

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NORMAN W. SCHAAD, NIKOLAS J. PANOPOULOS
and EFSTATHIOS HATZILOUKAS

Appeal No. 1999-1289
Application 08/334,085

ON BRIEF

Before WINTERS, SCHEINER and GRIMES, Administrative Patent Judges.

SCHEINER, Administrative Patent Judge.

MODIFIED DECISION UNDER 37 CFR § 1.197(b)

Appellants request rehearing of the Board's decision entered January 30, 2001, wherein the Board vacated the examiner's rejections of the claims under 35 U.S.C. §§ 102(a) and 103, and entered a new ground of rejection as to claims 1 through 4, all the claims pending in the application, under the provisions of 37 CFR § 1.196(b).

Appellants' request is premised on the assertion that the Board overlooked or misapprehended certain teachings in the specification in finding the claims indefinite under the second paragraph of 35 U.S.C. § 112. We are not persuaded that the claims satisfy the requirements of the second paragraph of 35 U.S.C. § 112, but appellants' request is granted to the extent that our previous decision is modified to reflect a different basis for the rejection. As a consequence of this modification, we denominate this decision as a new decision under 37 CFR § 1.197(b).

As set forth in appellants' request, "[t]he rejection was made on the grounds that the language of claim 1, step c is not clear," in particular, the phrase "other sample processing." Claim 1 reads as follows:

1. A method for the detection of target DNA-containing cells or microorganisms in a sample, said method comprising
 - a) culturing said cells or microorganisms in order to increase the number of cells or microorganisms in the sample,
 - b) removing the cultured cells or microorganisms from culture,
 - c) performing enzymatic amplification of a target DNA sequence of the cultured cells or microorganisms to produce amplification products by direct polymerase chain reaction, wherein said direct polymerase chain reaction is performed without prior DNA extraction, cell lysis or other sample processing, and
 - d) detecting the amplification products as an indication of the presence of target DNA-containing cells or microorganisms.

In our previous decision, we stated that, "based on the specification, 'other sample processing' does not appear to encompass everything that could be considered

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processing, but it is not clear which activities are encompassed by the term and which are not.” For example, we stated that “the term ‘other sample processing’ . . . does not appear to encompass ‘washing [the cultured cells] by filtration, centrifugation or other conventional means’.” Appellants correctly point out that, on page 7, lines 8-11 of the specification, “this particular activity is identified as a removing step,” which corresponds to step b of claim 1, rather than step c, a point we had overlooked.

It may well be, as appellants maintain, that the specification describes “a two-step process: the culture step (or biological amplification) and the PCR step (or enzymatic amplification),” wherein “[t]he removing step directly connects the biological and the enzymatic amplifications.” Request, page 2. It may also be that the term “direct polymerase chain reaction,” as used in the specification and claims, even without the phrase “or other sample processing,” would be understood by one skilled in the art to preclude “any intervening activity which would affect the sample, or especially the target.” Id.

Nevertheless, the generic phrase “or other sample processing,” when coupled with two specific examples of processing, “DNA extraction” and “cell lysis,” gives rise to confusion over the intended scope of the claim. Compare, e.g. Ex parte Hall, 83 USPQ 38 (Bd. App. 1949) (“material such as rock wool or asbestos”); Ex parte Hasche, 86 USPQ 481 (Bd. App. 1949) (“lighter hydrocarbons, such, for example, as the vapors or gas

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produced”); and Ex parte Steigerwald, 131 USPQ 74 (Bd. App. 1961) (“normal operating conditions such as while in the container of a proportioner”).

SUMMARY

We grant appellants’ request for rehearing to the extent that our previous decision is modified to reflect a different basis for rejecting the claims under the second paragraph of 35 U.S.C. § 112. We therefore denominate this decision as a new decision under 37 CFR § 1.197(b).

In setting the following time period for response, we remind appellants that should they elect to request rehearing under 37 CFR § 1.197(b) they do not then have the later option of having the examiner consider an amendment to the claims, or reconsider the matter on any basis.

TIME PERIOD FOR RESPONSE

This opinion 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, “A new ground of 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

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respect to the new ground of rejection to avoid termination of proceedings (37 CFR

§ 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 . . . (emphasis added)

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

37 CFR § 1.196(b)

Sherman D. Winters)
Administrative Patent Judge)
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) BOARD OF PATENT
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