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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* ROBERT KINCAID and MELANIE TORY

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Appeal 2018-002635  
Application 13/918,572  
Technology Center 2600

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Before JOSEPH L. DIXON, ALLEN R. MACDONALD, and  
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the  
Examiner's decision to reject claims 1, 7–15, and 17–20. *See* Final Act. 1.

We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Agilent Technologies, Inc. Appeal Br. 1.

### CLAIMED SUBJECT MATTER

The claims are directed to a system for automating laboratory experiments. Claim 1, reproduced below, is representative of the claimed subject matter:

1. An apparatus comprising:

a controller and

a top planar surface comprising a display area and a first component area adapted to receive a first component, said display area displaying an image determined by said controller, said image providing information about said first component, wherein said controller determines said image by interacting with said first component when said first component is placed in said first component area,

wherein said planar surface comprises a touch enabled computer display screen and said controller determines an identity for said first component based on a touch pattern on said touch enabled computer display screen, said touch pattern being generated by said first component touching said touch enabled computer display screen at a plurality of locations on said touch enabled computer display screen

### REFERENCES

The prior art relied upon by the Examiner is:

Curtis	US 2003/0107738 A1	June 12, 2003
Du	US 2005/0102056 A1	May 12, 2005
Zhang et al.	US 2005/0112033 A1	May 26, 2005
Gu et al.	US 2011/0290882 A1	Dec. 1, 2011
Pradeep	US 2012/0219980 A1	Aug. 30, 2012
Andolina	US 2013/0194192 A1	Aug. 1, 2013
Feldotte	WO 2012/104034 A1 <sup>2</sup>	Aug. 9, 2012

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<sup>2</sup> Please note US 2013/0333957 A1 “Weighing Compartment with Integrated Balance” is used herein as an English translation document, and passages of Feldotte cited herein refer to the translation, consistent with the Examiner’s and Appellant’s usage.

## REJECTIONS

Claims 1, 7, 13, and 17 stand rejected under pre-AIA U.S.C. § 103(a) as being un-patentable over Du in view of Andolina.

Claims 8, 14, 15, and 20 stand rejected under pre-AIA U.S.C. § 103(a) as being un-patentable over Du and Andolina further, in view of Pradeep.

Claims 9 and 10 stand rejected under pre-AIA U.S.C. § 103(a) as being un-patentable over Du and Andolina, and, further, in view of Zhang.

Claim 11 stands rejected under pre-AIA U.S.C. § 103(a) as being un-patentable over Du, in view of Andolina in view of Zhang and, further, in view of Curtis.

Claim 12 stands rejected under pre-AIA U.S.C. § 103(a) as being un-patentable over Du and Andolina further in view of Gu.

Claims 18 and 19 stand rejected under pre-AIA U.S.C. § 103(a) as being un-patentable over Du and Andolina in view of Feldotte and, further, in view of Pradeep.

## OPINION

*35 U.S.C. §103*

### *Claim 1*

Appellant contends the Examiner errs that one skilled in the art “would be motivated to replace display 18 shown in Figure 2 of Du with the touch-enabled display of Andolina, because the computer could identify the display component placed in area 26.” (Appeal Br. 6.) Appellant further contends that the “Examiner’s argument assumes that the computer does not already know the identity of that component that is placed in area 26.”

(Appeal Br. 6.)

Appellant further argues that “the Examiner does not explain how getting the identity of the object from the object, as opposed to getting that identity from information inputted by the user, which would include other information as well, is worth altering the mode of operation of the system of Du.” (Appeal Br. 6.)

Appellant contends that “the Examiner is confusing the mode of operation of the device with the measurements to be provided by the device.” (Appeal Br. 6.) Appellant also contends that “Examiner has not pointed to any teaching that such ink could be applied to the plastics used in micro-titer plates and still maintain the charge” and “[i]t should also be noted that the plates would need to be printed after manufacture and sterilization but before use without contaminating the plates in a manner that would alter the assays performed in the plates.” (Appeal Br. 7.)

Appellant argues that “[t]he electrically charged ink would need to remain charged throughout the experiment and not attract neutralizing charges from the environment that would render the charged ink invisible.” (Appeal Br. 7.)

Appellant contends that “the alteration of Du suggested by the Examiner would not have a reasonable expectation of success or of providing the benefits claimed by the Examiner.” (Appeal Br. 7.)

Arguments must be commensurate in scope with the actual claim language. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982); see *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998) (“[The] proffered facts . . . are not commensurate with the claim scope and are therefore unpersuasive.”).

“The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference . . . .” *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). Instead, the

relevant issue is “what the combined teachings of the references would have suggested to those of ordinary skill in the art.” *Id.* “Combining the *teachings* of references does not involve an ability to combine their specific structures.” *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973); *see also In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012) (“It is well-established that a determination of obviousness based on teachings from multiple references does not require an actual, physical substitution of elements.”).

The Examiner maintains that

the proposed changes to Du’s apparatus comprise modifying [the] display panel and associated software to incorporate the touch-related features and functionality of Andolina’s touch screen such that an object/component may be “identified” when the component is placed on Du/Andolina’s touch screen, with the expected benefit of improving the accuracy of ‘identifying’ the component since a user is not required to manually enter text and/or a numeric code to establish the identity of the component.

(Ans. 4–5.)

Appellant contends that the combination of the Du and Andolina references would change the basic mode of operation of the system of Du.

(Appeal Br. 5.)

The Examiner maintains that “modifying Du with Andolina’s touch screen does not change the fact that a user may still interact with the combined Du/Andolina apparatus/system to manually input information in order to edit sampling protocols.” (Ans. 5.)

We note claim terms are to be given their broadest reasonable interpretation, as understood by those of ordinary skill in the art and taking into account whatever enlightenment may be had from the Specification. *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). “In the patentability context, claims are to be given their broadest reasonable interpretations . . .

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limitations are not to be read into the claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citations omitted).

We disagree with Appellant and find that under the broadest reasonable interpretation, the claimed invention is not specifically limited to chemical/sample analysis as argued by Appellant. We further find the intended field of use in chemical/sample analysis does not change the principle of operation of the display and touch sensitive system. Although the combination may have some impact on the end use of the system, we find the claimed generic “apparatus” is not directed to any specific intended field of use and the claimed “first component” has no specific characteristics so as to further limit the claimed invention. Therefore, we find Appellant’s argument regarding the combination of prior art teachings to be unavailing.

Appellant argues that the Examiner has not pointed to any teaching that the conductive ink could be applied to the plastics used in the micro-titer plates and still maintain the charge and there would be no reasonable expectation of success. (Appeal Br. 6–7.)

The Examiner maintains that Appellant’s argument is not commensurate in scope with the language of independent claim 1. (Ans. 5–6.) We agree with the Examiner that Appellant’s argument is based upon limitations not expressly found in the claimed invention, and Appellant is arguing a bodily incorporation of the two teachings rather than what would have been suggested to one of ordinary skill in the art at the time of the invention. Consequently, we find Appellant’s argument to be unpersuasive of error in the Examiner’s factual findings or conclusion of obviousness of independent claim 1.

In the Reply Brief, Appellant contends that the Examiner fails to address why one of ordinary skill would make the alterations to the system

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of the Du reference to arrive at a device that satisfies the claims of the present application. (Reply Br. 1.) Additionally, Appellant contends that if the system did not know the identity of the plate, the system could not generate the image because the Du reference utilizes protocols in which the user is instructed to perform an operation on one particular cell in a plate where the system must know the type of plate and layout in advance as well as the identity of the plate using information is entered when the user edits the profile for the procedure. (Reply Br. 2.) Appellant also contends that proposed modifications must have a reasonable expectation of success independent of the claim limitations. (Reply Br. 2.)

We disagree with Appellant and find the Examiner has shown a reasonable expectation of success of the combined disclosures and suggestions of the prior art teachings to the general field of touch enabled computer screens and controllers. Moreover, we find Appellant's argument with respect to the reasonable expectation of success does not have a nexus to the claimed scope of the invention. We further find Appellant's argument is based upon a bodily incorporation of the prior art teachings rather than what would be suggested to the skilled artisan relative to the scope of the claimed invention.

Appellant also contends that "the modifications to Du suggested by the Examiner would lead to a device that does not function for the purposes of Du, because the charged surface would be discharged during the experiment, and hence, no longer readable." (Reply Br. 2.)

We disagree with Appellant, as discussed above, and find that the general teachings of the Du reference are readily combinable with the teachings of the Andolina reference. Moreover, we find Appellant's arguments are directed to a bodily incorporation of the Du reference to the

specific implementation and use, but the claimed invention is directed to a broader application of the general teachings and suggestions of the prior art references. Therefore, we agree with the Examiner that a person of ordinary skill in the art would have combined the teachings and suggestions of the Du and Andolina references “with the expected benefit of quickly and accurately identifying a sample component since said sample component may be identified using attached barcode information.” (Final Act. 5.) Therefore, we find Appellant’s argument to be unpersuasive of error in the conclusion of obviousness.

*Claim 17*

For claim 17, Appellant provides general arguments that correspond to the arguments advanced with respect to independent claim 1. (Appeal Br. 7–8.) Additionally, Appellant contends that while the Du reference integrates “multiple displays and multiple computers into a work station, Du is silent with respect to how that integrated system is laid out,” and the description in the Du reference “does not teach that the two adapters are independent of each other and that there is a controller that interacts with the two adapters and places the images in the display areas.” (Appeal Br. 8.)

The Examiner maintains, rather, that “[a] plurality of computers and a plurality of display panels can be integrated into a single sample handling system. Sample handling control menu 20 can be either displayed on the same panel as the sample container image 26 or on a separated display panel.” (Ans. 9 (citing Du ¶ 98).) We agree with the Examiner that the Du reference teaches and suggests the combination of plural panels with either a single or separate controllers. Therefore, we find Appellant’s argument to

be unavailing to show error in the Examiner's factual findings or conclusion of obviousness of independent claim 17.

Appellant contends that with the modification of the Du reference, the proposed system operates in a different manner than that of Du and that there is no reasonable expectation of success. (Appeal Br. 7.) We disagree with Appellant, as discussed above. As a result, we find Appellant's argument to be unavailing to show error in the Examiner's factual findings or conclusion of obviousness of independent claim 17.

*Claims 8–11, 14–15 and 20*

With respect to the dependent claims, Appellant relies upon the arguments advanced with respect to independent claims 1 and 17, and Appellant contends that the additional prior art references do not provide the missing teachings in the respective independent claims. Because we found no deficiency in the base combination, we find Appellant's argument to be unpersuasive to show error in the Examiner's conclusion of obviousness of the dependent claims.

*Claims 12, 18, and 19*

With respect to dependent claim 12, Appellant contends the combination of Du and Andolina does not teach the limitations of claim 1 and the Gu reference does not provide the missing teachings. (Appeal Br. 9.) Appellant further contends that the "Examiner's argument assumes that a QR code printed in electrically conducting ink can be read via the touch-enabled screen with sufficient accuracy to detect the code and determine its location and orientation," and Appellant contends that the "Examiner has not

cited any evidence that the touch-enabled screens have that level of resolution.” (Appeal Br. 10.)

The Examiner maintains that Appellant is arguing the references individually and that “a person of ordinary skill in the art may either print directly or affix a QR code onto a first component in a pre-determined location and orientation (i.e. upper-left corner, oriented substantially in a horizontal direction).” (Ans. 12.) The Examiner further maintains that the Gu reference “expressly discloses the input device may be a touch-enabled device” (*see* Gu Figure 14 and para. 96), “therein leading one of ordinary skill in the art to reasonably conclude a QR code printed in electrically conducting ink can be read via the touch-enabled screen with sufficient accuracy to detect the code and determine its location and orientation.” (Ans. 13.) We agree with the Examiner and conclude that the disclosed input device would have had the ability to read the code and was within the level of skill in the art and that the claim sets forth no physical dimensions or characteristics that would prevent proper operation of the combined teachings. Additionally, Appellant has not provided a specific argument for patentability or provided any reason why it would not have been within the ability of the input device in the combination to perform the function as proffered by the Examiner. Moreover, Appellant has not provided further argument in the Reply Brief in response to the Examiner’s further clarifications of the obviousness rejection in the Examiner’s Answer. As a result, we find Appellant’s argument does not show error in the Examiner’s factual findings or conclusion of obviousness of dependent claim 12.

With respect to dependent claim 18, Appellant contends that someone knowing the apparatus of Du would not “be motivated to search the art area

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of Feldotte to improve the apparatus of Du,” and the “Examiner has not provided any factually articulated reasoning for someone of ordinary skill to search the art area of Feldotte.” (Reply Br. 3.)

We disagree with Appellant and find that the Feldotte reference discloses a well-known alternative in display devices to use a well-known projector in place of a physical display device (Feldotte paragraphs 8 and 11) rather than other physical display devices. We note that the broadest reasonable interpretation of independent claim 17 merely recites a “display area” and the Feldotte reference discloses the use of both known alternatives. The Examiner further maintains that Appellant is arguing limitations not in the claims. (Ans. 17.) As a result, we agree with the Examiner and find Appellant’s argument to be unpersuasive of error in the Examiner’s factual findings or conclusion of obviousness of dependent claim 18.

With respect to dependent claim 19, Appellant argues “the camera, as placed in the reference, could not form an image of the underside of the adapters, which the Examiner identifies as the work surface.” (Appeal Br. 11.) Appellant provides further argument that the Examiner is overgeneralizing the fields of measurements of substances. (Reply Br. 3.)

The Examiner substantively responds to Appellant’s general argument and clarifies the application of the prior art in combination. (Ans. 18.) We disagree with Appellant’s argument regarding the fields of measurement and processing and find Appellant’s argument is not commensurate in scope with the broad language directed to the generic “system” recited in the language of independent claim 17 and further limited in dependent claims 18 and 19 setting forth the generic limitations. As a result, we find the Examiner’s reliance upon the general teachings and suggestions in the prior

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art references to be reasonable in light of the broad field of endeavor of the claimed invention. Therefore, we find Appellant's argument does not show error in the Examiner's factual findings or conclusion of obviousness of dependent claim 19.

### CONCLUSION

The Examiner's obviousness rejections are affirmed.

### DECISION SUMMARY

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 7, 13, 17	103	Du, Andolina	1, 7, 13, 17	
8, 14, 15, 20	103	Du, Andolina, Pradeep	8, 14, 15, 20	
9, 10	103	Du, Andolina, Zhang	9, 10	
11	103	Du, Andolina, Zhang, Curtis	11	
12	103	Du, Andolina, Gu	12	
18, 19	103	Du, Andolina, Feldotte, Pradeep	18, 19	
<b>Overall Outcome:</b>			1, 7-15, 17-20	

### TIME PERIOD FOR RESPONSE

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

AFFIRMED