

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte VICTOR P. BUROLLA

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Appeal No. 95-3189  
Application No. 08/055,403<sup>1</sup>

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HEARD: Apr. 9, 1999

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Before JOHN D. SMITH, PAK, and KRATZ, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3-19, 21-23, and 26-32, which are all of

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<sup>1</sup> Application for patent filed April 29, 1993. According to appellant, this application is a continuation of Application 07/542,673, filed June 22, 1990, now abandoned; which is a continuation of Application 07/188,773, filed April 29, 1988, now abandoned.

the remaining claims pending in this application on appeal.<sup>2</sup>

CLAIMED SUBJECT MATTER

The appellant's invention relates to a method and apparatus for capillary electrophoresis which may be automated. An understanding of the invention can be derived from a reading of exemplary claims 5 and 23, which are reproduced below.

5. A process of electrophoresis comprising the steps of:

providing a capillary having distal ends;

providing a modular, portable and interchangeable cartridge having a bottom;

mounting said capillary to said cartridge so that the distal ends of the capillary protrudes from the bottom of said cartridge at two spaced apart first and second exits;

providing a conveyor for conveying a series of vials containing sample or electrolyte under said first and second exits;

supporting the cartridge in a manner to allow the distal ends of the capillary to be accessible by the vials and to allow the cartridge to be easily detached for interchanging with another cartridge;

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<sup>2</sup> See pages 1 and 3 of the brief. Also, we note the February 11, 1993 amendment that was filed after final action in prior application No. 07/542,673 requested cancellation of claims 24 and 25. Applicant requested entry of that amendment as a matter of right in the instant file wrapper continuation application (FWC) under 37 CFR § 1.62. See item No.3 of the transmittal letter filed April 29, 1993.

registering a vial containing said sample to the end of said capillary at said first exit to immerse said end in sample to inject a quantity of sample to said capillary;

registering vials containing electrolyte to the distal ends of said capillary to immerse the ends of said capillary in electrolyte;

and applying an electropotential across the vials containing electrolyte whereby the sample electrophoreses along the length of said capillary.

23. An electrophoresis apparatus comprising:

first and second containers for holding sample or electrolyte;

a portable capillary cartridge including a length of capillary having two ends; and a body in which is defined a space in which the capillary is supported whereby the ends of the capillary are positioned for fluid communication with the containers;

the cartridge being supported with respect to the containers in a manner allowing the capillary to be in fluid communication with the contents in the container; and

means for applying electropotential to effect electrophoretic separation within the capillary.

#### REJECTION

Claims 1, 3-19, and 21-32 stand rejected under 35 U.S.C. § 112, first paragraph, on the ground that the specification is non-enabling.

#### OPINION

Because the examiner has failed to carry his initial burden of establishing a prima facie case of non-enablement based on the present record, the above-noted rejection cannot be sustained.

The examiner attacks the sufficiency of appellant's specification urging, for example, that the specification is incomplete; does not adequately describe how "the elements are integrated into a whole" (answer, page 3); and does not teach how a program controller is integrated (answer, page 4) and how a capillary cartridge is constructed to be portable, removable, and interchangeable (answer, page 5). Appellant argues that the specification<sup>3</sup> and drawings do provide an adequate and enabling written description of the claimed method and apparatus concerning an automated capillary

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<sup>3</sup> While appellant refers to a substitute specification in the brief, we note that our review of the application file does not clearly indicate that the examiner has considered appellant's preliminary amendment of April 29, 1993 requesting entry of a previously filed non-entered amendment after final that included a substitute specification that was filed February 11, 1993 in parent application No. 07/542,673. We note that our consideration of the propriety of the enablement rejection under 35 U.S.C. § 112, first paragraph, is based on the original disclosure of this continuation application.

electrophoresis device including a removable, portable, and interchangeable capillary cartridge (brief, pages 3-8).

With respect to enablement, the predecessor of our appellate reviewing court stated in *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971):

[A] specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented *must* be taken as in compliance with the enabling requirement of the first paragraph of § 112 *unless* there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. . . .

. . . .

. . . it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.

In addition, an analysis of whether the claims under appeal are supported by an enabling disclosure requires a determination of whether one skilled in the art could make and use the claimed invention from the disclosure coupled with

information known in the art without undue experimentation.  
See United States v. Telectronics, Inc., 857 F.2d 778, 785, 8  
USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct.  
1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ  
659, 661 (CCPA 1976).

Here, the examiner's analysis did not take into account information known in the art, nor does the examiner supply any convincing evidence which would cause doubt about the accuracy of appellant's disclosure. Accordingly, in our view, the examiner has not carried his initial burden of setting forth evidence or sound technical reasoning which indicates that any person skilled in the art would not have been enabled by appellant's specification to construct the claimed apparatus and carry out the claimed process according to the guidelines in appellant's specification.

For the above reasons, we do not sustain the rejection under 35 U.S.C. § 112, first paragraph.

#### OTHER ISSUES

This application is remanded to the examiner to consider the status of the proposed substitute specification and amendments filed February 11, 1993 in the parent application

prior to final disposition of this application in light of the request filed April 29, 1993 in the present FWC application that the previously unentered amendment from the prior application be entered in the FWC application. See 37 CFR §§ 1.62, 1.125, and 1.126. Of course, any amendment(s) that are entitled to entry should be reviewed for new matter and objection(s) under 35 U.S.C. § 132 and/or rejection(s) under 35 U.S.C. § 112, first paragraph, that are appropriate, if any, should be made.

The decision of the examiner is reversed and the application is remanded for consideration of the issues raised above.

This application, by virtue of its special status requires an immediate action. Manual of Patent Examining Procedure 708.01(d)(7th ed., July 1998). It is important that the Board be informed promptly of any action affecting this case.

REVERSED/REMANDED

	JOHN D. SMITH	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	
	CHUNG K. PAK	)	BOARD OF
PATENT	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
	PETER F. KRATZ	)	)
	Administrative Patent Judge	)	

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APPEAL NO. - JUDGE KRATZ  
APPLICATION NO. 08/055,403

APJ JOHN D. SMITH

APJ PAK

APJ KRATZ

DECISION: **REVERSED/REMANDED**

Prepared By: TINA

**DRAFT TYPED:** 13 Apr 99

**FINAL TYPED:** 14 Apr 99