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| 13/418,016   | 03/12/2012  | Milton L. Lee        | 4941.BYU.NP            | 1019             |
| 26986  | 7590        | 09/26/2019           | EXAMINER               |                  |
| MORRIS OBRYANT COMPAGNI CANNON, PLLC<br>4505 S WASATCH BLVD, SUITE 270<br>SALT LAKE CITY, UT 84124 |             |                      | FAYYAZ, NASHMIYA SAQIB |                  |
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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* MILTON L. LEE, XIAOFENG XIE, JACOLIN A. MURRAY,  
JESSE A. CONTRERAS, TAI VAN TRUONG, and H. DENNIS TOLLEY<sup>1</sup>

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Appeal 2018-009089  
Application 13/418,016  
Technology Center 2800

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Before CATHERINE Q. TIMM, JEFFREY T. SMITH, and  
JAMES C. HOUSEL, *Administrative Patent Judges*.

PER CURIAM.

DECISION ON APPEAL

This decides an appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection under 35 U.S.C. § 103 of claims 1, 3–19 and 25–28<sup>2</sup> as obvious over *Oborny* (US 7,399,449 B1, issued Jul. 15, 2008) in view of *Pawliszyn* (US 2001/0032521 A1, published Oct. 25, 2001).<sup>3</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

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<sup>1</sup> Appellant identifies Brigham Young University as the real party in interest.

<sup>2</sup> Which constitute all the claims pending in this application.

<sup>3</sup> The complete statement of the rejection on appeal appears in the Final Office Action. (App. Br. 5; Final Act. 4–6).

Appellant's invention is generally directed to a system for calibration of a gas chromatograph-mass spectrometer. (Spec. ¶ 2.) Claim 1 illustrates the subject matter on appeal and is reproduced below:

1. A method for creating a standard vapor sample from a non-liquid sample source in a closed container, said method comprising the steps of:

providing non-liquid calibration analytes in a calibrant reservoir;

disposing the calibrant reservoir in a sample vial where no liquid is present such that there is a headspace volume above the calibrant reservoir;

allowing thermodynamic equilibrium to be established between the non-liquid calibration analytes in the calibrant reservoir and headspace vapor in the sample vial, wherein the sample vial is closed to create the thermodynamic equilibrium;

extracting a calibration sample from the headspace vapor using solid phase microextraction (SPME), wherein the calibration sample is suitable for gas chromatograph (GC) and mass spectrometer (MS) calibration.

#### OPINION

We review the appealed rejection for error based upon the issues identified by Appellant and in light of the arguments and evidence produced thereon. *See* 37 C.F.R. § 41.37(c)(iv) (2017) (“The arguments shall explain why the examiner erred as to each ground of rejection contested by appellant.”); *see also Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential), *cited with approval in In re Jung*, 637 F.3d 1356, 1365 (Fed.

Cir. 2011) (“[I]t has long been the Board’s practice to require an applicant to identify the alleged error in the examiner’s rejections.”).

Claims 1, 3–7, 9–19 and 25–27

After consideration of the respective positions advanced by the Examiner and Appellant in light of this appeal record, we affirm the Examiner’s rejection of claims 1, 3–7, 9–19 and 25–27 for the reasons set forth in the Answer to the Appeal Brief and Final Office Action appealed from, which we adopt as our own.

Appellant’s Brief summarizes the prosecution history including referencing the April 14, 2017 Final Office Action from which this appeal is taken. However, Appellant, in the Brief<sup>4</sup> dated March 16, 2018, fails to provide arguments addressing the April 14, 2017 final rejection.<sup>5</sup> That is, Appellant in the Brief does not present arguments addressing the rejection over the combination of Oborny and Pawlisyn. (Br. generally.) Although Appellant recognizes the appealed claims were rejected as obvious over the combination of Oborny and Pawlisyn (Br. 5 and 14.), Appellant has failed to present arguments identifying error in the Examiner’s final rejection from which this appeal arises. Thus, Appellant has not identified a reversible

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<sup>4</sup> Appellant’s Brief does not include page numbering. We will refer to the Appeal Brief as though it were consecutively numbered beginning with the title page “APPEAL BRIEF” as page 1.

<sup>5</sup> The Examiner in the Final Rejection, in response to Appellant’s amendments, entered a new ground of rejection over the combination of Oborny and Pawliszyn. (Final Act. 7).

error in the Examiner's rejection of claims 1, 3-7, 9-19 and 25-27 as obvious over Oborny in view of Pawlisyn.

Claims 8 and 28

The Examiner in the Final Office Action determined Oborny, col. 8, lines 36-43, describes the subject matter of claims 8 and 28. (Final Act. 6.) The Examiner has maintained this position throughout the prosecution.

Claims 8 and 28 require a granular form of heat-conditioned polydimethylsiloxane (PDMS). The portions of Oborny identified by the Examiner fail to disclose the PDMS as "a granular form of heat-conditioned" PDMS. (Oborny col. 8.) The Examiner has not identified other portions of the cited prior art for describing this feature. Consequently, we are constrained to reverse the rejection of claims 8 and 28.

#### DECISION

The Examiner's rejection is affirmed-in-part.

#### DECISION SUMMARY

| <b>Claims Rejected</b> | <b>Basis</b>                  | <b>Affirmed</b>        | <b>Reversed</b> |
|------------------------|-------------------------------|------------------------|-----------------|
| 1, 3-19 and 25-28      | § 103(a) Oborny and Pawliszyn | 1, 3-7, 9-19 and 25-28 | 8, 28           |

#### FINALITY AND 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).

Appeal 2018-009089  
Application 13/418,016

AFFIRMED-IN-PART