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14/981,791	12/28/2015	Allen K. Bates	TUC1P162A/ TUC920120099US2	5851
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ZILKA-KOTAB, PC- IBM 1155 N. 1st St. Suite 105 SAN JOSE, CA 95112			KRCHA, MATTHEW D	
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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* ALLEN K. BATES, NILS HAUSTEIN, STEPHEN L. SCHWARTZ, ANNA W. TOPOL, and DANIEL J. WINARSKI

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Appeal 2019-001040  
Application 14/981,791  
Technology Center 1700

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BEFORE MICHAEL P. COLAIANNI, MONTÉ T. SQUIRE, and SHELDON M. MCGEE, *Administrative Patent Judges*.

McGEE, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner's decision to reject claims 1–4 and 6–21.

We have jurisdiction. 35 U.S.C. § 6(b).

We affirm-in-part.

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<sup>1</sup> We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as International Business Machines Corporation. Appeal Br. 2.

### SUBJECT MATTER

The claims are directed to a cartridge for storing biological samples, where the cartridge has the same form factor as a data tape cartridge used in an automated tape library. By having such a form factor, “[t]he biosample storage cartridges may be handled by the same robotic mechanisms that handle data cartridges in automated data storage library systems,” purportedly allowing for convenient access, manipulation, processing, and long-term archival storage of the biosamples contained therein. Spec. ¶¶ 5, 20.

Claim 1, reproduced below, is illustrative, with the dispositive limitation in this appeal italicized for emphasis:

1. A cartridge for storing biosample carriers, comprising:  
*an enclosure having the same form factor as a data tape cartridge used in an automated tape library; and*  
a rotatable biosample carrier holder disposed in the enclosure and having a plurality of radial slots for receiving the biosample carriers.

Appeal Br. 24.

### REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Suzuki	US 4,200,607	Apr. 29, 1980
Smith	US 5,897,090	Apr. 27, 1999
Mengel	US 6,167,767 B1	Jan. 2, 2001
Strand	US 2002/0155033 A1	Oct. 24, 2002
Kuo	US 6,769,760 B1	Aug. 3, 2004
Melching	US 2004/0212285 A1	Oct. 28, 2004
Srinivas	US 2010/0230344 A1	Sept. 16, 2010
Pedrazzini	US 2011/0158850 A1	June 30, 2011
Katsumi	US 2011/0223063 A1	Sept. 15, 2011

## REJECTIONS

The claims are rejected under pre-AIA 35 U.S.C. § 103(a) as follows:

- I. Claims 1–4, 6, 10, 13, and 16–20 as obvious over Mengel in view of Melching;
  - II. Claim 7 as obvious over Mengel, Melching, and Smith;
  - III. Claim 8 as obvious over Mengel, Melching, and Kuo;
  - IV. Claim 9 as obvious over Mengel, Melching, and Srinivas;
  - V. Claim 11 as obvious over Mengel, Melching, and Katsumi;
  - VI. Claim 12 as obvious over Mengel, Melching, and Suzuki;
  - VII. Claims 13 and 14 as obvious over Mengel, Melching, and Pedrazzini;
  - VIII. Claim 15 as obvious over Mengel, Melching, and Strand;
- and
- IX. Claim 21 as obvious over Mengel, Melching, Suzuki, Pedrazzini, Strand, Smith, Kuo, Srinivas, and Katsumi.

Additionally, claims 1–4, 6–18, and 20 are rejected on the ground of non-statutory obviousness type double patenting over claims 1–3, 4–18, and 20 of U.S. Patent 9,250,254.

## OPINION

### *The Obviousness Rejections*

Because the dispositive limitation is recited in each independent claim, we need only discuss the Examiner’s obviousness rejection of claim 1. In rejecting this claim, the Examiner finds that Mengel teaches all of the recited limitations except for the claimed “enclosure having the same form factor as a data tape cartridge used in an automated tape library.”

Final Act. 4. To address this difference, the Examiner relies on Melching, which the Examiner finds “teaches a climatic cabinet in which a monitor device is designed with respect to its form and outside dimensions so that it can be transported by a transporting system and laid on a specimen storage place.” *Id.* Based on this disclosure, the Examiner determines it would have been obvious for the skilled artisan “to select the shape of a data tape cartridge for the purpose of allowing the enclosure to be transported by a transporting system and laid in its storage place.” *Id.*

We reverse each of the obviousness rejections. As Appellant correctly argues (Appeal Br. 9–12), the relied upon prior art does not teach or suggest a tape cartridge having the claimed form factor. Furthermore, the Examiner’s reasoning regarding why the skilled artisan would have changed the shape of Melching’s “monitoring device,” e.g., a barcode scanner or camera, is insufficient to demonstrate how the skilled artisan would have been motivated to design Mengel’s enclosure to have the claimed form factor. Melching ¶¶ 3, 19. As Appellant succinctly states, “Melching’s monitoring device and Mengel’s cartridges are very different structures, and serve different functions, such that a skilled artisan would not appreciate a teaching as to the form of one to be informative to the appropriate form of the other.” Appeal Br. 11.

#### *Obviousness-Type Double Patenting*

The Examiner rejects claims 1–4, 6–18, and 20 under the judicially created doctrine of obviousness-type double patenting over certain claims of US Patent 9,250,254. Final Act. 14.

We affirm this rejection. Appellant does not present arguments regarding the scope of the appealed claims vis-à-vis those of the ’254 patent.

Rather, Appellant focuses on the public policy governing the judicially created doctrine, and how that policy does not apply to this particular case. Appeal Br. 7–8. Specifically, Appellant argues that there is no risk of an unjust extension of patent rights because this application is a family member of the '254 patent, and there is no possibility for harassment by multiple assignees because “[t]he present application and the '254 patent remain, and always have been, assigned to” a common entity. *Id.* at 8.

We are not persuaded by Appellant’s argument regarding multiple assignees because, as correctly noted by the Examiner, the application could be assigned in the future. Ans. 3.

### CONCLUSION

The Examiner’s obviousness rejections are reversed.

The Examiner’s obviousness-type double patenting rejection is affirmed.

### DECISION SUMMARY

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1–4, 6, 10, 13, 16–20	103	Mengel, Melching		1–4, 6, 10, 13, 16–20
7	103	Mengel, Melching, Smith		7
8	103	Mengel, Melching, Kuo		8
9	103	Mengel, Melching, Srinivas		9
11	103	Mengel, Melching, Katsumi		11
12	103	Mengel, Melching, Suzuki		12

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
13, 14	103	Mengel, Melching, Pedrazzini		13, 14
15	103	Mengel, Melching, Strand		15
21	103	Mengel, Melching, Suzuki, Pedrazzini, Strand, Smith, Kuo, Srinivas, Katsumi		21
1-4, 6-18, 20		Nonstatutory Double Patenting	1-4, 6-18, 20	
<b>Overall Outcome</b>			1-4, 6-18, 20	19, 21

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**