UNITED STATES PATENT AND TRADEMARK OFFICE

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

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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 ALEXANDER GAIDUK, DOMINIK STEHR, BENNO RADT,
WOLD JOCKUSCH, ENRICO GEISSLER, JOHANNES WINTEROT,
MARKUS GNAUCK, JOHANNES KNOBLICH, and MAX FUNCK

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Appeal 2018-006971
Application 14/255,914
Technology Center 2400

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Before CAROLYN D. THOMAS, CARL W. WHITEHEAD JR, and
MICHAEL J. STRAUSS, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant[1] appeals from the
Examiner's decision to reject claims 1–10, 12, 14–18. We have jurisdiction
over the appeal under 35 U.S.C. § 6(b). An Oral Hearing was held on
February 25, 2020.

We AFFIRM.

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[1] 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 Carl Zeiss
Microscopy GMBH. Appeal Br. 3.

The present invention relates generally to a digital microscope. *See* Spec., Abstract.

Claim 1 is illustrative:

> 1.   A digital microscope comprising:
> an optics unit and a digital image processing unit, which are arranged on a swiveling microscope stand;
> a microscope image sensor for capturing an image of a sample to be arranged on a sample table;
> at least one first monitoring sensor for observing an overview image, wherein the overview image comprises an image of the sample, and either the sample table, the optics unit or a user; and
> a monitoring unit, wherein, in the monitoring unit, data of the monitoring sensor are evaluated in an automated manner and used for automated control of the digital microscope; and
> wherein, in the monitoring unit, user input is received to identify areas in the overview image and to select a desired magnification to automatically move the sample table and automatically adjust the optics unit to capture the microscopic image of the sample in response to the input.

Appellant appeals the following rejections:

Claims 1–10, 12, and 14–18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over (at least) Douglass (US 2007/0206843 A1, Sept. 6, 2007) and Kiyota (US 2013/0027539 A1, Jan. 31, 2013) in combination with various other prior art. *See* Final Act. 2–7.

We review the appealed rejections for error based upon the issues identified by Appellant, and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential).

ANALYSIS

Appellant contends that the combined teachings of Douglass and Kiyota does not teach "*receiving user input to* identify areas in the overview image . . . and select a desired magnification." Appeal Br. 10–11. Appellant further contends that "[b]y Douglass' own admission, 'the present invention provides a method and apparatus for *automated* cell analysis *which eliminates the need for operator input* to locate cell objects for analysis.'" *Id.* at 10. Additionally, Appellant contends that "the Examiner only cites Kiyota to render obvious the claimed monitoring sensor for observing an image of the sample" (*Id.* at 11) and "the Examiner cites Pittsyn and Ledley for allegedly teaching additional features." *Id.* at 12.

In other words, Appellant contends that the Examiner primarily relies upon Douglass to teach or suggest "*receiving user input to* identify areas in the overview image . . . and select a desired magnification" and Douglass is silent about receiving user input for such claimed features. Appellant's argument in the Appeal Brief emphasizes the invention's need for operator input and how Douglass "*eliminates the need for operator input*." *See* Appeal Br. 10. As a result, our analysis is directed to this specific *highlighted* language.

In response, the Examiner finds, and we agree, that both Douglass and Kiyota teaches *receiving user input to* identify areas and to select magnification. *See* Ans. 7–8.

For example, Douglass discloses:

The operator can specify the size, shape and location of the area to be scanned or alternatively, the system can automatically locate this area. The operator then commands the system to begin automated scanning of the slides through a graphical user interface. Unattended scanning

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begins with the automatic loading of the first carrier and slide onto the precision motorized X-Y stage **38**.

¶ 48.

Each slide is then scanned at a user selected low microscope magnification, for example, 10x, to identify candidates cells based on their color, size and shape characteristics.

¶ 49.

In other words, Douglass discloses a user specifying the location of the area to be scanned and selects a low microscope magnification to scan the slide. As such, we find unavailing Appellant's contention that Douglass "is silent with respect to *receiving user input to*" given the aforementioned disclosure in Douglass.

Similarly, Kiyota discloses:

Further, the CPU **51** displays a magnification change button **58**b^1*,* in the vicinity of the micro live image **58***b* on the display **58**. The magnification change button **58**b^1 is a button with which the user inputs an instruction of changing the observation magnification, into the computer **50**.

¶ 98.

Note that when the user selects a partial area which is not highlighted on the tiling fluorescence image **58***d*, it is possible to cancel the designation of the extraction target candidate at the present moment, and to designate the selected partial area as a new extraction target candidate.

¶ 104. In other words, like Douglass, Kiyota also teaches user input to identify areas and to select a desired magnification. As such we have cumulative teachings of the argued limitations, i.e., Kiyota's teachings are not necessary.

As a result, we find unavailing Appellant's contention that Douglass and/or Kiyota fails to teach or suggest *user input is received to identify areas in the overview image and to select a desired magnification*, as recited in independent claims 1 and 7. We note that independent claim 18 does not include any *user input* limitation, as such Appellant's unpersuasive arguments *supra* do not relate to claim 18, and no separate argument were made regarding claim 18.

Accordingly, we sustain the Examiner's rejection of representative claim 1. Appellant's arguments regarding the Examiner's rejection of independent claims 7 and 18 rely on the same arguments as for claim 1, and Appellant does not argue separate patentability for the dependent claims. We, therefore, also sustain the Examiner's rejection of claims 2–10, 12, and 14–18.

New Argument in Reply Brief

Appellant newly contends: "Assuming *arguendo*, that Douglass teaches this manual input, Douglass does not teach selecting a desired magnification to ***automatically move the sample table*** and ***automatically adjust the optics unit*** to capture the microscopic image of the sample ***in response to the input***. Reply Br. 2. Here, Appellant argues different features of the claims, i.e., automatically moving/adjusting.

The Examiner's statement of rejection for claim 1 in the Answer appears to be substantially the same as, if not identical to, the statement of the rejection in the Final Rejection. *See* Final Act. 2–3; Ans. 7. The Examiner merely adds cumulative teachings from Kiyota, which Appellant fails to rebut. Ans. 7. Appellant thus could have presented the new argument regarding automatically moving/adjusting in support of claim 1 in

the Appeal Brief, such that we would have had benefit of the Examiner's evaluation of the argument in the responsive Answer. Appellant does not explain what good cause there might be to consider the new argument. Appellant's new argument is thus untimely and has, accordingly, not been considered. *See Ex parte Borden*, 93 USPQ2d 1473 (BPAI 2010) (informative).

CONCLUSION

The Examiner's rejections of claims 1–10, 12, and 14–18 as being unpatentable under 35 U.S.C. § 103 over at least Douglass and Kiyota is affirmed.

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–10, 12, 14–18	103	(at least) Douglass, Kiyota	1–10, 12, 14–18	

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

AFFIRMED