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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte FRANK A. CHAN and HENNING GROLL

Appeal 2014-009642
Application 13/552,220
Technology Center 3700

Before MICHAEL L. HOELTER, MICHELLE R. OSINSKI, and
THOMAS F. SMEGAL, *Administrative Patent Judges*.

OSINSKI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Frank A. Chan and Henning Groll (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's Final decision rejecting claims 3, 4, 10, 16, and 17.^{1,2} We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ According to Appellants, Roche Diagnostics Operations, Inc., is the real party in interest. Appeal Br. 2.

² Claims 1, 2, 5–9, 11–15, 18, and 19 are cancelled. Appeal Br. 2.

THE CLAIMED SUBJECT MATTER

Claims 16 and 17 are independent. Claim 16 is illustrative of the claimed subject matter on appeal and is reproduced below.

16. A container for storing a plurality of test strips, the container comprising:

a housing having inner walls defining a cavity;
a lid to close an opening of the housing to the cavity; and
a compressible insert removably mounted in the cavity and sized to substantially fill the cavity, the compressible insert consisting of a compressible material shaped to resemble the cavity and is externally sized such that the compressible insert substantially fills the cavity and is frictionally retained within the cavity, and said compressible insert defines therein a single axially extending rectangular slot longitudinally disposed relative to the opening of the housing, wherein the slot is sized relative to the plurality of test strips being provided in a vertical orientation such that the compressible material of the compressible insert frictionally retains the plurality of test strips within the slot.

EVIDENCE

The Examiner relied on the following evidence in rejecting the claims on appeal:

Sandel	US 4,485,919	Dec. 4, 1984
Sibley	US 5,160,0121	Nov. 3, 1992
Walker	US 5,944,179	Aug. 31, 1999
Perlman	US 5,950,832	Sept. 14, 1999
Bucholtz	WO 2009/140627 A2	Nov. 19, 2009

REJECTIONS

- I. Claims 3, 4, 10, 16, and 17 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bucholtz and Perlman. Final Act. 2–3.
- II. Claims 3, 4, 10, 16, and 17 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bucholtz and Walker. *Id.* at 3–5.

- III. Claims 3, 4, 10, 16, and 17 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bucholtz and Sibley. *Id.* at 5–6.
- IV. Claims 3, 4, 10, 16, and 17 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bucholtz and Sandel. *Id.* at 6–8.

OPINION

The Examiner finds that Bucholtz teaches many of the limitations of independent claims 16 and 17, but acknowledges that it fails to teach that the insert is compressible. Final Act. 6–7. The Examiner turns to Sandel to address this missing limitation, finding that Sandel teaches the use of a compressible open cell foam holder with slots. *Id.* at 7 (citing Sandel, 1:22–26). The Examiner concludes that it would have been obvious to a person of ordinary skill in the art “to modify Bucholtz in view of Sandel . . . to provide a material capable of sterilization and [that] also resist[s] the generation of particles in air suspension, dust, and other aerosols which might contaminate the device.” *Id.* (citing Sandel, 1:22–26).

The Examiner also acknowledges that the claim requires a compressible insert *consisting of* a compressible material defining a single slot. *Id.* at 7–8. To the extent that Bucholtz fails to teach an insert with a single slot, the Examiner concludes that it would have been obvious to provide a single slot, as opposed to multiple slots, “in order to save costs to the manufacturer.” *Id.* at 8. Moreover, the Examiner concludes that it would have been obvious to omit an undesired slot “because omission of an element and its function is obvious if the function of the element is not desired.” *Id.* at 7, 8 (citing *Ex Parte Wu*, 10 USPQ 2d 2031 (BPAI 1989)).

Appellants argue that modifying the insert of Bucholtz from a rigid material to a compressible foam material will render Bucholtz unsatisfactory

for its intended purpose. Appeal Br. 22–23. More particularly, Appellants argue that Bucholtz teaches the incorporation of a rigid insert or liner “to reinforce [the container’s] portions at or near the beginning and end of the minor axis” and “to stiffen the sidewalls of the container,” and that without such rigidity and stiffness, “the Bucholtz device cannot maintain a moisture tight seal.” *Id.* at 22 (citing Bucholtz ¶¶ 131, 181) (emphasis omitted).

The Examiner responds that the “intended purpose of Bucholtz is to dispense and protect test strips” and the modification would not prevent Bucholtz from being “fully capable of performing its intended purpose.” Ans. 8. The Examiner also responds that Bucholtz specifically contemplates that the liner can be made of other suitable materials, and that the thickness and the height of the insert (and not merely the material itself) affects the deflection of the sidewall for facilitating a moisture tight seal. *Id.* at 8–9.

We are not persuaded by Appellants’ argument as to Bucholtz being rendered unsatisfactory for its intended purpose when modified as proposed by the Examiner. As explained by the Examiner, the principal purpose of Bucholtz is to house test strips (Ans. 8), as well as to control the ingress and/or egress of moisture (Bucholtz ¶ 2), and neither of these purposes are compromised by the Examiner’s proposed modification. As to the control of moisture particularly, Bucholtz specifically contemplates that the size (e.g., height and thickness) of the insert adjusts sidewall deflection (and, in turn, facilitates closure of the lid so as to be moisture-tight). Ans. 8–9.

Accordingly, we agree with the Examiner that the intended purpose of controlling the ingress and/or egress of moisture is not destroyed when the insert is modified to be a compressible material in that it is recognized that

the height and thickness of the insert can be varied as needed to maintain desired sidewall deflection for effective sealing.

Appellants also argue that the Examiner failed to provide a reason to combine Bucholtz and Sandel. Appeal Br. 23. Appellants argue that Bucholtz and Sandel “are directed to solutions for unrelated problems.” *Id.* More particularly, Appellants argue that Bucholtz relates to providing a reinforcement to stiffen a container, whereas Sandel relates to providing a material that is sterilizable and resists contamination. *Id.* at 23–24. Appellants further argue that “it is impermissible to assert a combination of references on the basis of applying a sterilizable reticulated foam as a solution from Sandel to a problem [i.e., capability of sterilization and resistance to the generation of particles in air suspension, dust, and other aerosols which might contaminate the device] that is not even suggested let alone explicitly identified by the teachings of Bucholtz.” *Id.* at 24.

We are not persuaded that the Examiner’s stated reason to combine Bucholtz and Sandel lacks rational underpinnings. Bucholtz is explicitly concerned with a holder design that “minimize[s] contact of water vapor *or other environmental substances with* the test strips.” Bucholtz ¶ 157 (emphasis added). Accordingly, we determine that a rationale in support of modifying the insert of Bucholtz so as to be made of a material that resists the generation of particles that can contaminate the test strips has rational evidentiary underpinnings.

Appellants argue that “[t]he present application is believed to be the first such teaching of using a compressible material to frictionally retain test strips in a slot of a compressible insert mounted in a container in the manner disclosed” and claimed. Appeal Br. 24. Even if this may be true, this line of

argument is unconvincing because the rejection is based on obviousness, not anticipation. Although the Examiner did not find a single reference disclosing all of the claimed features (as would be required for an anticipation rejection), the Examiner made findings that all of the claimed features can be found in the prior art of Bucholtz and Sandel, and the Examiner provided a reason for modifying the insert of Bucholtz to be made of the compressible foam material of Sandel. For the reasons described hereinabove, Appellants have not persuaded us that the Examiner's stated reason lacks rational evidentiary underpinnings. *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited with approval in *KSR*, 550 U.S. at 418) (“[R]ejections on obviousness grounds . . . [require] some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”).

Appellants also argue that Bucholtz would be rendered unsatisfactory for its intended purpose if the insert is modified to include a single slot, rather than multiple slots. Appeal Br. 25–26. In particular, Appellants argue that Bucholtz partitions the reservoir, creating a multiple slot effect, for the specific purposes of stiffening the container against deflection, positioning the test strips away from the sealing locations, allowing discrete placement of the test strips to keep them more neatly arranged, and assisting in maintaining the freely held test strips upright for presentation. *Id.* at 26.

We are not persuaded by Appellants' argument as it too narrowly defines the intended purposes of Bucholtz. As described above, the primary purpose of the device of Bucholtz is to house a test strip and control the ingress and/or egress of moisture, and the Examiner's proposed modification does not compromise these primary objectives. *See Ans.* 10.

Appellants also argue that there is no evidence to support that providing one slot versus multiple slots would result in saving manufacturing costs. Appeal Br. 26. More particularly, Appellants argue that the Examiner fails to explain where Bucholtz or Sandel teaches that providing merely one slot versus multiple slots would save money. *Id.* The Examiner responds that it is known in the art that providing fewer slots will save costs to the manufacturer. Ans. 11. We determine that the rationale to support a modification of the prior art need not be expressly stated in the prior art and can be reasoned from knowledge generally available to one of ordinary skill in the art. *See* MPEP § 2144(I) and cases cited therein. Appellants have not demonstrated error in the Examiner's finding that the rationale is based on knowledge available to one of ordinary skill in the art.

For the foregoing reasons, we sustain the rejection of claims 16 and 17 as unpatentable over Bucholtz and Sandel. We also sustain the rejection of claims 3, 4, 10, which depend from claim 16 or 17, and for which Appellants relied on the same arguments we found unpersuasive in connection with the independent claims. Appeal Br. 27.

Because our decision affirming the Examiner's rejection of claims 3, 4, 10, 16, and 17 under 35 U.S.C. § 103(a) as unpatentable over Bucholtz and Sandel disposes of all claims before us on appeal, we do not address the Examiner's alternative rejections of these claims as unpatentable over Bucholtz and one of Perlman, Walker, and Sibley. Final Act. 2–6; *see* 37 C.F.R. § 41.50(a)(1) (“The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed.”).

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DECISION

The Examiner's decision to reject claims 3, 4, 10, 16, and 17 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED