

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KIMBERLY ANN MUDAR and RAM KUMAR RAMESH

Appeal No. 2006-0771
Application No. 09/426,827¹

HEARD: April 25, 2006

Before PAK, OWENS, and FRANKLIN, Administrative Patent Judges.
PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's refusal to allow claims 1, 3 through 8, 10 through 24 and 26. Claims 9 and 25, the only other pending claims in the above-identified application, stand objected to as being dependent upon a rejected base claim, but are indicated to be allowable "if rewritten in

¹ Application for patent filed October 25, 1999.

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independent form including all of the limitations of the base claim and any intervening claim." See the Answer, page 2. We have jurisdiction pursuant to 35 U.S.C. § 134.

APPEALED SUBJECT MATTER

The subject matter on appeal is directed to a puncture-resistant patch bag used for packaging products. See the specification, page 1. Details of this patch bag are recited in representative claims 1 and 26 which are reproduced below:

1. A patch bag comprising a heat-shrinkable patch adhered to a heat-shrinkable bag, the heat-shrinkable patch comprising a first heat-shrinkable film and the heat-shrinkable bag comprising a second heat-shrinkable film, the first heat-shrinkable film comprising a blend of:
 - A) ethylene/alpha-olefin copolymer having a density greater than about 0.915 g/cm^3 in an amount of at least about 5 percent, based on a total weight of the blend; and
 - B) heterogeneous ethylene/alpha-olefin copolymer having a density of less than about 0.915 g/cm^3 , present in an amount of at least about 21 percent, based on the total weight of the blend; and

wherein the ethylene/alpha-olefin copolymer having a density greater than about 0.915 g/cm^3 and heterogeneous ethylene/alpha-olefin copolymer having a density of less than about 0.915 g/cm^3 together make up at least 70 percent of the total weight of the first film, and wherein the patch is adhered to the bag with an adhesive or corona treatment.

26. A patch bag comprising a heat-shrinkable patch adhered to a heat-shrinkable bag, the heat-shrinkable patch comprising a first heat-shrinkable film and the heat-shrinkable bag comprising a second heat-shrinkable film, the first heat-shrinkable film comprising a blend of:

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- A) ethylene/alpha-olefin copolymer having a density greater than about 0.915 g/cm³, present in an amount of at least about 5 percent based on a total weight of the blend; and
- B) heterogeneous ethylene/alpha-olefin copolymer having a density of less than about 0.915 g/cm³ and a composition distribution breadth index less than 55 percent, present in an amount of at least about 21 percent, based on the total weight of the blend; and

wherein the ethylene/alpha-olefin copolymer having a density greater than about 0.915 g/cm³ and heterogeneous ethylene/alpha-olefin copolymer having a density of less than about 0.915 g/cm³ together make up at least 70 percent of the total weight of the first film, and wherein the patch is adhered to the bag with an adhesive or corona treatment.

REFERENCE

The prior art references relied upon by the examiner in support of the Section 103 (a) rejections before us are:

Ferguson et al. (Ferguson '856)	4,640,856	Feb. 3, 1987
Ferguson (Ferguson '403)	4,755,403	Jul. 5, 1988
Walton et al. (Walton)	5,562,958	Oct. 8, 1996

REJECTION

Claims 1, 3 through 8, 11 through 17 and 26 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Ferguson '856 and Walton. Claims 10 and 18 through 24 stand rejected under 35 U.S.C. § 103(b) as unpatentable over the combined disclosures of Ferguson '856, Walton and Ferguson '403.

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OPINION

We have carefully reviewed the claims, specification and prior art, including all of the arguments advanced by both the examiner and the appellants in support of their respective positions. This review has led us to conclude that the examiner's § 103(a) rejections are not well founded.

Accordingly, we reverse the examiner's rejections for essentially the reasons set forth in the Brief and the Reply Brief. We only add the following for emphasis.

The initial burden of presenting a prima facie case of obviousness rests on the examiner. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Where an obviousness determination is based on the combination of prior art references, "there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000), citing In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998). "[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected the components for combination in the manner claimed." Kotzab, 217 F.3d at 1371, 55 USPQ2d at 1317. Our reviewing court

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has made it clear that "the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Here, the examiner relies on Ferguson '856 to show a heat shrinkable and puncture-resistant plastic film for making receptacles, such as pouches and bags. See the Answer, page 3. The plastic film is said to be made from an ethylene/alpha-olefin copolymer/heterogeneous ethylene/alpha-olefin copolymer blend. See the Answer, pages 4 and 5. The examiner acknowledges that Ferguson '856 fails to teach, inter alia, "a heat-shrinkable patch adhered to the heat-shrinkable bag." See the Answer, page 5.

To remedy this deficiency, the examiner relies on the disclosure of Walton. However, as correctly pointed out by the appellants (the Reply Brief, pages 2-3), Walton teaches employing tough film materials, rather than a patch, for forming a bag to reduce the puncture problem. Specifically, the portion of Walton relied upon by the examiner states (column 2, line 62 to column 3, line 16) that:

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Successful packaging or wrapping for all four methods, depends on the toughness and abuse or implosion resistance properties of the film materials themselves such that the packaged product's integrity is maintained during distribution, handling and/or display. However, toughness and abuse resistance are particularly important in food shrink wrapping and vacuum packaging which often times involves packaging of meat and other food cuts with deep cavities and sharp exposed bones as well as exposed edges that can puncture the film webs or fabricated bag during the heat-shrink or vacuuming-form operation or during subsequent package handling and distribution. To avoid premature puncturing, film producers resort to expensive practices to toughen the package such as using thicker films and bags, using an extra layer of film at critical contact points of the bag in a patch-like fashion as described by Ferguson in U.S. Pat. No. 4,755,403, or by using cross-ply or non-parallel layer constructions. Similarly, to "artificially" enhance the puncture and other abuse or implosion resistance characteristics of known film materials, food packagers routinely wrap or cap exposed bone edges with cloth, molded plastic articles or other materials [emphasis added].

To avoid such an expensive approach, Walton goes on to state (column 4, lines 38-46) that:

While prior art film materials have varying degrees of toughness, implosion resistance, low temperature shrinking characteristics, and bag making heat sealing performances, even tougher film materials are desired in shrink, skin and vacuum packaging for reduced bag punctures or for maintaining puncture resistance levels when down-gauging film thicknesses for environmental source reduction purposes, cost-effectiveness or other considerations [emphasis added].

Given the above teachings, we determine that the combined teachings of Ferguson '856 and Walton, at best, would have

suggested forming a bag with the heat shrinkable and puncture-resistant plastic film taught by Ferguson '856. However, there is nothing in Ferguson '856 and Walton, suggesting the desirability of forming a patch material with the heat shrinkable and puncture-resistant plastic film taught by Ferguson '856 as required by the claims on appeal.² Moreover, we note that the examiner does not point to any prior art to support his or her assertion at page 5 of the Answer that one of ordinary skill in the art is expected to use "the same film for the patch as for the bag" In re Lee, 277 F.3d 1338, 1343-44, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) ("This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority."). Nor does the examiner demonstrate that the bag made of the puncture-resistant plastic film taught by Ferguson '856 is known to suffer from a puncture problem.

It follows that the teaching-suggestion-motivation test set forth above by our reviewing court compels us to agree with the appellants that the examiner has not carried his or her initial

² The examiner does not rely on Ferguson '403 to remedy the deficiency discussed supra. Ferguson '403 is relied upon to show obviousness of the subject matter defined in dependent claims 10 and 18 through 24. See the Answer, page 10.

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burden of establishing a prima facie case of obviousness
regarding the claimed subject matter within the meaning of § 103.

CONCLUSION

In view of the foregoing, we are constrained to reverse the
examiner's decision rejecting all of the claims on appeal under
35 U.S.C. § 103(a).

REVERSED

CHUNG K. PAK)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
TERRY J. OWENS)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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BEVERLY A. FRANKLIN)	
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