

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* Dean L. Rhoades

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Appeal 2007-0924  
Application 10/401,079  
Technology Center 3700

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Decided: October 24, 2007

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Before TERRY J. OWENS, MURRIEL E. CRAWFORD, and JENNIFER  
D. BAHR, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Dean L. Rhoades (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1, 2, 5, 8, 9, 10 and 16-18. Claims 3, 4, 6, 7 and 11-15 stand withdrawn from consideration. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

THE INVENTION

Appellant's claimed invention is directed to containers and caps for pharmaceutical or nutritional products, such as tablets, capsules and medicinal syrups (Specification ¶ 2), as well as food, beauty products, chemicals and other items (Specification ¶ 26). Independent claims 1 and 16 are illustrative of the claimed invention and read as follows:

1. An apparatus comprising:

a housing defining a first internal space to store at least one item and a first aperture;

an occluding structure removably coupled to the housing to occlude the first aperture wherein one of the housing and the occluded<sup>[1]</sup> structure defines a second internal space separate from the first internal space;

an expandable structure configured to have a retracted state and an expanded state, the expandable structure capable of being manipulated between the retracted state and the expandable state and having a dimension suitable to reside within the second internal space in the retracted state, the expandable structure having a first surface with symbols printed thereon such that at least a portion of the symbols are visible when the expandable structure is in an expanded state.

16. An apparatus comprising:

means for storing objects;

means for enclosing the means for storing objects; and

means for providing an expandable structure including a first surface with symbols printed thereon,

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<sup>1</sup> The term "occluded" should be "occluding" for consistency.

wherein one of the storing objects means and the enclosing means defines an internal space in which the expandable structure can be manipulated from a retracted state that confines the expandable structure within the one of the storing object means and the enclosing means and an expanded state external to the one of the storing object means and the enclosing means.

### THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

|          |              |               |
|----------|--------------|---------------|
| Yannuzzi | US 3,402,808 | Sep. 24, 1968 |
| Wolfe    | US 4,679,822 | Jul. 14, 1987 |

The following rejections are before us for review.<sup>2,3</sup>

Claims 2, 5 and 17 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 16-18 stand rejected under 35 U.S.C. § 102(b) as anticipated by Wolfe.

Claims 1, 2, 5, 8 and 10 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Wolfe in view of Yannuzzi.

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<sup>2</sup> The rejection of claims 2, 5 and 17 under 35 U.S.C. § 112, first paragraph, set forth on pages 2 and 3 of the Final Rejection (mailed April 28, 2005) has been "removed for purpose of appeal" (Ans. 2).

<sup>3</sup> Appellant requests that we review the propriety of the withdrawal of claims 3, 6, 7, 11 and 14 (App. Br. 8-11) and the objection to the drawings under 37 C.F.R. § 1.83(a) (App. Br. 13-14). These issues relate to petitionable matters and not to appealable matters. *See Manual of Patent Examining Procedure (MPEP)* §§ 1002 and 1201 and are not within the jurisdiction of the Board. *See In re Mindick*, 371 F.2d 892, 894, 152 USPQ 566, 568 (CCPA 1967).

Claim 9 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Wolfe in view of Official Notice.

The Examiner provides reasoning in support of the rejection in the Answer (mailed September 19, 2006). Appellant presents opposing arguments in the Appeal Brief (filed November 16, 2005) and Reply Brief (filed November 13, 2006).

## OPINION

### *The indefiniteness rejection*

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986) (citations omitted). A claim may be invalid for indefiniteness if it is “insolubly ambiguous” and not “amenable to construction.” *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1375, 60 USPQ2d 1272, 1276 (Fed. Cir. 2001).

Appellant discloses a container (10 or 1100, for example) provided with a cap (20 or 1105, for example) and housing an expandable or extendable ribbon (30 or 1107, for example). The ribbon 30 can be biased into the retracted position within the container by a spring 36, for example (Specification ¶ 42). Other retraction mechanisms, disclosed for biasing the ribbon 1107 into a storage position within the container, include a biased rotating pin, spring mechanisms, elastic materials in the ribbon 1107, and similar mechanisms (Specification ¶ 46).

Claim 2 recites "a retraction mechanism for biasing the expandable structure to the retracted state" and claim 5, which depends from claim 2, further recites "wherein a retraction mechanism includes a spring." Claim 17 recites "means for biasing the expandable structure to a retracted position."

The Examiner's basis for the rejection, as articulated on page 3 of the Answer, is that "[i]t is not clear how an elastic material can be construed as a retraction mechanism when the ribbon is in an expanded form." The Examiner contends that an elastic material does not meet the definition of "mechanism" as "... a process, physical or mental, by which something is done, or comes into being" offered by Appellant (App. Br. 12) because an elastic material is not considered a process (Ans. 6) and further that an elastic material does not meet the more appropriate definition of "mechanism" as "a system of parts that operate or interact like those of a machine" or "[t]he arrangement of connected parts in a machine" (Ans. 7).

First, we note that neither claim 2 nor claim 5 is limited to an "elastic material" and the Examiner appears to concede that spring mechanisms and biased rotating pins, two of the other retraction mechanisms disclosed in Appellant's Specification, are "mechanisms" (Ans. 7). Claim 17 does not even recite a "retraction mechanism" but, rather, recites a "means for biasing" and thus does not appear to suffer from the deficiency alleged by the Examiner in any event. Moreover, while a single component, such as an elastic material, may not be a system of parts so as to technically meet the definition of "mechanism" applied by the Examiner, a person of ordinary skill in the art would understand what is meant by claims 2, 5 and 17 when these claims are read in light of the Specification. Specifically, a person of

ordinary skill in the art would understand a "retracting mechanism" as used in the claims to be a means or device for retracting the expandable structure. Moreover, Appellant's use of the term "mechanism" to include an elastic material is not inconsistent with the ordinary and customary usage of the term "mechanism," which includes "any system or means for doing something" (*Webster's New World Dictionary* 880 (David B. Guralnik ed., 2<sup>nd</sup> Coll. Ed., Simon & Schuster, Inc. 1984)).

In light of the above, we conclude that claims 2, 5 and 17 are not "insolubly ambiguous" and are "amenable to construction." It follows that they are not invalid for indefiniteness. The rejection cannot be sustained.

#### *The Anticipation Rejection*

The issue presented to us is whether Wolfe teaches "a means for storing objects and a means for enclosing the storing objects means wherein one of the storing objects means and the enclosing means defines an internal space in which the expandable structure can be manipulated" as required by claim 16 (App. Br. 14). This issue turns on whether claim 16, by using means-plus-function language, requires that the "internal space" defined by one of the storing objects means and the enclosing means is separate from the compartment where the objects are stored (App. Br. 14).

In essence, Appellant's position appears to be that, as seen in Appellant's Figures 2, 8 and 11, each of the spaces (annular chamber 17, ribbon housing 25 and compartment 1109) in which Appellant's ribbon is stored is separate from the portion of the container or cap in which the contents of the container are retained (Reply Br. 7). Accordingly, Wolfe's hollow cover member 22b, which defines only a single internal compartment for storing label 20b that is not separate from a compartment for storing

objects, functions in a substantially different manner to produce a substantially different result from Appellant's container. Thus, according to Appellant, Wolfe's cover member 22b is neither the structure described by Appellant for storing objects nor an equivalent thereof. (Reply Br. 7-9.)

In order to meet a "means plus function" limitation, the prior art must (1) perform the identical function recited in the means limitation and (2) perform that function using the structure disclosed in the specification or an equivalent structure. *See Carroll Touch Inc. v. Electro Mechanical Sys. Inc.*, 15 F.3d 1573, 1578, 27 USPQ2d 1836, 1840 (Fed. Cir. 1994); *Valmont Indus. Inc. v. Reinke Mfg. Co.*, 983 F.2d 1039, 1042, 25 USPQ2d 1451, 1454 (Fed. Cir. 1993); *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1580, 12 USPQ2d 1382, 1386 (Fed. Cir. 1989).

Initially, we note that claim 16 does not recite a compartment for storing objects. Rather, claim 16 recites a means for storing objects and further recites that either the means for storing objects or the means for enclosing the means for storing objects defines an internal space in which the expandable structure can be manipulated. The functional language of defining an internal space in which the expandable structure can be manipulated is not part of the means plus function recitation of "means for storing objects." Moreover, claim 16 does not even define the "objects" as being different or distinct from the "means for providing an expandable structure" recited in the claim.

The Examiner and Appellant appear to be in agreement that the container 12<sup>4</sup>, 900, 1100 or 1200 is the structure described in Appellant's

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<sup>4</sup> While both the Examiner (Ans. 8) and Appellant (Reply Br. 7) refer to container 12, the reference numeral 10 refers to the container while

Specification for performing the function of storing objects (Ans. 8 and Reply Br. 7). While the embodiments illustrated in Appellant's Figures 2, 8 and 11 may show compartments or annular chambers for confining the ribbon in either the container or the cap that are separate from the compartments for storing the objects, such as pills, Appellant does not specifically define the compartment for storing the objects, such as pills, as being separate from the compartment for confining the ribbon. For example, Appellant's Specification describes that, "[i]n embodiments, as illustrated in Figure 2," the container 10 includes an inner cylindrical wall 16 encompassed by the outer cylindrical wall 12 (Specification ¶ 27), but does not expressly require such an inner cylindrical wall in all embodiments within the scope of the invention. Likewise, the Specification indicates that "[i]n an embodiment," ribbon 30 is housed in annular chamber 17 (Specification ¶ 29), but does not require such an annular chamber in all embodiments. Similarly, in discussing Figure 11, Appellant's Specification states that, "[i]n one embodiment," ribbon 1107 is packed into compartment 1109 (Specification ¶ 46), but does not specify that a separate compartment is a requirement of all embodiments. The cap for the container is the structure corresponding to the "means for enclosing the means for storing objects" recited in claim 16.

We determine the scope of the claims in patent applications "not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction 'in light of the specification as it would be interpreted by one of ordinary skill in the art.'" *Phillips v. AWH Corp.*, 415

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reference numeral 12 in fact refers to the outer cylindrical wall of the container.

F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (en banc) (quoting *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004)). We must be careful not to read a particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment. *See Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868-69 (Fed. Cir. 2004) ("Though understanding the claim language may be aided by the explanations contained in the written description, it is important not to import into a claim limitations that are not a part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.") The challenge is to interpret claims in view of the specification without unnecessarily importing limitations from the specification into the claims. *See E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003).

In light of the above, we conclude that the structure in Appellant's Specification corresponding to the means for storing objects is a container. We further conclude that, while, in some embodiments, such container may define a compartment for storing objects, such as pills, that is separate from a compartment, which may be in either the container or the cap for the container, for confining the ribbon, Appellant's Specification does not limit the container to a structure which defines a separate compartment for storing objects that is distinct from a compartment for confining the ribbon.

Wolfe's cover member 22b is a container that defines an internal space in which an expandable structure (label 20b) having information typed or written thereon (Wolfe, col. 5, ll. 41-42) is stored and can be manipulated,

such as by removing the label (Wolfe, col. 4, l. 66) or placing it back within the cover member 22b (Wolfe, col. 5, ll. 5-7). Wolfe's cap member 24b is, of course, a means for enclosing the cover member 22b. We therefore conclude that, contrary to Appellant's argument, Wolfe teaches "a means for storing objects and a means for enclosing the storing objects means wherein one of the storing objects means and the enclosing means defines an internal space in which the expandable structure can be manipulated" as required by claim 16.

For the reasons explained above, Appellant fails to demonstrate the Examiner erred in rejecting claim 16 as anticipated by Wolfe. The rejection is sustained as to claim 16, as well as claims 17 and 18, which Appellant has not argued separately from claim 16.

*The obviousness rejections*

*Claims 1, 2, 5 and 8:*

Claim 1, and claims 2, 5 and 8 depending therefrom, recite a housing defining a first internal space to store at least one item, an expandable structure, and an occluding structure removably coupled to the housing, wherein one of the housing and the occluding structure defines a second internal space separate from the first internal space. The Examiner concedes that the device of Figures 10 and 11 of Wolfe, relied upon by the Examiner in rejecting the claims, does not have structure defining first and second internal spaces, the second internal space being separate from the first internal space. To address this deficiency, the Examiner relies upon the teaching of Yannuzzi of providing a separate compartment within an emergency medical information container for emergency pills or other

medicinal agents used in emergency treatments (Yannuzzi, col. 1, ll. 62-64). According to the Examiner, in view of the combined teachings of Wolfe and Yannuzzi, one of ordinary skill in the art would provide different internal compartments within Wolfe to store other articles (Ans. 6).

The issue presented to us is whether it would have been obvious to one of ordinary skill in the art to provide a separate compartment within Wolfe's cover member 22b for storing other objects, such as emergency pills. Appellant argues that one of ordinary skill in the art would not understand Wolfe to teach a container for storing objects and would not find motivation to modify Wolfe in the manner relied upon by the Examiner (App. Br. 15). Appellant also argues that, if such compartments were incorporated into Wolfe, the spindle<sup>5</sup> and label would not fit within the cover, thereby rendering Wolfe unsatisfactory for its intended purpose (App. Br. 16).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented 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 to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of ordinary skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John*

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<sup>5</sup> The embodiment of Figures 10 and 11 of Wolfe does not include a "spindle."

*Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). *See also KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

"A person of ordinary skill is also a person of ordinary creativity, not an automaton." *KSR*, 127 S.Ct. at 1742, 82 USPQ2d at 1397.

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

*Id.* at 1740, 82 USPQ2d at 1396. We must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. *Id.*

We find ample reason why one of ordinary skill in the art would have been prompted to make the modification proposed by the Examiner. Both Wolfe and Yannuzzi are directed to emergency medical alert information devices worn by persons with medical conditions of concern (Wolfe, col. 1, ll. 4-6, col. 2, ll. 7-31; Yannuzzi, col. 1, ll. 29-65). Both devices are provided with a label (label 20b of Wolfe) or sheet (sheet 26 of Yannuzzi) containing medical information. Wolfe's device comprises a container or cover member 22b defining a compartment in which the label 20b is stored and from which the label can be extended for reading but does not

incorporate a separate compartment for containing emergency pills or other medicinal agents. Yannuzzi's container 10 is provided with intermediate partition walls 20, 21 to define a pill containing compartment 22 separate from the compartment 24 in which medical information sheet 26 is contained (Yannuzzi, col. 2, ll. 26-38; Fig. 3). The suggestion to provide a separate compartment within the cover member 22b of Wolfe for containing other objects, such as emergency pills, is provided by Yannuzzi's teaching of providing "still another compartment for containing emergency pills or other medicinal agents used in emergency treatment" (Yannuzzi, col. 1, ll. 62-64). Specifically, a person of ordinary skill in the art would have been prompted by the teaching of Yannuzzi to provide structure defining a second compartment within the cover member 22b of Wolfe, separate from the compartment in which label 20b is stored, for containing emergency pills or other medicinal agents that may be indicated by the medical condition to which the medical information label is directed.

Moreover, the structural modifications necessary to provide such a second compartment within cover member 22b of Wolfe would not have been beyond the technical grasp of a person of ordinary skill in the art. To assume, as Appellant's argument implies, that one of ordinary skill in the art would not be able to re-design the device of Wolfe so as to accommodate the additional compartment within cover member 22b inappropriately presumes lack of skill and ordinary creativity on the part of the person of ordinary skill in the art.

For the above reasons, we conclude that modification of Wolfe's device to provide structure defining a second compartment therein for containing emergency pills or other medicinal agents used in emergency

treatment would have been a predictable variation and obvious to one of ordinary skill in the art. Appellant's arguments do not demonstrate error in the Examiner's rejection. The rejection is sustained as to claims 1, 2, 5 and 8.

*Claim 10:*

Claim 10 depends from claim 1 and further recites the expandable structure includes "at least one of paper, fabric, and plastic." Thus, the additional issue presented with respect to claim 10 is whether it would have been obvious to make the expandable structure (label 20b) of Wolfe of at least one of paper, fabric and plastic, on the basis of its suitability for the intended use, as a matter of obvious design choice, as contended by the Examiner (Ans. 6).

Appellant argues that neither Wolfe nor Yannuzzi discloses the material of the label, much less provides that it may be of paper, fabric or plastic and that, unlike the situation in *In re Leshin*, 277 F.2d 197, 199, 125 USPQ 416, 418 (CCPA 1960) relied on by the Examiner, Appellant is not merely selecting from materials disclosed in the applied prior art (App. Br. 17). Appellant additionally argues the selection of a material as fragile as a piece of paper as the label material seems inconsistent with the Examiner's proposed modification of Wolfe to provide a second compartment, thereby increasing the size, and in turn the weight, of the Wolfe device (Reply Br. 12). Neither of these arguments is persuasive.

While there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and

creative steps that a person of ordinary skill in the art would employ.” *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396. While Wolfe does not specify any material for label 20b, Wolfe does teach that the label "is easily replaceable, exchanged or substitutable by another label 20 in order to update any information" (Wolfe, col. 5, ll. 31-34) and contemplates that information can be easily typed or written onto the label (Wolfe, col. 5, ll. 41-42). Any notion that one of ordinary skill in the art would not have immediately envisaged one of paper, fabric or plastic as a suitable material for a label onto which information is typed or written is simply untenable and disingenuous. Further, Wolfe's teaching that the cover member provides a device in which the label is protected from wear and tear (Wolfe, col. 1, ll. 35-36) dispels any concern about a material such as paper, fabric or plastic being too fragile for the disclosed application, especially when viewed in light of Wolfe's contemplation of an easily replaceable label.

Appellant's arguments fail to demonstrate the Examiner erred in rejecting claim 10 as unpatentable over Wolfe in view of Yannuzzi. The rejection is sustained.

*Claim 9:*

Claim 9 depends from claim 1 and further recites the housing includes an engagement mechanism to secure the occluding structure to the housing. Appellant challenges the propriety of the Examiner's reliance on official notice of the conventional application of locking means for locking a base to the lid (Ans. 6) to address this claimed feature (App. Br. 18). Both the Examiner's reliance on official notice and Appellant's challenge thereto are immaterial to the patentability of claim 9 over Wolfe, as Wolfe discloses connecting the cap members and cover members, albeit of the devices of

Figures 1-7 and not specifically the device of Figures 10 and 11 relied upon by the Examiner, together "either by means of friction, engaging screw threads or by a snap-fit" (Wolfe, col. 5, ll. 11-15). A person of ordinary skill in the art would have immediately appreciated that, while engaging screw threads may not be a feasible securement mechanism for the cap member 24b and cover member 22b of Wolfe's embodiment of Figures 10 and 11, a friction or snap-fit of the cap member 24b to cover member 22b would improve the device of Figures 10 and 11 in much the same way that such a securing arrangement improves the device of Figures 1-7. Further, Appellants have not alleged, much less shown, that such a modification would yield unpredictable results or present a unique challenge to one of ordinary skill in the art. We thus conclude Appellant has failed to demonstrate the Examiner erred in determining the subject matter of claim 9 would have been obvious. The rejection of claim 9 is sustained.

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### SUMMARY

The indefiniteness rejection of claims 2, 5 and 17 is reversed and the rejections under 35 U.S.C. §§ 102 and 103 of claims 1, 2, 5, 8, 9, 10 and 16-18 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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