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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JUSTO GARCIA, PASCAL PRUD'HOMME, and DAI YOKOE<sup>1</sup>

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Appeal 2015-006119  
Application 13/990,476  
Technology Center 2800

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Before BRADLEY R. GARRIS, MICHAEL P. COLAIANNI, and  
CHRISTOPHER C. KENNEDY, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134, Appellants appeal from the Examiner's rejection under 35 U.S.C. § 102(b) of claims 11–23 as anticipated by Grubb (WO 2009/007367 (A1), pub. Jan. 15, 2009 with US 2010/0254785 A1, pub. Oct. 7, 2010 relied on and cited to as an English language equivalent). We have jurisdiction under 35 U.S.C. § 6.

We AFFIRM-IN-PART.

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<sup>1</sup> TN International is identified as the real party in interest. App. Br. 2.

Appellants claim a long-term storage device 1 comprising a storage case 9 for receiving a containment case 3 containing radioactive materials (independent claims 11 and 22, Figs. 3–4).

A copy of representative claims 11 and 22, taken from the Claims Appendix of the Appeal Brief, appears below.

11. A long-term storage device (1) intended to receive a containment case (3) containing radioactive materials, where the said device includes a main body (2) having an inner surface (5) delimiting a housing (7),

wherein in an unloaded configuration, in which the said containment case (3) containing radioactive materials is absent from the storage device, the storage device (1) includes a storage case (9) housed in the said housing (7) of the body, and delimiting a cavity (4) to receive the containment case (3), where the said storage device also includes ventilation means (17, 18, 117, 118) allowing air to circulate between the exterior of the storage device and a space (30) delimited between the said inner surface (5) of the main body (2) and the storage case (9).

22. A long-term storage device (1) intended to receive a containment case (3) containing radioactive materials, where the said device includes a main body (2) having an inner surface (5) delimiting a housing (7),

wherein the storage device (1) includes a storage case (9) housed in the said housing (7) of the body, and delimiting a cavity (4) to receive a containment case (3) containing radioactive materials, where the said storage device also includes ventilation means (17, 18, 117, 118) allowing air to circulate between the exterior of the storage device and a space (30) delimited between the said inner surface (5) of the main body (2) and the storage case (9).

Appellants correctly point out that “Grubb merely teaches a package 1 defining a package housing 4 for receiving a case 3 containing radioactive materials” (App. Br. 6) and correspondingly argue that “[Grubb] fails to

disclose an intermediate storage case within the package housing 4 for receiving the case 3 of radioactive material [as required by the independent claims]” (*id.*). With specific reference to independent claim 11, Appellants further argue:

Additionally, in an unloaded configuration of Grubb where its containment case 3 is absent, the package housing 4 of Grubb would not contain any casing. As such, Grubb certainly fails to disclose an unloaded configuration wherein a storage case is housed within a housing of a main body, as required by independent claim 11.

(*Id.*).

The Examiner does not respond to Appellants’ further argument regarding claim 11 (*see* Ans. 4–5). Moreover, the rejection of this claim fails to identify any disclosure in Grubb that satisfies Appellants’ argued limitation “wherein in an unloaded configuration, in which the said containment case (3) containing radioactive materials is absent from the storage device, the storage device (1) includes a storage case (9) housed in the said housing (7) of the body” (claim 11) (*see* Final Action 2–3 and Ans. 2–3).

For this reason, we do not sustain the Examiner’s § 102 rejection of independent claim 11 and of claims 12–21 and 23 which depend therefrom as anticipated by Grubb.

Significantly, independent claim 22 does not contain the above discussed limitation of claim 11. Instead, claim 22 requires that “the storage device (1) includes a storage case (9) housed in the said housing (7) of the body, and delimiting a cavity (4) to receive a containment case (3) containing radioactive materials” (claim 22). This requirement of claim 22 (as well as the subsequently recited limitation concerning the ventilation

means) appears to be satisfied when Grubb's case 3 is considered to read on the claimed storage case.

In support of a contrary view, Appellants argue that “the case 3 [of Grubb] does not receive an inner containment case and therefore is not intermediate an outer main body and inner containment case[, and] [a]ccordingly, the case 3 of Grubb does not correspond to the claimed intermediate storage case” (Reply Br. 4).

Appellants' argument is directed to the functional limitation that storage case (9) delimits a cavity (4) “to receive a containment case (3) containing radioactive materials” (claim 22). As explained in *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997), choosing to define an element functionally, rather than structurally, carries with it a risk, namely:

[W]here the Patent [and Trademark] Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

(Quoting *In re Swinehart*, 439 F.2d 210, 213 (CCPA 1971)).

Here, it is reasonable to believe that the cavity of Grubb's case 3 inherently possesses the capability of performing the recited function “to receive a containment case (3) containing radioactive materials” (claim 22). The cavity of Grubb's case is disclosed as performing the function of receiving radioactive materials (*see, e.g.*, Grubb ¶ 43), and there is no apparent reason why this cavity would be incapable of performing its receiving-function with respect to radioactive materials contained within a containment case. Under these circumstances, we discern no convincing

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merit in Appellants' argument that "case 3 of Grubb does not correspond to the claimed intermediate storage case" (Reply Br. 4).

We sustain, therefore, the § 102 rejection of claim 22.

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 C.F.R. § 1.136(a).

AFFIRMED-IN-PART