipping and billing information, the identity of the molecular moieties, information relating to the means by which the

moieties were attached to the substrate, and suggested storage conditions relating to the molecular moieties (see specification, ¶ 0052).

(Reply Br. at 20.)

"In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the representative claim at issue to determine its scope. Second, we determine whether the construed claim would have been obvious." *Ex Parte Massingill*, No. 2003-0506, 2004 WL 1646421, at *2 (Bd.Pat.App & Int. 2004). Having determined what subject matter is being claimed, *supra*, "the next inquiry is whether the subject matter would have been obvious." *Id.*, at *3.

The question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently. . . ." *In re Zurko*, 258 F.3d 1379, 1383, 59 USPQ2d 1693, 1696 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d

781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, Perttunen discloses "a system for forming at least one molecular detection device." (Col. 3, ll. 46-47.) The "molecular detection device including a support member (36) and a plurality of molecular receptors (34) arranged at a plurality of sites of the support member (36)." (Abs., ll. 1-3.) A "data writing device 37 writes data associated with the mapping [of the receptors] directly to the support member 36 or to another member associated with the support member 36. The data can include data which indicates or encodes the mapping, and/or data which identifies the mapping." (Col. 4, ll. 62-67.) Examples of the writing include "writ[ing] magnetic data to a magnetic storage medium; . . . writ[ing] electronic data to an electronic storage device such as a memory; . . . writ[ing] printed data to a substrate; and . . . writ[ing] optical data to an optical storage medium." (Col. 5, ll. 7.) We find that writing of the data associated with the mapping to the magnetic storage medium, the substrate, the memory, or the optical storage medium teaches the claimed saving of some sort of data in a memory.

The reference further explains that "[t]he molecular detection device includes a substrate 120 which supports a molecular detection array 122." (Col. 8, ll. 20-21.) "The substrate 120 includes a perforation 124 which demarcates a first portion 126 from a

second portion 130. Data 132 indicative of the mapping is supported by the second portion 130." (*Id.* at ll. 34-37.) "In use, the second portion 130 is separated from the first portion 126 along the perforation 124 prior to applying a sample to the molecular detection array 122. An end user retains the second portion 130 for safekeeping," (*id.* at ll. 38-42), and "[t]he sample is applied to the molecular detection array 122." (*id.* at ll. 43-44.) We find that the user's retention of the portion of the substrate containing data indicative of the mapping implies that the substrate containing the data was forwarded to a location remote from where the array was fabricated.

For its part, Ellson "relates to the formation and use of biomolecular arrays on a substrate in conjunction with machine-readable information contained within the same substrate." (§ 0002.) "The information may be contained in a substrate having one or more types of information storage media, e.g., magnetic, optical, electronic, and/or mechanical." (§ 0052.) We find that reference's saving of the machine-readable information in the storage media teaches the claimed saving of some sort of data in a memory.

"The information may include, for example, the identity of a customer, secured information, **shipping** and/or **billing information**, the identity of at least one of the

molecular moieties, information regarding the nature of attachment of the molecular moieties to the substrate surface, information relating to experimental conditions that describe potential uses of the molecular moieties, and/or information relating to the results of such experiments. The information may be electronically, magnetically, optically, and/or mechanically readable." (§ 0008 (emphases added).) Ellson explains that its "technology allows an array manufacturer to produce customized arrays to order for customers who provide the desired specifications." (§ 0004.) We find that Ellson's inclusion of shipping information in the storage media teaches the claimed forwarding of data to a location remote from where an array is fabricated to the premises of customers. Therefore, we affirm the rejection of claim 1 and of claims 2, 4-16, and 47-54, which fall therewith, as obvious over Perttunen and Ellson.

D. OBVIOUSNESS OVER PERTTUNEN, ELLSON, AND ZELENY

The examiner finds, "Zelany et al . . . teach that . . . control probes are useful for calibrating and adjusting [a] scanner thereby facilitating scanning (Column 3, lines 19-25.) (Examiner's Answer at 17.) The appellants do not contest this finding but merely reference the "reasons described above." (Reply Br. at 24.) Having been unpersuaded by these reasons, we affirm the rejection of claims 45 and 46 as obvious over Perttunen, Ellson, and Zeleny.

E. OBVIOUSNESS TYPE DOUBLE-PATENTING OVER CLAIMS 1-19 OF CATTELL '351

Comparison of the appellants' claims 1, 2, 4-16, and 45-54 and claims 1-19 of Cattell '351 has not persuaded us that the are two sets of claims are not patentably distinct. Therefore, we reverse the rejection of the former claims under the judicially created doctrine of obviousness type double-patenting over claims 1-19 of Cattell '351.

III. CONCLUSION

In summary, the rejections under § 102(e) and under § 103(a) are affirmed. The rejections of claims 1, 2, 4-16, and 45-54 are also affirmed. The rejection under the judicially created doctrine of obviousness type double-patenting, however, is reversed.

"Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown." 37 C.F.R. § 41.37(c)(1)(vii). Accordingly, our affirmance is based only on the arguments made in the briefs. Any arguments or authorities omitted therefrom are neither before us nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1367, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.") No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

JERRY SMITH
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

ERIC GRIMES
Administrative Patent Judge

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AGILENT TECHNOLOGIES, INC.
INTELLECTUAL PROPERTY ADMINISTRATION
LEGAL DEPARTMENT, DL429
P. O. BOX 7599
LOVELAND, CO 80537-0599