Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JORAM AGAR CORPORATION, INC.

Appeal No. 2000-1022
Reexamination Control No. 90/004,524

ON BRIEF

Before THOMAS, KRASS, and BARRY, Administrative Patent Judges.
BARRY, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is a decision on the appellant's request that we reconsider our decision of August 22, 2000, affirming the final rejections of claims 1-8, 12-21, 24, 28, 30, 31, and 34 under 35 U.S.C. § 103(a) as obvious over Perl in view of Herzl and of claims 9-11, 25-27, and 29 under 35 U.S.C. § 103(a) as obvious over Perl in view of Herzl further in view of Warren. The appellant makes two arguments. Rather than repeat the arguments in toto, we refer the reader to the request for the details thereof. After reconsidering our decision in light of

the arguments and the totality of the record, we are not persuaded of any error therein. Therefore, we decline to make any changes in the decision.

At the outset, we recall that claims 1-21, 24-31, and 34 stand or fall together as a group and that we selected claim 15 to represent the group. (Op. at 6.) We also recall that "'[e]very patent application and reference relies to some extent upon knowledge of persons skilled in the art to complement that [which is] disclosed ....'" In re Bode, 550 F.2d 656, 660,
193 USPQ 12, 16 (CCPA 1977) (quoting In re Wiggins, 488 F.2d 538, 543, 179 USPQ 421, 424 (CCPA 1973)). Those persons "must be presumed to know something" about the art "apart from what the references disclose." In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). With this grouping and these principles in mind, we consider the appellant's two arguments.

First, the appellant argues, "Perl's method and apparatus in no way determines [sic] the volume fraction of water in a mixture of water and oil from the electrical measurement from

a probe ...." (Req. Reh'g at 9.) "'[T]he main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. [T]he name of the game is the claim ....'" In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) (quoting Giles S. Rich, The Extent of the Protection and Interpretation of Claims--American Perspectives, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499, 501 (1990)). "In the patentability context, claims are to be given their broadest reasonable interpretations. Moreover, limitations are not to be read into the claims from the specification." In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993)(citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)). Here, representative claim 15 specifies in pertinent part the following limitations: "determine the percentage of water present in the mixture." Giving the claim its broadest reasonable interpretation, the limitations do not require using a probe. These merely recite determines the percentage of water in an oil-and-water mixture.

The combination of references would have suggested the limitations. "Non-obviousness cannot be established by attacking references individually where the rejection is based upon the

teachings of a combination of references." In re Merck & Co., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986)(citing In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)). In determining obviousness, furthermore, a reference "must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole." Id., 231 USPQ at 380.

Here, the rejection is based on a combination of Perl and Herzl. For its part, Perl teaches a method for determining whether an oil-and-water emulsion, i.e., mixture, is in the oil continuous phase or the water continuous phase and for determining the volume fraction, i.e., percentage, of water in the mixture. Specifically, "[t]he techniques described [there]in use electromagnetic methods to determine concentrations and emulsion types, particularly in solutions or dispersions where water is one of the components. These electronic determinations can be made rapidly,

nondestructively and in some cases, noninvasively." Pp. 74-75.

More specifically, "[a] novel method for the simultaneous determination of emulsion type and water content from complex dielectric measurements is described." P. ix. Figure 8 of the reference depicts the "Simultaneous Determination of Water Content and Emulsion Type ...." P. 24. "The examination of loss tangent in Figure 8 ... allows the immediate, unambiguous determination of emulsion type for which either Figure 6 or 7 provides accurate determination of the volume fraction of water." P. 32. Because Perl teaches providing an accurate determination of the volume fraction of water based on electronic measurement, we are persuaded that the teachings of Perl and Herzl in combination with the prior art as a whole would have suggested the limitations of "determin[ing] the percentage of water present in the mixture."

Second and last, the appellant argues, "[t]he primary reference, Perl, with the secondary reference, Herzl ... in no way teach or suggest that these references can be combined

...." (Req. Reh'g at 1.) The prior art, however, would have suggested combining teachings of Herzl with those of Perl. "Obviousness is not to be determined on the basis of purpose alone." In re Graf, 343 F.2d 774, 777, 145 USPQ 197, 199 (CCPA 1965). It is sufficient that references suggest doing what an appellant did, although the appellant's particular purpose was different from that of the references. In re Heck, 699 F.2d 1331, 1333, 216 USPQ 1038, 1040 (Fed. Cir. 1983)(citing In re Gershon, 372 F.2d 535, 539, 152 USPQ 602, 605 (CCPA 1967)). "'[T]he question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" In re Beattie, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)).

Here, as explained responsive to the first argument, Perl teaches a method for determining whether an oil-and-water mixture is in the oil continuous phase or the water continuous phase and for determining the percentage of water therein. As

also explained responsively, the method involves measurements. It also involves calculations.

Persons skilled in the art would have known that measurements and calculations generally lend themselves to performance by a computer. See, e.g., Engineering Research Assocs., High-Speed Computing Devices 3 (1950)("The existence and importance of ... computational problems have fostered the development of machine aids to computation."). More specifically, U.S. Patent 4,340,938 (Rosso), which was submitted by the appellant, evidences that persons skilled in art would also have known that measurements and calculations of oil and water percentages specifically lend themselves to performance by "[a] net oil computer ...." Col. 7, l. 1. Accordingly, Perl's complex measurements and calculations would have suggested themselves to performance by a computer. In fact, the reference teaches that the measurements "lend themselves to interfacing in a computer process control scheme." P. 75.

For its part, Herzl teaches a computer process control scheme employing a microcomputer to perform complex calculations to determine the volumes of water in a metered fluid stream. Specifically, "the micro-computer ... is then able to solve for
X and Y, the respective volumes of oil and water." Col. 6, ll. 43-49. We are persuaded that Perl's teaching of determining the percentage of water in a mixture using complex measurements and calculations that lend themselves to a computer process control scheme and Herzl's teaching of employing a microcomputer to perform complex calculations to determine the volume of water in a fluid stream would have suggested the desirability, and thus the obviousness, of performing Perl's method with a computer.

Any other arguments in the request for rehearing merely repeat those made in the briefs and duly considered by the Board in rendering its decision. There is no need to repeat the positions set forth in our opinion; we simply note that the appellant's same arguments are still not persuasive.

Arguments not made in the briefs, furthermore, are not before us, are not at issue, and are considered waived.

We have granted the appellant's request to the extent that we have reconsidered our decision of August 22, 2000, but we deny the request with respect to making any changes therein. No period for taking subsequent action concerning this appeal may be extended under 37 C.F.R. § 1.136(a).

DENIED

JAMES D. THOMAS Administrative Patent Judge	)	
ERROL A. KRASS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
LANCE LEONARD BARRY Administrative Patent Judge	)	

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