

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDMUND D. D'SILVA

Appeal No. 97-0615
Application 08/359,664¹

ON BRIEF

Before FRANKFORT, STAAB and CRAWFORD, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 8 and 18 through 20. Claims 9 through 17, the only other claims remaining in the application,

¹Application for patent filed December 20, 1994.

Appeal No. 97-0615
Application 08/359,664

have been withdrawn from further consideration under 37 CFR § 1.142(b) as being directed to a non-elected invention.²

Appellant's invention as represented in the claims before us on appeal relates to a system for marking a container subjected to a process to indicate the status of the container. More specifically, as explained on page 1 of the specification, the system involves

marking and/or identifying a disposable plastic bag or container having an interior for holding a mixture of methylene blue and a blood component, such as plasma. The system marks the bag to indicate whether the bag has been subjected to a process, such as an illumination process, used to treat the mixture, such as for sterilization.

Independent claim 1 is representative of the subject matter on appeal and a copy of that claim appears in the Appendix to appellant's brief.

The prior art references of record relied upon by the

² Claim 1 was amended subsequent to the final rejection in a paper filed May 15, 1996 (Paper No. 9). According to the advisory action (Paper No. 10, mailed May 23, 1996), this amendment corrected the § 112 problem noted in the final rejection and was to be entered upon the filing of the appeal. We note, however, that this amendment has not as of yet been clerically entered.

Appeal No. 97-0615
Application 08/359,664

examiner in rejecting the appealed claims are:

Alfandari	2,547,242	Apr.
03, 1951		

Hymmen	4,656,907	Apr. 14,
1987		

Clark	4,936,175	Jun. 26,
1990		

Claims 1 through 7, 18 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Clark in view of Alfandari.

Claims 8 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Clark and Alfandari as applied to claims 1 and 18 above, and further in view of Hymmen.

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the examiner's answer (Paper No. 13, mailed September 5, 1996) for the examiner's reasoning

Appeal No. 97-0615
Application 08/359,664

in support of the rejections, and to appellant's brief (Paper No. 12, filed August 14, 1996) for appellant's arguments thereagainst.

OPINION

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

Turning first to the examiner's rejection of claims 1 through 7, 18 and 19 under 35 U.S.C. § 103, we note that the examiner urges (answer, page 3) that Clark shows a punching system having all the recited limitations, except for a workpiece holder (means for holding) that is inside a housing for the cutting/punching process, but outside the housing for workpiece loading. To address this difference the examiner looks to Alfandari, taking the position (answer pages 3-4) that

Alfandari shows that it is well known to have a tray (39) having a tool passageway (47), said tray (39)

Appeal No. 97-0615
Application 08/359,664

being slidable into a housing (defined by walls 52, 52, 53, 54, 10) for cutting in order to protect the operator (see lines 22-43 of column 1). It would have been obvious to one of ordinary skill in the art to have modified Clark by making the workpiece holder (tray 23 with apertures) movable from a position outside a housing to a position inside the housing, as taught by Alfandari, in order to shield the operator from possible contact with the cutting elements, while maintaining the easy workpiece loading. Clark's punches could extend thru the housing from above, since Alfandari teaches a tool (23) that extend through the housing.

Like appellant (brief, pages 5-8), we are of the opinion that the examiner's above position is based on impermissible hindsight gleaned from appellant's own disclosure and not from any fair teaching or suggestion found in the applied prior art references themselves. In this regard, we consider that the examiner has used appellant's own disclosure and the claimed invention itself as a blueprint for piecing together unrelated elements from disparate references in the prior art so as to defeat patentability of the system defined in appellant's independent claims 1 and 18 on appeal.

Absent the disclosure of the present application, it is our opinion that one of ordinary skill in the art would not have been motivated to modify the printing plate registering

Appeal No. 97-0615
Application 08/359,664

device of Clark in light of the shoulder pad cutting machine of Alfandari so as to arrive at the subject matter set forth in appellant's claims 1 and 18 on appeal. Given the critical nature of the alignment between the masking flat (97) carrying the image to be printed and the printing plate (99) in Clark (see column 1 therein) and the importance of having the operator confirm such alignment, we see no way that one of ordinary skill in the art would have been motivated to make a combination like that suggested by the examiner. Moreover, we see no problem in Clark of the operator being exposed to a cutting operation as mentioned in Alfandari, and thus no reason to employ the receptor (36) of Alfandari in Clark, where the operator is already shielded from the punches (44, 46). Thus, the examiner's rejection of appellant's claims 1 through 7, 18 and 19 under 35 U.S.C. § 103 based on Clark and Alfandari will not be sustained.

We have also reviewed the patent to Hymmen applied by the examiner in the § 103 rejection of dependent claims 8 and 20.

Appeal No. 97-0615
Application 08/359,664

However, we find nothing in this reference which would supply that which we have noted above to be lacking in the basic combination of Clark and Alfandari. Accordingly, the examiner's rejection of claims 8 and 20 on appeal under 35 U.S.C. § 103 will likewise not be sustained.

As should be apparent from the foregoing, the decision of the examiner rejecting claims 1 through 7 and 18 through 20 of the present application is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

Appeal No. 97-0615
Application 08/359,664

Bradford R.L. Price (RLP-30)
Baxter International, Inc.
Route 120 and Wilson Road
Round Lake, IL 60073