

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT-A. OLLAR

Appeal No. 94-3182
Application 07/899,707¹

ON BRIEF

Before WINTERS, WILLIAM F. SMITH, and GRON, Administrative
Patent Judges.

GRON, Administrative Patent Judge.

DECISION ON APPEAL UNDER 35 U.S.C. § 134

¹ Application for patent filed June 17, 1992. According to applicant, this application is a divisional of Application 07/426,573, filed October 24, 1989, now U.S. Patent 5,153,119.

This is an appeal from an examiner's rejection of Claims 29, 30 and 31. Claims 1-35 are pending in this case. In response to a restriction requirement under 37 CFR § 1.142(a), applicant elected to prosecute the invention of Claims 29-31. Nonelected Claims 1-28 and 32-35 have been withdrawn from consideration by the examiner in accordance with 37 CFR § 1.142(b).

Claims 29-31 stand rejected under 35 U.S.C. § 102(b) as anticipated by Ollar, Robert-A. (Ollar), "A Paraffin Baiting Technique that Enables a Direct Microscopic View of 'in situ' Morphology of Nocardia Asteroids with the Acid-Fast or Fluorescence Staining Procedures," Zbl. Bakt. Hyg., I. Abt. Orig. A 234, pp. 81-90 (1976). The examiner entered the rejection under 35 U.S.C. § 102(b) as a new ground in the Examiner's Answer (Paper No. 8, mailed February 16, 1994), simultaneously withdrew all the appealed final rejections of Claims 29-31 under 35 U.S.C. § 103 in view of the combined teachings of Ollar and other prior art, and repeated the new ground of rejection in the Supplemental Examiner's Answer (Paper No. 12). Claims 29-31 read as follows:

29. An apparatus for determining the sensitivity of MAI to different antibiotics and dosages thereof comprising:

Appeal No. 94-3182
Application 07/899,707

a plurality of test tubes each adapted to contain a sterile aqueous broth, an amount of antibiotic to be tested and MAI to be assayed; and

means for determining the concentration of said antibiotic necessary to resist said MAI growth, said means comprising a plurality of paraffin coated slides, each of which is adapted to being placed in one of said test tubes, whereby observation of the growth of said MAI on each of said slides can be used to determine the concentration of said antibiotic necessary to resist growth of said MAI.

30. The apparatus of Claim 29, wherein one of said test tubes is adapted to be a control test tube containing no antibiotic.

31. The apparatus of Claim 30, wherein the other said test tubes are adapted to contain different concentrations of said antibiotic.

The examiner newly rejected appellant's claims under 35 U.S.C. § 102(b) over Ollar alone because the examiner found (Supplemental Examiner's Answer, page 2, first full paragraph):

Ollar teaches the apparatus of the instant invention viz. a plurality of glass test tubes and a plurality of paraffin-coated slides adapted to be inserted into the glass test tubes.

The examiner notes that (Supplemental Examiner's Answer, page 2, second paragraph, to page 3, first paragraph):

. . . it has been held by the courts that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform and does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138 . .

Appeal No. 94-3182
Application 07/899,707

. . . a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations (*Ex parte Masham*, 2 USPQ2d 1647 [1987]). It has further been held that the functional "whereby" statement does not define any structure and accordingly can not serve to distinguish (*In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957)).

On the other hand, we are aware of support for a holding that "adapted to" and "whereby" clauses in claims further limit the claimed subject matter and should not be disregarded. For example, see *In re Venezia*, 530 F.2d 956, 958-59, 189 USPQ 149, 151-52 (CCPA 1976). *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 USPQ2d 1871, 1876 (Fed Cir. 1990) recognizes (emphasis added) that:

. . . by deleting the preamble and all limitations that include "adapted to", "whereby", and "thereby" . . . the claims are reduced to mere collections of parts.

Before determining whether appellant's claims are unpatentable under 35 U.S.C. § 102(b), examiners must first ascertain exactly what subject matter is being claimed. See *In re Wilder*, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970) ("Once having ascertained exactly what subject matter is being claimed, the next inquiry must be into whether such

Appeal No. 94-3182
Application 07/899,707

subject matter is novel.") See also In re Moore, 439 F.2d

1232, 1235, 169 USPQ 236, 238 (CCPA 1971):

[T]he claims must be analyzed first in order to determine exactly what subject matter they encompass. . . .

This first inquiry therefore is merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. It is here where the definiteness of the language employed must be analyzed--not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art.

The examiner appears here to have interpreted the claim language in a vacuum. It is certainly true that terms which merely set forth the intended use for, or a property inherent in, subject matter that is in fact old, do not differentiate the claimed subject matter from the subject matter the prior art describes. In re Pearson, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974). However, Pearson cautions at 1403, 181 USPQ at 644:

We do not mean to imply that terms which recite the intended use or a property . . . can never be used to distinguish a new from an old composition. However, assuming their compliance with the definiteness requirement of the second paragraph of 35 U.S.C. 112, such terms must define, indirectly at least, some characteristic not found

Appeal No. 94-3182
Application 07/899,707

in the old composition.

The problem with this appeal is that the examiner appears to have held that terms such as "adapted to contain" and "whereby" in patent claims per se do not further limit the subject matter claimed and so disregards them. However, claim interpretation independent of the teaching of the supporting specification is improper. Claims are to be given their broadest reasonable interpretation, but the interpretation must be consistent with the description of the invention in the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). The purpose of broad claim interpretation during examination is to completely explore the invention applicant claims and its relation to the prior art, to bring ambiguities to light, and to induce and allow applicant to clarify and delineate the claimed invention by amendment. Id. Prosecution which starts with the Examiner's Answer defeats the primary purpose of examination.

In this case, the rejection under 35 U.S.C. § 102(b) was entered for the first time in the Examiner's Answer. As a result, the exploration of the invention applicant claims and its relation to the prior art was incomplete, claim ambiguities were inadequately considered, and appellant's

Appeal No. 94-3182
Application 07/899,707

efforts to clarify and delineate the claimed subject matter by amendment appear to have been indeliberate.

Alas, when considered in light of the specification, the phrases "a plurality of test tubes each adapted to contain a sterile aqueous broth, an amount of antibiotic to be tested and MAI to be assayed" and "whereby observation of the growth of said MAI on each of said slides can be used to determine the concentration of said antibiotic necessary to resist growth of said MAI" in Claim 29 are subject to many different interpretations. We find significant, however, that no single interpretation appears to be entirely consistent with the teaching in the specification and satisfactorily reflects the subject matter which applicant appears to regard as his invention.

For example, applicant's specification cites Ollar and indicates that the subject matter described therein is not his invention. See the paragraph bridging pages 3 and 4 of the specification. The specification indicates that applicant's test tubes differ from Ollar's test tubes by the sterile aqueous broth and optionally the antibiotic and/or MAI they contain. See page 4, line 19 to page 5, line 14; and page 11, line 10, to

Appeal No. 94-3182
Application 07/899,707

page 12, line 2. Note that dependent Claims 30 and 31, if they are not read to further limit the amount of antibiotic contained in the test tubes of Claim 29, do not further limit Claim 29 at all and are improper dependent claims. See 35 U.S.C. § 112, fourth paragraph.

On the other hand, in holding that appellant's claims are directed to no more than test tubes containing paraffin coated slides and finding that appellant's claims are anticipated by the test tubes containing the paraffin coated slides described by Ollar, the examiner gave appellant notice that his claims are ambiguous and the phrase "adapted to contain a sterile aqueous broth, an amount of antibiotic to be tested and MAI to be assayed" in Claim 29 is held meaningless, i.e., the phrase does not further limit the claimed invention. Rather than amend the claim so to alleviate the ambiguity and clarify that the test tubes of the claimed apparatus do indeed contain a sterile aqueous broth and optionally an antibiotic and/or MAI, appellant incomprehensively added means plus function limitations, apparently to distinguish the paraffin coated slides of the claimed apparatus from the paraffin coated slides Ollar describes which inherently are adapted to being placed in test tubes which are capable of being used to

Appeal No. 94-3182
Application 07/899,707

determine the concentration of an antibiotic necessary to resist MAI growth on the slides.

We hereby vacate the examiner's rejection in this case. We cannot here assume ab initio, as the court did in In re Pearson, 494 F.2d at 1403, 181 USPQ at 644 (CCPA 1974), that appellant's claims comply with the definiteness requirement of the second paragraph of 35 U.S.C. § 112. The phrase "adapted to contain" does not clearly define, directly or indirectly, some characteristic not found in the old composition.

Thus, the examiner's rejection under 35 U.S.C. § 102(b) is vacated.

New Ground of Rejection Under 37 CFR § 1.196(b)

For the reasons stated above, we hereby newly reject Claims 29, 30 and 31 under 35 U.S.C. § 112, second paragraph. It is not clear from the teaching of the specification that the test tubes which comprise the apparatus of Claims 29, 30 and 31 "contain [(1)] a sterile aqueous broth, [(2)] an amount of antibiotic to be tested and [(3)] MAI to be assayed" (Claim 29). Clarification of this ambiguity is readily accomplished by amendment. If the tubes contain broth, contain antibiotic and/or contain MAI, applicant should so state explicitly to delineate the claimed subject matter from the apparatus

Appeal No. 94-3182
Application 07/899,707

described by Ollar. On the other hand, if appellant declines to explicitly state that the test tubes contain at least one of broth, antibiotic and MAI, the examiner is justified and hereby authorized to finally reject Claims 29-31 anew under 35 U.S.C. § 102(b) as anticipated by the test tubes Ollar describes which are adapted to contain paraffin coated slides. The patentability of the subject matter appellant claims stands or falls with the clarity with which he defines the subject matter that he regards as his invention.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

§ 1.196(b) provides that, "A new rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise

one of

the following two options with respect to the new ground of

Appeal No. 94-3182
Application 07/899,707

rejection to avoid termination of proceedings (§ 1.197(c)) as
to the rejected claims:

(1) Submit an appropriate amendment of the
claims so rejected or a showing of facts
relating to the claims so rejected, or both, and
have the matter reconsidered by the examiner, in
which event the application will be remanded to
the examiner. . . .

(2) Request that the application be reheard
under § 1.197(b) by the Board of Patent Appeals
and Interferences upon the same record. . . .

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

VACATED; 37 CFR § 1.196(b)

	Sherman D. Winters)	
	Administrative Patent Judge)	
)	
)	
	William F. Smith)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
	Teddy S. Gron)	
	Administrative Patent Judge)	

Appeal No. 94-3182
Application 07/899,707

Eckert Seamans Cherin and Mellott
600 Grant Street
42nd Floor
Pittsburgh, PA 15219