

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALFRED J. KOLB,
ROY L. MANNS and KENNETH E. NEUMANN

Appeal No. 96-0401
Application No. 08/127,304¹

ON BRIEF

Before COHEN, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-8, 10-12, 14-21, 32 and 33. Claims 22-31 have been withdrawn from consideration under 37 CFR § 1.142(b) as being drawn to a nonelected invention. Claims 9 and 13 have been canceled. The appellants have confined the appeal to only claims 1-8, 10-12, 14, 15, 32 and 33 (brief, p. 2). Consequently, the appeal is dismissed with respect to

¹ Application for patent filed September 27, 1993.

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claims 16-21. Claims 1-8, 10-12, 14, 15, 32 and 33 remain on
appeal.

We REVERSE.

BACKGROUND

The appellants' invention relates to a microplate assembly for use in analyzing samples captured on a filter medium. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Freeman 1972	3,649,464	Mar. 14,
Manns 1990 (Manns '442)	4,948,442	Aug. 14,
Manns 1991 (Manns '215)	5,047,215	Sep. 10,

Claims 1-5, 7, 8, 10, 11, 14, 15, 32 and 33 stand rejected under 35 U.S.C. § 103 as being unpatentable over Manns '442 or Manns '215.

Claims 6 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Manns '442 or Manns '215 in view of Freeman.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 14, mailed May 16, 1995) and the supplemental examiner's answer (Paper No. 16, mailed October 13, 1995) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 13, filed April 17, 1995), reply brief (Paper No. 15, filed July 17, 1995) and supplemental reply brief (Paper No. 17, filed December 4, 1995) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification² and

² The appellants describe Figure 4 on page 8 of the specification. In accordance with 37 CFR § 1.74, the appellants should amend the brief description of the drawings (specification, p. 5) to refer to Figure 4.

claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1-8, 10-12, 14, 15, 32 and 33 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be

supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on

§ 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

With this as background, we turn to the rejection of the only independent claim on appeal (i.e., claim 1).

The examiner determined (answer, pp. 3-4) that

[t]he Manns patents both disclose a multiwell test plate assembly comprising a holding tray (24), a filter medium (22) received in the holding tray, a collimator (20) having wells (28), and a carrier plate (26) for supporting the holding tray. The Manns patents fail to teach 1) the collimator being removably disposed in the holding tray and 2) the holding tray being a solid plate without holes. Even though all the structural parts of the Manns' assembly are thermally bonded whereby all parts are integral, it would have been obvious to one of ordinary skill in the art to make the parts separable Furthermore, it would have been obvious to one of ordinary skill in the art to make the holding tray from a solid plate without holes for the extended storage and analysis of biological samples.

The appellants argue (brief, pp. 8-14) that the subject matter of claim 1 would not have been suggested by the teachings of Manns '442 or Manns '215. We agree for the reasons set forth below.

We agree with the examiner (answer, p. 6) that the collimator (20) is initially separable from the holding tray (24). Accordingly, prior to the thermal bonding of the collimator (20) to the holding tray (24) it would be appropriate to characterize the collimator (20) as being removably disposed within the holding tray (24). However, we see no evidence, as shown by some objective teaching in the

prior art or by knowledge generally available to one of ordinary skill in the art, that would have suggested to one of ordinary skill in the art at the time the invention was made to omit the apertures (42) from the holding tray (24). Instead, it appears to us that the examiner relied on impermissible hindsight in reaching the determination that it would have been obvious to one of ordinary skill in the art to make the holding tray from a solid plate without holes for the extended storage and analysis of biological samples.

Since all the limitations³ are not taught or suggested by the applied prior art, we will not sustain the 35 U.S.C. § 103

³ We note that the claimed holding tray recited in claim 1 is not readable on Manns' base enclosure 26. While Manns' base enclosure 26 does have a bottom wall without holes, the bottom wall of Manns' base enclosure 26 is not adjacent (as disclosed in the appellants specification adjacent encompasses either the filter medium abutting the bottom wall of the holding tray or the filter medium abuts a thin, i.e., thickness ranging from 0.005 inches to 0.020 inches, crosstalk shield which abuts the bottom wall of the holding tray) to the lower surface of the filter sheet 22 as shown in Figure 5.

rejection of independent claim 1, and of dependent claims 2-8,
10-12, 14, 15, 32 and 33.⁴

⁴ We have also reviewed the Freeman reference additionally applied in the rejection of dependent claims 6 and 12 but find nothing therein which makes up for the deficiencies of Manns '442 and Manns '215 discussed above regarding claim 1.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-8, 10-12, 14, 15, 32 and 33 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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APPLICATION NO. 08/127,304

APJ NASE

APJ STAAB

APJ COHEN

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 04 Nov 98

FINAL TYPED: