THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

This opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CAROL MAZUREK, CHARLES L. NELSON, STEVE C. HODGES and JAMES W. SCHEFFEL

Appeal No. 94-4421
Application No. 07/893,964[1]

ON BRIEF

Before COHEN, FRANKFORT, and McQUADE, *Administrative Patent Judges*.

COHEN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 14 through 24, all of the claims remaining in the application.

[1] Application for patent filed June 4, 1992. According to the appellants, the application is a continuation of 07/818,410, filed January 3, 1992, now abandoned, which is a continuation of 07/572,519, filed August 23, 1990, now abandoned.

Appellants' invention pertains to an agglutination assay and to an agglutination assay device for detecting the presence or amount of an analyte in a test sample. A basic understanding of the invention can be derived from a reading of exemplary claims 14 and 19, copies of which are appended to this opinion.

In rejecting appellants claims under 35 U.S.C. 102(b) and 35 U.S.C. § 103, the examiner has relied upon the reference specified below:

Coleman	3,799,742	Mar. 26, 1974

The following rejections, specified in the final rejection (Paper No. 19), are before us for review.

Claims 14, 19, and 20 stand rejected under 35 U.S.C. 102(b) as being anticipated by Coleman.

Claims 15 through 18 and 21 through 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Coleman.[2]

The full text of the examiner's rejections and response to the argument presented by appellants appears in the answer (Paper No. 22), while the complete statement of appellants' argument can be found in the main (pages 4 through 8) and reply briefs (Paper Nos. 21 and 23).

OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellants' specification and claims, the applied references[3],

[2] We have specified herein the claims rejected under 35 U.S.C. 103 in the final rejection. In error, the answer (page 3) referred to claims 14-15 and 19-21 as being rejected under 35 U.S.C. 103.

[3] In our evaluation of the applied references, we have considered all of the disclosure of each reference for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966).

and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The rejection under 35 U.S.C. § 102(b)

We do not sustain the rejection of claim 14, but do sustain the rejection of claims 19 and 20.

Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). However, the law of anticipation does not require that the reference teach specifically what an appellant has disclosed and

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Additionally, this panel of the board has taken into account not only the specific teachings of each reference, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

is claiming but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983); cert. denied, 465 U.S. 1026 (1984).

Claim 14 is drawn to an agglutination assay method. This method requires, inter alia, the step of placing the test sample in a device comprising a sample receiving well which accommodates the test sample when the device is horizontal, and the step of placing the device at an angle to the horizontal. Read in light of the underlying disclosure, we understand the aforementioned first step as requiring the placing of and accommodation of the test sample in the receiving well when the device is horizontal.

Turning now to the applied Coleman patent, our reading thereof reveals to us that, as to the method of use, the patentee only intended the miniaturized integrated analytical test container to be in a vertical position. Thus, the method of claim 14 is not anticipated by the evidence proffered by the examiner.

We, therefore reverse the rejection of claim 14 under 35 U.S.C. § 102(b).

As to article claims 19 and 20, it is our view that the subject matter of these claims is anticipated by the Coleman disclosure. Thus, we affirm the rejection of these claims under 35 U.S.C. § 102(b).

With reference to the test container depicted in Figure 36 of Coleman (columns 21 and 22), we determine that the structure of the device now claimed is addressed by the container 852 of Figure 36 of Coleman. We particularly note that this container 852 includes a side entry port with a stopper 856, and a configuration having flat walls. With the aforementioned entry port and configuration, we conclude that the device disclosed by Coleman is clearly capable of accommodating a particular volume of test sample when the device is in a horizontal position and the test sample will pass by the effect of gravity from a receiving well and fill a reaction chamber when the device is placed at an angle to the horizontal, but will not pass when the

device is horizontal. For these reasons, claim 19 is anticipated by Coleman. Claim 20 is also anticipated by this reference. The bottom wall of the container shown in Figure 36 is a support means placing the device at an angle to the horizontal, as set forth in claim 20.

The argument advanced by appellants does not convince us that the device of claims 19 and 20 is patentable over the Coleman disclosure. The circumstance that, as argued, the device of Coleman is intended to be always maintained at an angle to the horizontal (vertical) does not alter the determination that appellants' claimed device is addressed by the container of Coleman, which container is capable of the use now claimed.

The rejection under 35 U.S.C. § 103

We do not sustain the rejection of claims 15 through 18 or the rejection of claims 22 through 24, but do sustain the rejection of claim 21.

Claims 15 through 18 depend from method claim 14. Simply stated, it is our view that the subject matter of method claim 14 and dependent claims 15 through 18 would not have been obvious to one having ordinary skill in the art based upon the method disclosed by Coleman. Thus, the rejection of claims 15 through 18 must be reversed.

As to claim 21, it is clear to us that one of ordinary skill in the art would have appreciated the flat wall opposite the flat wall holding the stopper 856 of Coleman (Figure 36) to be a second support capable of placing the container in a horizontal position. Accordingly, we sustain the rejection of claim 21.

In the matter of claims 22 through 24, we conclude that the Coleman teaching would not have been suggestive of the specific angles claimed, which provide operable and acceptable results as disclosed by appellants. The evidence relied upon by the examiner (the Coleman patent) only suggests a vertical orientation for the container, and a container configuration that

would vertically orient the container. Thus, based upon the evidence relied upon by the examiner, we conclude that the subject matter of claims 22 through 24 would not have been obvious.

In summary, this panel of the board has

reversed the rejection of claim 14 under 35 U.S.C. § 102(b) as being anticipated by Coleman, but affirmed the rejection of claims 19 and 20 on this same ground, and reversed the rejection of claims 15 through 18 and 22 through 24 under 35 U.S.C. 103 as being unpatentable over Coleman, but affirmed the rejection of claim 21 on this same ground.

Appeal No. 94-4421
Application No. 07/893,964

The decision of the examiner is affirmed-in-part.

AFFIRMED-IN-PART

IRWIN CHARLES COHEN)
Administrative Patent Judge)
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CHARLES E. FRANKFORT)
Administrative Patent Judge) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES
)
)
JOHN P. McQUADE)
Administrative Patent Judge)

Appeal No. 94-4421
Application No. 07/893,964

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14. An agglutination assay for detecting the presence or amount of an analyte in a test sample, comprising the steps of:

a) placing the test sample in a device comprising:

i) a sample receiving well which accommodates the test sample when the device is in a horizontal position,

ii) a reaction chamber having a first end and a second end, wherein said receiving well communicates with said first end of said reaction chamber such that the test sample passes from said receiving well and fills said reaction chamber when the device is placed at an angle to the horizontal but will not pass when the device is horizontal,

iii) a reservoir communicating with said second end of said reaction chamber to collect excess test sample from said reaction chamber,

iv) a vent communicating from said reservoir to the exterior of the device; and

b) placing the device at an angle to the horizontal, thereby initiating an agglutination reaction between a suspension of particles and the analyte whereby gravity causes the downward movement of said particles through said filled reaction chamber to cause agglutination if the analyte is present at a threshold amount; and

c) observing the agglutination reaction which occurs in said reaction chamber in the presence of analyte.

19. An agglutination assay device for detecting the presence or amount of an analyte in a test sample, comprising:

a) a sample receiving well which accommodates the test sample when the device is in a horizontal position;

b) a reaction chamber having a first end and a second end,

wherein said receiving well communicates with said first end of said reaction chamber such that the test sample passes from said receiving well and fill said reaction chamber when the device is placed at an angle to the horizontal but will not pass when the device is horizontal,

thereby initiating an agglutination reaction between a suspension of particles and the analyte whereby gravity causes the downward movement of said particles through said reaction chamber to cause agglutination if the analyte is present at a threshold amount,

c) a reservoir communicating with said second end of said reaction chamber to collect excess test sample from said reaction chamber; and

d) a vent communicating from said reservoir to the exterior of the device.