

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN H. SILVER AND GOTTHILF WENIGER

Appeal No. 2006-1300
Application No. 08/203,672

ON BRIEF

Before McQUADE, HANLON, and TORCZON, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Brian H. Silver et al. appeal from the final rejection of claims 20-26.¹ Claims 8-14 and 19, the only other claims pending in the application, stand allowed.

THE INVENTION

The subject matter on appeal relates to a disposable plastic bag for storing breast milk. Representative claims 20, 24 and 25 read as follows:

¹ Claims 20-26 correspond to claims 1-4, 18, 25, and 26, respectively, in U.S. Patent No. 6,328,082 to Lafond. The appellants copied these claims in an attempt to provoke an interference with the patent (see the paper filed June 11, 2002).

20. A disposable bag adapted to contain breast milk, comprising a flexible closed enclosure defining a chamber adapted to contain therein breast milk, said enclosure being permanently sealed except at one portion thereof which comprises a bag access adapted to substantially seal said bag in a first position thereof but also adapted to selectively allow in a second position thereof the breast milk to be introduced in said chamber when it is desired to use said bag, whereby once in said second position the breast milk can be received in said bag, wherein said bag comprises a section located remote from said enclosure and adapted for receiving thereon information about a content of said bag.

24. A disposable sterile plastic bag in combination with a bag holder, said bag being adapted to contain milk, said bag holder comprising a hollow body and a cap provided with a nipple and being adapted for feeding a baby, said bag holder being adapted for receiving therein said bag, said bag comprising a flexible closed enclosure defining a chamber adapted to contain milk therein, said enclosure being permanently sealed except at one portion thereof which comprises a bag access adapted to substantially seal said bag in a first position thereof but also adapted to selectively allow in a second position thereof the milk to be introduced in said chamber when it is desired to use said bag, wherein, once in said second position, a top end of said bag can be folded over an upper end of said bag holder with said cap being engageable to said upper end of said bag holder for imprisoning said top end of said bag between said cap and said upper end of said bag holder such that said bag hangs in said bag holder with milk being introduced in said bag at least one of before and after said bag is inserted in said bag holder and mounted thereto, wherein said bag comprises a section located remote from said enclosure and adapted for receiving thereon information about a content of said bag.

25. A method of substantially sterile handling breast milk, comprising the steps of:

a) providing a closed disposable sterile bag comprising a tear off strip and providing a bag holder;

b) removing said tear off strip to reveal a milk receiving chamber of said bag; and

c) mounting said bag to said bag holder;

wherein milk is introduced in said chamber between said steps b) and c) or after step c).

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Graham	3,905,477	Sep. 16, 1975
Yanase (Yanase '104)	4,600,104	Jul. 15, 1986
Yanase (Yanase '006)	4,634,006	Jan. 06, 1987

THE REJECTIONS

Claims 20-23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Graham.

Claims 25 and 26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Yanase '104.

Claims 20-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yanase '006 in view of Graham.

Attention is directed to the main and reply briefs (filed June 24, 2003 and August 18, 2005) and the final rejection and answer (mailed September 25, 2002 and May 16, 2005) for the respective positions of the appellants and examiner regarding the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 102(b) rejection of claims 20-23 as being anticipated by Graham

Graham discloses a pouch for packaging, freezing, storing and/or transporting viable and perishable materials such as blood components. As shown in Figure 1, the pouch 11 comprises a front side wall 13 and a rear side wall 15 formed by a transparent, flattened, tubular plastic film, a transverse seal 17 closing the bottom of the pouch, a transverse seal 25 generally closing the top of the pouch and a transverse seal 19 extending between the top and bottom seals. The seal 19 divides the pouch into an upper filling compartment 27 and a lower label compartment 21. The pouch also includes a filling/emptying tube 29, a vent tube 31 and a pressure sensitive label 23. The tubes 29 and 31 extend through the top seal 25 and provide, via suitable plug or clamp means, selectively sealable communication between the exterior of the pouch and the filling compartment 27. The label 23 lies within the label compartment 21 and displays information written thereon by pressure applied through the overlying plastic film. Figure 1 indicates that the information can pertain to the date, donor and type of blood component contained in the

pouch. Graham teaches that this labeling arrangement, which is isolated from filling compartment 27, contributes to the structural and hygienic integrity of the bag. By way of example, Graham asserts a reduced risk of puncturing a fluid-filled compartment 27 with an instrument used to mark the label (see column 1, line 38, through column 2, line 7; and column 3, line 57, through column 4, line 2).

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

The appellants' position that the § 102(b) rejection of claims 20-23 is unsound focuses on independent claim 20 (see pages 9-10 in the main brief and page 4 in the reply brief).

Noting Graham's compartment-enclosed label, the appellants contend that "[i]n contrast, the writing area of the present invention is a writing area formed integral with and from the bag by the same sealing technique as the enclosure, so that . . . the area is on the bag" (main brief, page 9). In the same vein, the appellants urge that "[i]n further contrast, the writing area of the present invention does not require an outer seal to be formed as does Graham (Seal 17) and thus, further distinguishes from Graham" (main brief, page 9).

This line of argument fails because it is not commensurate with the actual scope of claim 20. See In re Self, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982) ("[m]any of appellant's arguments fail from the outset because . . . they are not based on limitations appearing in the claims"). With regard to the so-called "writing area" discussed by the appellants, claim 20 merely calls for "a section located remote from said enclosure and adapted for receiving thereon information about a content of said bag." Graham's label 23, which is part of the pouch or bag 11, constitutes such a section as it is located remote from the enclosure (compartment 27) and is adapted for receiving thereon information about a content

of the bag or pouch. Claim 20 does not recite a "writing area," let alone a "writing area" that is formed integral with and from the bag by the same sealing technique as the enclosure so that the "writing area" is on the bag. Claim 20 also does not include any limitation that excludes, or is otherwise inconsistent with, a bottom seal such as the seal 17 disclosed by Graham.

The appellants additionally contend that Graham does not disclose "the simplified releasably sealed seam bag access of Claim 20" (main brief, page 10) or "a bag access which permits attachment to a breastpump as in the present invention" (main brief, page 10).

Here again, such arguments are unpersuasive because they are not commensurate with the actual scope of claim 20. Simply put, claim 20 does not recite a releasably sealed seam bag access or a bag access that permits attachment to a breast pump.

Finally, the appellants submit that the subject matter recited in claim 20 is not anticipated because Graham fails to disclose "using a bag access portion of the enclosure itself in first and second positions to respectively seal or permit access to the bag" (reply brief, page 4) for the introduction of breast milk.

The appellants have not cogently explained, however, and it is not apparent, why Graham's filling tube 29 does not structurally embody a bag access that (1) constitutes a portion of the enclosure and (2) is adapted to substantially seal the bag in a first position and selectively allow the introduction of breast milk in a second position as recited in claim 20. The language in the claim pertaining to breast milk merely sets forth an intended use of the disposable bag and does not recite the breast milk in combination with the bag. Although Graham does not describe breast milk as one of the viable and perishable materials that can be introduced into and stored within pouch 11, the pouch clearly is inherently capable of being used for this purpose. In this regard, it is well settled that the manner or method in which a device is to be utilized is not germane to the issue of patentability of the device itself (In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967)) and that the recitation of a new intended use for an old product does not make a claim to the old product patentable (In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997)).

Thus, the appellants' position that the subject matter recited in claim 20 distinguishes over that disclosed by

Graham is unpersuasive. Therefore, we shall sustain the standing 35 U.S.C. § 102(b) rejection of claim 20 as being anticipated by Graham.

We also shall sustain the standing 35 U.S.C. § 102(b) rejection of dependent claims 21-23 as being anticipated by Graham since the appellants have not challenged such with any reasonable specificity, thereby allowing these claims to stand or fall with parent claim 20 (see In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)).

II. The 35 U.S.C. § 102(b) rejection of claims 25 and 26 as being anticipated by Yanase '104

Yanase '104 pertains to bags for the preservation of breast milk. For purposes of the rejection, the examiner focuses on the particular bag 1 illustrated in Figures 1-10.

Bag 1 comprises upper and lower surfaces 7 and 8 formed by a transparent, flattened, tubular plastic film, welding portions or seals 3 closing the open edges of the tubular film, and notches 9 in the welding portions 3 adjacent one end of the bag (in use the upper end of the bag). The notches delineate a tear strip that can be removed to open the bag for the receipt of milk. Before it is opened, the bag defines a hermetically sealed structure that can be sterilized by irradiation. The bag also

includes a scale 27 printed on its upper surface for measuring the volume of received milk and a space 28 on the tear strip for accommodating printed instructions.

In use, one opens the bag by removing the tear strip, fills the bag with milk collected by a breast pump and closes the bag by folding the open end and securing it with adhesive tape (see column 6, line 6, through column 7, line 12). After the filled bag is closed, the user writes the date or like information on its upper surface and stores it in a freezer (see column 7, lines 13-17). When it is desired to feed the milk to a baby, the user removes the bag from the freezer, warms the milk and pours it into a conventional baby bottle, and discards the bag (see column 7, lines 13-25).

Yanase '104 teaches that the milk can be initially collected by way of a breast pump such as that disclosed in U.S. Patent No. 3,977,405 to Yanase (Yanase '405) and then poured into the bag by inserting the end of the breast pump through the opening in the bag (see, for example, column 1, lines 20-33; column 1, line 60, through column 2, line 2; column 3, lines 4-8; and column 6, lines 35-53). Yanase '104 also discloses that this breast pump embodies a baby

bottle that can be used for ultimately feeding the milk to a baby (see column 7, lines 25-28).

As indicated above, independent claim 25 recites a breast milk handling method comprising, inter alia, the steps of providing a bag holder and mounting a bag to the bag holder. The examiner's determination (see page 5 in both the final rejection and answer) that these steps are met by the description in Yanase '104 of the breast pump disclosed by Yanase '405 and the manner in which the breast pump is used with the bag disclosed by Yanase '104 is ill founded. In short, Yanase '104, even when considered in light of the references therein to Yanase '405, does not teach a step of mounting the bag to the breast pump or to any other structure that might reasonably be construed as a bag holder.

Thus, Yanase '104 does not disclose each and every element of the method recited in claim 25. Accordingly, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of independent claim 25 and dependent claim 26 as being anticipated by Yanase '104.

III. The 35 U.S.C. § 103(a) rejection of claims 20-24 as being unpatentable over Yanase '006 in view of Graham

Yanase '006 is a continuation-in-part of Yanase '104. For purposes of the rejection, the examiner relies on the disclosure by Yanase '006 of bag 1, which disclosure is essentially identical to that discussed above in connection with Yanase '104.

The examiner's assessment that Yanase '006 responds to all of the limitations in independent claim 20 except for the one requiring the claimed bag to comprise a section located remote from the enclosure and adapted for receiving thereon information about a content of the bag is reasonable on its face. The appellants have not advanced any cogent reasoning to support their argument (see page 5 in the reply brief) that the Yanase '006 bag also lacks an access as recited in the claim.

For the reasons discussed above, and notwithstanding the appellants' arguments to the contrary (see page 12 in the main brief), Graham discloses a bag having an information section of the sort broadly recited in claim 20. Graham also enumerates structural and hygienic advantages afforded by this information section including a reduced risk of puncturing a filled bag with a writing implement. Graham's description of these advantages would

have furnished the artisan with ample suggestion or motivation to provide the Yanase '006 bag with an information section as recited in claim 20 in order to safely carry out Yanase's stated desire to write information on the bag after it is filled.

Thus, the combined teachings of Yanase '006 and Graham justify the examiner's conclusion that the differences between the subject matter recited in claim 20 and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Consequently, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 20 as being unpatentable over Yanase '006 in view of Graham.

We shall sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 21-23 as being unpatentable over Yanase '006 in view of Graham since the appellants have not challenged such with any reasonable specificity, thereby allowing these claims to stand or fall with parent claim 20 (see In re Nielson, supra).

We also shall sustain the standing 35 U.S.C. § 103(a) rejection of independent claim 24 as being unpatentable over Yanase '006 in view of Graham.

The arguments advanced by the appellants with respect to claim 24 (see page 12 in the main brief and page 5 in the reply brief) mirror those made with respect to claim 20 and are unpersuasive for the same reasons. In this regard, the appellants have not challenged the examiner's conclusion (see page 8 in the final rejection and page 6 in the answer) that Yanase '006, considered in light of the references therein to the breast pump/baby bottle disclosed by Yanase '405, responds to the various "bag holder" limitations in claim 24.

IV. New ground of rejection

The following new ground of rejection is entered pursuant to 37 CFR § 41.50(b).

Claims 24-26 are rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification that fails to comply with the written description requirement.

The test for determining compliance with the written description requirement of § 112, ¶ 1, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re

Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The content of the drawings may also be considered in determining compliance with the written description requirement. Id.

In short, the disclosure of the instant application as originally filed would not reasonably convey to the artisan that the appellants had possession at that time of (1) a combination including a bag holder as recited in claim 24 or (2) a method comprising the steps of providing a bag having a tear off strip, providing a bag holder and mounting a bag to the bag holder as recited in claims 25 and 26. It is quite telling that when claims 20-26 were presented in the paper filed June 11, 2002 (see n.1, supra), the appellants pointed out a basis in their disclosure for all of the limitations in these claims except for those here at issue.

SUMMARY

The decision of the examiner to reject claims 20-26 is affirmed with respect to claims 20-24 and reversed with respect to claims 25 and 26. In addition, a new ground of rejection is entered against claims 24-26.

Regarding the affirmed rejections, 37 CFR § 41.52(a)(1) provides that "[a]ppellant may file a single

request for rehearing within two months of the date of the original decision of the Board.”

In addition to affirming the examiner's rejections of one or more claims, this opinion contains a new ground of rejection pursuant to 37 CFR § 41.50(b). 37 CFR § 41.50(b) provides that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the appellants elect to prosecute further before the examiner pursuant to 37 CFR § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejections, the effective date of the affirmance is deferred until

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conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejections are overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejections, including any timely request for rehearing thereof.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 41.50(b).

JOHN P. McQUADE)	
Administrative Patent Judge)	
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