

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 JASON SMITH

Appeal 2006-2405
Application 10/208,928
Technology Center 3700

Decided: March 28, 2007

Before TERRY J. OWENS, MURRIEL E. CRAWFORD, and LINDA E. HORNER, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This appeal involves claims 1, 3-17, the only claims pending in this application. Claim 2 has been canceled. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

The claims are directed to a flexible band for attachment across the wrists, which includes a holder affixed to the flexible band for holding a vacuum blood collection barrel. Claim 1 is illustrative:

1. An appliance fitted for facilitating the blood drawing process by a phlebotomist comprising:

a flexible band for attachment across the wrist of the phlebotomist,

a holder affixed and oriented generally perpendicularly to the longitudinal axis of the flexible band for receiving and holding a vacuum blood collection barrel during the blood drawing process; and

a vacuum blood collection barrel, positioned in the holder generally parallel to the longitudinal axis of the band, for receiving blood sampling tubes.

The Examiner relies on the following prior art references to show unpatentability:

| | | |
|---------|-----------------|---------------|
| Schmitt | US 5,259,392 | Nov. 9, 1993 |
| Shesol | US 5,897,519 | Apr. 27, 1999 |
| Ekey | US 6,461,319 B1 | Oct. 8, 2002 |

The rejection as presented by the Examiner is as follows:

Claims 1 and 3-17 are rejected under 35 U.S.C. § 103(a) as unpatentable over Shesol in view of Schmitt and Ekey.

The Examiner contends that a person of ordinary skill in the art would have found it obvious to combine the teachings of Shesol, Schmitt, and Ekey because it would have been obvious to adapt a preexisting medical appliance to hold any preexisting medical device.

Appellants contend that there is no motivation to combine the teachings of Shesol, Schmitt, and Ekey.

ISSUE

The issue is whether the Appellant has shown that the Examiner erred in holding that there is a suggestion or motivation to combine the teachings of Shesol, Schmitt, and Ekey.

FINDINGS OF FACT

Appellant invented a device which includes a flexible band for attachment across the wrist and which includes a holder affixed to the flexible band for receiving a vacuum blood collection barrel (Specification 1).

Shesol discloses an intravenous securing device that may be attached to the hand and includes a holder 26 for an intravenous tube (Shesol, Figure 5). Shesol does not disclose a holder for a vacuum blood collection barrel.

Schmitt discloses a barrel shaped blood collection device (Schmitt, Figure 1).

Ekey discloses a medical device which includes adjustable shoulder belt 14 and arm belt 16 which together hold a pouch 18 and a holder 44 attached to the pouch 18. Holder 44 is adapted to hold a barrel shaped intravenous drip reservoir 46.

PRINCIPLES OF LAW

On appeal, Appellant bears the burden of showing that the Examiner has not established a legally sufficient basis for combining the teachings of Shesol, Schmitt, and Ekey. Appellant may sustain this burden by showing that, where the Examiner relies on a combination of disclosures, the Examiner failed to provide sufficient evidence to show that one having ordinary skill in the art would have done what the Appellant did. *In re*

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Kahn, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006);
DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Partrick, Co.,
464 F.3d 1356, 1360-61, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006). The
mere fact that all the claimed elements or steps appear in the prior art is not
per se sufficient to establish that it would have been obvious to combine
those elements. *Smith Indus. Med. Sys., Inc. v. Vital Signs, Inc.*, 183 F.3d
1347, 1356, 51 USPQ2d 1415, 1420-21 (Fed. Cir. 1999).

ANALYSIS

The Examiner correctly shows where all the claimed elements appear in Shesol, Schmitt, and Ekey. However, Appellant correctly points out that the Examiner premised the rejection on incorporating the blood collection barrel of Ekey held in a holder as disclosed in Schmitt in the Shesol device. The Examiner's reasoning that it would have been obvious to adapt any known medical device to hold any known medical device is not a sufficient motivation to combine the teachings of Shesol and Ekey. Accordingly, we determine that the Examiner has shown all claimed elements were known in the prior art but has not given a persuasive reason why one skilled in the art would have combined the prior art elements to make Appellant's claimed invention. On the record before us, it follows that the Examiner erred in rejecting claims 1 and 3-17 under 35 U.S.C. § 103(a).

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CONCLUSION OF LAW

On the record before us, Appellant has shown that the Examiner erred in holding that there is a suggestion or motivation to combine the teachings of Shesol, Schmitt, and Ekey.

ORDER

The Examiner's rejection of claims 1 and 3-17 is *reversed*.

REVERSED

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