

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KATHRYN D. PETRICK, A. MATTHEW KRAMER  
and RICHARD L. MOOR

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Appeal No. 2000-2045  
Application No. 09/206,253

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ON BRIEF

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Before CALVERT, ABRAMS, and NASE, Administrative Patent Judges.  
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 15-19 and 22-36, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

### BACKGROUND

The appellants' invention relates to a container assembly. An understanding of the invention can be derived from a reading of exemplary claim 15, which appears in the appendix to the Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Cornish <u>et al.</u> (Cornish)	4,944,603	Jul. 31, 1990
Bates <u>et al.</u> (Bates)	5,411,295	May 2, 1995
Marino, Jr. <u>et al.</u> (Marino)	5,605,230	Feb. 25, 1997

The prior art set out by the appellants in the specification at page 4, lines 9 and 10, and page 12, lines 25 and 26 (the related prior art).

Claims 15, 17-19 and 28-34 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bates in view of Cornish.

Claims 16 and 22-27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bates in view of Cornish and the related prior art.

Claims 35 and 36 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bates in view of Cornish and Marino.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (Paper No. 11) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 10) and Reply Brief (Paper No. 12) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

All of the rejections are under 35 U.S.C. § 103. A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art (see In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)). This is not to say, however, that the claimed invention must expressly be suggested in any one or all of the references, rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art (see, for example, Cable Elec. Prods. v. Genmark, Inc., 770 F.2d 1015, 1025, 226 USPQ 881, 886-87 (Fed. Cir. 1985)), considering that a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference (see In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)). Insofar as the references themselves are concerned, we are bound to consider the disclosure of each for what it fairly teaches one of ordinary skill in the art, including not only the specific teachings, but also the inferences which one of ordinary skill in the art would

reasonably have been expected to draw therefrom (see In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966) , and In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968)).

#### The Rejection of Claims 15, 17-19 and 28-34

These claims stand rejected on the basis of Bates and Cornish.

The appellants' invention pertains to tamper evident labels for medical containers. Claim 15, the sole independent claim before us, is directed to a medical container assembly. It is the examiner's view that all of the subject matter recited in this claim is disclosed by Bates, except that Bates discloses two tamper evident labels, each of which contact only the removable top and the side of the container, whereas the claim requires that a label be "wrapped completely around said medical container contacting said removable and replaceable cap, at least a portion of said sides, and said bottom thereof." However, the examiner has taken the position that it would have been obvious to one of ordinary skill in the art to replace at least one of the Bates tamper-evident labels with a label that is wrapped completely about the container, in view of the teachings of Cornish. The appellants have set forth a number of arguments in opposition to the rejection of claim 15, however, we are not persuaded by them that the rejection should not stand.

The first of these arguments (Brief, page 5) is that even if the references were combined they would not teach a label wrapped completely around a medical container

contacting a removable cap, at least a portion of the sides, and the bottom, as recited in claim 15. From our perspective, however, Bates discloses a medical container having the required structure, and if one were to carry out the examiner's proposed modification, that is, wrap a tamper-evident label completely around the top, sides and bottom of the Bates container, the result would meet the terms of the claim. Another argument is grounded in the proposition that the failure of Bates to utilize the teachings of Cornish, which were available in the art for several years prior, supports a conclusion that no suggestion to combine the references exists (Brief, page 6). We do not agree. There could be many reasons why Bates chose to utilize two short tamper-evident labels rather than one label that completely wraps around the container, which are not explicitly set forth in the reference. However, Bates does not exclude using the single wrap-around label, and therefore the issue is whether one of ordinary skill in the art would have been motivated to do so. To agree with the appellants' theory would mean that it never would be proper to modify a reference in view of the teachings of an older reference, and that is not in accordance with the guidance provided by our reviewing court for evaluating the issue of obviousness.

Another contention by the appellants is that the references do not recognize that enhanced tamper evidency could be provided for a medical container by wrapping the label completely around the container (Brief, page 6). It is true that Bates does not teach

utilizing an encompassing tamper-evident label for medical containers; if it did, the rejection would be one of anticipation. Cornish was applied by the examiner for teaching wrapping a tamper-indicating label completely around a package for advantages which one of ordinary skill in the art would have recognized. The fact that the appellants recognized other advantages that flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the claimed subject matter otherwise would have been obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Int. 1985). Further with regard to this argument, it is interesting to note that Cornish teaches that although the label “typically” completely encircles the package, such is not necessary (column 2, lines 30-32), which teaches one of ordinary skill in the art that either system can be used, depending upon other factors worthy of consideration, such as how much of the package is desired to be protected against tampering and the techniques desired to be used for installation of the label. Finally, we are unable to appreciate the relevance with regard to claim 15 of the argument on page 6 of the Brief regarding the “location of [the] label in a particular place,” for such a limitation does not appear in this claim.

With regard to the allegation that Cornish is nonanalogous art (Reply Brief, page 2), the test for analogous art is first whether the art is within the field of the inventor's endeavor and, if not, whether it is reasonably pertinent to the problem with which the inventor was involved (see In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979)), and

a reference is reasonably pertinent if, even though it may be in a different field of endeavor, it logically would have commended itself to an inventor's attention in considering his problem because of the matter with which it deals (see In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992)). In our opinion, at the very least, Cornish logically would have commended itself to an inventor considering the problem of providing the opening in a package with a tamper-evident label, and therefore we consider it to be analogous art.

Looking now to our reasoning, Cornish is directed to a bag-like package comprising a reclosable opening at or near its top which is spanned by a tamper-evident band. Before relating the Cornish package to the language of the appellants' claims, we must state that we differ with the examiner's interpretation of what constitutes the top, bottom, and sides of the Cornish package. In our view, and with reference to the description in columns 2 and 3 and the drawings, the "top" of the container is where the reclosable seal means 18 and 19 are located, the "bottom" is the opposite portion of the container where bottom seam 16 is located, and the "sides" are the panels extending therebetween. This having been said, however, one cannot ignore the fact that the Cornish tamper-evident band is described as "encompassing the package **10** and bonded to [the] bag panels" (column 4, lines 25 and 26), in the course of which it "passes across the access opening [of the package] and . . . serves as a tamper-evident feature" (column 1,

lines 65 and 66). Figure 3 shows that when the top and bottom portions are folded back against the product-carrying portion, the band will contact the protected package around substantially its entire circumference (column 4, lines 34-39). Cornish further teaches that a single tamper-indicating label can be used to close two openings (Figure 3).

We share the examiner's opinion that it would have been obvious to modify the Bates medical container by replacing at least one of the none-encircling tamper-evident labels with a label that encircles the entire container, contacting the cap and the sides, and having its ends attached to one another, in view of the combined teachings of Bates and Cornish. From our perspective, one of ordinary skill in the art would have recognized from these two references that advantages flow from encircling the container with a single tamper-indicating label, such as achieving the enhanced tamper protection provided by two spannings of the cap and sides, for skill is presumed on the part of the artisan, rather than the lack thereof (In re Sovish, 769 F.2d 738, 742-43, 226 USPQ 771, 774 (Fed. Cir. 1985)). This being the case, we will sustain the rejection of claim 15.

We reach the opposite conclusion, however, with regard to claim 17, which depends from claim 15 and adds thereto "centrally located indicia indicating that said indicia is to be placed on said removable cap of said medical container." As we understand the appellants' invention, this feature will result in the ends of the label being located at a particular place with respect to the bottom and sides of the container. Such is

not, in our view, present in or suggested by Bates and Cornish, and therefore we will not sustain the rejection of claim 17 or of claims 32, 33, and 34, which are rejected on the same grounds and depend therefrom.

Claim 18 recites that the container of claim 15 has a particular capacity, and the label has a particular length. The appellants have described the size of the claimed container as being “conventional” (specification, page 4). It is our view that, once having knowledge of the dimensions of this conventional container, it would have been obvious to the artisan to provide an encircling label of a complementary length, considering the teaching of Cornish that the ends of the label should overlap for attachment to one another. The rejection of claim 18 is sustained.

As for claim 19, it is our view that one of ordinary skill in the art would not have been taught by Bates and Cornish that there should be two tamper-evident labels on a single container, with a first one encircling the container while a second “much shorter” one does not. The rejection of claim 19 is not sustained. The same is true of claim 28, which adds this same feature to claim 18.

The “substantially cylindrical” container and top added by claim 29 to claim 15 is clearly disclosed by Bates, and we will sustain this rejection.

Claim 30 adds to claim 29, and claim 31 to claim 15, the limitation that a portion of the first surface of the label engages a portion of the second surface “at or adjacent the

bottom” of the container. For reasons explained above with regard to the naming of the parts of the Cornish package, from our perspective Cornish teaches attaching the ends of the label together along the side of the container rather than at or adjacent the bottom thereof, and we therefore will not sustain the rejection of claims 30 and 31.

The Rejection of Claims 16 and 22-27

These claims stand rejected on the basis of Bates, Cornish, and the “related prior art.”

Claim 16 adds to claim 15 the requirement that the label have serrated side edges. This feature has been acknowledged by the appellants to be “known per se” for such labels (specification, page 4). Thus, it is our opinion that to provide the label in the modified Bates container with such a feature would have been obvious to one of ordinary skill in the art for the known advantages thereof, and we will sustain this rejection.

Claim 22 adds to claim 16 the centrally located indicia. As we stated above with regard to claim 17, the combined teachings of Bates and Cornish do not render this feature obvious, and it is our further view that such is not alleviated by considering the “related prior art.” The rejection of claim 22 is not sustained, nor is the rejection of claims 25 and 27, which depend from claim 22 and thus also contain this limitation.

The rejection of claim 23, which adds the container size and label length limitations to claim 16, is sustained for the reasons expressed above with regard to claim 18.

The rejection of claim 24 is not sustained on the basis of the reasons set forth above with regard to claim 19, for further consideration of the “related prior art” does not alter that conclusion.

The rejection of claim 26 is sustained for the same reasons as claim 18.<sup>1</sup>

#### The Rejection of Claims 35 and 36

These claims stand rejected on the basis of Bates, Cornish, and Marino.

Since there is no dispute that Bates discloses a medical container (Brief, page 4), we will sustain the rejection of claim 35, which adds to claim 15 the requirement that the container have a medical specimen or pharmaceutical substance therein, which one of ordinary skill in the art would have recognized as being among the conventional contents of such a container. Marino is merely confirmatory of the fact that it was known at the time of the appellants’ invention to utilize containers such as that of Bates to contain medical substances.

The rejection of claim 36, which depends from claim 30, will not be sustained, for Marino, which was added to the rejection of this claim, fails to overcome the shortcoming in the combination of Bates and Cornish explained above with regard to claim 30.

#### SUMMARY

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<sup>1</sup>The subject matter of claims 23 and 26 is identical, and claim 26 depends from claim 23, which means they are duplicate claims. This situation should be remedied.

The rejection of claims 15, 18, and 29 as being unpatentable over Bates in view of Cornish is sustained.

The rejection of claims 17, 19, 28 and 30-34 as being unpatentable over Bates in view of Cornish is not sustained.

The rejection of claims 16, 23, and 26 as being unpatentable over Bates in view of Cornish and the related prior art is sustained.

The rejection of claims 22, 24, 25 and 27 as being unpatentable over Bates in view of Cornish and the related prior art is not sustained.

The rejection of claim 35 as being unpatentable over Bates in view of Cornish and Marino is sustained.

The rejection of claim 36 as being unpatentable over Bates in view of Cornish and Marino is not sustained.

The decision of the examiner is affirmed-in-part.

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

AFFIRMED-IN-PART

IAN A. CALVERT	)	
Administrative Patent Judge	)	
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	)	
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	)	BOARD OF PATENT
NEAL E. ABRAMS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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