



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/046,595	01/27/2005	Marsha R. Cohen	END920040082US1	5766
30449	7590	01/25/2013	EXAMINER	
SCHMEISER, OLSEN & WATTS			BADAWI, SHERIEF	
22 CENTURY HILL DRIVE			ART UNIT	PAPER NUMBER
SUITE 302			2167	
LATHAM, NY 12110			MAIL DATE	DELIVERY MODE
			01/25/2013	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARSHA R. COHEN, JEAN B. CRAIG,
JOHN M. HIGDON, PAUL J. KIRKWOOD,
TINA M. LEMIRE, ROSS A. MIKOSH,
TERRY D. PITTS, ANTHONY P. SCHERK,
and MARY LOUISE SNEDDEN

Appeal 2010-005091
Application 11/046,595
Technology Center 2100

Before DAVID M. KOHUT, JOHNNY A. KUMAR,
and LARRY J. HUME, *Administrative Patent Judges*.

KUMAR, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants have filed a Request for Rehearing under 37 C.F.R. § 41.52 (hereinafter “Req. for Reh’g”) on December 31, 2012, requesting that we reconsider our decision of October 31, 2012 (hereinafter “Decision”), wherein we affirmed the Examiner’s rejection of claims 3, 4, 6, 7, and 29-34.

Appellants contend that the Board overlooked the phrase “consists of” as recited in dependent claims 32-34. Req. for Reh’g 1-5.

We have reviewed our Decision in light of Appellants’ arguments, but are not persuaded that we overlooked this phrase in our Decision.¹

Appellants’ attention is directed to the Manual of Patent Examining Procedure (MPEP) Section 2111.03 which sets forth supporting legal authority that states:

The transitional phrases “comprising” . . . and “consisting of” define the scope of a claim with respect to what unrecited additional components or steps, if any, are excluded from the scope of the claim. . . .

. . . See also *In re Crish*, 393 F.3d 1253, 73USPQ2d 1364 (Fed. Cir. 2004) (The claims at issue “related to purified DNA molecules having promoter activity for the human involucrin gene (hINV).” *Id.*, 73USPQ2d at 1365. In determining the scope of applicant’s claims directed to “a purified oligonucleotide comprising at least a portion of the nucleotide sequence of SEQ IDNO:1 wherein said portion consists of the nucleotide sequence from ... to 2473 of SEQ ID NO:1, and wherein said portion of the nucleotide sequence of SEQ ID NO:1has promoter activity,” *the court stated that the use of “consists” in the body of the claims did not limit the open-ended “comprising” language in the claims* (emphases added). *Id.* at 1257, 73 USPQ2d at 1367. The court held that the claimed promoter sequence designated as SEQ ID NO:1 was obtained by sequencing the same prior art plasmid and was therefore anticipated by the prior art plasmid which necessarily possessed the same DNA sequence as the claimed

¹ Claim 32 depends from dependent claims 29 and 30 which further depend from independent claim 7. Claims 33-34 depend from claim 32. Independent claim 7 recites “A content searching method, *comprising...*” (emphasis added).

oligonucleotides. *Id.* at 1256 and 1259, 73 USPQ2d at 1366 and 1369. The court affirmed the Board’s interpretation that the transition phrase “consists” did not limit the claims to only the recited numbered nucleotide sequences of SEQ ID NO:1 and that “the transition language ‘comprising’ allowed the claims to cover the entire involucrin gene plus other portions of the plasmid, as long as the gene contained the specific portions of SEQ ID NO:1 recited by the claim[s]” *Id.* at 1256, 73 USPQ2d at 1366.

Thus, when the term “consists of” follows the term “comprising” in a claim, it is reasonable to interpret the term “consists of” as limiting subsequently named elements, while the earlier term “comprising” means that the claim can include the named elements plus other elements. *See In re Crish*, 393 F.3d 1253, 1254, 1257 (Fed. Cir. 2004).

In the instant case, consistent with *In re Crish*, and even though dependent claims 32-34 contain the limitation “consists of” in the body of the claim following the preamble limitation “comprising” in independent claim 7, claims 32-34 are not solely limited to “the displayable content” and “the searchable content” claimed, as argued by Appellants. Req. for Reh’g 2. Instead, dependent claims 32-34 were interpreted to require the particular content claimed, and may include any additional “displayable content” and “searchable content.” Since we agreed with the Examiner that the disclosed limitations were taught or suggested by the combination of Saito, Ferrel, and Babula, we do not find Appellants’ arguments to be persuasive. Decision 9.

Appeal 2010-005091
Application 11/046,595

CONCLUSION

We have granted Appellants' request for rehearing to the extent that we have reconsidered our Decision of October 31, 2012, but we deny the request with respect to making any changes thereto.

DECISION

The request for rehearing is denied.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REHEARING DENIED

msc