

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WILLIAM HUBBS, CHRIS GALARDI  
and JAMES TRAPPANI

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Appeal No. 2005-1486  
Application No. 10/099,423

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ON BRIEF

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Before FRANKFORT, MCQUADE, and BAHR, Administrative Patent Judges.  
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

William Hubbs et al. appeal from the final rejection (mailed February 26, 2004) of claims 1 through 15, all of the claims pending in the application.

THE INVENTION

The invention relates to "a carton that serves to both ship and display a product" (specification, page 1). Representative claim 1 reads as follows:

1. A product shipping and display carton, comprising:  
a display box defined by a bottom panel and an upwardly extending wall panel together forming a product carrying enclosure, said display box having an open top defined by a top wall panel edge opposite said bottom panel, said wall panel having a reinforced top product-restraining rail and a

removable panel portion below said open top and said reinforced top product-restraining rail, defining a product viewing window in said display box;

a shipping sleeve defined by a top panel and a downwardly extending wall panel together forming a telescoping enclosure, said shipping sleeve having an open bottom defined by a bottom wall panel edge opposite said top panel, said display box being positioned in said telescoping enclosure such that said open top and said upwardly extending wall panel are substantially entirely covered by said shipping sleeve; and

a removable fastener for securing said shipping sleeve to said display box during shipment and permitting removal of said shipping sleeve from said display box after shipment to display product disposed within said product carrying enclosure of said display box.

THE PRIOR ART

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

Welshenbach	2,761,610	Sep. 04, 1956
Krizan et al. (Krizan)	3,982,690	Sep. 28, 1976
Kim	6,135,288	Oct. 24, 2000

THE REJECTION

Claims 1 through 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Welshenbach in view of Kim and Krizan.

Attention is directed to the main and reply briefs (filed July 1, 2004 and October 12, 2004) and answer (mailed August 11, 2004) for the respective positions of the appellants and examiner regarding the merits of this rejection.

## DISCUSSION

### I. Grouping of claims

As the appellants, stating that “[c]laims 1-15 stand or fall together” (main brief, page 3), do not argue separately the patentability of any particular claim apart from the others, all of the appealed claims shall stand or fall with representative claim 1 (see In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978)).

### II. The merits

Welshenbach, the examiner’s primary reference, discloses “a vertically elongated container or carton that has strength and rigidity enough to make it suitable for shipping loose, heavy articles such as nails, bolts, nuts, screws or the like” (column 1, lines 19 through 22). In general, the carton comprises an inner box A and a cover box B having substantially identical constructions with slight differences in dimension to permit the cover box to fit closely over the inner box. As described in more detail by Welshenbach,

[t]he inner box A of the present invention is preferably vertically elongated and has parallel upright single ply walls 1 and 2. The other two walls of the box are double ply walls having outer plies 3 and 4 that are hinged to and integral with the side

wall 1 and inner plies 5 and 6 which are hinged to and integral with the side wall 2.

The bottom of the box is preferably composed of three thicknesses of paperboard having a bottom ply 7 that is hinged to and integral with the side walls 1 and 2. The intermediate ply of the bottom is preferably formed by flaps 8 and 9 which are hinged to and integral with the outer plies 3 and 4 of the two ply walls. The top ply of the bottom is preferably formed by flaps 10 and 11 that are hinged to and integral with the inner plies 5 and 6 of the two ply side walls. The flaps 8 and 9 are preferably of unequal length with the flap 9 longer than the flap 8. The flaps 10 and 11 are also preferably of unequal length with the flap 10 being longer than the flap 11. By forming these flaps of unequal length the end edges of the flaps forming the intermediate and top layers of the bottom wall adjoin along lines 12 and 13 which are offset from each other and from the center of the box so as to increase the rigidity of the bottom.

The overlapping plies of the box may be secured together in any suitable way. As herein shown the plies 3 and 5 and 4 and 6 of the two ply side walls are secured together by means of staples 14.

The cover box B has elements 1a to 14a corresponding to the above described elements of box A.

The inner box provides a receptacle which may be filled with loose articles such as nails, bolts, or the like, after which the cover box B may be placed over the inner box A and secured thereto by suitable means such as bands 15 [column 2, lines 15 through 48].

The examiner's determination (see page 3 in the answer) that Welshenbach responds to all of the limitations in claim 1 except for those calling for the display box to have a reinforced top product-restraining rail and a removable panel portion defining a

product viewing window is reasonable on its face and not disputed by the appellants.

Kim discloses a box designed to allow display of and access to commodities packaged therein, thereby eliminating the need for a separate display stand for the commodities and the expense and extra space associated therewith (see column 1, lines 37 through 45). To this end, a front surface plate 11 of box body 10 includes cutting lines 20 defining cut-off portions 30 which can be detached from the front surface plate to form opening portions 40 which permit the commodities within the box body to be exhibited, and to be removed from and placed back into the box (see column 4, lines 7 through 49).

In proposing to combine Welshenbach and Kim to reject claim 1, the examiner submits that it would have been obvious "to provide a removable panel portion in the carton of Welshenbach '610 as taught by Kim '288 in order to view the commodities stored in the interior of the carton and [allow] easier removal of the commodities from the carton" (answer, page 4).

The appellants contend generally that this proposed reference combination stems from impermissible hindsight, and more specifically that the proposed modification of the

Welshenbach carton in view of Kim runs counter to Welshenbach's objective of creating a high strength container and that an opening formed in a wall of the container would allow the loose articles stored therein to fall out.

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In this regard, all of the disclosures in a reference must be evaluated for what they fairly teach one of ordinary skill in the art. In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). In conducting this evaluation, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 159 USPQ 342, 344 (CCPA 1968).

In the present case, Kim's description of the above noted benefits afforded by the inclusion of a detachable cut-off portion which defines an opening permitting display of and access

to commodities stored in a box would have furnished the artisan with ample suggestion or motivation to provide such a cut-off portion in any of the side walls of Welshenbach's inner box A. The appellants have not cogently explained, and it is not apparent, why such a modification would appreciably reduce the strength of the Welshenbach carton or lessen its suitability for shipping articles such as nails, bolts, nuts and screws. The appellants also have failed to cogently point out, and it is again not evident, why a cut-out portion, appropriately dimensioned and located depending on the nature of the commodities stored in the Welshenbach box, would necessarily result in spillage of the commodities. Indeed, the combined teachings of Welshenbach and Kim would have suggested the use of the Welshenbach carton for stackable commodities less likely to spill (see Kim at column 4, lines 37 through 42, and Figures 2 and 3) than the exemplary loose commodities specified by Welshenbach. Thus, the appellants' position that the proposed combination of Welshenbach and Kim rests on impermissible hindsight is not well founded.

As so modified in view of Kim, the Welshenbach carton would respond to all of the limitations in claim 1 including those

requiring the display box to have a reinforced top product-restraining rail and a removable panel portion defining a product viewing window. Although neither reference mentions a reinforced top product-restraining rail, such would necessarily result from the inclusion of a removable panel portion as in Kim in one of the double ply side walls of Welshenbach's inner box A.

Hence, the combined teachings of Welshenbach and Kim justify the examiner's conclusion that the differences between the subject matter recited in claim 1 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. The examiner's application of Krizan against claim 1 is, at worst, superfluous.

Accordingly, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 1 and claims 2 through 15 which stand or fall therewith.

#### SUMMARY

The decision of the examiner to reject claims 1 through 15 is affirmed.

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

AFFIRMED

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JOHN P. MCQUADE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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