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EXAMINER

WRIGHT, PATRICIA KATHRYN

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte XUAN S. BUI, ANTHONY L. HARTMAN, TOSHIYUKI
FUJIMAKI, SHINJI TOKUDAIJI, YOSHITAKE OKABE, and
YOSHITADA MIZUSAWA

Appeal 2017-011629
Application 14/579,858
Technology Center 1700

Before ADRIENE LEPIANE HANLON, KAREN M. HASTINGS, and
MICHAEL G MCMANUS, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ seeks our review under 35 U.S.C. § 134(a) of the Examiner's final decision rejecting claim 1 under 35 U.S.C. § 102(b) as being anticipated by Spence et al. (US 2009/0298129 A1 published Dec. 3, 2009); claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Spence; and claim 3 under 35 U.S.C. § 103(a) as being as unpatentable over Spence

¹ Appellant is the Applicant, Sakura Finetek U.S.A., Inc., who is also stated to be the real party in interest (Appeal Br. 3).

in view of Dole (U.S. 4,978,502 issued Dec. 18, 1990)². We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

Claim 1 is illustrative of the appealed subject matter:

1. An apparatus comprising:

a reagent cartridge comprising a housing that defines a reagent retaining recess and a reagent directing channel, the reagent retaining recess is fluidly connected to a first sloped surface connecting the reagent retaining recess to an outlet channel extending from a bottom side of the housing, and the reagent directing channel comprises a first inclined portion and a second inclined portion connecting the reagent directing channel to the outlet channel, the second inclined portion extends from the first inclined portion at a substantially right angle, and in a direction toward the first sloped surface, such that the first sloped surface and the second inclined portion converge with one another at the outlet channel, and

wherein the reagent retaining recess comprises a sidewall and a ledge extending inwardly from the sidewall, wherein the ledge is dimensioned to support a reagent capsule removably positioned within the reagent retaining recess and fluidly couple the reagent capsule with the first sloped surface.

Appeal Br. 23 (Claims Appendix).

ANALYSIS

Appellant de facto argues that the Examiner has taken an unreasonably broad interpretation of the recited “reagent retaining recess and

² The Examiner withdrew the § 112 rejection for indefiniteness of claims 1–6 and 52–55 (Ans. 2).

reagent directing channel” (Appeal Br. 14, 15; Reply Br. 2–4), as well as the “first inclined portion” of the reagent directing channel and thus, has not shown how Spence identically discloses this feature (Appeal Br. 15, 16; Reply Br. 4, 5) as well as other features required by the claim (Briefs *generally*). A preponderance of the evidence supports Appellant’s position.

“[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.” *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1256 (Fed. Cir. 2007) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)); *see also In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (The scope of the claims in patent applications is not determined solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art.) (citations omitted); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (“[T]he specification ‘is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.’” (Citation omitted)) (*see, e.g.*, Appeal Br. 8, 9 for discussion of the claimed dielectric sidewall layers as set forth in the Specification).

The Examiner relies upon the structure of a “waste tray cover **1640**” of Spence (Spence ¶ 213; Figs. 30A, 30B) as describing all of the structural features of claim 1, and labels diagram Fig. 30B of Spence with the recited claim elements (Ans. 3; Final Act. 6).

Appellant urges that one of ordinary skill in the art would not consider this waste tray cover “a reagent cartridge comprising a housing that defines a reagent containing recess and a reagent directing channel” and that the

Examiner's labels are not in line with numerous other features as required by the claims (e.g., Appeal Br. 14–17). Appellant's Specification's description of the claimed “first sloped surface”, the “first inclined portion” and the “second inclined portion” structure is discussed in the Appeal Brief in the argument concerning the Examiner's now withdrawn §112 rejection (Appeal Br. 9–12; Spec. ¶¶ 93, 94, Figs. 7, 8; Ans. 2). Appellant argues the Examiner has not established that Spence describes all these features in the same way as recited in claim 1 (Appeal Br.; Reply Br. *generally*). For example, Appellant points out that the vertical top portion of channel 1616 of Spence cannot reasonably be considered “a first inclined portion” as required by the claims, because it has not been shown to deviate from the vertical orientation (Appeal Br. 15, 16).

The Examiner has not adequately explained how one of ordinary skill would have reasonably considered Spence's first sloped surface, and first inclined portion, as labeled by the Examiner (Ans. 3) to be encompassed by the language of claim 1 (Ans. *generally*). Thus, for example only, Spence's labeled “first inclined portion” as labeled by the Examiner falls short of being “a first inclined portion” of the reagent directing channel as required by the claims. Therefore, we agree with Appellant that the Examiner has taken an unreasonably broad interpretation of the aforementioned claim limitations when considered in light of the Specification for the reasons explained in the Briefs and, in doing so, erred in finding that Spence discloses the claimed subject matter. As such, we cannot sustain the anticipation rejection. *See also, Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008) (If a reference does not disclose “not only all of the limitations claimed but also all of the limitations arranged or

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combined in the same way as recited in the claim”, it cannot anticipate under 35 U.S.C. § 102).

Accordingly, we reverse the Examiner’s 35 U.S.C. § 102 rejection of claim 1. Since the Examiner does not rely upon any other reasoning and/or reference to cure these deficiencies, the § 103 rejections of claims 2 and 3 are also reversed.

DECISION

The Examiner’s decision is reversed.

ORDER

REVERSED