

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

*Ex parte* MARY A. REPPY and CHARLES F. SALLER

---

Appeal 2008-2532  
Application 10/420,807  
Technology Center 1600

---

Decided: June 30, 2008

---

Before ERIC GRIMES, LORA M. GREEN, and JEFFREY N. FREDMAN,  
*Administrative Patent Judges.*

GREEN, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-28. We have jurisdiction under 35 U.S.C. § 6(b). Claims 1 and 15 are the independent claims on appeal, and read as follows:

1. A method for evaluating at least one of the partition coefficient or oral absorption or cellular permeability of a compound, which comprises
  - exposing a three-dimensional array of a polydiacetylene backbone or a two-dimensional array of a polydiacetylene backbone, or both, to the compound to be evaluated;
  - measuring the effect on the array of the compound to be evaluated by detecting the change in fluorescence or phosphorescence,
  - comparing the change to a change in fluorescence or phosphorescence from exposure of the array of the kind being used to a reference compound in solution.
15. A method for evaluating the binding of a compound to a protein, which comprises
  - exposing a three-dimensional array of a polydiacetylene backbone or a two-dimensional array of a polydiacetylene backbone, or both, to a solution of the compound to be evaluated post or during exposure to the protein;
  - measuring the effect on the array of the compound to be evaluated by detecting the change in fluorescence or phosphorescence,
  - comparing the change to changes in fluorescence or phosphorescence from exposure of the array of the kind being used to a reference compound in solution.

The Examiner relies on the following references:

Ribi	US 5,268,305	Dec. 7, 1993
Arnold	US 5,310,648	May 10, 1994
Charych	US 6,080,423	Jun. 27, 2000

We affirm.

## DISCUSSION

Claims 1-10, 13-24, 27, and 28 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ribi. As Appellants do not argue the claims separately, we focus our analysis on claim 1, and claims 2-10, 13-24, 27, and 28 stand or fall with that claim. 37 C.F.R. § 41.37(c)(1)(vii).

The Examiner finds that Ribi teaches the steps in the body of independent claim 1, *i.e.*, the steps of: exposing a three-dimensional array of a polydiacetylene backbone or a two-dimensional array of a polydiacetylene backbone, or both, to the compound to be evaluated; measuring the effect on the array of the compound to be evaluated by detecting the change in fluorescence or phosphorescence; and comparing the change to a change in fluorescence or phosphorescence from exposure of the array of the kind being used to a reference compound in solution (Ans. 3).

Appellants do not argue that finding by the Examiner. Rather, Appellants argue that Ribi does not teach a “method for evaluating at least one of the partition coefficient or oral absorption or cellular permeability of a compound,” as required by the preamble of claim 1 (App. Br. 6-7). Therefore, the issue on Appeal is: Should the preamble of claim 1 be considered as a limitation of claim 1?

During prosecution before the Office, claims are to be given their broadest reasonable interpretation consistent with the Specification as it would be interpreted by one of ordinary skill in the art. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). “An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.” *In re Zletz*, 893 F.2d 319, 322 (Fed. Cir. 1989). Moreover, it is during prosecution that applicants have “the opportunity to amend the claims to obtain more precise claim coverage.” *American Academy*, 367 F.3d at 1364.

As to the preamble, “[i]f the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim. . . . If, however, the body of the claim fully and intrinsically sets forth the complete invention, including all of the limitations, and the preamble offers no distinct definition of the claimed invention’s limitations, but rather merely states, for example, the purpose of the intended use of the invention, then the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999).<sup>1</sup>

We conclude that the preamble does not add any further limitations to those recited in the body of the claim. In this instance, the body of claim 1 sets forth a complete method, as the preamble does not provide a limitation to any of the method steps recited in the body of the claim. *See IMS Technology, Inc. v. Haas Automation, Inc.*, 206 F.3d 1422, 1434 (Fed. Cir. 2000) (“If the preamble adds no limitations to those in the body of the claim, the preamble is not itself a claim limitation and is irrelevant to proper construction of the claim.”); *see also Seachange International, Inc. v. C-Cor*

---

<sup>1</sup> Appellants argue that in *Pitney Bowes*, the Federal Circuit in fact relied on the preamble to interpret the claim, as the preamble recitation of spots was needed to “interpret the remainder of the claim when referring to the term ‘spots,’” and thus in fact supports Appellants’ position. (Reply Br. 2.) *Pitney Bowes* is relied upon, however, as a statement when the Federal Circuit, our reviewing court, considers the preamble a limitation. Moreover, as discussed in the analysis of claim 1, there is nothing in the preamble that is required in the interpretation or performance of the steps in the body of the claim.

*Inc.*, 413 F.3d 1361, 1376 (Fed. Cir. 2005) (preamble a limitation where it provides antecedent basis for terms in the claim body). Thus, the preamble merely states the intended use of the claimed method, that is, a method for evaluating at least one of the partition coefficient or oral absorption or cellular permeability of a compound. While the preamble does recite the term “compound,” there is nothing in the preamble that further limits the compound to be tested. As to “partition coefficient,” “oral absorption,” and “cellular permeability,” they do not limit how the method steps in the body of the claim are to be performed. Therefore, we interpret the language “[a] method for evaluating at least one of the partition coefficient or oral absorption or cellular permeability of a compound,” as a statement of intended use, and not a patentable limitation.

Appellants rely on *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329 (Fed. Cir. 2003), to support their position that the preamble should be read as a limitation of the claim (App. Br. 7). According to Appellants, in *Jansen*, “the claim was directed to a method of treating or preventing pernicious anemia in humans by administering a certain vitamin preparation to ‘a human in need thereof.’ The court held that the preamble is not merely a statement of effect that may or may not be desired or appreciated, but rather is a statement of the intentional purpose for which the method must be performed.” (*Id.*)

Appellants’ argument is not convincing. As noted by Appellants (App. Br. 7), the claim at issue in *Jansen* was directed to a method of treating anemia in humans by administering a vitamin preparation “*to a human in need thereof.*” *Jansen*, 342 F.3d at 1330. The court found that “the claim preamble sets forth the objective of the method, and the body of

the claim directs that the method be performed on someone ‘in need.’” *Id.* at 1333. In this case, as noted above, nothing in the preamble of the claim directs or provides a limitation how any of the steps in the body of the claim are to be performed.

Similarly, in *Rockwell International Corp. v. United States*, 147 F.3d 1358 (Fed. Cir. 1998), also relied upon by Appellants to support their position, the court found that the preamble gave meaning to the claim, because, “[i]f the preamble language were not used, there would be no limitations regarding the . . . substrate used in the process.” *Id.* at 1362. Thus, again, in that case, the preamble provided a limitation to the process.

Therefore, we agree with the Examiner, and find that Ribi anticipates the method of claim 1, and the rejection is affirmed. As claims 2-10, 13-24, 27, and 28 stand or fall with that claim, the rejection is affirmed as to those claims as well.

Claims 11 and 25 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Ribi and Arnold; and claims 12 and 26 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Ribi and Charych.

Appellants merely argue that Arnold and Charych do not remedy the deficiencies of Ribi (App. Br. 7-8). Thus, these rejections are affirmed for the reasons set forth to the anticipation rejection over Ribi.

## CONCLUSION

In summary, we affirm the rejection of claims 1-10, 13-24, 27, and 28 under 35 U.S.C. § 102(b) as being anticipated by Ribi; the rejection of

Appeal 2008-2532  
Application 10/420,807

claims 11 and 25 under 35 U.S.C. § 103(a) as being obvious over the combination of Ribi and Arnold; and the rejection of claims 12 and 26 under 35 U.S.C. § 103(a) as being obvious over the combination of Ribi and Charych.

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

AFFIRMED

Ssc:

CONNOLLY BOVE LODGE & HUTZ, LLP  
1875 EYE STREET, N.W.  
SUITE 1100  
WASHINGTON, DC 20036