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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PATRICK O. TENNICAN

Appeal 2019-002469
Application 15/349,828
Technology Center 3700

Before JENNIFER D. BAHR, JOHN C. KERINS, and DANIEL S. SONG,
Administrative Patent Judges.

KERINS, *Administrative Patent Judge.*

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant appeals from the Examiner's decision to reject claims 21–23 and 25–36.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ The term “Appellant” is used herein to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Hyprotek, Inc. Appeal Br. 3.

THE CLAIMED SUBJECT MATTER

Appellant's invention relates to a plurality of caps releasably attached to a substrate. Claim 21 is illustrative, and is reproduced below:

21. An apparatus comprising:

a plurality of caps, each cap having an opening and a cavity, and each cap including a film releasably attached to the respective cap adjacent the opening to seal the cavity; and

a substrate to which each cap is releasably attached consecutively via an external surface of a closed end of the respective cap opposite the film at the opening sealing the cavity such that each cap is individually removable from the substrate without separating the film from the opening, the substrate, when the plurality of caps are and are not attached to the substrate, being a flexible and rollable strip, and the plurality of caps being disposed in a row along a length of the rollable strip.

THE REJECTIONS

The Examiner rejects:

(i) claims 31–36 under 35 U.S.C. § 112(a) as failing to comply with the written description requirement; and

(ii) claims 21–23 and 25–36 under 35 U.S.C. § 103 as being unpatentable over Tennican (US 2013/0138085 A1, published May 30, 2013) in view of Iwasaki (US 2005/0123749 A1, published June 9, 2005) and Bunnelle (US 2012/0213956 A1, published Aug. 23, 2012).

ANALYSIS

Claims 31–36--§ 112(a), written description

The Examiner finds that the limitation in claim 31 requiring that “the flexible, rollable substrate strip is rollable when the plurality of caps are and

are not attached to the substrate,” lacks written descriptive support in the application as filed. Final Act. 2–3. The Examiner acknowledges that the Specification discloses that the substrate may be made of a flexible, rollable material, but “[n]owhere is the substrate disclosed as being rollable when a plurality of caps are attached.” *Id.* at 3. The Examiner also points out that the drawing figures also do not show a substrate strip with a plurality of caps attached thereto in a rolled condition. *Id.*

Appellant argues that paragraphs 46 and 47 provide ample written descriptive support for the limitation at issue. Appeal Br. 8. Appellant relies principally on the following passage in paragraph 47:

In some embodiments, the substrate 802 may be composed of a flexible, rollable thermoplastic material. Individually sealed cap devices may then [be] dispensed by cutting between the cap devices 800(1)–(4) in the substrate 802.

Spec. ¶ 47; Appeal Br. 8–9.

Appellant urges that a grammatical dissection of the sentences leads inescapably to an understanding that the presence of the word “then” implies that “rollable” means “rolled” in terms of describing the substrate, and that it would be understood that the substrate would be rolled with the cap devices affixed thereto. *Id.* Appellant then posits three questions, to which Appellant maintains the logical answers would lead to the understanding that, in describing the substrate as being rollable, the person of ordinary skill in the art would understand that Appellant had possession of subject matter including a substrate having cap devices secured thereon being rollable. *Id.* at 9–10.

None of this is particularly instructive as to whether a person of ordinary skill in the art would understand Appellant to have been in

possession of the limitation at issue in claim 31. For all of the purported importance Appellant attaches to the presence of the word “then” in the passage quoted above, more likely than not it is present because, in the drafting of the present Specification, the sentence it appears in and the preceding sentence were fashioned after the following disclosure, at paragraph 35 of the Tennican reference (cited in the § 103 rejection):

The result is a strip 702 containing multiple individually sealed devices. Individual devices may then [be] dispensed by cutting between the devices in the strip 702.

Tennican ¶ 35. The similarities, including the presence of the same typographical error, “may then by,” are undeniable. Of interest here is that this passage from Tennican involves the finishing of the packaging, thereby readying the devices for dispensing. The strip being rollable or rolled does not appear to be of concern. Similarly, in Appellant’s current Specification, the manner in which Appellant’s cap devices may “then” be dispensed has little to nothing to do with whether the strip they are fastened to is rollable or not, or rolled or not. There is thus no true connection between the two sentences in paragraph 47 cited by Appellant. We therefore do not ascribe to contorting the meaning of terms and importing them from one sentence into the other, just because what appears to be imprecise application drafting might “grammatically” seem to mean something other than what it says.

We, like the Examiner, are not inclined to speculate as to why the Specification describes the substrate as being rollable, if the finished products with the cap devices thereon were not rollable, and, thereafter, rolled. A rollable substrate in rolled form, for example, might well facilitate the feed of the substrate material to a manufacturing station at which the cap devices are introduced for affixation thereto.

We thus are not persuaded that paragraphs 46 and 47 of Appellant's Specification clearly evidence that a person of ordinary skill in the art would understand Appellant to be in possession of a device in which the substrate strip is rollable when a plurality of caps are attached thereto. However, the manner in which paragraph 8 of the Specification describes the invention, which Appellant belatedly points out in the Reply Brief, does, we believe, provide adequate evidence that Appellant was in possession of a substrate strip being rollable, however bulkily, with caps attached thereto. The relatively simple statement that "a top end of each cap device may be consecutively adhered to a roll-able strip," adequately conveys that the strip is contemplated to be rolled up once the cap devices are adhered thereto. Spec. ¶ 8. Moreover, the claims do not require that the substrate actually be rolled with the cap devices thereon, and attaching the cap devices would not appear to destroy the material property of the substrate being rollable.

Accordingly, the rejection of claims 31–36 under 35 U.S.C. § 112(a), written description, is not sustained.

Claims 21–23 and 25–36--§ 103--Tennican/Iwasaki/Bunnelle

The Examiner cites to Tennican as disclosing the claimed caps, but not a flexible and rollable strip to which an external surface of the closed ends of the caps are releasably attached. Final Act. 4. The Examiner cites to Iwasaki as disclosing a flexible and rollable strip to which articles are attached, and to Bunnelle as disclosing attaching the closed ends of articles to a substrate in a packaging process. *Id.* at 4–5. The Examiner concludes that it would have been obvious to attach the Tennican caps to a rollable and flexible strip of the type disclosed in Iwasaki, with the orientation taught by

Bunnelle, so that the caps can easily be detached and so that there is accessibility to the open ends of the caps. *Id.* at 5.

Among Appellant’s arguments is an assertion that Iwasaki is nonanalogous art, and therefore improperly combined with Tennican in reaching the obviousness conclusion. Appeal Br. 12 (Iwasaki being in “a technological field unrelated to medical caps”); Reply Br. 11–13.²

The Examiner appears to find that Iwasaki is not considered to be in the same field of endeavor as the claimed invention, in that, in response to Appellant’s statement about the different technological fields, the Examiner mainly asserts that “Iwasaki is pertinent to the problem of consecutively organizing products on a substrate.” Ans. 15. Appellant maintains that this characterization of the problem is excessively specific, and notes instead that the problem faced is “considering how to package the individual cap devices in a convenient and simple way.” Reply Br. 12.

Appellant additionally argues that Iwasaki is directed to a display means for bagged snacks, and that it would not have been reasonably pertinent to Appellant’s problem, because the bagged snack articles have no similarity in shape or size to the cap devices, and there is no similar concern about the sterilization requirements for the cap devices. Reply Br. 13.

Appellant has the better position here. Consecutively organizing cap articles in packaging, albeit in a strip of individually sealed compartments, is disclosed in Tennican, which shares the same inventive entity and ownership as the present application, and thus would not be the

² The pages of the Reply Brief are unnumbered. We start the page count at the title page.

particular problem faced in the present invention. Thus, the Examiner's proffered problem to be solved is at least partially defective.

The present Specification provides precious little guidance as to a particular problem faced, but it appears that developing a packaging scheme allowing easier access to the caps, and/or a less expensive way to package the caps, as compared to the packaging approach in Tennican, underlie the presently claimed invention. As such, the problem faced by the inventor was also not specifically how to attach the caps to a substrate. Attaching the caps to a substrate is part of the solution, not part of the problem. Given that the articles (caps and chip bags) are markedly different in type, shape, and size, Iwasaki is not seen as being reasonably pertinent to the problem of more efficiently packaging the claimed caps.

The rejection of claims 21–23 and 25–36 as being unpatentable over Tennican, Iwasaki, and Bunnelle is not sustained.

DECISION

The rejection of claims 31–36 under 35 U.S.C. § 112(a) as failing to meet the written description requirement, is reversed.

The rejection of claims 21–23 and 25–36 under 35 U.S.C. § 103 is reversed.

CONCLUSION

In summary:

Claims Rejected	Basis	Affirmed	Reversed
31-36	§ 112(a) written description		31-36
21-23, 25-36	§ 103 Tennican, Iwasaki, Bunnelle		21-23, 25-36
Overall Outcome			21-23, 25-36

REVERSED