

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENNETH F. UFFENHEIMER

Appeal No. 95-1860
Application 07/988,074¹

ON BRIEF

Before THOMAS, HAIRSTON and FLEMING, ***Administrative Patent Judges.***

FLEMING, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is a decision on appeal from the final rejection of
claims 2, 7, 9, 11, 19, 27, 30, 35 and 43. However, the Examiner

¹Application for patent filed December 09, 1992. According to
appellant, this application is a divisional of application no. 07/671,713,
filed April 4, 1991, now U.S. Patent No. 5,201,232, issued April 13, 1993.

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only maintains the rejection of claims 2, 7, 9, 11 and 19 in the Examiner's answer.

The invention relates to an apparatus and method for integrated sampling from both closed and open sample liquid containers through use of the same sample liquid analysis system sampling probe.

The independent claim 2 is reproduced as follows:

2. In sample liquid container support apparatus for use in a sampler, the improvements comprising, said support apparatus comprising, a plurality of sample liquid container mounting means each of which is operable to mount either a closed sample liquid container or an open sample liquid container, and means on said support apparatus for operatively connecting said support apparatus to a sampler for use in said sampler.

The Examiner relies on the following references:

Jones	3,897,216	Jul. 29, 1975
Bradley et al.	4,478,095	Oct. 23, 1984

Claims 2, 7, 9 and 11 stand rejected under 35 U.S.C. § 102 as being anticipated by Jones or in the alternative under 35 U.S.C. § 103 as being unpatentable over Jones. Claims 2, 7, 9 and 19 stand rejected under 35 U.S.C. § 102 as being anticipated by Bradley or in the alternative under 35 U.S.C. § 103 as being unpatentable over Bradley.

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Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the brief and answer for the respective details thereof.

OPINION

We will not sustain the rejections of claims 2, 7, 9, 11 and 19 under 35 U.S.C. §§ 102 or 103.

It is axiomatic that anticipation of a claim under §102 can be found only if the prior art reference discloses every element of the claim. **See *In re King***, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and ***Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.***, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

Appellant argues in the brief that neither Jones nor Bradley teaches "a plurality of sample liquid container mounting means each of which is operable to mount either a closed sample liquid container or an open sample liquid container" as recited in Appellant's claim 2. On page 7 of the brief, Appellant argues that Jones teaches a sample liquid container mounting means operable to mount an open sample liquid container but not a closed sample liquid container. On the same page of the brief,

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Appellant argues that Bradley teaches a sample liquid container mounting means operable to mount a closed sample liquid container but not an open sample liquid container. Appellant argues that neither reference teaches a sample liquid container mounting means operable to mount either an open sample liquid container or a closed sample liquid container.

The Examiner does not dispute the fact that neither Jones nor Bradley teaches a sample liquid container mounting structure that mounts either an open sample liquid container or a closed sample liquid container. However, the Examiner argues on pages 3-5 of the answer that the phrase "each of which is operable" fails to set forth structure or a means plus function limitation.

The Appellant on pages 11 and 16 of the brief argues that the Examiner's position is incorrect and without legal merit in that the sample liquid means is to be construed to cover the corresponding structure as clearly defined in Appellant's specification, namely the universal sample liquid containers mounting apertures 72, 74, 76, 78, 80 and 82 which mount either a closed sample liquid container or an open sample liquid container therein.

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Our reviewing court has stated in *In re Donaldson Co. Inc.*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) that the "plain and unambiguous meaning of paragraph six is that one construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure." We find that the claimed sample liquid container mounting means, corresponds to the mounting structure shown in figure 1 that is capable of mounting both containers. Hence, we find that the Examiner has failed to show that neither Jones nor Bradley teaches this feature as "a plurality of sample liquid container mounting means each of which is operable to mount either a closed sample liquid container or an open sample liquid container" as recited in Appellant's claims. Therefore, we will not sustain the Examiner's rejection of the claims under 35 U.S.C. § 102.

In regard to the 35 U.S.C. § 103 rejections, the Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the

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art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. **In re Sernaker**, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983).

"Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." **Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.**, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), **citing W. L. Gore & Assocs., Inc. v.**

Garlock, Inc., 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), **cert. denied**, 469 U.S. 851 (1984). The Examiner has not addressed these issues in any way in the answer. Furthermore, the Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." **In re Fritch**, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), **citing In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor."

Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d at 1087, 37

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USPQ2d at 1239, *citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13.

We have not sustained the rejection of claims 2, 7, 9, 11 and 19 under 35 U.S.C. §§ 102 or 103. Accordingly, the Examiner's decision is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
KENNETH W. HAIRSTON)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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MICHAEL R. FLEMING)	
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