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BACON & THOMAS, PLLC			DESAI, RITA J	
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**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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* LUTZ HAALCK, ERK GEDIG, HANS-JUERGEN HOELPERT,  
and VIOLA PODSADLOWSKI

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Appeal 2010-002620  
Application 10/130,547  
Technology Center 1600

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Before DONALD E. ADAMS, JEFFREY N. FREDMAN, and  
STEPHEN WALSH, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

This appeal under 35 U.S.C. § 134 involves claims 104-116, the only claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

#### STATEMENT OF THE CASE

The claims are directed to a fluorescent dye. Claim 1 is representative and is reproduced in the “Claims appendix” of Appellants’ Brief.

The rejections presented by the Examiner follow:

1. Claims 104-115 stand rejected under 35 U.S.C § 103(a) as unpatentable over the combination of Waggoner,<sup>2</sup> the Abstract of Sumioka,<sup>3</sup> the Abstract of Matsubayashi,<sup>4</sup> and the Abstract of Maruyama.<sup>5</sup>
2. Claim 116 stands rejected under 35 U.S.C § 103(a) as unpatentable over the combination of Waggoner, the Abstract of Sumioka, the Abstract of Matsubayashi, and the Abstract of Maruyama, and Cohen.<sup>6</sup>

We reverse.

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<sup>2</sup> Waggoner et al., US 5,268,486, issued December 7, 1993.

<sup>3</sup> Sumioka et al., JP 09090562, published April 4, 1997, Translation No. PTO 09-5439.

<sup>4</sup> Tatsuro Matsubayashi et al., JP 08292589, published November 5, 1996, Translation No. PTO 09-5449 (the Examiner refers to this document as Tatsuro).

<sup>5</sup> Atsushi Maruyama et al., JP 08152729, published June 11, 1996, Translation No. PTO 09-5448 (the Examiner refers to this document as Atsushi).

<sup>6</sup> Cohen et al., WO 90/03383, published April 5, 1990.

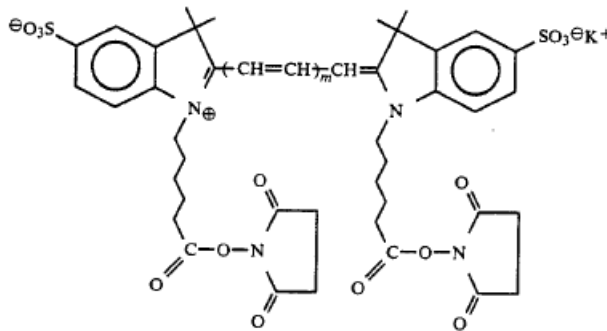
*The rejection of claims 104-115:*

### ISSUE

Does the combination of Waggoner, the Abstract of Sumioka, the Abstract of Matsubayashi, and the Abstract of Maruyama support the Examiner's conclusion of obviousness?

### ANALYSIS

The Examiner relies on Waggoner to teach a luminescent cyanine dye of the formula:



(Waggoner, col. 19, l. 53; Ans<sup>7</sup>. 5). Waggoner differs from the claimed invention in teaching a pyrrole ring substituted with a CH<sub>3</sub>-C-CH<sub>3</sub> group instead of a spiro ring (Ans. 5). In the Final Rejection the Examiner relies on the Caplus Abstracts of Sumioka, Matsubayashi, and Maruyama to make up for the deficiency in Waggoner (Final Rej<sup>8</sup>. 3; App. Br. 6 (“It [is] noted that the abstracts alone are relied upon in the rejection not the full disclosures”)).

Appellants appeal is from the Examiner's Final Rejection of claims 104-116 (*see* Notice of Appeal<sup>9</sup>). While the Examiner expressly states that

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<sup>7</sup> Mailed July 24, 2009 as amended by the Communication mailed August 12, 2009.

<sup>8</sup> Mailed April 3, 2007.

<sup>9</sup> Received July 3, 2007.

the Caplus Abstracts of Sumioka, Matsubayashi, and Maruyama are relied upon to support the rejection of record (Ans. 2 and 3), the Examiner's rejection in the Answer is not limited to the abstracts, but instead relies on the full disclosures of these references (*see* Ans. 6-11). The Examiner's reliance on the full disclosures of Sumioka, Matsubayashi, and Maruyama constitutes a new ground of rejection. The Examiner's Answer does not contain a statement that a new ground of rejection was entered into the record. Accordingly, the rejections relying on the full disclosures of Sumioka, Matsubayashi, and Maruyama are not properly before this panel. Therefore, we limit our review of this record to the rejection of Waggoner in combination with only the Abstracts of Sumioka, Matsubayashi, and Maruyama.

By relying on the full disclosures of Sumioka, Matsubayashi, and Maruyama the Examiner has tacitly conceded that the Abstracts of each of these references are not sufficient to support the rejection of Appellants' claimed invention. We agree. Accordingly, we reverse the rejection of Waggoner in combination with the Abstracts of each of Sumioka, Matsubayashi, and Maruyama.

#### CONCLUSION OF LAW

The combination of Waggoner, the Abstract of Sumioka, the Abstract of Matsubayashi, and the Abstract of Maruyama fails to support the Examiner's conclusion of obviousness. The rejection of claims 104-115 under 35 U.S.C § 103(a) as unpatentable over the combination of Waggoner, the Abstract of Sumioka, the Abstract of Matsubayashi, and the Abstract of Maruyama is reversed.

*The rejection of claim 116:*

### ISSUE

Does the combination of Waggoner, the Abstract of Sumioka, the Abstract of Matsubayashi, the Abstract of Maruyama, and Cohen support the Examiner's conclusion of obviousness?

### ANALYSIS

The Examiner relies on the combination of Waggoner, the Abstract of Sumioka, the Abstract of Matsubayashi, and the Abstract of Maruyama as discussed above (Ans. 12). The Examiner relies on Cohen to teach "using the phosphoramidite[] reactive group with the DNA. [ ]The compound used is acridine[], however the teaching is there to use the phosphoramidite[] as the fluor[e]scent markers reactive group" (*id.*). The Examiner fails to explain how Cohen is to be combined with the other references to reach the requirements of claim 116. In addition, the Examiner fails to identify a teaching in Cohen that makes up for the deficiencies in the combination of Waggoner, the Abstract of Sumioka, the Abstract of Matsubayashi, and the Abstract of Maruyama as discussed above.

### CONCLUSION OF LAW

The combination of Waggoner with the Abstract of Sumioka, the Abstract of Matsubayashi, the Abstract of Maruyama, and Cohen fails to support the Examiner's conclusion of obviousness. The rejection of claim 116 under 35 U.S.C § 103(a) as unpatentable over the combination of Waggoner, the Abstract of Sumioka, the Abstract of Matsubayashi, and the Abstract of Maruyama, and Cohen is reversed.

REVERSED

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Application 10/130,547

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