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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* TETSUO OHASHI, YUKIO OIKAWA, and KEI SHINADA

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Appeal 2018-000530  
Application 14/126,838  
Technology Center 1700

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Before JEFFREY T. SMITH, N. WHITNEY WILSON, and  
AVELYN M. ROSS, *Administrative Patent Judges*.

ROSS, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

Appellant<sup>2</sup> appeals under 35 U.S.C. § 134(a) from a final rejection of claims 15–17, 19, and 21. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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<sup>1</sup> In our Decision we refer to the Specification filed December 16, 2013, as amended, (“Spec.”), the Final Office Action appealed from dated November 1, 2016 (“Final”), the Appeal Brief filed May 1, 2017 (“Appeal Br.”), the Examiner’s Answer dated August 21, 2017 (“Ans.”), and the Reply Brief filed October 22, 2017 (“Reply Br.”).

<sup>2</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Shimadzu Corporation. Appeal Br. 2.

### STATEMENT OF THE CASE

The subject matter on appeal relates to a vessel “for separating and collecting an accommodated substance . . . without contact with outside air or without leakage to the outside.” Spec. ¶ 1. According to the Specification,

an object of the invention is to provide a simple, quick, and low-processing cost method capable of reliably separating part (for example, a collection liquid) of an accommodated substance (for example, a manipulation medium for performing physical, chemical, and/or biochemical treatment and a collection liquid containing a target substance) accommodated in the same vessel-shaped structure only by simple mechanical operation while maintaining a hermetically-sealed state without any contact with an outside atmosphere.

*Id.* ¶ 11. Claim 15, reproduced below, is illustrative of the claimed subject matter:

15. A manipulation vessel for subjecting a sample containing an object component to a predetermined manipulation therein, the manipulation vessel comprising:  
a manipulation portion in which a sample containing an object component is subjected to a predetermined manipulation;  
a collection portion in which a target substance from the manipulation portion is collected; and  
a self-fusing material covering an outer surface of a part including an open end of the manipulation portion and an open end of the collection portion to integrally connect the manipulation portion and the collection portion together, and  
the manipulation vessel accommodating a manipulation medium selected from the group consisting of a liquid, a solid, a gas, and a dispersion system as a field for performing manipulation to which the object component is to be subjected.

Appeal Br. 21 (Claims App’x).

## REJECTIONS

The Examiner maintains<sup>3</sup> the following rejections:

- A. Claims 15–17 and 21 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Andersen<sup>4</sup> in view of Bennett<sup>5</sup> as evidenced by Rhino.<sup>6</sup> Final 2.
- B. Claim 19 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Andersen in view of Bennett as evidenced by Rhino and further in view of Hargreaves.<sup>7</sup> *Id.* at 5.

Appellant seeks our review of Rejections A and B. Appeal Br. 4. Appellant presents argument for claims 15, 16, and 17 (Rejection A), and does not separately argue the merits of any remaining claim. *See generally id.* However, because our basis for reversal—that is, the combination of Anderson and Bennett would render Anderson unsuitable for its intended

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<sup>3</sup> The Examiner withdraws the rejection of claim 19 under 35 U.S.C. § 112(b) as being indefinite and the provisional rejection of claims 15, 16, 19, and 21 on the ground of nonstatutory double patenting as being unpatentable over claims 1–3, 5, 7, and 10 of copending Application No. 14/387,116. Ans. 3.

<sup>4</sup> Ove Anderson, US 2010/0303688 A1, published December 2, 2010 (“Anderson”).

<sup>5</sup> Bennett et al., US 2006/0257665 A1, published November 16, 2006 (“Bennett”).

<sup>6</sup> Rhino Linings of the Metroplex, Frequently Asked Questions: Truck Bedliners – General Q&A (2003–2008) (“Rhino”).

<sup>7</sup> William R. Hargreaves, US 6,121,055, issued September 19, 2000 (“Hargreaves”).

purpose—is common to all rejected claims, we focus our discussion below on independent claim 15.

## OPINION

We review the appealed rejections for error based upon the issues identified by Appellant and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) (*cited with approval* in *In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (“[I]t has long been the Board’s practice to require an applicant to identify the alleged error in the examiner’s rejections . . . .”). After considering the evidence presented in this Appeal and each of Appellant’s arguments, we are persuaded that Appellant identifies reversible error. Thus, we do not sustain the Examiner’s rejections for the reasons expressed below.

### *Obviousness (claims 15–17 and 21)*

The Examiner rejects claims 15–17 and 21 as obvious over the combination of Anderson and Bennett, as evidenced by Rhino. Final 2.

The Examiner finds that Anderson teaches most of the limitations of claim 15, including a manipulation vessel having manipulation portion containing an object containing portion and collection portion for collecting a target substance. *Id.* at 4; *see also* Figs. 2–3 (ends 2A and 2B). The Examiner finds that the “manipulation vessel is punctured and split into two separate pieces.” *Id.* The Examiner acknowledges that “Anderson does not teach a self-fusing covering an outer surface which is capable of integrally connecting the manipulation portion and the collection portion together,” but finds that Bennett describes a liquid container with a coating that provides a liquid tight seal. *Id.* Bennett’s coating is a highly elastomeric, self-fusing

polyurethane which can connect the manipulation and collection portions together and prevent leakage. *Id.* at 4–5. The Examiner concludes that one skilled in the art would have reason to incorporate Bennett’s self-fusing material into Anderson’s manipulation vessel “in order to provide a liquid tight seal under conditions where the manipulation vessel is punctured.” *Id.* at 5.

Appellant contends that a person of ordinary skill in the art would not have been motivated to provide Bennett’s composite layer to the manipulation vessel of Anderson because the combination would render Anderson unsuitable for its intended purpose. Appeal Br. 9–10. Appellant explains that “the purpose of the device of Anderson is to break off specimens in the breakable multi-specimen storage vessel” and that “add[ing] or apply[ing] the composite-material (i.e., self-fusing material) of Bennett et al., to the breakable multi-specimen storage vessel of Anderson . . . would prevent the storage vessel from breaking into multiple pieces.” *Id.* at 9.

On this record, we agree with Appellant that the Examiner’s rejection fails to show a prima facie case of obviousness. There can be no motivation to combine the teachings of references if to do so would render the prior art invention being modified unsatisfactory for its intended purpose. *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984); *see also McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1354 (Fed. Cir. 2001) (“If references taken in combination would produce a ‘seemingly inoperative decide,’ we have held that such references . . . cannot serve as predicates for a prima facie case of obviousness.”).

Here, Anderson describes a breakable multi-specimen storage vessel for biological samples that are often stored in a frozen state. Anderson ¶¶ 2, 11. Anderson explains that

Biological samples, such as substances in solution, e.g. blood samples, water tests, and tissue samples such as fertilized embryos, can often be effectively stabilized by freezing. The frozen fluid and/or sample will remain stable for extended periods of time as long as it is kept in the frozen state. Frequently these samples are collected in relatively large quantities, or collective sample, but could be utilized in smaller quantities, or specimens e.g. for test purposes.

*Id.* ¶ 3. Anderson explains that problems exist when a smaller specimen is needed because it “often requires thawing the entire collective sample to obtain the specimen currently needed.” *Id.* As a result of repeated freezing and thawing cycles, the collective sample often becomes unstable. *Id.* Anderson purports to overcome the problems existing in the prior art by providing a container that can store “a frozen collective sample [that] may be divided into smaller quantities or specimens.” *Id.* at 13. Anderson explains that by utilizing a container that includes “multiple break portions at which the container may be divided . . . [t]he remaining samples can be stored or transported for processing or testing without having to be thawed and refrozen.” *Id.* at 14. Therefore, critical to Anderson’s specimen container is the ability to break into segments. The Examiner proposes combining Anderson’s container with the composite coating of Bennett “in order to provide a liquid tight seal under conditions where the manipulation vessel is punctured.” Ans. 9. According to Bennett, its Tuff Stuff® composite material is useful, for example, for coating “a hydrocarbon fuel tank in a military fuel tanker vehicle” (Bennett ¶ 14) “to defeat liquid

leakage following a projectile penetration of the container” (*id.* at ¶ 42). Tuff Stuff<sup>®</sup> is a cured resin that dries quickly after coating, is intended to become a permanent fixture once applied, and is “specifically engineered not to warp, crack, peel or split.” Rhino, 3–4. Therefore, and as Appellant explains (Reply Br. 3), when combined with Bennett’s composite layer, Anderson’s vessel would be prevented from breaking, rendering Anderson inoperable for its intended purpose.

In the Answer, the Examiner states that the combination of Bennett and Anderson has been done for a different reason, that is, “in order to provide a liquid tight seal under conditions where the manipulation vessel is punctured.” Ans. 9. However, that the Examiner combines the teachings of Anderson and Bennett for a different reason than Appellant, does not change the fact that Anderson, as modified, would not be useful for its intended purpose. Accordingly, on this record, we cannot sustain the Examiner’s rejection of claim 15.

Because Appellant has argued persuasively that the Examiner’s modification of Anderson’s manipulation vessel to include Bennett’s composite layer would render Anderson unsatisfactory for its intended purpose, we do not sustain the rejection of independent claim 15 or its dependent claims 16–17, 19, and 21.

#### CONCLUSION

Appellant identified a reversible error in the Examiner’s rejection of claims 15–17 and 21 under 35 U.S.C. § 103(a) as unpatentable over Andersen in view of Bennett as evidenced by Rhino.

Appellant identified a reversible error in the Examiner's rejection of claims 19 under 35 U.S.C. § 103(a) as unpatentable over Andersen in view of Bennett as evidenced by Rhino and further in view of Hargreaves.

**DECISION**

For the above reasons, the Examiner's rejection of claims 15–17, 19, and 21 is reversed as summarized below.

<b>Claims Rejected</b>	<b>Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
15–17, 21	§ 103 Anderson and Bennett as evidenced by Rhino		15–17, 21
19	§ 103 Anderson, Bennett as evidenced by Rhino, and Hargreaves		19
<b>Overall Outcome</b>			15–17, 19, 21

**REVERSED**