

1 UNITED STATES PATENT AND TRADEMARK OFFICE

2
3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7
8 *Ex parte* ANTHONY J. M. GARWOOD
9

10
11 Appeal 2008-1329
12 Application 10/368,953
13 Technology Center 3600
14

15
16 Decided: April 28, 2008
17

18
19 Before ANTON W. FETTING, JOSEPH A. FISCHETTI, and
20 STEVEN D.A. McCARTHY, *Administrative Patent Judges*.

21
22 FETTING, *Administrative Patent Judge*.

23 DECISION ON APPEAL

24
25 STATEMENT OF CASE
26

27 Anthony J. M. Garwood (Appellant) seeks review under 35 U.S.C. § 134
28 of a final rejection of claims 1, 2, 4-7, and 9-12, the only claims pending in
29 the application on appeal.

1 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
2 (2002).

3
4 We AFFIRM.

5
6 The Appellant invented a way of processing and packaging under
7 conditions of reduced oxygen for substantially decontaminating and
8 prolonging the shelf life of perishable goods, such as beef (Specification
9 1:22-25). Part of this process, to which the claims in this application are
10 directed, includes a way of tracing a good that includes associating
11 information pertaining to an animal on a carrying means for the animal or
12 any of its divisions. This information could be stored on an RFID tag, and
13 include such information as country of origin, place or originating location
14 of the animal. In this way, a label can be prepared by being able to trace the
15 origin of the packaged good through the disassembly process (Specification
16 16:1-15).

17
18 An understanding of the scope of the invention as claimed can be
19 derived from a reading of exemplary claim 1, which is reproduced below
20 [bracketed matter and some paragraphing added].

- 21 1. A method of labeling goods comprising the steps of:
22 [1] placing goods in a tray;
23 [2] acquiring information relating to the goods placed in said
24 tray;
25 [3] marking said tray with indicia unique to said goods;
26 [4] storing the information relating to the goods in said tray
27 in a memory keyed to said indicia;

- 1 [5] relaying the information stored in the memory
2 to a remote location over a communication system;
3 [6] grouping one or more trays loaded with goods in a
4 container;
5 [7] associating a read/write device with said container; and
6 [8] applying information relating to said goods
7 on said read/write device
8 for each tray stored therein.
9

10 This appeal arises from the Examiner's final Rejection, mailed June 1,
11 2005. The Appellant filed an Appeal Brief in support of the appeal on May
12 30, 2006. An Examiner's Answer to the Appeal Brief was mailed on July
13 16, 2007. A Reply Brief was filed on September 7, 2007.

14 PRIOR ART

15 The Examiner relies upon the following prior art:

Caveney	US 5,038,283	Aug. 6, 1991
Goldsmith	US 5,306,466	Apr. 26, 1994

16 REJECTION

17 Claims 1, 2, 4-7, and 9-12 stand rejected under 35 U.S.C. § 103(a) as
18 unpatentable over Caveney and Goldsmith.

19 ISSUES

20 The issue pertinent to this appeal is whether the Appellant has sustained
21 its burden of showing that the Examiner erred in rejecting claims 1, 2, 4-7,
22 and 9-12 under 35 U.S.C. § 103(a) as unpatentable over Caveney and
23 Goldsmith.

- 1 05. As individual bar coded items are packed within a container,
2 they are scanned into a database of container packing records, and
3 a unique bar coded container label is printed to record each bar
4 code with the bar code identifying the container as a grouped set
5 of information comprising a container packing record (Caveney
6 2:30-40).
- 7 06. The packer affixes the container label to the container. The
8 container packing record includes a shipment indicia uniquely
9 identifying the specific means of shipment, for example the
10 specific truck used to deliver the container to the shipping
11 destination (Caveney 2:41-45).
- 12 07. The container packing records of individual containers are
13 transmitted from the shipping location to the shipping destination
14 of the containers. The shipping destination computer enters the
15 transmitted container packing record into a data base accessible by
16 the computer (Caveney 2:50-57).
- 17 08. Included within the shipping destination computer's data base
18 are previously recorded outstanding customer order lists
19 containing quantities of items ordered by individual customers
20 including identifying indicia or bar code information for each
21 item. A bar code cross reference list is stored in the shipping
22 destination computer and used to match customer codes
23 identifying individual items ordered with the corresponding bar
24 code used on the package of each item (Caveney 2:58-68).

1 09. The shipping destination computer identifies from the container
2 packing records the shipping containers that are shipped together
3 in a single shipment and compares the bar codes of shipping
4 containers as they are actually received with the list of containers
5 shipped in a single shipment and provides an output either
6 confirming the receipt of all of the containers previously shipped
7 in the single shipment or providing an output listing the containers
8 lost in shipment (Caveney 3:58-67).

9 *Goldsmith*

10 10. Goldsmith is directed to a food contamination detector
11 comprised of a tray, for holding a food product, and a bar code
12 detector with a toxin printed onto a substrate and an indicator
13 bound to the toxin to form a bar code. When the bar code detector
14 is contacted with a toxin, the indicator is removed from the
15 substrate destroying the bar code (Goldsmith 2:5-13).

16 *Facts Related To Differences Between the Claims and the Prior Art*

17 11. Neither Caveney nor Goldsmith describe setting prices or shelf
18 lives. However, Goldsmith describes selling food such as meat
19 and Caveney describes shipping goods to a different location.
20 One of ordinary skill, and indeed most grocery customers, knew
21 that meat packaged as in Goldsmith was priced and had a shelf
22 life, and that both the price and shelf life were dependent upon the
23 market conditions and food processing regulations of the location
24 in which food was sold.

1 specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In*
2 *re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369, (Fed. Cir. 2004).

3 Limitations appearing in the specification but not recited in the claim are
4 not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364,
5 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the
6 specification” without importing limitations from the specification into the
7 claims unnecessarily)

8 Although a patent applicant is entitled to be his or her own lexicographer
9 of patent claim terms, in *ex parte* prosecution it must be within limits. *In re*
10 *Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing
11 such definitions in the Specification with sufficient clarity to provide a
12 person of ordinary skill in the art with clear and precise notice of the
13 meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480
14 (Fed. Cir. 1994) (although an inventor is free to define the specific terms
15 used to describe the invention, this must be done with reasonable clarity,
16 deliberateness, and precision; where an inventor chooses to give terms
17 uncommon meanings, the inventor must set out any uncommon definition in
18 some manner within the patent disclosure so as to give one of ordinary skill
19 in the art notice of the change).

20 *Obviousness*

21 A claimed invention is unpatentable if the differences between it and
22 the prior art are “such that the subject matter as a whole would have been
23 obvious at the time the invention was made to a person having ordinary skill
24 in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l v. Teleflex Inc.*, 127 S.Ct.
25 1727 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

1 In *Graham*, the Court held that that the obviousness analysis is
2 bottomed on several basic factual inquiries: “[(1)] the scope and content of
3 the prior art are to be determined; [(2)] differences between the prior art and
4 the claims at issue are to be ascertained; and [(3)] the level of ordinary skill
5 in the pertinent art resolved.” 383 U.S. at 17. *See also KSR Int’l v. Teleflex*
6 *Inc.*, 127 S.Ct. at 1734. “The combination of familiar elements according to
7 known methods is likely to be obvious when it does no more than yield
8 predictable results.” *KSR*, 127 S.Ct. at 1739.

9 “When a work is available in one field of endeavor, design incentives
10 and other market forces can prompt variations of it, either in the same field
11 or a different one. If a person of ordinary skill can implement a predictable
12 variation, § 103 likely bars its patentability.” *Id.* at 1740.

13 “For the same reason, if a technique has been used to improve one
14 device, and a person of ordinary skill in the art would recognize that it would
15 improve similar devices in the same way, using the technique is obvious
16 unless its actual application is beyond his or her skill.” *Id.*

17 “Under the correct analysis, any need or problem known in the field
18 of endeavor at the time of invention and addressed by the patent can provide
19 a reason for combining the elements in the manner claimed.” *Id.* at 1742.

20 *Obviousness and Nonfunctional Descriptive Material*

21 Nonfunctional descriptive material cannot render nonobvious an
22 invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d
23 1336, 1339 (Fed. Cir. 2004). Cf. *In re Gulack*, 703 F.2d 1381, 1385 (Fed.
24 Cir. 1983) (when descriptive material is not functionally related to the

1 substrate, the descriptive material will not distinguish the invention from the
2 prior art in terms of patentability).

3 ANALYSIS

4 *Claims 1, 2, 4-7, and 9-12 rejected under 35 U.S.C. § 103(a) as*
5 *unpatentable over Caveney and Goldsmith.*

6

7 *Claims 1 and 6*

8 Claim 1 is the sole independent claim. The Appellant does not
9 separately argue claim 6 and so we treat it as grouped with claim 1.
10 37 C.F.R. § 41.37(c)(1)(vii) (2007).

11 The Examiner found that Caveney described all of the limitations of
12 claim 1 except for the items being in a tray, for which the Examiner applied
13 Goldsmith. The Examiner found that Goldsmith's application toward foods
14 such as meats and vegetables suggested using Goldsmith's trays to one of
15 ordinary skill with Caveney to provide the benefits of Caveney's packaging
16 to such foods (Answer 3).

17 The Appellant contends that Caveney does not suggest coding a
18 container with information related to its goods (Br. 10:First full ¶); placing
19 goods in a separate tray and marking the tray with indicia unique to the
20 goods, storing the information keyed to the indicia, and relaying the
21 information to a remote location; grouping one or more trays in a container
22 and applying information related to the goods to a read/write device
23 associated with the container (Br. 10:Bottom ¶).

24 We disagree with the Appellant's contentions.

1 Goldsmith describes step [1] placing goods in a tray and step [3]
2 marking said tray with indicia unique to said goods by placing food in a tray
3 with a bar code which is indicia unique to the food, since it identifies the
4 food (FF 10).

5 Caveney is directed to a shipping method for facilitating the efficient
6 distribution of goods (FF 01). Caveney describes steps [2] acquiring
7 information relating to the goods placed in a package and [3] marking said
8 package with indicia unique to said goods by placing goods in a package
9 with a bar code which is indicia unique to the goods, since it identifies the
10 goods with bar codes for the items chosen to uniquely identify identical
11 items and thus act as identification indicia (FF 02 & 03). The only
12 difference is that Caveney does not use a tray. Goldsmith is applied to show
13 that a tray may be an instance of Caveney's package.

14 Caveney describes steps [4] storing the information relating to the goods
15 in the package in a memory keyed to said indicia and [5] relaying the
16 information stored in the memory to a remote location over a
17 communication system by storing the bar codes from the packages in a
18 database (FF 05) and transmitting to the destination computer (FF 07).
19 Since the bar codes are identifiers, and data base entries are keyed by
20 identifiers, the database records must be keyed to the bar codes.

21 Caveney describes steps [6] grouping one or more trays loaded with
22 goods in a container; [7] associating a read/write device with said container;
23 and [8] applying information relating to said goods on said read/write device
24 for each tray stored therein by packing the packages in its container (FF 05),
25 and printing a bar coded packing record. The bar coded packing record is

1 written and susceptible to reading, and therefore is a read/write device (FF
2 05).

3 The Appellant's argument that Caveney does not use a tray and the tray
4 is not marked with indicia is simply attacking the rejection piecemeal, since
5 Goldsmith is applied to describe the tray and its indicia. Nonobviousness
6 cannot be established by attacking the references individually when the
7 rejection is predicated upon a combination of prior art disclosures. *See In re*
8 *Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

9 The Appellant's argument that Caveney does not describe the other
10 limitations is unpersuasive, as we found that Caveney describes all of the
11 remaining limitations *supra*. The Appellant argues that Caveney does not
12 describe storing information such as weight (Br. 11:First full ¶). This is not
13 commensurate with the scope of claim 1, as claim 1 merely requires that the
14 information relate to the goods, which Caveney's bar code clearly does.
15 Thus, the Appellant has not convinced us of error on the part of the
16 Examiner.

17 *Claims 4, 5, and 9-11*

18 Claims 4 and 10 require retrieving information at the destination to set a
19 price; claims 5 and 11 require retrieving information at the destination to set
20 a shelf life; and claim 9 requires comparing the information from a
21 read/write device on the container with a database. The Appellant argues
22 that none of these are described by Caveney or Goldsmith. The Examiner
23 found that Caveney described claim 9's comparison, and that the
24 information required by claims 4, 5, 10, and 11 were well known types of
25 information collected for items such as food (Answer 6).

1 We agree with the Examiner that Caveny explicitly describes comparing
2 the information on the container label with that stored at the destination data
3 base (FF 09). We also agree that although neither Caveny nor Goldsmith
4 describe setting prices or shelf lives, Goldsmith describes selling food such
5 as meat and Caveny describes shipping goods to a different location. One
6 of ordinary skill, and indeed most grocery customers, knew that meat
7 packaged as in Goldsmith was priced and had a shelf life, and that both the
8 price and shelf life were dependent upon the market conditions and food
9 processing regulations of the location in which food was sold (FF 11).
10 These would depend on data that had to be supplied by the shipper, such as
11 weight and date of origination, and so would necessarily be based on the
12 retrieved information.

13 *Claims 2, 7, and 12*

14 Claims 2 and 7 require storing the weight or other data. The Examiner
15 found this was non-functional descriptive material. The Appellant argues
16 that the data relate to the underlying substrate in the form of the tray.

17 As we found *supra*, such data would be required for pricing and safety
18 regulation and were at least predictable types of data for storage. “The
19 combination of familiar elements according to known methods is likely to be
20 obvious when it does no more than yield predictable results.” *KSR*, 127 S.
21 Ct. at 1739.

22 Further, we agree with the Examiner that such data are non-functional
23 descriptive material and given no patentable weight, *In re Ngai*, 367 F.3d at
24 1339. The Appellant’s argument that the data written on the tray is related
25 to the contents is misplaced, because there is no functional relationship

1 within the claim between the contents of the label and the contents of the
2 tray. The label contents, even if weight, are still only descriptive, and
3 provide no functional relationship between the contents and tray.

4 Claim 12 requires that the read/write device be an RFID device. The
5 Examiner found that RFID devices were art recognized equivalents to
6 Caveney's bar codes (Answer 4). The Appellant argued that the additional
7 benefits of RFID devices negated such equivalence (Br. 13-14). We agree,
8 that for the purposes of application to Caveney, an RFID device is
9 equivalent to a bar code. While neither Caveney nor Goldsmith describe
10 RFID devices, one of ordinary skill, and indeed most customers, were
11 familiar with RFID devices as being used commonly in place of bar codes.
12 One of ordinary skill also knew that such tags were capable of storing data
13 dynamically, and therefore of greater value than bar codes where additional
14 data might need to be added (FF 12). Thus, substitution of an RFID device
15 for a bar code in Caveney was no more than routine substitution in the
16 package marking arts.

17 The Appellant has not sustained its burden of showing that the Examiner
18 erred in rejecting claims 1, 2, 4-7, and 9-12 under 35 U.S.C. § 103(a) as
19 unpatentable over Caveney and Goldsmith.

20 **CONCLUSIONS OF LAW**

21 The Appellant has not sustained its burden of showing that the Examiner
22 erred in rejecting claims 1, 2, 4-7, and 9-12 under 35 U.S.C. § 103(a) as
23 unpatentable over the prior art.

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19

DECISION

To summarize, our decision is as follows:

- The rejection of claims 1, 2, 4-7, and 9-12 under 35 U.S.C. § 103(a) as unpatentable over Caveney and Goldsmith is sustained.

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

AFFIRMED

vsh

CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC
1420 FIFTH AVENUE
SUITE 2800
SEATTLE WA 98101-2347