

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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SCOTT A FATH, GARY ATWELL,
PAM MOORE and ROBERT T. MITTEN

Appeal No. 2006-1371
Application No. 10/323,250

ON BRIEF

Before FRANKFORT, WARREN and OWENS, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from a rejection of claims 1-27, which are all of the pending claims.

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THE INVENTION

The appellants claim a package comprising an enclosure and a plurality of removable product packs therein, and claim a method for making the package. Claim 1 is illustrative:

1. A package comprising:

a packaging enclosure having an interior surface and including opposite side and end walls;

a plurality of removable product packs each having a given height inside the enclosure engaging the interior surface thereof and the side and end walls;

each of the side and end walls having a height substantially equal to the given height of the product packs; and

each of the packs including outer wrap material at least a portion of which is secured to the interior surface of the enclosure such that upon removal of a product pack from the enclosure at least a portion of the outer wrap material remains secured to the enclosure.

THE REFERENCES

Carnes	2,920,759	Jan. 12, 1960
Evers et al. (Evers)	5,147,037	Sep. 15, 1992
Chacko et al. (Chacko)	2003/0121805	Jul. 3, 2003 (filed Sep. 13, 2002)

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows:
claims 19-23 over Carnes; claims 1, 6-18 and 24-27 over Evers in view of Carnes; and claims 1-5 over Chacko in view of Carnes.

OPINION

We reverse the rejection over Carnes, affirm the rejection over Evers in view of Carnes, affirm the rejection over Chacko in view of Carnes, and remand the application to the examiner to consider new rejections of claims 19-23.

Rejection over Carnes

Carnes discloses a package for dispensing, one at a time, a plurality of wrapped individual packages such as cigarette packs (col. 1, lines 16-20; col. 2, line 55; figures 1 and 3). The wrapped individual packages (10) are placed on a supporting tray (11), and the bottoms of their wrappers (15) are adhesively fastened to the bottom (17) of the tray (col. 1, lines 57-60; col. 2, lines 17-19). Each of the wrappers has a line of weakness around it such that when the individual package is removed from the tray, the wrapper severs along the line of weakness leaving a portion (18) of the wrapper adhesively attached to the tray and exposing an opened end of the individual package (col. 2, lines 20-28). Thus, the dispensing package provides quick access to the contents of the wrapped individual package by combining into a single step what formerly took two steps (removing and opening) (col. 3, lines 12-15). Also, the dispensing package saves carton material and provides an attractive multiple package display (col. 3, lines 15-17).

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The appellants' method claims 19-23 require that the height of each of the end and side walls of a packaging enclosure and the height of each of a plurality of product packs inside the enclosure are substantially the same.

The examiner argues that "[i]t would have been an obvious matter of design choice to provide product packs of a height substantially equal to the opposite side and end walls since the applicant has not disclosed that such an arrangement is for any purpose or solves any stated problem, and one of ordinary skill in the art would expect the package of Carnes to perform equally well with the product packs shown in Figure 3 or product packs having a height substantially equal to the opposite side and end walls" (final rejection mailed June 3, 2004, page 3).

In order for a *prima facie* case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. *See In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a *prima facie* case of obviousness. *See In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The examiner must explain why the prior art would have suggested to one of ordinary skill in the art the desirability of

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the modification. See *Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1783-84.

Thus, even if the examiner is correct that the appellants have not stated that the substantially equal heights of the enclosure and product packs has a purpose or solves a problem, and even if the appellants' and Carnes' packages perform similarly, that does not necessarily mean that the appellants' product design (or any other design) would have been obvious as a design choice. The examiner is required to establish that the prior art would have fairly suggested the claimed package-making method to one of ordinary skill in the art, and the examiner has not done so.

The examiner argues that "a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim" (answer, pages 5-6). The examiner also argues that "to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure" (final rejection mailed June 3, 2004, pages 3-4). The appellants are not claiming a method for

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using a particular package but, instead, are claiming a method for making a package. Hence, to set forth a *prima facie* case of obviousness of the claimed invention the examiner must establish that the claimed method for making the package would have been fairly suggested to one of ordinary skill in the art by the applied prior art, and the examiner has not done so. Moreover, in our view, the showing of a low profile tray (11) with short end and sidewall (Figs. 1-3) coupled with the specific disclosure in Carnes that such a configuration saves a substantial amount of carton material would have discouraged one of ordinary skill in the art from seeking to modify the tray of Carnes in the manner urged by the examiner.

For the above reasons we conclude that the examiner has not carried the burden of establishing a *prima facie* case of obviousness of the method claimed in the appellants' claims 19-23).

Rejections over Evers or Chacko, in view of Carnes
Evers discloses a cigarette carton that can be opened by either detaching panel 118 from front wall 110, or disconnecting webs 114a-d from either or both panels 110 and 112 (col. 4, lines 51-58; fig. 3).

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Chacko discloses a multi-pack cigarette package with "a sleeve having a first pocket for receiving one product pack and an adjacent second pocket on the other side of the vertical hinge for receiving one or more additional product packs" (¶ 0001).

"[T]he packaging sleeves **12** are particularly useful for packaging two or three product packs sold in promotional activities such as buy one or two packs and get one pack free" (¶ 0023).

The appellants argue: "Carnes is primarily directed to a dispensing system for a plurality of individual retail packages while the present invention is directed to an individual retail package per se. The concepts are entirely different and there is no suggestion in the prior art for securing the product packs of an individual retail package [such as that of Evers or Chacko] to the interior surface of the enclosure forming that package" (brief, page 5). The appellants stress "that the enclosure of Evers and Chacko is a single retail unit while Carnes simply discloses a dispensing system that comprises a plurality of such retail units individually secured to a support surface" (brief, page 6). The appellants further argue: "The dispensing system of Carnes does not suggest securing the product packs of an individual retail unit inside the enclosure of that unit. At best Carnes suggests securing the cartons or packaging sleeves of

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Evers or Chacko, each containing multiple packs, to the tray support surface of Carnes' dispensing system" (brief, pages 7-8).

The packages of Evers (fig. 4) and Chacko (fig. 13), like those of the appellants (fig. 1), have a plurality of individual packs inside an enclosure. Carnes' package differs in that the individual packs are secured to a tray (fig. 1) rather than being within an enclosure. However, Carnes' technique of adhesively securing part of each individual pack's wrapper such that when a pack is removed, the wrapper severs along a tear line, thereby automatically opening the pack for quick access (col. 1, lines 57-64; col. 3, lines 12-15), would have been perceived by one of ordinary skill in the art as being independent of the shape of the substrate to which the individual pack's wrapper is adhered. Hence, Carnes would have fairly suggested, to one of ordinary skill in the art, adhesively securing part of the wrappers of the individual packs of Evers and Chacko to the substrate which they contact, i.e., the enclosure, to obtain the benefit of the quick access disclosed by Carnes.

Therefore, we are not convinced of reversible error in the examiner's rejections over Evers or Chacko, in view of Carnes.

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Remand

The appellants' claims 19-23 are comparable to the claims rejected over Evers or Chacko, in view of Carnes, yet the examiner did not reject claims 19-23 over those combinations of references. We therefore remand the application for the examiner to consider rejecting claims 19-23 over Evers or Chacko, in view of Carnes.

DECISION

The rejection under 35 U.S.C. § 103 of claims 19-23 over Carnes is reversed. The rejections under 35 U.S.C. § 103 of claims 1, 6-18 and 24-27 over Evers in view of Carnes, and claims 1-5 over Chacko in view of Carnes, are affirmed. The application is remanded to the examiner.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a remand. 37 CFR § 41.50(e) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) provides that

[w]henever a decision of the Board includes a remand, that decision shall not be considered final for judicial review. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board may enter an order otherwise making its decision final for judicial review.

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Regarding any affirmed rejection, 37 CFR § 41.52(a)(1) provides "[a]ppellants may file a single request for rehearing within two months from the date of the original decision of the Board."

The effective date of the affirmance is deferred until conclusion of the proceedings before the examiner unless, as a mere incident to the limited proceedings, the affirmed rejections are overcome. If the proceedings before the examiner do not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejections, including any timely request for rehearing thereof.

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

AFFIRMED-IN-PART and REMANDED

CHARLES E. FRANKFORT
Administrative Patent Judge)
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) BOARD OF PATENT
) APPEALS
) AND
CHARLES F. WARREN) INTERFERENCES
Administrative Patent Judge)
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