

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. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID J. ECKER, OSCAR ACEVEDO, NORMAND HEBERT,
PETER W. DAVIS, JACQUELINE R. WYATT, and JOHN S. KIELY

Appeal No. 2000-0122
Application No. 08/309,925

ON BRIEF

Before WALTZ, DELMENDO, and MOORE, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 43, 44, 46 through 51, and 54 through 59. Claims 1 through 42, 52, 53, 60 and 61 are the only other claims in this application and stand withdrawn from consideration by the examiner as drawn to a non-elected invention. See 37 CFR

Appeal No. 2000-0122
Application No. 08/309,925

§ 1.142(b); Brief, page 2; and the Answer, page 2.¹ We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellants, the invention is directed to a reaction assembly which comprises a support with a first and second surface, where fluid is capable of being transported from the first to the second surface in a direction substantially normal to the first surface (Brief, page 3). The assembly also comprises a collection plate adjacent to the second surface, which has a plurality of collection wells for receiving the transported fluid (*id.*). Appellants state that it is not their intention that the claims stand or fall together (Brief, page 5). However, appellants fail to present any specific, substantive reasons for the separate patentability of any individual claim (Brief, pages 5-9). Merely reiterating the limitations of each dependent claim is not sufficient reasoning. See 37 CFR § 1.192(c)(7)(8)(1997). Accordingly, pursuant to the provisions of 37 CFR

¹The examiner states that claims 52 and 53 have also been withdrawn from consideration as directed to a non-elected invention (Answer, page 2), although the final rejection dated July 1, 1996, Paper No. 11, and the Brief (page 2) do not state that these claims were withdrawn from consideration. Since appellants have not traversed the examiner's statement in the Answer (see the Reply Brief in its entirety), for purposes of this appeal we will only consider the claims on appeal as claims 43, 44, 46-51, and 54-59. See the action dated Sep. 27, 1995, Paper No. 7, pages 2-4.

Appeal No. 2000-0122
Application No. 08/309,925

§ 1.192(c)(7)(1997), we select claim 43 from the grouping of claims and decide the grounds of rejection in this appeal on the basis of this claim alone.² A copy of illustrative independent claim 43 is reproduced below:

43. A chemical reaction assembly comprising a reaction support having first and second surfaces and being capable of transporting fluid contacting the first surface to the second surface of the support in a direction substantially normal to the first surface, and a collection plate adjacent to the second surface having a plurality of wells for receiving fluid transported through said support.

The examiner relies upon the following references as evidence in support of the rejections on appeal:

Rosenthal et al. (Rosenthal)	4,882,127	Nov. 21, 1989
Caldwell et al. (Caldwell)	5,112,736	May 12, 1992
Khalil et al. (Khalil)	5,198,368	Mar. 30, 1993
Cody et al. (Cody)	5,324,483	Jun. 28, 1994

Claims 43, 44, 46, 47, 49, 54, 55 and 57 stand rejected under 35 U.S.C. § 102 as anticipated by Rosenthal (Answer, page 3).

Claims 43, 44, 46, 47, 49, 51, 54, 55, 57 and 59 stand rejected under 35 U.S.C. § 103 as unpatentable over Rosenthal taken with Caldwell (*id.*). Claims 43, 44, 46-49 and 54-57 stand rejected under 35 U.S.C. § 103 as unpatentable over Rosenthal taken with

²Of course, for the rejection of claims 50 and 58, we select claim 50 from this grouping and decide this ground of rejection on the basis of claim 50 alone. See *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002).

Appeal No. 2000-0122
Application No. 08/309,925

Cody (*id.*). Claims 50 and 58 stand rejected under 35 U.S.C. § 103 as unpatentable over Rosenthal taken with Khalil (*id.*).

We *affirm* the rejections on appeal essentially for the reasons stated in the Answer and those set forth below, with the exception that we *reverse* the rejection of claims 50 and 58 for the reasons which follow.

OPINION

The examiner finds that Rosenthal teaches a chemical reaction apparatus having a shaped body (4) having an array of reaction wells, a porous reaction support (4.6) in said reaction wells, and a collection plate (1.1) having a plurality of collection wells (1.2) (Final Rejection, Paper No. 11, page 3). From these findings, the examiner states that Rosenthal discloses "all the structural limitations of the instant claims." *Id.* We agree.

The chemical reaction assembly recited in claim 43 on appeal requires a reaction support having a first and second surface and a collection plate adjacent to the second surface having a plurality of wells. As found by the examiner *supra*, Rosenthal discloses a collection plate (base block 1.1) having a plurality of collection wells (reaction vessels 1.2) that is adjacent to the second surface of a reaction support (carrier matrix 4.6). See Figure 1b; Figure 2b; col. 3, l. 59-col. 4, l. 58; and Example 18 at cols. 10-11.

Appeal No. 2000-0122
Application No. 08/309,925

Appellants argue that there is no disclosure in Rosenthal of transport of fluid through the support (Brief, page 6; Reply Brief, page 2). Appellants submit that an essential feature of Rosenthal is that the sample materials are immobilized onto the carrier matrix, i.e., not transported through it (*id.*). Appellants' arguments are not persuasive. See *Gechter v. Davidson*, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997) (The claims must first be correctly construed to define the scope and meaning of any contested limitations). As correctly argued by the examiner, claim 43 on appeal only requires a "capability" of transporting fluid contacting the first surface to the second surface, not any structural limitations (Final Rejection, Paper No. 11, page 3). See *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997) (Claim language must be construed as broadly as reasonably possible, as read in light of the specification and interpreted by one of ordinary skill in the art). The examiner finds that, as the punching device of Rosenthal punches through the carrier matrix, fluid is transported from the first surface to the second surface and subsequently to the adjacent collection plate and wells, even though the fluid of Rosenthal is transported as immobilized on the carrier matrix (*id.*, see also Rosenthal, col. 11, ll. 36-42).

Appeal No. 2000-0122
Application No. 08/309,925

For the foregoing reasons and those stated in the Final Rejection and the Answer, we determine that the examiner has established a *prima facie* case of anticipation for the subject matter of claim 43 which has not been adequately rebutted by appellants' arguments. Accordingly, we affirm the examiner's rejection under 35 U.S.C. § 102 of claim 43, and claims 44, 46, 47, 49, 54, 55 and 57 which stand or fall with claim 43, over Rosenthal.

As discussed above, we decided each of the grounds of rejection under section 103 over Rosenthal in view of Caldwell and Rosenthal in view of Cody on the basis of claim 43 alone, and thus we affirm both of these rejections over Rosenthal alone since anticipation is the ultimate or epitome of obviousness. See *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982). A discussion of Caldwell and Cody is therefore unnecessary to our decision.

With regard to the examiner's rejection of claims 50 and 58 under section 103 over Rosenthal in view of Khalil, we cannot sustain the examiner's rejection. Even assuming *arguendo* that Khalil teaches a fibrous material that has its fibers positioned normal to its surface in order to allow capillary action of the fibers to assist in transporting fluid (Final Rejection, Paper No. 11, page 6), the examiner has failed to advance any cogent

Appeal No. 2000-0122
Application No. 08/309,925

reasoning or motivation for combining this reference with Rosenthal. See *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). As correctly argued by appellants (Reply Brief, pages 5-6), the examiner has failed to identify any convincing evidence or reasoning why one of ordinary skill in the art would have transported fluid via fibers, as taught by Khalil, in the process of Rosenthal, which is directed to a punch process.

For the foregoing reasons, we determine that the examiner has failed to establish a *prima facie* case of obviousness. Accordingly, we reverse the examiner's rejection of claims 50 and 58.

For the foregoing reasons, the examiner's decision is affirmed-in-part.

Appeal No. 2000-0122
Application No. 08/309,925

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

AFFIRMED-IN-PART

THOMAS A. WALTZ)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ROMULO H. DELMENDO)	APPEALS
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JAMES T. MOORE)	
Administrative Patent Judge)	

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Appeal No. 2000-0122
Application No. 08/309,925

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