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Quest Diagnostics Attn: Legal Department 33608 Ortega Highway San Juan Capistrano, CA 92675			FRITCHMAN, REBECCA M	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte QIBO JIANG, SUM CHAN, and RICHARD E. REITZ

Appeal 2019-004698
Application 14/991,987
Technology Center 1700

Before KAREN M. HASTINGS, LILAN REN, and
MERRELL C. CASHION, JR., *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ requests our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1–12 under 35 U.S.C. § 103(a) as being unpatentable over the combined prior art of Midttun (Øivind Midttun et al., *Multianalyte Quantification of Vitamin B₆ and B₂ Species in the Nanomolar Range in Human Plasma by Liquid Chromatography—Tandem Mass Spectrometry*, 51 *Clinical Chemistry* 7, 1206–16 (2005) (“Midttun”)) and Guzzetta (Andrew Guzzetta, *Reverse Phase HPLC Basics for LC/MX, IonSource Tutorial* (July 22, 2001), <https://ionsource.com/tutorial/>

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as Quest Diagnostics Investments Incorporated (Appeal Br. 1).

chromatography/rphplc.htm (last viewed June 15, 2020)).² We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

CLAIMED SUBJECT MATTER

Claim 1 is illustrative of the subject matter on appeal (emphasis added to highlight key limitation in dispute):

1. A method for detecting the presence or amount of pyridoxal 5'-phosphate in a body fluid sample by tandem mass spectrometry, comprising:

(i) purifying said sample with *an extraction column* and an analytical column for chromatographic separation;

(ii) generating a parent ion of said pyridoxal 5'-phosphate from said purified sample;

(iii) generating one or more daughter ions of said parent ion; and

(iv) detecting the presence or amount of one or more said ions generated in step (ii) or step (iii) or both, and relating the detected ions to the presence or amount of said pyridoxal 5'-phosphate in said sample.

(Appeal Br. 15, Claims Appendix).

Appellant's arguments are directed to the meaning of the italicized phrase in claim 1 (Appeal Br. 12, 13; Reply Br. 2–4). Accordingly, we decide the appeal on the basis of the arguments made in support of patentability of claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2017).

² The Examiner withdrew the rejection under 35 U.S.C. § 101 (Ans. 6).

ANALYSIS

After considering the evidence presented in this Appeal and each of Appellant's arguments, we are not persuaded that Appellant identifies reversible error. 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), 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.”). We sustain the Examiner’s rejection for the reasons expressed in the Final Office Action and the Answer.

We add the following primarily for emphasis.

Appellant does not dispute most of the Examiner’s findings based on Midttun and Guzzetta (Final Act. 4–7). The Examiner relies upon Midttun for a teaching of an extraction column and an analytical column as recited in claim 1 (Final Act. 4, 5; Ans. 4).

Appellant makes three main arguments: 1) the method of Midttun is laborious and time consuming compared to the method of the present invention (Appeal Br. 13); 2) Midttun does not use an extraction column as does the presently claimed method (*id.*); and 3) the Examiner is mistaken that Midttun’s C8 guard column is an extraction column because it “is part of the analytical HPLC column” of Midttun (Reply Br. 4).

With respect to Appellant’s first argument, the Examiner counters that there is nothing in the claim about the efficiency or accuracy of the method recited (Ans. 7). Limitations not appearing in the claims cannot be relied upon for patentability. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

With respect to Appellant’s arguments listed as 2) and 3) above, it is well established that “the PTO must give claims their broadest reasonable construction consistent with the specification. . . . Therefore, we look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation.” *In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (also noting that “as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee”); *see also Alloc, Inc. v. Int’l Trade Comm’n*, 342 F.3d 1361, 1370 (Fed. Cir. 2003) (A court must not read particular embodiments and examples appearing in the Specification into the claims unless the Specification requires it.).

Notably, Appellant’s Specification lacks any limiting definition of an “extraction column” (*see generally* Spec.; *see also, e.g.*, Spec. ¶ 17 (disclosing a large particle extraction column, for use “[i]n preferred embodiments”), ¶ 18). As pointed out by the Examiner, Midttun explicitly discusses two columns, a guard column, with 5 µm particle size, and an analytical column, with 3.5 µm particle size (Ans. 8; Midttun p. 1209). Guard columns are known to remove impurities before the sample reaches the analytical column (Ans. 8). Appellant has not provided any evidence to support the assertion that the guard column is not an extraction column. Thus, the Examiner reasonably determined that the claim recitation “an extraction column and an analytical column” encompasses the use of Midttun’s C8 guard/extraction column and C8 analytical column (*id.*).

Therefore, Appellant has not demonstrated reversible error in the Examiner’s determination that the disputed claim term encompasses the guard column of Midttun.

Accordingly, we sustain the Examiner's rejection of independent claims 1, as well as all claims dependent thereon, noting that Appellant relies upon the arguments made for claim 1 for all the other claims.

The decision of the Examiner is affirmed.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1-12	103(a)	Midttun, Guzzetta	1-12	

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

AFFIRMED