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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANTHONY MICHAEL FONTECCHIO

Appeal 2019-003761
Application 15/651,812
Technology Center 3700

Before KEVIN F. TURNER, DANIEL S. SONG, and
BRANDON J. WARNER, *Administrative Patent Judges*.

SONG, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ 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 the inventor, Anthony Michael Fontecchio. Appeal Br. 1.

CLAIMED SUBJECT MATTER

The claims are directed to an insulin pen holder and storage device.

Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. An injector pen holder, comprising:
a base plate having first and second opposing sides;
an attachment structure affixed to the first side of the base plate;
a plurality of retaining members connected to the second side of the base plate, each retaining member *having a respective pair of opposing sides, wherein each opposing side extends from the second side of the base plate toward a respective opposing side to a respective first edge parallel to a first edge of the respective opposing side and to the second side of the base plate forming a region there between* configured to receive a respective injector pen; and
a support member connected to the base plate and arranged to support one end of each said respective injector pen.

Appeal Br. 22, Claims App. (emphasis added).

REJECTIONS

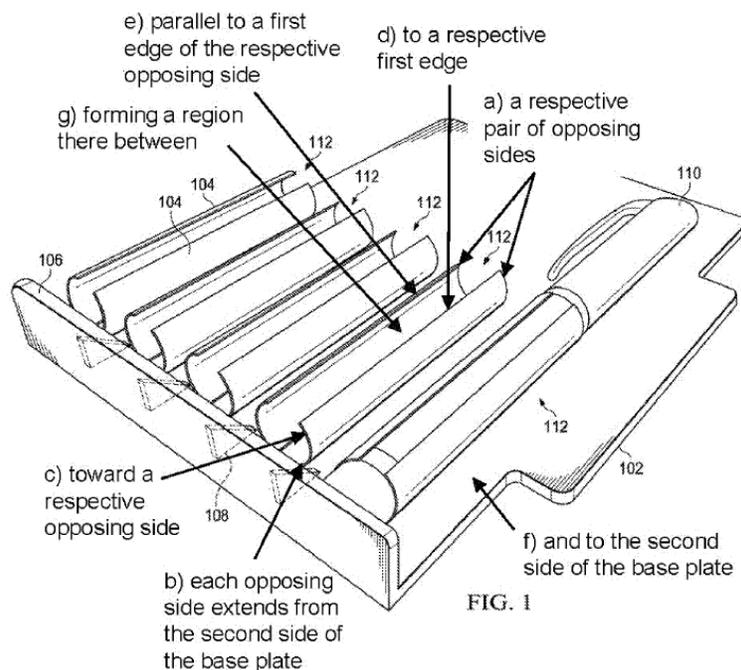
1. The Examiner rejects claims 1–20 under 35 U.S.C. § 112(a) as failing to comply with the written description requirement. Final Act. 2.
2. The Examiner rejects claims 1–20 under 35 U.S.C. § 112(b) as being indefinite. Final Act. 4.
3. The Examiner rejects claims 1, 3, 4, 6, 9–12, and 14–19 under 35 U.S.C. § 102(a)(2) as anticipated by Jesse (US 6,955,259 B1, iss. Oct. 18, 2005). Final Act. 6.
4. The Examiner rejects claims 2, 5, 7–9, 13, and 20 under 35 U.S.C. § 103 as unpatentable over Jesse in view of Yakel (US 9,084,593 B2, iss. July 21, 2015) or Spilotro (US 8,955,697 B2, iss. Feb. 17, 2015). Final Act. 7.

OPINION

Rejection 1: Written Description

The Examiner rejects all of the pending claims for failure to comply with the written description requirement. Final Act. 2. Each of independent claims 1, 10, and 16 was amended by the Appellant to include the language of claim 1 italicized above. Amendment filed September 21, 2018. The Examiner finds that the subject matter of the amended claim language was “not described in the written description so as to show possession.” Final Act. 3. Specifically, the Examiner finds that the added text of the claims “lack[s] any support whatsoever in the detailed written description text.”
Ans. 5.

The Appellant argues that the figures of the application provide written descriptive support, and submits an annotated version of Figure 1, which identifies the various recitations of the claim language at issue. Appeal Br. 8, Figure 1 (annotated). The annotated Figure 1 is reproduced below.



The annotated Figure 1 reproduced above shows a perspective view of an injector pen holder with numerous annotations with leading arrows pointing to various features of the injector pen holder that correspond to the added claim limitations. According to the Appellant, “[t]he annotated FIG. 1 above shows every feature added to each independent claim in Appellant’s amendment.” Appeal Br. 9. The Appellant also argues that the rejection is improper because the Examiner “only relies on his own subjective opinion” rather than considering the disclosure as it would be understood by one of ordinary skill in the art. Reply Br. 5; *see also* Reply Br. 7 (“The proper objective standard is whether a person skilled in the art would recognize the inventor had possession of the claimed invention with reference to the drawings and written description. It is not a subjective standard where an examiner arbitrarily decides what constitutes sufficient detail.”).

We agree with the Appellant that the drawings of the application as filed sufficiently establish that the Appellant was in possession of the claimed invention for the reasons argued, and address the Examiner’s responses *infra*.

The Examiner points out that “[t]he annotations in annotated Fig 1 are not part of the application disclosure as filed,” but instead, the annotations “have been added by the applicant to show the same subject matter that was added by amendment to the claims.” Ans. 9. The Examiner states that the Appellant “cannot amend the claims and the drawings . . . to add therein features that are not in the written description and argue convincingly that the added features are a part of the application as filed.” Ans. 9.

However, one describes the invention to show “possession” of the invention using descriptive means, which include figures and diagrams that

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fully set forth the claimed invention. *See Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997); *see also Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1565 (Fed. Cir. 1991) (“drawings alone may provide a ‘written description’ of an invention as required by § 112”). The annotations to Figure 1 *do not add to the subject matter disclosed* in Figure 1, but are provided to identify/point to the structure corresponding to the added recitations of the claims, in response to the Examiner’s written description rejection. We agree with the Appellant that Figure 1 illustrates the claimed invention to sufficiently demonstrate possession.

The Examiner further responds that the drawings still fail to establish written description because the claims require the opposing sides to extend “from the second side of the base plate toward a respective opposing side” but “it is apparent that the opposing sides 104 extend at least initially ‘away from’, not ‘towards’ each other.” Ans. 5–6. However, as the Examiner’s response implies, the drawings nonetheless disclose opposing sides that extend toward each other. Spec., Fig. 1.

The Examiner also finds that the recitation “to a respective first edge parallel to a first edge of the respective opposing side” is not supported by the drawings because “there is no indication whatsoever from the drawings that the edges are parallel.” Ans. 6. However, Figures 1 and 3 in combination show that the edges of the opposing sides are parallel to each other. *See* Figs. 1 and 3. According to the Examiner, “Fig 3, like the other figures, does not point to any edges” so “by itself does not conclusively show anything to be parallel.” Ans. 6. Although the originally filed drawings do not include helpful annotations, this does not detract from what Figures 1 and 3 actually show, which is that the illustrated edges of the opposing sides are parallel.

The Examiner further finds that the recitation “and to the second side of the base plate” is also not supported by the drawings because this recitation allows for two different interpretations, one of which is not supported by the drawings. Ans. 6–7. In that regard, the Examiner initially interprets the recitation “each opposing side extends from the second side of the base plate toward a respective opposing side to a respective first edge parallel to a first edge of the respective opposing side and to the second side of the base plate” to mean that each opposing side extends from the base plate to the first edge, and then “go[es] back down from the first edge” to the base. Ans. 6–7. The Examiner finds that such configuration lacks written descriptive support. Ans. 7. As to an alternative interpretation, the Examiner concedes that “it is also possible that the final claim limitation above is to be interpreted as if the word ‘parallel’ was inserted immediately after ‘and’,” so that “the limitation requires is that the first edge is parallel to the second side of the base.” Ans. 7. Accordingly, the Examiner explains that “[g]iven that it is reasonable to interpret that last underlined claim limitation in at least the indicated two ways with only the application drawings in hand, it is apparent that a rejection for lack of adequate written description for that claimed subject matter is also required.” Ans. 7.

However, we disagree that the Examiner’s initial interpretation of the claims is reasonable. As argued by the Appellant, the Examiner’s initial interpretation construes the limitations at issue in a piecemeal manner. *See* Final Act. 6; Reply Br. 4 (“Examiner has intentionally omitted the words in italics to justify his contention that ‘it is reasonable to interpret that last underlined claim limitation in at least two ways.’”). We agree with the Appellant that the limitations at issue “include two prepositional phrases in the conjunctive case, which both modify parallel. Thus, each first edge is

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parallel to a first edge of an opposing side and to the second side of the base plate.” Reply Br. 4. The Examiner’s initial interpretation is not reasonable in view of the claim language itself, and the disclosure via the drawings. Indeed, the Examiner even concedes that the initial interpretation results in a limitation that is “redundant,” recites something that is not necessary, and recites something not shown in the drawings or otherwise discussed in the Specification. *See* Final Act. 6–7. Accordingly, we disagree with the Examiner’s assertion that such interpretation is reasonable.

The Examiner also asserts that “there is no indication from the drawings that the first edges are parallel to the base” and that the edges can be sloped, and as such, determines that there is no written descriptive support for the recitation that the first edges are parallel to the base. Ans. 7. However, Figures 1–2D illustrate that the edges are parallel to the base, and do not illustrate sloping or angling relative to the base. Spec., Figs. 1–2D.

The Examiner also states that “[s]ince the claim limitations were added to the application disclosure by amendment to the claims, the rejection is also one for new matter.” Final Act. 3. However, no disclosure has been added to the Specification or the drawings, and a new matter rejection was not was not made by the Examiner. Accordingly, this statement of the Examiner is not pertinent to the present appeal.

Dependent claim 8 was also amended to recite “a first bracket fixture” and “a second bracket fixture.” Amendment filed September 21, 2018. The Examiner further determines that “features of claim 8 were also not described in the application written description,” and that “it is not clear from the description what is intended by ‘first mounting bracket’ and ‘second mounting bracket.’” Final Act. 3.

However, as the Appellant points out, the Specification explicitly discloses a “first bracket fixture 210” and a “second bracket fixture 212.” Appeal Br. 10; Spec. ¶ 20. Although the claim may be broad in the sense that it does not define in detail the configuration of the mounting brackets, this does not mean that written descriptive support has not been provided.

Thus, we disagree with the Examiner’s assertion that the claim limitations added by amendment lack written descriptive support, and we reverse this rejection of claims 1–20.

Rejection 2: Indefiniteness

The Examiner also rejects claims 1–20 as indefinite, determining that in view of the lack of adequate written description, the added recitations of the independent claims “cannot be properly understood or interpreted.” Final Act. 4. However, as discussed above, the added recitations are sufficiently supported by the drawings.

The Examiner also determines that “it is not clear how each opposing side can be said to extend from the second side of the base plate toward a respective opposing side” because the drawings show each side extending “at least initially from the second side of the base plate **away** from an opposing side.” Final Act. 5. However, the fact that the opposing sides initially extend away from each other before extending toward each other does not make the explicit recitation indefinite. *See also* Appeal Br. 13 (Appellant arguing that the Specification and Figure 1 shows the sides “formed in a semicircular configuration” such that the sides eventually extend toward the opposing side, and that the claim recitation “is directed to a part of each side that does extend toward a respective opposing side”).

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This recitation is sufficiently clear as to what it says and sets forth the subject matter which the applicant regards as his invention.

The Examiner also determines that it is not clear how the limitations “to a respective first edge,” and “and to the second side of the base plate” further limit the claims. Final Act. 5. However, the initial claim interpretation of the Examiner is unreasonable for the reasons already discussed above relative to Rejection 1. As the Appellant argues, the limitation “to a respective first edge” “defines the extent of a side of a retaining member of the embodiment of FIG. 1,” and these limitations, “require[] . . . ‘a respective first edge’ to be ‘parallel to a first edge of the respective opposing side **and** to the second side of the base plate.’” Appeal Br. 13.

The Examiner also determines that the Appellant is “relying solely on the application drawings for interpretations of the claim limitations,” and “is improperly relying on only appellant[']s own interpretations of the application drawings.” Ans. 11. However, the rejection at hand is that of indefiniteness, and the question is whether the claims are ambiguous, vague, incoherent, opaque, or otherwise unclear. *See In re Packard*, 751 F.3d 1307, 1311 (Fed. Cir. 2014). Although the Examiner has asserted that the added limitations are amenable to two different interpretations, as discussed relative to Rejection 1, we find the initial claim interpretation of the Examiner to be unreasonable, and agree with the Appellant’s interpretation.

As to dependent claim 8, the Examiner determines that claim 8 “cannot be properly understood or interpreted given the deficiency in the written description and drawings indicated above.” Final Act. 4. However, as discussed above, the assertion of lack of written description is unfounded.

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See Appeal Br. 16 (Appellant arguing that adequate descriptive support has been provided).

Accordingly, we agree with the Appellant that the limitations added to the independent claims sufficiently define features in the drawing and “particularly point out and distinctly claim the subject matter which the Appellant regards as his invention.” Appeal Br. 12. Therefore, we reverse the rejection of claims 1–20 for indefiniteness.

Rejection 3: Anticipation

The Examiner rejects claims 1, 3, 4, 6, 9–12, and 14–19 as anticipated by Jesse. Final Act. 6. In particular, the Examiner finds, *inter alia*, that Jesse discloses “each opposing side extend[ing] towards a respective opposing side (note Fig 4 that shows each opposing side extending in an arc towards a respective opposing side),” and “at the top and bottom of Fig 4, each edge of a side extends parallel to an edge of the respective opposing side.” Final Act. 7. The Examiner further explains that “[t]he end of the lead line from numeral 18 in Fig 1 touches a first edge as shown in the figure. It has an opposite in the other side (clip) and both edges are parallel.” Ans. 13. Thus, the Examiner considers the edge surface of each clip member 16, 18 extending perpendicularly to the second side of the base 12 in Jesse to correspond to the claimed “first edge.”

However, in accordance with the Examiner’s application of Jesse, “[n]o first edge of member 16 of Jesse is parallel to a first edge of member 18 and to base 12. Likewise, no first edge of member 18 of Jesse is parallel to a first edge of member 16 and to base 12.” Appeal Br. 18. Thus, we agree with the Appellant that “Jesse DOES NOT disclose ‘a respective first edge parallel to a first edge of the respective opposing side and to the second

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side of the base plate’ as required by independent claims 1, 10, and 16.”
Appeal Br. 18 (emphasis omitted).

According to the Examiner, the pertinent limitation of the claims is met because “each member of the pair extends to the second side of the base plate (in the same manner as each extended from the second side of the base plate).” Ans. 13. However, this reasoning is based on the previously discussed initial interpretation of this limitation, which, as explained above, is unreasonable.

Moreover, we further note that it is not apparent how a clip member, i.e., “opposing side,” can be reasonably considered to “extend[] from the second side of the base plate toward a respective opposing side” as required by the claims. In particular, we observe that in Jesse, the clip members, although curved along the base plate, extend “from . . . the base plate” perpendicularly outward such that the distance between the clip members is not changed relative to each other as the clip members extend from the base plate. Accordingly, the clip members of Jesse do not extend “toward a respective opposing side” as they extend from the base plate, as the claims require. *See Jesse*, Fig. 1.

Therefore, in view of the above considerations, we reverse this anticipation rejection of the independent claims 1, 10, and 16, as well as of claims 3, 4, 6, 9, 11–12, 14, 15, and 17–19. The remaining disputed issues regarding the shelf 28 of Jesse are moot. *See Final Act. 6; Appeal Br. 18–19; Ans. 14.*

Rejection 4: Obviousness

The Examiner rejects claims 2, 5, 7–9, 13, and 20 as unpatentable over Jesse in view of Yakel or Spilotro. Final Act. 7. The Examiner relies

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on Yakel or Spilotro for disclosing the recited limitations of these dependent claims pertaining to the gusset, suction cups, hook/loop fasteners, and brackets, to conclude that these claims would have been obvious to one of ordinary skill in the art. However, the Examiner's application of these secondary references does not address the above-discussed deficiencies of Jesse as to the rejection of the independent claims from which these claims ultimately depend. Accordingly, this obviousness rejection of claims 2, 5, 7-9, 13, and 20 is also reversed.

CONCLUSION

The Examiner's rejections are reversed.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1-20	112(a)	Written Description		1-20
1-20	112(b)	Indefiniteness		1-20
1, 3, 4, 6, 9-12, 14-19	102(a)(2)	Jesse		1, 3, 4, 6, 9-12, 14-19
2, 5, 7-9, 13, 20	103	Jesse and Yakel or Spilotro		2, 5, 7-9, 13, 20
Overall Outcome				1-20

REVERSED