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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/257,119	10/23/2008	Bradley M. Wilkinson	3896-083185 (P-7920/1)	6454
32182	7590	02/20/2013	EXAMINER	
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			ART UNIT	PAPER NUMBER
			1777	
			NOTIFICATION DATE	DELIVERY MODE
			02/20/2013	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRADLEY M. WILKINSON, C. MARK NEWBY,
CLINTON A. HAYNES, and ROBERT G. STATES, III

Appeal 2012-000852
Application 12/257,119
Technology Center 1700

Before CHUNG K. PAK, CHARLES F. WARREN, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*

DECISION ON APPEAL

The named inventors (hereinafter “Appellants”)¹ appeal under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1, 2, and 5 through 39. An oral hearing was held on February 4, 2013. We have jurisdiction under 35 U.S.C. § 6(b).

¹ Appellants identify the real party in interest as “Becton, Dickinson and Company, having its principal place of business at 1 Becton Drive, Franklin Lakes, New Jersey 07417.” (*See* Appeal Brief filed May 24, 2011 (“App. Br.”) at 3.

STATEMENT OF THE CASE

The subject matter on appeal is directed to “a container for storing a biological sample.” (Spec. 1, para. 0002.) Details of the appealed subject matter are recited in illustrative independent claims 1 and 29 reproduced below from the “CLAIMS APPENDIX” in the Appeal Brief:

1. A container assembly, comprising:
a container extending between a first end and a second end, the container comprising:
a first chamber having a sidewall extending between an open end and a closed end and defining a first chamber interior adapted to receive a sample holder therein; and
a second chamber having a sidewall extending between an open end and a closed end, defining a second chamber interior adapted to subsequently receive the sample holder therein, the first chamber interior and the second chamber interior accessible through the first end of the container; and
a closure for engagement with the first end of the container for enclosing at least one of the open end of the first chamber and the open end of the second chamber and adapted to be detachably connected to the sample holder, wherein, when the sample holder is connected to the closure and received within at least one of the first chamber interior and the second chamber interior, the closure is rotatable with respect to the sample holder.

29. A container assembly for storing a biological sample, comprising:
a container comprising a first end, a second end, and a sidewall extending between the first end and the second end defining a container interior;
a first chamber defined within the container interior and having an opening adjacent the first end of the container;
a second chamber defined within the container interior and having an opening adjacent the first end of the container, the second chamber in fluid isolation from the first chamber; and

a closure for sealingly engaging the first end of the container and comprising a sample holder for storing a biological sample therein, the closure adapted to engage the container in a first orientation in which the sample holder is received within the first chamber, and a second orientation in which the same sample holder is subsequently received within the second chamber, wherein, when the sample holder is received within at least one of the first chamber and the second chamber, the closure is rotatable with respect to the sample holder.

(See App. Br. 22 and 26 (Claims App'x).)

Appellants seek review of the following grounds of rejection maintained by the Examiner in the Answer:

1. Claims 1, 2, 5 through 8, 11 through 19, 25 through 27, 29, 30, 33, 37, and 38 under 35 U.S.C. § 103(a) as unpatentable over Consolidated² in view of Reid;³
2. Claims 9, 10, 31, and 32 under 35 U.S.C. § 103(a) as unpatentable over Consolidated in view of Reid and Haywood;⁴
3. Claims 20 through 24, 35, and 36 under 35 U.S.C. § 103(a) as unpatentable over Consolidated in view of Reid and Kusters;⁵ and

² British Patent 1 234 044 published in the name of Consolidated Laboratories, Inc. on June 3, 1971.

³ U.S. Patent 5,455,180 issued to Reid on October 3, 1995.

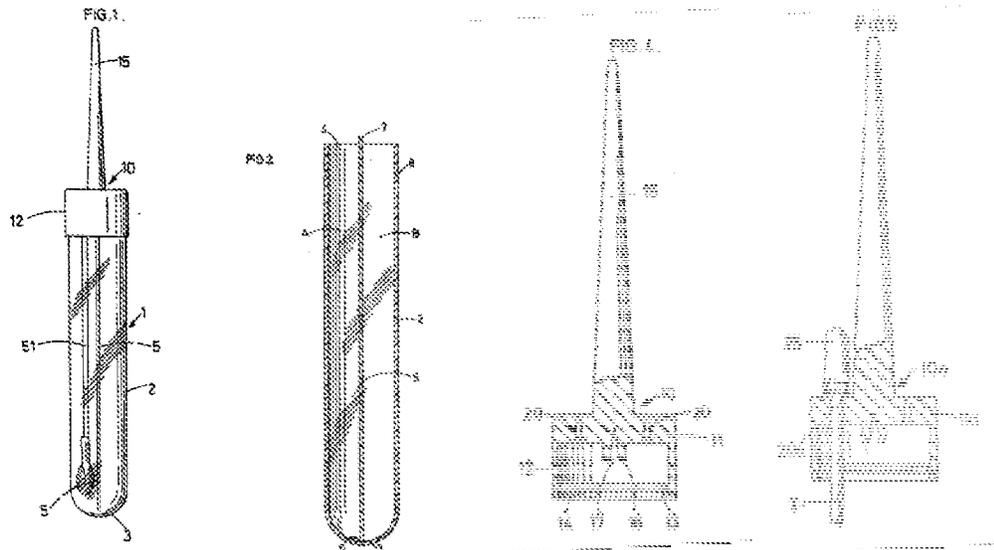
⁴ US 2003/0086830 A1 published in the name of Haywood et al. on May 8, 2003.

⁵ WO 2006/041297 A2 published in the name of Kusters et al. on April 20, 2006.

4. Claims 28 and 39 under 35 U.S.C. § 103(a) as unpatentable over Consolidated in view of Reid and Witty.⁶ (See App. Br. 2-3 and Examiner's Answer mailed June 13, 2011 ("Ans.") at 4-8.)

DISCUSSION

Figures 1, 2, 4, and 5 of Consolidated are reproduced below:



Figures 1 and 2 of Consolidated shows a tube 1 having discrete chambers A and B divided by a wall or septum 5, a closure or cap 10 for the tube 1, and a specimen-procuring or specimen-acquiring member, such as swab S on stick S1, carried by the closure or cap 10. (See Figures 1 and 2, together with p. 2, ll. 59-113.) Figures 4 and 5 of Consolidated show more detailed structures of the closure or cap 10 which comprises a handle 15, an annular

⁶ U.S. Patent 4,675,299 issued to Witty et al. on June 23, 1987.

portion 11 defining recesses 20 or 20a for carrying the specimen-procuring or specimen-acquiring member and a generally centrally positioned ridge 16 defining a recess 17 for receiving the top portion 7 of the wall or septum 5 and a circumferential skirt 12 having an inwardly directed annular ridge 13 and defining an open end 14. (*See* Figures 4 and 5, together with p. 2, l. 85-126.) As is apparent from the design of the ridge 16 having a recess for receiving the top portion 7 of the wall or septum 5, Consolidated's closure is precluded from rotating with respect to the tube. Indeed, as acknowledged by the Examiner at pages 5, 9, and 10 of the Answer, "Consolidated's closure is not configured such that the closure is rotatable with respect to the sample holder when the sample holder is connected to the closure and receive within either the first or second chamber" as required by claims 1 and 29. (*See also* App. Br. 12.)

To remedy this deficiency, the Examiner relies on the disclosure of Reid. The Examiner does not rely on the disclosures of Haywood, Kusters, and Witty to remedy such deficiency. According to the Examiner (Ans. 5):

Reid discloses an improved closure capable of maintaining a biological sample under tight seal (col. 5, lines 1-10). His closure features an area to attach a sample holder (Fig. 2, sockets 30) such that when the sample holder is connected to the closure and within his container, the closure is rotatable with respect to the sample holder (where the closure is divided into at least two parts, the threaded closure ring 16 and the elastomeric gasket disk 18 ... the sample holder is connected to the gasket disk, col. 5, lines 49-55, and the closure ring moves independently with respect to the gasket disk, col. 6,

lines 45-60).

The Examiner then concludes at page 6 of the Answer that:

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified Consolidated's container assembly to incorporate Reid's closure structure in order to take advantage of Reid's improved seal, and furthermore, it is obvious to merely substitute one feature of the prior art with another where there is a reasonable expectation of success and where there is no unexpected result from the substitution.

Appellants contend that the collective teachings of Consolidated and Reid would not have led one of ordinary skill in the art to the subject matter recited in claims 1 and 29. (App. Br. 11-16.)

Thus, the dispositive question is:

Has the Examiner reversibly erred in determining that the collective teachings of Consolidated and Reid would have led one of ordinary skill in the art to the subject matter recited in claims 1 and 29 within the meaning of 35 U.S.C. §103(a)?

On this record, we answer this question in the affirmative for the reasons stated by Appellants in the Appeal Brief and the Reply Brief. In particular, we concur with Appellants that the Examiner has not demonstrated that one of ordinary skill in the art would have been led to substitute the structure of the annular portion of Reid's closure for the structure of the annular portion 11 of Consolidated's closure, for Reid's

closure does not take into account not only the need for a generally centrally positioned ridge defining a recess for receiving the top portion of the wall or septum responsible for forming two chambers in Consolidated's tube, but also the need for a different structure design for carrying a specimen-procuring or specimen-acquiring member in Consolidated's tube having two chambers. (*Compare* Reid, Figs. 1, 2, and 7 *with* Consolidated, Figs. 1-5.) In other words, the structure of Reid's closure is not shown to be compatible to Consolidated's tube or closure in terms of both the structure and function.

It follows that the Examiner has reversibly erred in finding that the collective teachings of Consolidated and Reid would have led one of ordinary skill in the art to modify Consolidated's closure so that it, in addition to providing the structures for particular functionalities required by Consolidated as indicated *supra*, is rotatable with respect to a sample holder when the sample holder is connected to the closure and receive within either the first or second chamber as required by claims 1 and 29.

ORDER

Upon consideration of the record, and for the reasons given, it is ORDERED that the decision of the Examiner rejecting claims 1, 2, and 5 through 39 under 35 U.S.C. § 103(a) is REVERSED.

REVERSED

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