

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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VINCENZO VASSAROTTI

Appeal No. 1998-2581
Application No. 08/472,965

ON BRIEF

Before OWENS, WALTZ, and SMITH, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1 through 3, 5, 6, 8, 11, 13, 14 and 16 as amended subsequent to the final rejection (see the amendments dated Feb. 13, 1997, Paper No. 10, and Mar. 11, 1997, Paper No. 13, entered as per the Advisory Actions dated Feb. 27, 1997, Paper No. 12, and Mar. 20, 1997, Paper No. 14, respectively). The remaining claims pending in this application are claims 9 and 10, indicated as allowed by the

Appeal No. 1998-2581
Application No. 08/472,965

examiner, and claims 4, 7, 12 and 15, indicated as allowable by the examiner (Final Rejection dated Aug. 9, 1996, Paper No. 7, page 4). Claims 4, 7, 9, 10, 12 and 15 form no part of this appeal (Brief, page 1).

According to appellant, the invention is directed to a device for removing or replacing solvent in a liquid sample containing macromolecules, wherein the improvement includes the provision of an auxiliary reservoir in gas-tight or liquid-tight relationship to the concentration chamber during the operation of the device resulting in hydrostatic pressure in the concentration chamber which advantageously accelerates the concentration procedure (Brief, pages 3-6). A copy of illustrative independent claims 1 and 2 is attached as an Appendix to this decision.

The examiner relies upon Zipilivan et al. (Zipilivan), U.S. Patent No. 3,817,379, issued June 18, 1974, as support for the rejections on appeal. Accordingly, claims 1-3, 6 and 14 stand rejected under 35 U.S.C. § 102(b) as anticipated by Zipilivan (Supplemental Answer, page 3). Claims 3, 5, 8, 11, 13 and 16 stand rejected under 35 U.S.C. § 103 as unpatentable over

Appeal No. 1998-2581
Application No. 08/472,965

Zipilivan (*id.*). We *reverse* all of the examiner's rejections
for reasons which follow.

OPINION

The examiner finds that Zipilivan discloses a device having a "chamber provided with the membrane and absorbent, a sample collection container or section for introducing a pipette from the top of the chamber, and forming an auxiliary reservoir, and having an opening for inserting the reservoir." Office Action dated Dec. 18, 1995, Paper No. 4, page 2 (incorporated by reference in the Final Rejection and the Answer). The examiner's position is that the prior art discloses an opening and pipette adapted to fit that opening which reads on the claimed aperture and sealing means (Answer, page 4).

Appellant submits that Zipilivan discloses a pipette **34** as a means for the introduction or withdrawal of liquid from channel **36** into which the pipette **34** is inserted (Brief, page 11). Appellant argues that claims 1 and 2 expressly recite means for providing a gas-tight or liquid-tight seal between the auxiliary reservoir and the concentration chamber while Zipilivan does not teach any such gas/liquid-tight sealing relationship between the pipette **34**

Appeal No. 1998-2581
Application No. 08/472,965

and the concentration chamber at any time (Brief, pages 12-13).

Implicit in our review of the examiner's anticipation and obviousness analyses is that the claim must first have been correctly construed to define the scope and meaning of each contested limitation. *See Gechter v. Davidson*, 116 F.3d 1454, 1457, 1460 n.3, 43 USPQ2d 1030, 1032, 1035 n.3 (Fed. Cir. 1997). The contested limitation is "means for providing a gas-tight or liquid-tight seal between said auxiliary reservoir and the concentration chamber" when the reservoir is received in the aperture in the chamber (see both claims 1 and 2 on appeal). Accordingly, this limitation invokes the strictures of 35 U.S.C. § 112, ¶6, since it recites "means" in combination with a function with no corresponding claimed structure. *See Al-Site Corp. v. VSI Int. Inc.*, 174 F.3d 1308, 1318, 50 USPQ2d 1161, 1166 (Fed. Cir. 1999). As correctly argued by appellant on page 15 of the Brief, recitation in the claim of a "means plus function" limitation is construed by looking to the specification to interpret this language in light of the corresponding structure described therein, and equivalents

Appeal No. 1998-2581
Application No. 08/472,965

thereof. See *In re Donaldson Co.*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994)(in banc).

Appellant's specification describes the detachable auxiliary reservoir "which seals onto the concentration chamber by means of a conical or any other type of seal arrangement." Specification, page 4, ll. 18-20. Furthermore, appellant describes the use of a pipette in the aperture and teaches "[a] conical fit, as shown in figure 1 c, could be appropriate but any liquid-tight fit would do." Accordingly, we must construe the "means for sealing" limitation of claims 1 and 2 on appeal as including conical fits of pipettes into the aperture provided, any other sealing arrangement that is liquid-tight, or equivalents thereof.¹

The examiner's position apparently is that Zipilivan discloses a circular pipette **34** which is inserted into a circular opening **32**, thus inherently providing a liquid- or gas-tight sealing relationship (Answer, pages 4-5, citing Fig. 4 of the reference; see the Brief, page 16). The initial burden of

¹In view of our disposition of this appeal *infra*, we need not construe the scope of "equivalents thereof."

Appeal No. 1998-2581
Application No. 08/472,965

establishing a *prima facie* basis to deny patentability rests with the examiner and the examiner, if relying on a theory of inherency, must provide a basis in fact and/or technical reasoning to reasonably support a determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. See *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). Inherency cannot be established by probabilities or possibilities. See *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999). The examiner has failed to show by fact and/or reasoning that the insertion of the pipette **34** into the aperture **32** of Zipilivan would have *necessarily* resulted in a gas-tight or liquid-tight seal with the concentration chamber. Actually, the examiner has not cited any evidence or reasoning that the pipette **34** is even inserted into aperture **32** during the introduction of the liquid sample since Figures 1 and 4 of the reference do not show the pipette **34** in the aperture **32**. Of course, the pipette **34** must be inserted into aperture **32** and go through channel **36** for withdrawal of the concentrated liquid sample (see col. 3, ll. 28-30; 40-46). Merely because the sizes

Appeal No. 1998-2581
Application No. 08/472,965

of the pipette **34** and the aperture **32** appear to be similar in the Figures does not meet the examiner's burden of establishing the inherency of a sealing relationship in the device of Zipilivan.

We further determine that the examiner has no basis for the finding that Figure 1 of Zipilivan shows the pipette as being fixed to the concentration chamber (Answer, page 4; see the Supplemental Reply Brief, page 2). Figure 1 of Zipilivan clearly shows the pipette **34** above the apertures **32** in the top of the concentration chamber. Accordingly, the examiner has not established that Zipilivan shows the limitation of claim 2 on appeal that the detachable auxiliary upper reservoir is fixed to the aperture.

For the foregoing reasons, we determine that the examiner has not met the initial burden of presenting a *prima facie* case of unpatentability under 35 U.S.C. § 102(b). Accordingly, the rejection of claims 1, 2, 3, 6, and 14 under section 102(b) over Zipilivan is reversed.

The examiner has rejected claims 3, 5, 8, 11, 13 and 16 under section 103 (Supplemental Answer, page 3).

Appeal No. 1998-2581
Application No. 08/472,965

However, this rejection fails to advance any further evidence and/or reasoning to remedy the deficiencies noted above.

Accordingly, the rejection of claims 3, 5, 8, 11, 13 and 16 under 35 U.S.C. § 103(a) over Zipilivan is reversed.

The decision of the examiner is reversed.

REVERSED

TERRY J. OWENS)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
THOMAS A. WALTZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JEFFREY T. SMITH)	
Administrative Patent Judge)	

TAW/jrg

Appeal No. 1998-2581
Application No. 08/472,965

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APPENDIX

1. In a device for removing or replacing solvent in a liquid sample containing macromolecules comprising a concentration chamber (3) having at least one rigid wall and one opposite wall formed from a membrane (7) permeable to said solvent, an aperture adjacent an upper part of said concentration chamber for introduction and removal of liquid, a pocket (11) in its lower portion for retaining a fixed volume of a concentrated sample, and an absorption container (1) provided with absorbent material (10) arranged closely adjacent said membrane wall of said concentration chamber and capable of absorbing said solvent, the improvement comprising said aperture adjacent the upper end of said concentration chamber arranged to receive an outlet of a detachable auxiliary upper reservoir (5), and means for providing a gas-tight or liquid-tight seal between said auxiliary reservoir and the concentration chamber when said auxiliary reservoir is received in said aperture in the concentration chamber.

2. In a device for removing or replacing solvent in a liquid sample containing macromolecules comprising a concentration chamber (3) having at least one rigid wall and one opposite wall formed of a membrane (7) permeable to said solvent, an aperture adjacent an upper part of said concentration chamber for introduction and removal of liquid, a pocket (11) in its lower portion for retaining a fixed volume of a concentrated sample, and an absorption container (1) provided with absorbent material (10) arranged closely adjacent said membrane wall of said concentration chamber and capable of absorbing said solvent, the improvement comprising a detachable auxiliary upper reservoir (5) arranged fixed to said aperture adjacent the upper end of said concentration chamber and means for providing a gas-tight or liquid-tight seal between said auxiliary reservoir and the concentration chamber (3) when said auxiliary reservoir (5) is received in said aperture in the concentration chamber (3).

Jenine Gillis

JUDGE WALTZ

APPEAL NO. 1998-2581

APPLICATION NO. 08/472,965

APJ WALTZ

APJ OWENS

APJ JEFFREY T. SMITH

DECISION: **REVERSED**

PREPARED: May 24, 2002

OB/HD

PALM

ACTS 2

DISK (FOIA)

REPORT

BOOK

GAU: 1700