

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HSIAOHO E. TUNG,
YUZHANG WU,
JIELIN DAI, and YING YANG

Appeal 2008-1693
Application 10/989,935
Technology Center 1700

Decided: March 14, 2008

Before EDWARD C. KIMLIN, JEFFREY T. SMITH, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-28.

Claim 1 is illustrative:

1. A liquid sample collection and analysis device, comprising:
a cup having an interior for containing a liquid sample;

a lid that forms an airtight seal when secured to the cup;

a chamber for holding liquid sample and containing a test component containing reagents for detecting an analyte of interest in the sample, the test component having a sample application zone and a detection zone;

a tube providing a passage between the interior of the cup and the chamber, for transport of a portion of the liquid sample from the interior of the cup into the chamber due to air pressure exerted on the surface of the liquid sample by application of the lid to the cup.

The Examiner relies upon the following reference in the rejection of the appealed claims:

Lappe 6,342,183 B1 Jan. 29, 2002

Appellants' claimed invention is directed to a liquid sample collection and analysis device comprising a cup that contains the liquid sample, a chamber that holds a test component that reacts with the liquid sample, a tube that provides passage between the interior of the cup and the chamber, and a lid that forms an airtight seal when secured to the cup. The liquid sample is transported through the tube into the chamber due to an air pressure on the surface of the liquid sample when the lid is applied to the cup.

Claims 1-28 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lappe.

We have thoroughly reviewed the respective positions advanced by the Appellants and the Examiner. In so doing, we find that the Examiner has not established a *prima facie* case of anticipation under 35 U.S.C. § 102. Accordingly, we will not sustain the Examiner's rejection.

At the outset, we must first interpret the claim language "a tube providing a passage between the interior of the cup and the chamber, for

transport of a portion of the lid sample from the interior of the cup into the chamber due to air pressure exerted on the surface of the liquid sample by application of the lid to the cup" (claim 1). We interpret the language as a recitation of a function performed by the claimed structure of the device.

Reading the claim language in light of the Specification, we find that devices within the scope of the appealed claims must be capable of performing the function of transporting the liquid sample from the cup to the chamber upon application of the lid to the cup.

There is no dispute that Lappe, while describing a device that provides for delivery of a liquid sample to a testing chamber, does not describe that the transport of the liquid sample is effected upon application of the lid to the cup. Rather, the cap of Lappe includes a plunger that is necessary for providing the required pressure to move the liquid sample from the bottom of the cup to a testing chamber located above the liquid sample. Hence, there is no factual basis for drawing a conclusion that the device of Lappe is capable of performing the function of transporting the liquid sample to the chamber by application of the lid to the cup.

The Examiner states that "when the lid [of Lappe] is applied to the container, an internal air pressure is imposed on the liquid sample [and] [t]he exerted pressure occurs in any lid-container application with a liquid therein" (Ans. 5, first para., last sentence). However, more is required to meet the requirements of the appealed claims. It is not enough that internal air pressure is imposed on the liquid sample when the lid is applied to the container, but the air pressure imposed must be sufficient to transport the liquid sample to the chamber. Lappe provides no disclosure that such air pressure is applied. Ergo, a plunger is employed.

The Examiner also states that he "is interpreting the application of the lid with the pump therein and depression of the pump as the step of application of the lid because this is what Lappe requires for sample transport to the lid" (Ans. 6). However, this is an erroneous reading of Lappe since Lappe provides no disclosure that applying the lid and depressing the plunger is one and the same act. Rather, it appears that the lid of Lappe is applied and then the plunger is depressed in a subsequent step.

The Examiner maintains that appealed "[c]laims 1 and 16 do not recite any structural differences from the device disclosed in the patent of Lappe" (Ans. 7, first para., last sentence). However, the claims recite a function performed by the claimed device which Lappe fails to teach is performed by the patented device. Also, the structures claimed and disclosed by Lappe are not the same since the claims do not define Lappe's plunger. The devices of Appellants and Lappe are structured to function differently.

While language in the preamble does not always serve as a structural feature that distinguishes over the prior art, the language at issue here is not in the preamble but sets forth a function that is not disclosed by Lappe. Although Lappe may disclose a liquid sample collection device comprising a cup, lid, chamber and tube, there is no disclosure of the elements in a particular arrangement that provides for the claimed function of transporting the liquid sample to the chamber upon application of the lid.

In conclusion, based on the foregoing, the Examiner's decision rejecting the appealed claims is reversed.

REVERSED

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