

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

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LAWRENCE J. ZAKARIN

Appeal No. 2001-2656
Application No. 09/208,514

ON BRIEF

Before ABRAMS, McQUADE, and BAHR, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-10 and 20, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a carrying bag. An understanding of the invention can be derived from a reading of exemplary claim 1, which reads as follows:

1. A carrying bag including:

at least one storage compartment,

said at least one storage compartment being formed from a recess defined in a first surface of said carrying bag, a material covering said recess, and access means operatively associated with said material to permit an article to be received in said recess and retained in said recess by said material, said material being expandable into an expanded configuration to accommodate a portion of said article received in said recess and extending beyond said first surface of said carrying bag, said material being automatically retractable into a retracted configuration substantially planar with said first surface of said carrying bag when said article is removed from said recess.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

| | | |
|--|-----------|--|
| Cunningham | 3,321,120 | May 23, 1967 |
| Zakarín | 5,950,895 | Sep. 14, 1999 (filed Dec. 17, 1997) |
| British Patent Specification (Platts) | 607,133 | Aug. 26, 1948 |
| Danish Patent ¹ (Pederson) | 57,338 | Mar. 4, 1940 |

Claims 1-10 and 20 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as

¹Our understanding of this foreign language document was obtained by means of a PTO translation, a copy of which is enclosed.

to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claims 1-10 and 20 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1-10 and 20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cunningham in view of Platts.

Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cunningham in view of Platts and Pedersen.

Claims 1-10 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of Zakarin U.S. Patent No. 5,950,895 in view of Cunningham and Platts.

Claim 20 stands rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of Zakarin U.S. Patent No. 5,950,895 in view of Cunningham, Platts and Pedersen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 19) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 18) and Reply Brief (Paper No. 20) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The First Rejection Under The First Paragraph of Section 112

The first of the two rejections of claims 1-10 and 20 under the first paragraph of Section 112 is that the "recess defined in a first surface" of the carrying bag was not described in the specification in such a way as to reasonably convey that the inventor had possession of the claimed invention at the time the application was filed. We do not agree.

It is true that the phrase "recess defined in the first surface" is not present in the specification as filed. However, as was pointed out by the appellant on page 8 of the Brief, the test for determining compliance with the written description requirement 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.²

Independent claims 1 and 20 are directed to a carrying bag including “at least one storage compartment,” which is disclosed on page 7 of the specification as “storage compartment 4.” The claims continue by stating that the storage compartment is “formed from a recess defined in a first surface of said carrying bag.” In this regard, page 7 of the specification informs one of ordinary skill in the art that a “storage compartment 4 is defined on a portion of a rear surface 8 of the backpack.” The common applicable definitions of “recess” being an indentation or an alcove,³ it is our view that one of ordinary skill in the art would have appreciated that the “recess” as set forth in claims 1 and 20 corresponds to the “storage compartment 4” described in the specification. This interpretation is confirmed by the statement in the claim that the recess is covered by the expandable material, which corresponds to the explanation on page 8 of the specification that compartment 4 has a surface 6 of expandable material.

This rejection is not sustained.

The Second Rejection Under The First Paragraph of Section 112

²See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)

³See, for example, Webster’s New Collegiate Dictionary, 1973, page 964.

It is not clear whether this rejection of claims 1-10 and 20 is under the description requirement, the enablement requirement, or both. In any event, as we found above, the claimed “recess defined in a first surface” of the carrying bag is supported by explanation in the specification, even though the words used in the claim are not present there. This being the case, and on the basis of analogous reasoning, it is our view that having understood from the specification and drawings that the claimed recess corresponds to the disclosed storage compartment 4, one of ordinary skill in the art clearly would have sufficient information to be enabled to make and use the invention.

We therefore find that the claimed invention meets the description and enablement requirements of Section 112, and we will not sustain this rejection.

The Rejection Under The Second Paragraph Of Section 112

It is the examiner’s position that it is unclear as to what the appellant intends as the “recess defined in a first surface,” and therefore independent claims 1 and 20 and those claims depending therefrom are indefinite.⁴ For the reasons expressed above

⁴The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Johnson*, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *Id.*

with regard to the first paragraph rejections, it is our view that the metes and bounds of claims 1 and 20 clearly are discernible to one of ordinary skill in the art, and therefore this rejection is not sustained.

The Rejections Under Section 103

The first of these rejections is that the subject matter of claims 1-10 would have been obvious to one of ordinary skill in the art in view of the combined teachings of Cunningham and Platts.⁵ It is the examiner's view that Cunningham discloses all of the subject matter recited in claim 1 except for the requirement that the material covering the recess be expandable, but that such a feature is taught by Platts and it would have been obvious to one of ordinary skill in the art to modify the Cunningham carrying bag "in order to provide adjustment means for the carrying bag to receive many objects" (Answer, page 8).

The objective of the Cunningham invention is to provide a pack that is capable of supporting a load "without sagging or bending" (column 1, line 31). To accomplish this,

⁵The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

Cunningham teaches dividing the pack into compartments by means of fabric webs or partitions “made of the same durable material as the walls” of the pack and “sewed or otherwise securely bonded to the front, rear and side walls of the pack” (column 2, lines 32-35), as is shown in Figure 4. Partition 27 is described as “acting as a tension member to prevent spreading of the front and rear walls in the lower portion of the filled pack (column 2, lines 67 and 68). The examiner considers the compartment bounded by walls 26 and 27 in Cunningham to be the required “recess in a first surface of said carrying bag.” Accepting this at face value, Cunningham fails to disclose “a material covering said recess . . . [and] being expandable into an expanded configuration to accommodate a portion of said article received in said recess and extending beyond said first surface of said carrying bag,” as is required by claim 1.

The Platts reference is directed to a suitcase having at least portions made of expandable material in order to allow it to stretch “in one or more directions automatically as contents are added” (page 1, lines 35-37). As shown in Figures 2 and 4, stretchable material is used in the sidewalls.

The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so.⁶ We fail to perceive any teaching, suggestion or incentive in either Cunningham or Platts which would have led one of ordinary skill in the art to modify the Cunningham pack in the

⁶In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

manner proposed by the examiner. To replace any portion of the Cunningham pack with expandable material would appear to be undesirable because it would allow portions of the pack to sag. Moreover, to install an expandable material around the access (the zipper) on the outer surface of the compartment formed by partitions 26 and 27, which Cunningham has explained is of particular importance in his invention (column 2, line 63 et seq.) would, from our perspective, clearly allow the pack to bend, which would compromise the objectives of the invention (column 1, line 31). This would, in our view, operate as a disincentive to one of ordinary skill in the art to modify Cunningham in the manner proposed by the examiner, that is, would negate suggestion to combine.

It therefore is our conclusion that the combined teachings of Cunningham and Platts fail to establish a prima facie case of obviousness with regard to the subject matter recited in independent claim 1, and we will not sustain the rejection of claim 1 or, it follows, of dependent claims 2-10.

Claim 20 stands rejected as being unpatentable over Cunningham and Platts, taken further in view of Pedersen. Claim 20 includes all of the limitations recited in claim 1, plus the requirement that there be a compartment for storing headgear and means for removably attaching it to a portion of the carrying bag. It is to the latter limitation that Pedersen is directed. However, be that as it may, Pedersen does not alleviate the problem we pointed out above with regard to combining the teachings of

Cunningham and Platts in such a manner as to render the subject matter of claim 1 obvious. Therefore, as was the case with claim 1, the rejection of claim 20 cannot be sustained.

The Double Patenting Rejections

Claims 1-10 stand rejected under the judicially created doctrine of obviousness-type double patenting “over claims 1-20 of U.S. Patent No. 5,950,895 [Zakarin] in view of Cunningham, and further in view of Platts,” and claim 20 “over claims 1-20 of U.S. Patent No. 5,950,895 [Zakarin] in view of Cunningham, and further in view of Platts . . . [and] Pedersen” (Answer, pages 6 and 7). At the outset, we note that the appellant rightly has protested that the examiner has failed to explain these two rejections in the manner required by Section 804 of the Manual of Patent Examining Procedure, in that he has not compared with particularity the subject matter recited in each of the appellant’s eleven claims with that which is recited in the claims of the ‘895 patent (Brief, pages 13 and 14). Thus the appellant, and the Board, are left to their own devices to speculate how the examiner would have constructed the rejection of each of the twelve claims before us on appeal. This is unacceptable, and in the usual such case would necessitate that the application be remanded to the examiner for statement of the rejections in the manner required by the MPEP.

However, in the interest of judicial economy, we nevertheless shall act on the standing double patenting rejections of the two independent claims, for it immediately is clear to us that they are not sustainable.

Zakarín's independent claims 1, 13 and 17 recite a carrying bag (or backpack) having first and second storage compartments, the latter of which is configured to receive headwear. Zakarín claims 1, 13 and 17 fail to set forth the recess in the surface of the bag covered by an expandable material to permit an article received therein to extend beyond the surface, as required by the claims in the application. The examiner relies upon the teachings of Cunningham to modify Zakarín by providing a compartment with a recess, and then upon those of Platts for the further modification of providing the claimed expandable material. Even assuming, arguendo, that it would have been obvious to provide the Zakarín bag with a compartment formed from a recess in a surface in view of the teachings of Cunningham, for the reasons set forth above with regard to the Section 103 rejections it is our conclusion that it would not have been obvious in view of the teachings of Platts to further modify the Zakarín bag in such a manner as to meet the expandable material requirement of application claims 1 and 20. With regard to claim 20, consideration of the added teachings of Pedersen would not overcome this problem.

We therefore will not sustain the double patenting rejections of claims 1 and 20, or of dependent claims 2-10.

CONCLUSION

None of the rejections are sustained.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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