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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/137,682	06/12/2008	Stacy R. Kaufman	QSS-064	8017
52554	7590	01/31/2019	EXAMINER	
Southeast IP Group, LLC. P.O. Box 14156 GREENVILLE, SC 29610			BATTULA, PRADEEP CHOUDARY	
			ART UNIT	PAPER NUMBER
			3725	
			MAIL DATE	DELIVERY MODE
			01/31/2019	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STACY R. KAUFMAN

Appeal 2017-003765
Application 12/137,682¹
Technology Center 3700

Before JOHN C. KERINS, EDWARD A. BROWN, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

BROWN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Stacy R. Kaufman (Appellant) seeks review under 35 U.S.C. § 134(a) of the Examiner's decision rejecting claims 1–5. Appellant's representative presented oral argument on January 8, 2019. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ JM Smith Corporation is identified as the real party in interest. Br. 1.

CLAIMED SUBJECT MATTER

Claims 1 and 5 are independent. Claim 1, reproduced below, illustrates the claimed subject matter:

1. A medicinal container having a label, said container comprising:

a container having a removable lid;

a label adapted to be applied to said container, said label comprising:

[a] label sheet for making a pharmaceutical label for placement on said medicinal container, said label sheet comprising:

a front printing face having an adhesive backing and a length that is substantially greater than a perimeter of said medicinal container, said adhesive backing covering substantially an entire area of a backside of said front printing face;

a backing sheet liner covering said adhesive backing;

said front printing face having a score formed therein defining a first portion and a second portion of said front printing face, said first portion having a length corresponding substantially to the perimeter of said container, said score defining a border between said first portion and said second portion, whereby said second portion projects from the container when said first portion is attached to said container; and

said backing sheet liner having a liner score line formed therein corresponding to said score in said front face for removing said releasable backing liner from said first portion.

Br. 8 (Claims App.).

REJECTION²

Claims 1–5 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Monico (US 6,021,942, issued Feb. 8, 2000), Ferres (US 726,894, issued May 5, 1903), and Fales (US 1,949,903, issued March 6, 1934).

ANALYSIS

Claims 1 and 5

As for claim 1, the Examiner finds that Monico discloses a label sheet capable of making a pharmaceutical label for placement on a container (package 51) that is capable of being used as a medical container. Non-Final Act. 4. The Examiner finds that the label sheet comprises a front printing face and a backing sheet liner covering an adhesive backing. *Id.* The Examiner finds that the label sheet has a length that is substantially greater than a perimeter of the container because “[t]he label form will have a size appropriate to some type of medical container such as a larger test tube.” *Id.* The Examiner determines that “[Monico’s label] only need be capable of being used on some sort/size of container in the claimed manner.” Ans. 7. The Examiner also finds that the front printing face has a score (line of weakness 18) defining first and second portions. Non-Final Act. 4–5. The Examiner finds that the first portion has a length corresponding substantially to the container’s perimeter, as “[t]his is merely just a matter of finding a container . . . to fit these dimensions.” *Id.* at 5.

² The rejection of claims 1–5 under 35 U.S.C. § 112, second paragraph, has been withdrawn. Ans. 7; Non-Final Act. 2–3.

The Examiner finds that Monico discloses a backing sheet liner having a liner score line formed therein corresponding to the score in the front printing face for removing the releasable backing liner from the first portion. Non-Final Act. 5 (citing Monico, col. 4, ll. 31–44). The Examiner notes that Monico discloses that when the labels are provided as individual sheets, a liner is provided in all sections of the label. *Id.* The Examiner reasons that because the operation of the label requires release in only one section, and the forms can be provided as individual sheets, the release would be provided in the individual sections for operation of the label. *Id.* (citing Monico, Fig. 2). Additionally, the Examiner concludes that it would have been obvious to have sectional release liners in Monico as one of the finite ways to provide release on sections of individual sheets. *Id.* The Examiner reasons that because the liners will cover the individual sections, the liners will be perforated/cut in a corresponding manner to properly cover individual sections. *Id.*

The Examiner relies on Ferres for teaching a tubular mailing container having a lid. *Id.* The Examiner reasons that it would have been obvious to a person of ordinary skill in the art to use a mailing tube, as taught by Ferres, with Monico’s label. *Id.* The Examiner relies on Fales for teaching a medical container having a label. *Id.* (citing Fales, Figs. 1, 4). The Examiner reasons that it would have been obvious to wrap the label of Monico, as modified by Ferres, around medicinal containers, as shown in Fales, to provide information about the package. *Id.* at 6–7.

Appellant contends that the claims require a label having explicit dimensions with respect to the container that the label is to be placed on, and it is unreasonable for the Examiner “to allege that a container ‘can be

found” or “the label will have a size ‘appropriate to some type of medical container.’” Br. 11. Appellant contends that Monico does not disclose that sheet 11 shown in Figure 4 has a length that is substantially greater than a perimeter of package 51, or that the first label portion (first section 21) corresponds substantially to the perimeter of package 51. *Id.* at 9.

Claims 1 and 5 recite a medicinal container comprising a container and a label adapted to be applied to the container and comprising a label sheet, the label sheet comprising a front printing face having (a) a length that is substantially greater than a perimeter of the container and (b) a first portion having a length corresponding substantially to the perimeter of the container. Br. 18–19 (Claims App.). Although the embodiment of the form and package shown in Figure 4 of Monico does not have length limitations (a) and (b), this does not apprise us of error in the Examiner’s rejection. The Examiner states, “[i]f a modification to Monico’s structure would be needed, this would be only to the size of Monico’s label so that it would fit a particular container.” Ans. 9–10. That is, the Examiner proposes to modify the label of Monico to have the claimed length limitations. The Examiner notes that the Federal Circuit has held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. *In Gardner v. TEC Syst., Inc.*, 725 F.2d 1338, 1349 (Fed. Cir. 1984). Here, referring to the embodiment shown in Figure 4 of Monico, for example, it does not appear that changing the length of first section 21 to “[have] a length corresponding substantially to the perimeter of [package 51],” such that first section 21 and

second section 22 together have “a length substantially greater than a perimeter of said container [i.e., package 51],” would cause the resulting label to perform differently. As noted above, the Examiner also finds that Ferres and Fales disclose other container configurations on which Monico’s labels having the claimed length limitations could be applied. For these reasons, we agree with the Examiner that length limitations (a) and (b) noted above do not provide a patentable distinction from the applied prior art.

Appellant contends that Monico teaches away from sheet 11 having a length that is substantially greater than a perimeter of the package and from first section 21 having a length corresponding substantially to the perimeter of package 51. Br. 9. According to Appellant, Monico discloses that the preferred embodiment provides the labels in a pad, as shown in Figure 3, where “all the forms in the pad are **identical**” and individual label sheets can be pulled from a pad of labels, as needed. *Id.* at 10 (citing Monico, col. 1, ll. 50–52, col. 3, ll. 31–34, col. 4, ll. 39–44, Fig. 3). Appellant asserts that the preferred embodiment teaches away from a label having dimensions determined relative to the size of the package. *Id.*

These contentions are unpersuasive. Monico teaches that forms 10 can be provided in a pad *or* as individual sheets. *See* Monico, col. 4, ll. 42–44. Appellant does not identify any portion of Monico that criticizes, discredits, or otherwise discourages changing the length of a section of a label provided as an individual sheet to be substantially greater than a perimeter of a container the label is provided on. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). Accordingly, we are not persuaded that Monico teaches away from sheet 11 having a length that is substantially

greater than a perimeter of a package or from a first section having a length corresponding substantially to the perimeter of the package. Br. 9.

Appellant also contends that modifying Monico's label to have a length substantially greater than the perimeter of the package would result in Monico being inoperable because "both the address and postage would be covered by the label, thus rendering the package undeliverable." Br. 10.

This contention is not persuasive. One of ordinary skill in the art would have the requisite knowledge and skill to construct a label that does not conceal such information. In this regard, we note "[a] person of ordinary skill is also a person of ordinary creativity, not an automaton." *See KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 421 (2007). Indeed, Figure 4 of Monico shows that the return address 53 and the mailing destination 52 of package 51 are uncovered by the attached label. Appellant does not explain persuasively how changing the *length* of the label relative to the perimeter of package 51 would, nonetheless, cause the label to cover this or any other information.

Appellant contends that Monico also does not disclose the limitation "said backing sheet liner having *a liner score line formed therein corresponding to said score in said front face* for removing said releasable backing liner from said first portion," as recited in claim 1. Br. 18 (Claims App.) (emphasis added).³ Claim 5 recites, "said backing sheet liner having *a liner score formed therein defining a first portion and a second portion of said front printing face*, said first portion having a length corresponding substantially to the perimeter of the container." *Id.* at 19 (Claims App.)

³ Appellant indicates incorrectly that claim 5 also recites this same limitation. Br. 8.

(emphasis added). Appellant contends Monico does not disclose that the release liner has (a) scores corresponding to the lines of weakness 18, 19, or (b) a score that defines a border between a first portion and a second portion of the label so that the length of the first portion corresponds to the perimeter of the container. Br. 9.

Even if Monico does not expressly describe or depict the claimed liner score line, the Examiner reasons that it would have been obvious to one of ordinary skill in the art to have sectional release liners in Monico, where the liners are perforated/cut to cover individual sections. Non-Final Act. 5–6. Appellant contends that the Examiner has not cited any reference that shows “sectional backing liners for different sections of the label.” Br. 12. To the extent it is Appellant’s position that Monico, Ferres, and/or Fales is required to explicitly disclose “sectional backing liners for different sections of the label,” we disagree. As stated in *KSR*, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *See KSR*, 550 U.S. at 418. Here, Appellant’s contentions do not apprise us error in the Examiner’s reasoning.

For these reasons, we sustain the rejection of claims 1 and 5.

Claim 2

For claim 2, Appellant relies on the same arguments presented for parent claim 1. Br. 14. Thus, we sustain the rejection of claim 2 for the same reasons as for claim 1.

Claim 3

Claim 3 depends from claim 2 and recites, “said backing sheet liner has a second liner score formed therein which corresponds to said further score line for removing a portion of said backing sheet liner from said third portion *which allows said third portion to adhere to said second portion when said first portion is attached to the container.*” Br. 18 (Claims App.) (emphasis added). The Examiner relies on the findings and reasoning provided for claim 1 about having “three independent liners” in Monico, which would allow the third portion to adhere to the second portion when the first portion is attached to a container of appropriate size. Non-Final Act. 8.

Appellant relies on the arguments presented for claim 1 with respect to “sectional backing liners for different sections of the label.” Br. 15. These contentions are not persuasive as discussed above for claim 1.

Appellant next contends there is no motivation to adhere the third portion of the label to the second portion in Monico, as this would render Monico unsatisfactory for its intended purpose. *Id.*

This contention is not persuasive. The Examiner proposes to modify the release liner in Monico to effectively have a distinct liner for each of the respective sections 21, 22, and 23. Claim 3 does not recite that the third portion *is* adhered to the second portion, but recites that the second liner score allows this. Appellant does not explain persuasively why the modified label structure of Monico would lack this capability. Thus, we sustain the rejection of claim 3.

Claim 4

Claim 4 depends from claim 1 and recites, “a face of said backing sheet liner which faces away from said adhesive backing *is formed of a material that can be printed on with a printer.*” Br. 19 (Claims App.) (emphasis added). The Examiner finds that the applied combination teaches this limitation. Non-Final Act. 8. The Examiner states, “[i]t is well known in the art that release liners are provided with silicone coating or wax material on a face that mates with adhesive where the opposite surface facing outward is not treated. This surface is very well known to be capable of being printed.” *Id.* The Examiner cites McKillip⁴ as evidence. *Id.* (citing McKillip, col. 3, ll. 6–9).

Appellant contends that Monico does not teach or suggest the limitation of claim 4. Br. 16. Appellant asserts that the Examiner impermissibly makes the assertion that this limitation is “very well known” without evidentiary support. *Id.*

These contentions are unpersuasive. Monico discloses that “[t]he release liner **28** is of any **35** conventional release liner material, such as *silicone coated paper.*” Monico, col. 4, ll. 34–36 (emphasis added). Although Monico does not expressly describe the limitation of claim 4, the Examiner cites McKillip as evidence to show that this limitation would be present in Monico’s label. Particularly, McKillip discloses that “[t]he release liner **22** . . . is made of *paper having a silicone coating*, as is well known in the art. If desired, *indicia may be printed on the back of the release liner.*” McKillip, col. 3, ll. 6–9 (emphasis added). Accordingly,

⁴ US 5,145,211, issued Sept. 8, 1992.

McKillip teaches that indicia can be printed on the back, that is, on the paper portion, of the conventional silicone coated paper. This teaching in McKillip provides evidentiary support for the Examiner's position that, in Monico's release liner 28 likewise made of conventional silicone coated paper, the back surface (i.e., "a face of said backing sheet liner which faces away from said adhesive backing") could be printed on by a printer. Appellant acknowledges the Examiner's citation to McKillip, but fails to persuasively address the Examiner's reliance on McKillip as evidence showing what Monico discloses with respect to release liner 28. As Appellant does not apprise us of error in the Examiner's findings or reasoning, we sustain the rejection of claim 4.

DECISION

We affirm the rejection of claims 1–5 as unpatentable over Monico, Ferres, and Fales.

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