

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES KORMANIK JR.

Appeal No. 2006-1451
Application No. 08/802,472

ON BRIEF

Before FRANKFORT, BAHR and FETTING, **Administrative Patent Judges**.
FETTING, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §134 from the examiner's final rejection of claims 5, 8¹ to 15, 17, 18, 20, 22, 23, 28 to 31, 49, 51, 53, 55 and 57. Claims 19, 21, 27, 50, 52, 54, 56 and 58 are objected to and claims 24 to 26 are allowed. These are all of the claims pending in the application.

We affirm-in-part and make new rejections under 37 CFR § 41.50 (b).

¹ Although the examiner's final rejection, mailed Dec. 2, 2003, indicated that claims 5, 9 to 15, 17, 18, 20, 22, 23, 28 to 31, 49, 51, 53, 55 and 57 were those rejected on the cover form, claim 8 was also rejected on p. 3 of the final rejection.

BACKGROUND

The appellant's invention relates to a method for making a thematic package and marketing it with an enclosed article visually suggested by the package. An understanding of the invention can be derived from a reading of exemplary claim 5, which is reproduced below.

5. A method for making a combination of a thematic package and an article contained in the package for combined marketing, the method including the steps of:

constructing the package as a replica of a recognizable icon, the package having a shape that is different than any shape to be contained therein,

the shape of the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package,

the package having a hollow interior;

locating the article within the hollow interior of the package to form the combination of the article and the thematically-shaped package; and

marketing the combination.

PRIOR ART

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

Gossard	3,624,939	December 7, 1971
Schaffer et al. (Schaffer)	D196,679	October 22, 1963
Francis	D346,185	April, 19, 1994

In addition, we make the following prior art of record.

Auction site web pages of a Babe Ruth wristwatch sold in a plastic baseball shaped package, circa 1948 and 1949 at Hunt Auctions² and at Diamond Galleries³

Servick et al.	5,450,979	September 19, 1995 (filed April 19, 1993)
Spector	5,386,909	February 7, 1995 (filed November 1, 1993)

REJECTIONS

Claims 5, 9, 11, 13, 20, 22, 28, 30 and 31 stand rejected under 35 U.S.C. § 102(b) as being unpatentable as anticipated over Gossard.

Claims 8, 10, 12, 14, 15, 18, 29, 51, 53, 55 and 57 stand rejected under 35 U.S.C. § 103 as being unpatentable as obvious over Gossard.

Claims 17 and 49 stand rejected under 35 U.S.C. § 103 as being unpatentable as obvious over Gossard in view of Francis.

Claim 23 stands rejected under 35 U.S.C. § 103 as being unpatentable as obvious over Gossard in view of Schaffer.

² Web page at http://www.huntauctions.com/online/imageviewer.cfm?auction_num=21&lot_num=390&lot_qual=

³ Web page at http://scoop.diamondgalleries.com/scoop_article.asp?ai=5938&si=123

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejection, we make reference to the examiner's answer (mailed 10/20/2005) for the reasoning in support of the rejection, and to appellant's brief (filed 6/30/2005) and reply brief (filed 12/27/2005) for the arguments thereagainst.

OPINION

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

Claims 5, 9, 11, 13, 20, 22, 28, 30 and 31 rejected under 35 U.S.C. § 102(b) as being unpatentable as anticipated over Gossard.

With respect to claim 5, appellant argues that

- 1) the examiner is presenting a moving target in switching suggested activities that the article and icon relate to, negating novelty; [see Brief at p. 15]
- 2) collecting Gossard's photographs is not a sport; [see Brief at p. 16]
- 3) no one would have imagined the activity of collecting photographs from Gossard's iconic container; [see Brief at p. 17]
- 4) no one would have imagined using Gossard's photographs as part of the play of a sport that Gossard's photographs portray; [see Brief at p. 18]
- 5) Gossard does not teach using the photographs during a sport [see Brief at p. 18];

- 6) the examiner is speculating as to the linkage between the article, the activity and the iconic package, rather than showing it in the reference (citing In re Bond) [see Brief at p. 19]; and
- 7) Gossard does not teach marketing the iconic container together with photographs. [see Brief at p. 19]

Before addressing the appellant's arguments concerning the rejections, we first note that this claim, and indeed all of the claims, contain the limitations that an icon be visually suggestive of an activity, and that the article be used during that activity. None of the independent claims further constrain the limits of visual suggestion or usage. Therefore the claim scope is as broad as the imagination of any individual making the association and performing the usage.

As to the appellant's first argument, while the examiner may be presenting multiple alternative theories under which Gossard may be interpreted, multiple theories do not negate novelty, but rather provide additional support for the argument. We note that Gossard's iconic representations of several sports playing pieces, such as a baseball, football and hockey puck, are each recognizable as such representations, and each would suggest activities associated with each of their respective sports, including the activity of referring to photographs, as in, for example, trading cards, having team members associated with each of the respective sports. This set of linkages generally corresponds to what the examiner was attempting to portray as a theory of anticipation under Gossard. Therefore, the examiner's presentation of multiple theories cannot be the basis for negating the rejection.

As to the appellant's second argument, it is unclear whether collecting photographs (e.g. trading cards) is itself a sport, but this argument is moot given that claim 5 imposes no limitation requiring a specific activity to be a sport, nor that the article be used as part of the play of a sport, but only that the article be used during an activity that the package visually suggests. The person performing the usage does not have to be engaged actively in the activity, but may instead be a spectator, so long as the spectating occurs during the activity. Similarly, as to the appellant's fifth argument, whether Gossard discloses the use of photographs as part of the play of a sport is moot for the same reason. As to the appellant's fourth and fifth arguments, the fact that the examiner imagined such activity and usage itself negates the argument that no one could have imagined them. Certainly, the appellant has produced no evidence that no one could have imagined them; the appellant has only offered a conclusory assertion of that.

As to the appellant's seventh argument, whether Gossard discloses marketing the combination of container and cards, Gossard's claim 1 is to the combination of the container and cards and Gossard's patent property was to that combination, which is substantial evidence of an intent to market the combination.

Finally, we take up appellant's sixth argument that the art must explicitly disclose a claim limitation in the appellant's reference to *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). As indicated by appellant, Bond states that

For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be identically shown in a single reference.

While this is what the *Bond* opinion states, the appellant fails to properly apply this to claim 5. Claim 5 requires marketing a container that contains an article, the container having a hollow interior. The claimed attributes of the container are that it is a replica of a **recognizable** icon and that the article be such that it is used in an activity that is **visually suggested** by the iconic shape. The appellant's contention is that *Bond* requires that Gossard explicitly recite the recognition and visual suggestion linkages between the iconic shape, the activity and the article to form anticipation. Such is simply not the law.

The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness. *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995). Gossard is available as anticipatory art for what it explicitly, implicitly or inherently teaches. Gossard teaches an iconic package [Figs. 1, 4, 7, 10 and 11] each of which resemble their iconic sports playing pieces. Gossard explicitly links the iconic shapes to the images on the trading cards (photographs) at col. 1 lines 19 to 25. The claim limitation is to an activity that the article is used in that is visually suggested by the package. The linkage of visual suggestion is completely within the mind of the person viewing the package. This may be inferred from the teachings of Gossard and still be anticipatory because the Gossard reference is available for its explicit, implicit and inherent teachings. Given that Gossard has explicitly linked the iconic package with the articles contained, any activity that the owner of the container would reasonably use its contents for is inherently suggested by the iconic representation of the container, if only through Gossard's linkage already

provided. However, the limitation of “visually suggested” is far broader than that, and is only limited by the memory and imagination of whoever views the package. We note that the preferred embodiment taught in the specification is raingear within a golf iconic package. [see Specification at p. 4] We further note that the activity of referring to, or even trading, Gossard’s photographs is at least as visually suggested by Gossard’s iconic representations, as the activity of putting on a raincoat during the play of a game is by the appellant’s iconic representation.

Therefore, we find the appellant's arguments as to claim 5 to be unpersuasive. Accordingly, we sustain the examiner’s rejection of claim 5 under 35 U.S.C. § 102(b) as being unpatentable as anticipated by Gossard.

As to claims 9, 11 and 13, these claims are dependent from claim 5 and specify that the icon is a baseball, football and a ball respectively. We note that Gossard describes each of these explicitly as potential embodiments. The appellant argues essentially the same as in claim 5, particularly the lack of a specific description that the photographs are used during the respective activity, and our discussion with respect to claim 5 applies here as well.

Therefore, we find the appellant's arguments as to claims 9, 11 and 13 to be unpersuasive. Accordingly, we sustain the examiner’s rejection of claims 9, 11, and 13 under 35 U.S.C. § 102(b) as being unpatentable as anticipated by Gossard.

As to claims 20 and 22, these claim are dependent from claim 5 and specify that the package have an independent utility and that it be capable of receiving subsequent

writing respectively. The appellant argues essentially the same as in claim 5, particularly the lack of a specific description that the photographs are used during the respective activity, and our discussion with respect to claim 5 applies here as well. We note that Gossard provides an explicit utility beyond that of containing the enclosed articles, that described as “shaped to identify a particular sport” [See col. 1 lines 21] whose utility is presenting a novelty form for view. Although Gossard is silent as to the choice of substances the container would be made from, as we noted above, characteristics in the prior art may be inherent or implicit, and we note that a magic marker (specific to the claim 22) can leave writing on almost any surface, and, more to the point, the containers in Gossard are highly personal and therefore must have been created with some capacity to receive some indicia of ownership following acquisition.

Therefore, we find the appellant's arguments as to claims 20 and 22 to be unpersuasive. Accordingly, we sustain the examiner's rejection of claims 20 and 22 under 35 U.S.C. § 102(b) as being unpatentable as anticipated by Gossard.

As to claims 28, 30 and 31, these claim are dependent from claim 5 and specify that there be an additional article, that the activity be a sport, and that the package have separably joinable pieces respectively. The appellant argues essentially the same as in claim 5, particularly the lack of a specific description that the photographs are used during the respective activity, and our discussion with respect to claim 5 applies here as well. We note that Gossard provides an explicit drawing showing a second article, i.e. a second photograph, in each of Figs. 2, 5 and 8. We further note that the drawings in Gossard portray a baseball, football, basketball and hockey puck, each suggestive of

the activity of the sport so named. The photographs in Gossard, to the extent they are the equivalent of trading cards, which we note are a highly ubiquitous embodiment of sports photographs, would be used by spectators during the play of the sport by the players represented on the cards to serve as memory joggers for the spectator, both of the visual form of the player, and of the statistics generally on the opposite side of such trading card photographs. Further, as the examiner noted in the rejection of claim 5, the activity of collecting itself is a hobby or sport. We note that Gossard shows the container being made of separably joinable pieces in Figs. 2, 5, 6 and 8. We further note that the breadth of the claims allows the pieces to not have to be totally separable such that there is no remaining connection, but only that the pieces be separable in some manner, which opening of the container accomplishes.

Therefore, we find the appellant's arguments as to claims 28, 30 and 31 to be unpersuasive. Accordingly, we sustain the examiner's rejection of claims 28, 30 and 31 under 35 U.S.C. § 102(b) as being unpatentable as anticipated by Gossard.

To summarize, the above conclusions, we sustain the rejections of claims 5, 9, 11, 13, 20, 22, 28, 30 and 31 under 35 U.S.C. § 102(b) as being unpatentable as anticipated over Gossard.

**Claims 8, 10, 12, 14, 15, 18, 29, 51, 53, 55 and 57 rejected under 35 U.S.C. § 103
as being unpatentable as obvious over Gossard.**

As to claims 8 and 12, these claims are dependent from claim 5 and specify that the icon is a golf ball and a tennis ball respectively. We note that Gossard describes

several sports balls explicitly as potential embodiments, and that golf and tennis would be immediately apparent as alternative embodiments to a person of ordinary skill in the art of creating sports novelty items as being similarly shaped balls in other popular sports. The appellant argues essentially the same as in claim 5, particularly the lack of a specific description that the photographs are used during the respective activity, and our discussion with respect to claim 5 applies here as well.

Therefore, we find the appellant's arguments as to claims 8 and 12 to be unpersuasive. Accordingly, we sustain the examiner's rejection of claims 8, and 12 under 35 U.S.C. § 103 as being unpatentable as obvious over Gossard.

As to claims 10, 14 and 15, these claims are dependent from claim 5 and specify that the icon is a life preserver, a wheel and a credit card respectively. We note that Gossard describes several sports balls and a hockey puck explicitly as potential embodiments, and that while other sports balls would be immediately apparent as alternative embodiments to a person of ordinary skill in the art of creating sports novelty items as being similarly shaped balls in other popular sports, the icons in these claims are not ball or hockey puck shaped and nothing in Gossard suggests other shapes. The examiner argues that these shapes are mere matters of design choice. Were there no connection between the icon and the contents, this might be a viable argument. But given the claim element of the connection between the icon and the contained articles, the choice of the iconic representation is more than mere design choice and some suggestion for that claimed iconic representation must be found in the prior art to

support a rejection. We find no such suggestion in Gossard and the examiner has not shown any.

Therefore, we find the examiner's arguments as to claims 10, 14 and 15 to be unpersuasive. Accordingly, we do not sustain the examiner's rejection of claims 10, 14 and 15 under 35 U.S.C. § 103 as being unpatentable as obvious over Gossard.

As to claim 18, this claim is dependent from claim 5 and specifies that an outer layer of packaging is added that is shaped to visually suggest the activity. The examiner argues that it would have been an obvious matter of design choice and it is notoriously well known to select such a package.

It would have been an obvious matter of design choice to add an outer layer of packaging shaped to visually suggest information about the associated activity since this is an inherently old and well known concept in the art of packaging/marketing (i.e., adding a plastic bubble enclosing the contents for sale in a store as well as for shipping purposes, to protect the contents, and also printing the contents or various characteristics of the contents on the outside layer of packaging, which in the instant case may include: "Baseball shaped sports memorabilia Bank" or a similar phrase, along with the location of the manufacturer). [See Final Rej. at p. 6-7]

The appellant argues that the appellant asked the examiner to provide evidence of the notoriety of packaging shaped as claimed and that the examiner did not provide such evidence and that even were one to follow the theoretical example offered by the examiner one would not achieve the claimed subject matter. More particularly, the appellant urges that

More so, even if we forgive all the above discussed deficiencies, and find some reason to combine the Examiner's personal recollections of a walk through some unspecified

department store about a decade ago and come up with some reason to combine and modify, the theory of the rejection still does not work. The Examiner mentions "adding plastic bubble enclosing the contents for sale in a store as well as for shipping purposes, to protect the contents," but this is not a teaching of the claimed outer layer of packaging shaped to visually suggest information about the associated activity. The Examiner also theorizes "also printing the contents or various characteristics of the contents on the outside layer of packaging which in the instant case may include "Baseball shaped sports memorabilia Bank" or a similar phrase, along with the location of the manufacturer, does not teach the claimed outer layer of packaging shaped to visually suggest information about the associated activity. In sum, even forgiving a mass of error, the theory still does not reach the claim requirements.

In sum, the Examiner has not made out a case of *prima facie* obviousness based on Gossard alone. [See Brief at p. 54-55]

We note that all of this argument is misplaced because neither the examiner nor the appellant has construed what is meant by the phrase "outer layer of packaging shaped to visually suggest the associated activity." This claim is not an originally presented claim, but was added by amendment on 6/29/1998 (certified as deposited in U.S. mail on 6/22/1998), over a year after initial filing. Therefore, we must consult the specification to determine the proper scope and interpretation of the phrase that would support the claim.

The support in the specification is on p. 7

Additionally, a protective sleeve such as that employing the protective cover can be packaged thematically. For example, if the sleeve is used for a golf bag, this sleeve can be housed in a plastic assembly resembling a golf ball, which in turn can be located in a box resembling that which is used to house golf balls, thereby suggesting the use to which the sleeve can be applied.

And on p. 12

To continue the theme, three of the packaging 52 items can be located in a box 54 resembling that which is used to contain or sell golf balls

Accordingly, a claim to the shape of the outer packaging is described and enabled only to the extent of a box that is shaped to resemble the type of box the iconic shape is ordinarily enclosed in, not to the extent that it is shaped to resemble any activity visually suggested by the iconic shape. More to the point, the specification shows that any package that resembles the package the original of the iconic representation would be sold in would meet the claim limitation. We note that one of ordinary skill would immediately apprehend the idea of packaging a representation of a sports playing piece, such as those described in Gossard, with the same shape of package as the original item the icon represents. For example, a person of ordinary skill in the novelty packaging art would immediately consider placing Gossard's baseball embodiment in a cubical outer package, for both the reason that this would be the shape that consumed the least packaging material using flat surfaces, and that this would be the same shape as the cubical cardboard boxes that baseballs are almost universally sold in.

The appellant further argues essentially the same as in claim 5, particularly the lack of a specific description that the photographs are used during the respective activity, and our discussion with respect to claim 5 applies here as well.

Therefore, we find the appellant's arguments as to claim 18 to be unpersuasive. Accordingly, we sustain the examiner's rejection of claim 18 under 35 U.S.C. § 103 as being unpatentable as obvious over Gossard.

As to claim 29, this claim is multiply dependent from claims 5 and 8-23 and specifies that the package and article be made from plastic. The examiner argues that it would have been an obvious matter of design choice based on the suitability of plastic as known in the art. The appellant argues that making photographs out of plastic may not be possible and even if it were, would make the cards unusable for the purpose intended, and similarly for making Gossard's spring hinge out of plastic. [See Brief at 56.]

We agree with the examiner that plastic is a notoriously well known construction medium for novelty items and we note that Gossard's container is a novelty item as evidenced by its title "Novelty Container for Photographs." As to the photographs contained within Gossard's container, we note that it is notoriously well known to coat photographs with plastic to preserve them. Claim 29 is drafted with an open ended transition phrase "comprising" and the phrase "constructed from" is open ended as well. Nothing in the phrase "constructed the replica out of plastic and the article out of plastic" precludes the use of other non-plastic materials in the construction. Therefore the obvious construction of Gossard's shell and photographs' exterior from plastic would meet the limitations of claim 29.

The appellant further argues essentially the same as in claim 5, particularly the lack of a specific description that the photographs are used during the respective activity, and our discussion with respect to claim 5 applies here as well.

Therefore, we find the appellant's arguments as to claim 29 to be unpersuasive. Accordingly, we sustain the examiner's rejection of claim 29 under 35 U.S.C. § 103 as being unpatentable as obvious over Gossard.

As to claims 51, 53, 55 and 57, these claims are similar to claims 5 and 13 with the difference being multiple combinations and multiple articles within a container. The appellant argues that Gossard does not teach or suggest these combinations. [See Brief at p. 57-61] We note that Gossard describes several sports balls explicitly as potential embodiments, and that simply marketing more than one of Gossard's embodiments would meet claims 51 and 57. Further, we note that using a box to contain the items being marketed is conventional in the sale of novelty items, which meets claim 53. Further, we note that different photographs of players on different types of sports teams as suggested by Gossard for each of its packaging embodiments would meet claim 55. We further note that packaging multiple variations of members of a set of similar items in variety pack formats, for example, different cereals in variety packs, was notoriously well known at the time of the invention.

The appellant further argues essentially the same as in claim 5, particularly the lack of a specific description that the photographs are used during the respective activity, and our discussion with respect to claim 5 applies here as well.

Therefore, we find the appellant's arguments as to claims 51, 53, 55 and 57, to be unpersuasive. Accordingly, we sustain the examiner's rejection of claims 51, 53, 55 and 57 under 35 U.S.C. § 103 as being unpatentable as obvious over Gossard.

To summarize the above conclusions, we sustain the rejections of claims 8, 12, 18, 29, 51, 53, 55 and 57, and we do not sustain the rejections of claims 10, 14 and 15, under 35 U.S.C. § 103 as being unpatentable as obvious over Gossard.

Claims 17 and 49 rejected under 35 U.S.C. § 103 as being unpatentable as obvious over Gossard in view of Francis.

Claims 17 and 49 depend from claim 5 and include the limitation that it have a logo and a message suggestive of use on the package respectively. We note that Francis shows text and graphic symbols that may reasonably be characterized as a logo and as a message suggestive of use on the package in the form of the words "CARD FOOTBAL" and a symbol representing the lacing on a football in its Fig. 1. The appellant argues that this is not a logo and is not a message suggestive of use. We note that the specification does not contain a definition of logo, and therefore we may consult a dictionary as extrinsic evidence of the meaning of the term. The American Heritage Dictionary defines a logo as a name, symbol, or trademark designed for easy and definite recognition, especially one borne on a single printing plate or piece of type. We note that the text in Francis' Fig. 1 satisfies this definition by being a name. The appellant then cites *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969)⁴, to support the argument that printed matter must be considered if it is functionally related to other

elements. We note that the examiner has considered this in the examiner answer p. 8 indicating that the logo is suggestive of activities using the cards that would be contained in the container shown in Francis Fig. 1. Such activities would be similar to those the cards in Gossard would be used with as discussed above. For the same reason, this text likewise satisfies the element of being a message suggestive of use.

The appellant also argues essentially the same as in claim 5, particularly the lack of a specific description that the photographs are used during the respective activity, and our discussion with respect to claim 5 applies here as well.

Therefore, we find the appellant's arguments as to claims 17 and 49, to be unpersuasive. Accordingly, we sustain the examiner's rejection of claims 17 and 49 as rejected under 35 U.S.C. § 103 as being unpatentable as obvious over Gossard in view of Francis.

Claim 23 rejected under 35 U.S.C. § 103 as being unpatentable as obvious over Gossard in view of Schaffer.

Claim 23 depends from claim 5 and includes the limitation that it have a means for attaching the package to another article secured to an exterior of the package. We note that Schaffer shows a carrying chain secured to an exterior of the baseball shaped package and that articles could be secured to the carrying chain. The appellant argues that Schaffer is not analogous art and therefore there would have been no motivation to combine Schaffer's carrying chain with Gossard's package. As the appellant points out,

⁴ The appellant's citation for this case is incorrectly given as 64 USPQ 46 on p. 3 of the appeal brief.

there are two tests for whether art is analogous. A reference is appropriate prior art if within the field of the inventor's endeavor. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 449 (Fed. Cir. 1986). Alternatively, a reference qualifies as prior art if "reasonably pertinent to the particular problem with which the inventor was involved." *Id.* "A reference is reasonably pertinent if, even though it may be in a different field of endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." *In re GPAC Inc.*, 57 F.3d 1573, 1578 (Fed. Cir. 1995)

We note that the package in Gossard is a novelty package shaped to resemble a sports icon that may be carried on one's person. Therefore, art that is reasonably pertinent to novelty packages shaped to resemble a sports icon that may be carried on one's person would qualify as analogous art. Schaffer's package containing a radio is shaped to resemble a baseball, which is, in fact, one of Gossard's specific embodiments, and may be carried on one's person. A person of ordinary skill in the art in constructing packages of a size that might be carried on one's person would have been motivated to look to art of similar articles that shows how to avoid losing such an article because of the nature of the manner of conveyance on one's person. Accordingly, we find that Schaffer is analogous art with respect to the claims and to Gossard.

The appellant also argues essentially the same as in claim 5, particularly the lack of a specific description that the photographs are used during the respective activity, and our discussion with respect to claim 5 applies here as well.

Therefore, we find the appellant's arguments as to claim 23 to be unpersuasive. Accordingly, we sustain the examiner's rejection of claim 23 as rejected under 35 U.S.C. § 103 as being unpatentable as obvious over Gossard in view of Schaffer.

New Grounds of Rejection Under 37 CFR § 41.50(b)

Pursuant to 37 CFR § 41.50(b), we enter the following new grounds of rejection:
Claims 18 and 19 are rejected under 35 U.S.C. § 112, first paragraph, as not being fully described or enabled to the extent of the scope of the claim.

More particularly, claim 18 has a limitation in which an outer layer of packaging is shaped to visually suggest the associated activity. However, claim 18 was not presented with the original filing, but was added by amendment on 6/29/1998 (certified as deposited in U.S. mail on 6/22/1998), over a year after initial filing. The support in the specification is on p. 7

Additionally, a protective sleeve such as that employing the protective cover can be packaged thematically. For example, if the sleeve is used for a golf bag, this sleeve can be housed in a plastic assembly resembling a golf ball, which in turn can be located in a box resembling that which is used to house golf balls, thereby suggesting the use to which the sleeve can be applied.

And on p. 12

To continue the theme, three of the packaging 52 items can be located in a box 54 resembling that which is used to contain or sell golf balls

Accordingly, a claim to the shape of the outer packaging is described and enabled only to the extent of a box that is shaped to resemble the type of box the iconic shape is ordinarily enclosed in, not to the extent that it is shaped to resemble any

activity visually suggested by the iconic shape. Therefore, the scope of claim 18 is not commensurate with the scope of its written description and enablement and we thus reject claim 18 under 35 U.S.C. § 112, first paragraph. Claim 19 is similarly rejected for fully incorporating the scope of its parent claim 18 and therefore is rejected for the same description and enablement issues, *supra.*, of its parent claim 18.

Claims 5, 17 to 24, 27 to 31 and 49 to 58 are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention.

More particularly, we point to the claimed characterization of an icon as “**recognizable**”, and of the claimed characterization of the shape of the package as “**visually suggestive**” of an activity “**associated with**” the icon in which the article is used during the activity. The characterization of “recognizable”, “visually suggestive”, and “associated with” are totally subjective to each individual obviating any possibility of pointing out the scope of the claims with any degree of particularity.

Our reviewing court has held that

Reference to undefined standards, regardless of whose views might influence the formation of those standards, fails to provide any direction to one skilled in the art attempting to determine the scope of the claimed invention.

Datamize, LLC v. Plumtree Software, Inc., 417 F. 3d 1342; 75 U.S.P.Q.2D 1801 (Fed. Cir. 2005). These noted characterizations in these claims so rejected have no objective standards and therefore fail to provide the direction required under 35 U.S.C. § 112, second paragraph, to one skilled in the art attempting to determine the scope of the claimed invention.

Analysis.

We first look to the intrinsic record to determine whether there is any objective standard for these claim terms. The specification states that

It has been discovered that packaging can and should have independent utility from merely containing. The **shape of the packaging** can be useful, for example, in **communicating what is in the packaging and/or how to use the contents of the packaging**. ... The process for making structural indicia packaging can therefore be described as having the steps of selecting a symbol or icon having a shape that **suggests** an activity ... (emphasis added) [See Specification at p. 3-4]

And

What is important is to pick a symbol or icon suitable for thematically-shaped packaging for a subsequently used article. [See Specification at p. 13]

And

There can be any item or article having a use suggested by the shape of the packaging... [See Specification at p. 15]

The specification then provides a golf ball as an example of the shape and rain apparel, insect repellent and bee sting treatment as an example of the contents. Perhaps most informative of the objectivity, or lack thereof, of any standard for the suggestive power of the icon is the specification's description of the inclusion of the raingear.

For a more specific example, packaging shaped like a golf ball suggests that the content of the packaging is useful in connection with the game of golf, i.e. light weight rain apparel or gear packaged in the golf ball for use in playing golf in the rain.

As to prosecution history, there appears to be no discussion regarding the standard for determining recognizability of an icon, but the appellant has generally relied on an inconceivability standard regarding the “visually suggestive of an activity associated with ... in which the article is used” criterion, e.g. “nor can one imagine” [see Brief at p. 18] and “no one could conceivably think of...” [see Applicant’s Amendment and Response filed 10/21/2002].

The specification thus relies on circular logic as the standard for both recognizability and being visually suggestive, as it teaches that the shape of the icon is to suggest what is inside and what is inside is taught as something suggested by the shape of the package. Thus there is no objective standard for either recognizability or being visually suggestive taught in the specification. We note that the example of raingear is of little assistance in forming a standard, for raingear is needed for any activity in the rain, a far broader category of activity than a single sport or theme. We can think of no way in which, absent foreknowledge of the contents and a conscious personal mental linkage made between the contents and the package, such linkage being personal and thus independent of any visual suggestive power of the icon, anyone would find a sports play piece icon suggestive of rain gear.

We further note that the example of golf in the specification introduces the linkage of an activity of playing golf between the icon and the contents, i.e. the icon of a golf ball suggests playing golf which in turn suggests the need for rain gear. [See Specification at p. 4] But raingear is not among the component parts suggested by the rules of golf, nor is it a uniform or some ubiquitous manifestation, such as a golf cart, of

golf. Hence its visual suggestion is only by virtue of what the particular person making the mental leap from icon to activity to article has by way of personal memory towards that suggestion. Hence there is no objective test disclosed for the scope of the activities that an icon might suggest, nor of the level of the icon's ability to visually suggest an article that might be used during any such activity. Indeed, the test the appellant has applied in the prosecution history, that of inconceivability, is highly subjective to the personal levels of conception.

As the opinion in *Datamize* (where the subjective element was the phrase "aesthetically pleasing") stated

The scope of claim language cannot depend solely on the unrestrained, subjective opinion of a particular individual purportedly practicing the invention. See Application of Musgrave, 431 F.2d 882, 893 (C.C.P.A. 1970) (noting that "[a] step requiring the exercise of subjective judgment without restriction might be objectionable as rendering a claim indefinite"). Some objective standard must be provided in order to allow the public to determine the scope of the claimed invention. Even if the relevant perspective is that of the system creator, the identity of who makes aesthetic choices fails to provide any direction regarding the relevant question of how to determine whether that person succeeded in creating an "aesthetically pleasing" look and feel for interface screens. A purely subjective construction of "aesthetically pleasing" would not notify the public of the patentee's right to exclude since the meaning of the claim language would depend on the unpredictable vagaries of any one person's opinion of the aesthetics of interface screens. While beauty is in the eye of the beholder, a claim term, to be definite, requires an objective anchor. Id. at 1350

And

Reference to undefined standards, regardless of whose views might influence the formation of those standards, fails to provide any direction to one skilled in the art attempting to determine the scope of the claimed invention. In short, the definition of

“aesthetically pleasing” cannot depend on the undefined views of unnamed persons, even if they are experts, specialists, or academics. Id. at 1352

We note that the standards of recognizability and visual suggestion are no more objective than a standard for aesthetic pleasure. All three are highly dependent on geographic, cultural, and personal history vagaries of the people to whom such criteria apply. An icon of a cricket bat might be immediately recognizable in British areas, but would more likely be thought to be a fraternity pledge paddle in the United States. Certainly the activities suggested by each would be very different indeed. A more domestic example would be a sphere with a small circle drawn on top. While most domestic observers might scratch their heads over what this represented, many from the American South would recognize it as an iconic black-eyed pea.

Therefore, because as the court stated in *Datamize*, the definition of a claim limitation cannot depend on the undefined views of unnamed persons, we reject claims 5, 17 to 24, 27 to 31 and 49 to 58 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention.

COMMENTS

Should prosecution be reopened, the examiner should consider the following art that we make of record: Babe Ruth wristwatch sold in a plastic baseball shaped package, circa 1948 and 1949, as evidenced by auction site web pages at Hunt Auctions and at Diamond Galleries, *supra.*, U.S. Pat. Nbr. 5,450,979 to Servick et al. (9/19/1995, filed 4/19/1993) and U.S. Pat. Nbr. 5,386,909 to Spector (2/7/1995, filed

11/1/1993). For example, the Babe Ruth wristwatch was clearly marketed together with its plastic baseball shaped package that held a Babe Ruth logo on it, as shown by the presence of both the watch and package on the original advertisement. The watch contains an emblem of the playing field of the sport the iconic baseball conveys, implying use during a baseball event and the case is a plastic baseball replica, and therefore a toy after removal of the watch, made of plastic, and as such could be written upon with a magic marker. Spector's bear shaped container contains a jar, not in any manner shaped as a bear and gummy bears, described as similar, but clearly not the same, and therefore different from, the shape of the bear container. A large bear in a shape similar, but not the same as, a gummy bear might suggest eating gummy bears. Servick's football shaped container is taught to also be a toy and can contain such items as deodorant used during sports activities in shoes, and can have a keychain attachment and can be made of a number of materials that inherently accept writing upon them.

CONCLUSION

To summarize,

- The rejection of claims the rejections of claims 5, 9, 11, 13, 20, 22, 28, 30 and 31 under 35 U.S.C. § 102(b) as being unpatentable as anticipated over Gossard **are sustained.**
- The rejections of claims 8, 12, 18, 29, 51, 53, 55 and 57 under 35 U.S.C. § 103 as being unpatentable as obvious over Gossard **are sustained.**

- The rejections of claims 10, 14 and 15 under 35 U.S.C. § 103 as being unpatentable as obvious over Gossard **are not sustained**.
- The rejections of claims 17 and 49 under 35 U.S.C. § 103 as being unpatentable as obvious over Gossard in view of Francis **are sustained**.
- The rejection of claim 23 under 35 U.S.C. § 103 as being unpatentable as obvious over Gossard **is sustained**.
- New rejections of claims 18 and 19 under 35 U.S.C. § 112, first paragraph, as not being fully described or enabled are made under 37 CFR § 41.50(b).
- New rejections of claims 5, 17 to 24, 27 to 31 and 49 to 58 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention are made under 37 CFR § 41.50(b).

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

In addition to affirming the examiner's rejection(s) of one or more claims, this decision contains new grounds of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50 (b) also provides that the appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

Should the appellant elect to prosecute further before the examiner pursuant to 37 CFR § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does 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 rejection, including any timely request for rehearing thereof.

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 NEW GROUND OF REJECTION UNDER
37 CFR § 41.50(b)**

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
JENNIFER D. BAHR)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
ANTON W. FETTING)	
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