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BARNES & THORNBURG LLP 11 SOUTH MERIDIAN INDIANAPOLIS, IN 46204			BASS, DIRK R	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte VINCENT I. PEREZ

Appeal 2011-013149
Application 12/174,213
Technology Center 1700

Before EDWARD C. KIMLIN, PETER F. KRATZ, and
GEORGE C. BEST, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 2, 4-21, and 24.
We have jurisdiction under 35 U.S.C. § 6(b). Claim 1 is illustrative:

1. A specimen gathering kit comprising:
a specimen gathering device including:
a swab member having opposing ends, wherein one end
comprises a swab tip;
a housing including a base and a cap; and
a solution;
wherein the housing base defines a solution chamber having a closed
end and an opposite open end and wherein the solution is received within the
solution chamber, and
wherein the base and the cap are releasably joined together to house
the swab member, the swab member being lodged within the cap with the

end of the swab member opposite the tip extending into the solution chamber and the swab member protruding from the open end of the solution chamber;

wherein the swab member seals the open end of the solution chamber to contain the solution therein; and

wherein the solution comprises a buffer solution including a DNA preservative configured to gather the specimen.

The Examiner relies upon the following references as evidence of obviousness:

Kingsley et al. (Kingsley)	3,995,618	Dec. 7, 1976
Nason	5,266,266	Nov. 30, 1993
Seymour	5,268,148	Dec. 7, 1993
Hochmeister et al. (Hochmeister)	6,085,907	Jul. 11, 2000
Salter et al. (Salter)	7,132,249 B1	Nov. 7, 2006

The appealed claims stand rejected under 35 U.S.C. § 103(a) as follows:

- (a) claims 1-2 and 4-12 over Kingsley in view of Nason,
- (b) claim 13 over Kingsley in view of Nason and Seymour,
- (c) claim 14 over Kingsley in view of Nason and Salter, and
- (d) claims 15-21 and 24 over Kingsley in view of Nason and Hochmeister.

We have thoroughly reviewed the respective positions advanced by Appellant and the Examiner. In so doing, we agree with Appellant that the Examiner's rejections are not sustainable.

The Examiner acknowledges that the cell-gathering device of Kingsley does not comprise the claimed solution chamber and the

arrangement of the swab member in relation to the solution chamber (Ans. 5). It is the Examiner's position that it would have been obvious to modify the device of Kingsley to include the solution chamber structure of Nason for the purpose of providing a collection device with facilitated solution delivery to a collection swab. However, we agree with Appellant that the Examiner has not satisfactorily explained how the device of Kingsley would be operable if the solution chamber of Nason was placed inside Kingsley's tube 11 or tube 12. To prevent the solution from leaving the chamber before use, a total reconstruction of Kingsley's device would be necessary. In effect, the required modifications would result in Kingsley's device having the structure of Nason's. In the present case, the Examiner has not presented a convincing rationale for why one of ordinary skill in the art would have transformed the structure of Kingsley, which is meant to serve as a cervical tissue cell-gathering device, into a structure like Nason's which is designed for collecting *and analyzing* biological specimens.

We note that the Examiner's rejections are not based on a finding that there is no apparent distinction between the structure of the device within the scope of appealed claim 1 and the structure of Nason's device. A rejection based on Nason as a primary reference is not before us.

In conclusion, based on the foregoing, we are constrained to reverse the Examiner's rejections.

REVERSED

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