

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 JOSE TAMEZ-PENA,
SAARA MARJATTA SOFIA TOTTERMAN,
EDWARD ASHTON, AND KEVIN J. PARKER

Appeal 2006-2559
Application 10/189,476
Technology Center 1600

Decided: June 18, 2007

Before KENNETH W. HAIRSTON, LANCE LEONARD BARRY,
and HOWARD B. BLANKENSHIP, *Administrative Patent Judges*.
HAIRSTON, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants have requested a rehearing of our decision dated November 1, 2006, wherein we affirmed the 35 U.S.C. § 102(b) rejection of claims 1, 8 to 14, 16, 17 and 23 to 29.

Appellants now argue (Request 2) that “in the species under examination” within method claim 1 and system claim 17, “the at least one biomarker comprises neovasculature characterization,” the step (b) in claim 1 and the processor (b) in claim 17 take “a higher-order measure of the at least one biomarker, and the higher-order measure comprises eigenfunction decompositions.” Appellants contend that the method step (b) in claim 1, and the operation of the processor (b) in claim 17 “must be read in light of the election of species” made by Appellants (Request 1 and 2). According to Appellants, “the Decision on Appeal does not address or even mention the above-noted limitations of the species under examination,” and the anticipation rejection of claims 1 and 17, and the claims that depend therefrom, should be reversed because “the Appellants did present patentability arguments for those claims, when read in light of the species under examination” (Request 2).

Our reviewing court has stated that “limitations from the specification must not be imported into the claims.” *Nazomi Communications, Inc. v. ARM Holdings, PLC*, 403 F.3d 1364, 1368, 74 USPQ2d 1458, 1461 (Fed. Cir. 2005). Reading a claim in light of the specification to interpret broadly worded limitations explicitly recited in the claims is a quite different thing from reading limitations of the specification into a claim to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claims. *In re Prater*, 415 F.2d 1393, 1405, 162 USPQ 541, 551 (CCPA 1969).

Appellants’ arguments in the request are not commensurate in scope with the inventions set forth in claims 1 and 17 on appeal. Neither claim 1

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nor claim 17 recites the use of “neovasculature characterization” or the use of “eigenfunction decompositions” as a “higher-order measure of the at least one biomarker,” and we hereby decline Appellants’ invitation to read such limitations into claims 1 and 17. Thus, we do not find any reversible error in our decision to affirm the anticipation rejection of claims 1, 8 to 14, 16, 17 and 23 to 29.

Appellants’ request for rehearing has been granted to the extent that our decision has been reconsidered, but such request is denied with respect to making any modifications to the decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REHEARING
DENIED

KIS

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