

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JUDY A. FRASER

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Appeal No. 94-2788  
Application 07/912,408<sup>1</sup>

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ON BRIEF

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Before CAROFF, WILLIAM F. SMITH, and WEIMAR, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

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<sup>1</sup> Application for patent filed July 13, 1992.

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DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1 through 28. Subsequently, claim 26 was canceled leaving claims 1 through 25, 27, and 28 for our consideration. These are all of the claims pending in the application.

Claims 1, 7, and 13, the independent claims pending in this application are illustrative of the subject matter on appeal and read as follows:

1. A method for rapidly obtaining a culture for detecting esculin hydrolyzing procaryotes via nucleic acid hybridization techniques wherein the step of plating the culture is eliminated, the improvement comprising pelleting an enrichment culture of the sample and performing a nucleic acid hybridization confirmation test on the sample.

7. A rapid method of obtaining a [sic] esculin hydrolyzing procaryotic culture suitable for performing a nucleic acid hybridization confirmation test, comprising:

- a) inoculating an enrichment broth with a sample and growing a culture in said enrichment; and
- b) pelleting said culture.

13. A method of rapidly detecting esculin hydrolyzing procaryotes, comprising:

- a) inoculating an enrichment broth with a sample and growing a culture in said broth;
- b) pelleting said culture; and
- c) using nucleic acid hybridization techniques to identify said culture.

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The references relied upon by the examiner are:

Stackebrandt et al. (Stackebrandt)                      5,089,386                      Feb. 18, 1992

Edberg et al. (Edberg), "Rapid Spot Test for the Determination of Esculin Hydrolysis,"  
Journal of Clinical Microbiology, pp. 180-84, August 1976.

Claims 1 through 25, 27, and 28 stand rejected under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Edberg and Stackebrandt. We affirm.

Appellant states at page 2 of the Appeal Brief that the claims stand or fall together for the purposes of this appeal. Accordingly, we shall limit our consideration of the issues raised in this appeal as they pertain to claim 7, the broadest claim pending in the application.

Claim 7 requires two steps. First, an enrichment broth is inoculated with a sample and a culture is grown. Subsequently, the culture is pelleted.

Edberg describes a rapid esculin hydrolysis spot test which requires an inoculum. As set forth in the fourth full paragraph of the left-hand column of page 181, the inoculum may be derived from a 24-h bacterial colony, or in the alternative, a "[d]ense, centrifuged material from a broth culture may also be used." See also the paragraph bridging the columns on page 182 of Edberg ("Centrifuged material from Trypticase soy broth was also efficacious." ).

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In our view, Edberg describes the two steps required by claim 7 on appeal. First, a bacterial strain (sample) is cultured in Trypticase soy broth. Subsequently, that culture is centrifuged, resulting in pelleted material, i.e., dense, centrifuged material. Consequently, Edberg is an anticipation of the method of claim 7. As set forth in In re May, 574 F.2d 1082, 1089, 197 USPQ 601, 607 (CCPA 1978), anticipation is the epitome of obviousness. Thus, our determination that Edberg is an anticipatory reference in regard to the subject matter of claim 7 does not constitute a new ground of rejection.

The decision of the examiner is affirmed.

#### Other Issues

If prosecution is resumed on this subject matter in a continuing application, we urge the examiner to carefully review the ACCUPROBE™ brochure submitted with the Information Disclosure Statement of August 14, 1992. The form PTO-1449 which accompanied that Information Disclosure Statement indicates that the ACCUPROBE™ was published in 1990. However, the brochure contains the date February 15, 1992 on its last page as well as a copyright notice dated 1992. Regardless of which publication date is correct, it appears that the ACCUPROBE™ brochure is prior art to the present claims. See also claim 6 which requires use of the test sold under the trademark ACCUPROBE.

We direct the examiner's attention to the ACCUPROBE™ brochure since a review of the specification of this application indicates that the present invention is an improvement over that procedure in that the sample obtained from an enrichment broth is pelleted. The hybridization confirmation test which is required by certain of the claims on appeal is taught by the brochure. As set forth in the "SAMPLE COLLECTION AND PREPARATION" section of the ACCUPROBE™ brochure, the sample used in that procedure may be obtained from two sources. First, the sample may be obtained from a solid growth media. Second, the sample may be obtained directly from a broth culture. The ACCUPROBE™ brochure does not appear in and of itself to teach or suggest the step of pelletizing the sample obtained from the broth culture. However, as set forth above, Edberg teaches that in this art area samples may be obtained either from a solid growth media or from dense, centrifuged material obtained from a culture broth.

As a separate matter, the examiner should consider the propriety of using trademarks in the claims as in claim 6. It is not clear whether appellants intend claim 6 to be limited to using only test kits sold under the trademark or whether the use of the trademark is meant to be exemplary.

The decision of the examiner is affirmed.

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

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AFFIRMED

Marc L. Caroff	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
William F. Smith	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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Elizabeth C. Weimar	)	
Administrative Patent Judge	)	

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