

The opinion in support of the decision being entered today 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* PAUL J. BAKER

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Appeal 2007-1593  
Application 10/462,972  
Technology Center 3700

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Decided: July 27, 2007

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Before WILLIAM F. PATE, III, HUBERT C. LORIN, and JENNIFER D. BAHHR, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Paul J. Baker (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1-11, 13, 14, and 21-23. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

Appellant's claimed invention is directed to "a sample container for relatively small objects configured to secure one or more cards, such as business cards, onto an interior or exterior surface of the container" (Specification [0002]). Claims 1 and 23 are the only independent claims pending in this application and read as follows:

1. A container for storing, visually displaying and dispensing small objects, the container comprising  
a lid and a hollow base;

the base comprising a plurality of sides and a bottom forming an inner volume; and

the lid comprising an inner surface and an outer surface and a plurality of card securing members, configured to secure one or more cards to a surface of the container, wherein the container is formed from a clear plastic which allows the small objects to be visible without opening the container.

23. A method of providing a visually apparent sample of a product in a container to a recipient with a business card integrally secured on the container, said method comprising:

distributing to the recipient a clear plastic container filled with small objects that are visible without opening the container, the container comprising a lid and hollow base, the base comprising a plurality of sides and a bottom forming an inner volume; and the lid comprising an inner surface and outer surface and a plurality of card securing members that secure the business card to the container.

The Examiner relies upon the following as evidence of unpatentability:

Alden	US 3,415,407	Dec. 10, 1968
Schoberg	US 4,790,434	Dec. 13, 1988
Perrin	US 5,823,353	Oct. 20, 1998
Masoud	US 6,240,989 B1	Jun. 05, 2001
Hobbs	US 6,264,032 B1	Jul. 24, 2001
Danielson	US 6,341,710 B1	Jan. 29, 2002

Appellant seeks review of the Examiner's rejections under 35 U.S.C. § 103(a) of:

- (1) claims 1-9, 11, 13, 14, 21, and 23 as unpatentable over Alden in view of Perrin or Hobbs,
- (2) claim 10 as unpatentable over Alden in view of Perrin or Hobbs, further in view of Masoud,
- (3) claim 22 as unpatentable over Alden in view of Perrin or Hobbs, further in view of Schoberg<sup>1</sup>,
- (4) claims 1-4, 6, 7, 13, 14, 21, and 23 as unpatentable over Danielson in view of Alden and Perrin or Hobbs,
- (5) claim 22 as unpatentable over Danielson in view of Alden and Perrin or Hobbs, further in view of Schoberg,
- (6) claims 1-11, 13, 14, 21, and 23 as unpatentable over Masoud in view of Alden and Hobbs or Perrin, and
- (7) claim 22 as unpatentable over Masoud in view of Alden and Hobbs or Perrin, further in view of Schoberg.

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<sup>1</sup> The Examiner cited Schoberg to support the official notice taken in the Final Rejection (mailed May 27, 2005). See Office Communication mailed December 5, 2005 and Answer 10, 12, and 14, for example.

The Examiner provides reasoning in support of the rejections in the Answer (mailed August 11, 2006). Appellant presents opposing arguments in the Appeal Brief (filed March 8, 2006), Reply Brief (filed July 3, 2006), and Supplemental Reply Brief (filed October 16, 2006). Appellant's counsel presented oral argument on July 12, 2007.

## OPINION

### Rejections (1) through (3)

An issue pertinent to all of rejections (1) through (3) is whether it would have been obvious to modify Alden's mailer to make it transparent. The Examiner contends that it would have been obvious to make Alden's mailer transparent to allow the user to view the contents within the mailer without opening it (Answer 3). Appellant, on the other hand, argues that modification to make Alden's mailer transparent "would fly in the face of Alden's described use" and that "one skilled in the art would not contemplate a clear container for a mailer since it is well understood that a mailer would be opaque so not to disclose the contents thereof during shipping "(Appeal Br. 4). Appellant further argues that making Alden's container, disclosed for use as a mailer for magnetic recording tapes (Alden, col. 1, ll. 13-15), would destroy Alden, since "it is well known that magnetic tape should be protected from exposure to ultra-violet light"<sup>2</sup> (Reply Br. 2).

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<sup>2</sup> Appellant indicates that this assertion regarding protection of magnetic tapes from ultraviolet light "has been consistently maintained by applicant" and ignored by the Examiner (Reply Br. 2). After having reviewed the electronic record of this application, however, we cannot find any earlier instance of this assertion.

Alden discloses a mailer comprising a container 11 with a cover 12 connected to the container by a hinge 13. The container 11 and cover 12 are provided with latching parts consisting of two recesses 15 on the container and cooperating detents 16 on the cover. (Alden, col. 2, ll. 52-63.) Alden's cover 12 comprises a large sidewall<sup>3</sup> 21 including a central depressed rectangular panel 22 discontinued at extreme corners of the rectangle along diagonal lines 23. The sidewall 21 also includes vertically displaced, thin flat retaining flanges 24 substantially coextensive with the discontinued portions of the rectangle of panel 22. An address card 20 is inserted into the spacing between the depressed sidewall 21 and retaining flanges 24. A raised rim 25 provides a rectangular border around sidewall 21 inside which the address card 20 is typically safe from snagging. (Alden, col. 3, ll. 6-31.) The retaining flanges permit the address card to be non-adhesively and thus removably secured to the cover so that the mailer can be used in hundreds or more mail shipments without the problem of adhesive address labels building up and eventually requiring removal (Alden, col. 1, ll. 14-15 and 35-55). Alden teaches a flexible plastic, such as isotactic polypropylene (Alden, col. 3, ll. 37-40), as the material for the mailer. Alden is silent as to transparency or opacity of the mailer.

Perrin and Hobbs evidence that it was well known at the time of Appellant's invention to make containers transparent to permit the contents thereof to be seen without opening the container (Perrin, col. 4, ll. 16-19 and Hobbs, col. 2, ll. 10-15). Neither Perrin nor Hobbs is specifically directed to a mailer, much less a mailer for magnetic tapes.

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<sup>3</sup> As illustrated in Figs. 1 and 2, Alden's "sidewall 21" in fact appears to be what would conventionally be considered the top surface of the cover.

The Examiner's position that, because Perrin's business card holder is capable of being mailed, it is appropriate to consider it a "mailer" (Answer 7) is not well taken. Appellant's argument that it would not have been obvious to combine Alden with Hobbs because Hobbs is not from Appellant's field of endeavor (Appeal Br. 6), however, is unsound. The combinability of Alden with either Perrin or Hobbs does not turn on whether Perrin or Hobbs is a "mailer" or whether either of them is from Appellant's field of endeavor.

While there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007).

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

*Id.*, at 1740, 82 USPQ2d at 1396. We must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. *Id.*

Further, when the improvement is technology-independent and the combination of references results in a product or process that is more desirable, an implicit motivation to combine exists even absent any hint of suggestion in the references themselves. “In such situations, the proper question is whether the ordinary artisan possesses knowledge and skills rendering him *capable* of combining the prior art references.” *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1368, 80 USPQ2d 1641, 1651 (Fed. Cir. 2006).

Perrin and Hobbs establish that the use of transparency for containers for the purpose of permitting the contents of the container to be seen whether the container is open or closed was known at the time of Appellant’s invention. The advantage of transparency is both notorious and technology-independent. One of ordinary skill in the art at the time of Appellant’s invention would have readily appreciated that transparency of Alden’s mailer container and cover would likewise permit the contents of the container to be seen without opening the container. Further, with increased concerns about security in the mailing and shipping industries over the past decade or so, one of ordinary skill in the art would have recognized that transparency would permit postal and security inspectors to inspect the contents of a mailer without having to open the mailer, thereby rendering the mailer easier to use and less susceptible to mutilation by well-meaning inspectors. *See Leapfrog Enterprises, Inc. v. Fisher Price, Inc.*, 485 F.3d 1157, 1162, 82 USPQ2d 1687, 1691 (Fed. Cir. 2007) (“[O]ne of ordinary skill in the art . . . would have found it obvious to combine the Bevan device with the SSR to update it using modern electronic components in order to gain the commonly understood benefits of such adaptation, such as

decreased size, increased reliability, simplified operation, and reduced cost.”)

Appellant’s argument that making Alden’s mailer transparent would render it unsuitable for its intended function, namely, shipping magnetic tapes, because magnetic tapes must be protected from ultraviolet light, is not persuasive. First, Appellant has not presented any evidence to support the assertion that it is well known that magnetic tapes must be protected from ultraviolet light. Appellant's attorney’s arguments in a brief cannot take the place of evidence. *In re Pearson*, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974). Further, even assuming Appellant is correct that the magnetic tapes discussed by Alden must be protected from ultraviolet light, Appellant has not asserted, much less proven, that selection of a suitable material for Alden’s mailer which is both transparent for purposes of permitting viewing therethrough and possessed of ultraviolet light shielding characteristics would have been beyond the skill of one of ordinary skill in the art at the time of Appellant’s invention.<sup>4</sup>

For the reasons set forth above, we conclude that Appellant has failed to demonstrate the Examiner erred in determining that it would have been obvious to modify Alden’s mailer to make it transparent. Accordingly, we sustain rejection (1) as to claims 1-9, 11, 13, 14, and 21. Appellant’s only argument with respect to rejection (2) is that Masoud does not overcome the deficiencies of the combination of Alden with Perrin or Hobbs (Appeal Br. 7). Having found Appellant’s arguments as to the deficiencies of this

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<sup>4</sup> We note, in this regard, that ultraviolet light-filtering transparent plastics for use in eyeglasses, for example, are notoriously well known.

combination themselves deficient in demonstrating error on the part of the Examiner, we sustain rejection (2) as well.

With respect to rejection (1) as to claim 23, Appellant merely argues that “the Examiner has completely failed to point out where the elements of method claim 23 are found in the combination of Alden with Perrin or Hobbs” (Appeal Br. 7). The Examiner responds to this argument by pointing out that “the only method step [of claim 23] is to distribute to the recipient a clear plastic container filled with small objects that are visible without opening the container” and proceeding to clarify where the elements of that step are found in Alden (Answer 9). To the extent that Appellant’s arguments that the Examiner has ignored the claim requirements of small objects present in the container and a business card secured to the container and that the Examiner has not shown where the step of distributing to a recipient is found in the prior art (Reply Br. 4) apply to rejection (1), such arguments are not persuasive for the reasons that follow. Rejection (1) is sustained as to claim 23.

The Examiner has addressed the “small objects” limitation from two angles. First, the Examiner points out that “the business cards within the container are considered small objects” (Answer 9). While this may be true, it overlooks the fact that Alden does not teach filling the container with business cards. Although Perrin teaches a container filled with business cards, the Examiner has not made a determination that it would have been obvious to combine that teaching of Perrin with Alden by placing business cards, rather than a magnetic tape, in Alden’s mailer. The Examiner’s alternative position, however, is well taken. The Examiner’s alternative position is that, “[m]oreover, Alden discussed providing mailers for small

reels or cartridges, which are the small object as claimed” (Answer 9). Alden teaches storage of plural objects or “reels” in the mailer (Alden, col. 2, ll. 57-58). Appellant has not explicitly defined the term “small” in the Specification. We therefore give the term its ordinary and customary meaning and, in so doing, we find the magnetic tape reels discussed by Alden to be “small.”

As for the limitation of a business card being secured to the container, Alden discloses an address card 20 non-adhesively secured to the cover 12. An address card is a card having contact information, such as a name and address, printed thereon and is thus a “business card.” Furthermore, the printed contents of the claimed “business card” cannot distinguish the invention from the prior art in terms of patentability. *See In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not patentably distinguish the invention from the prior art.)

Alden also discloses use of the disclosed container for mail shipments of the magnetic tapes therein and, as such, meets the step of distributing, in the sense of giving out or delivering (*see Webster’s Third New International Dictionary, Unabridged* 660 (G &C Merriam Co. 1961), the container with the magnetic reels contained therein to the recipient.

Rejection (3) is also sustained. As evidenced by Schoberg, textured surfaces on the base and lid of data cartridge cases “for aesthetic appeal if desired” was well known in the art at the time of Appellant’s invention (Schoberg, col. 3, ll. 66-68). Appellant argues that the aesthetic texturing described on the base and lid of Schoberg is on the outer surfaces of base 18 and lid 30 (Appeal Br. 8), but Schoberg does not so limit the description.

One of ordinary skill in the art at the time of Appellant's invention would have recognized that the use of texturing for aesthetic appeal would improve Alden's mailer in the same way as Schoberg and, further, would have been fully capable of applying such texturing on any desired surface of Alden's mailer with predictable results. Accordingly, the use of texturing on any surface, including an inner surface of container 11, amounts to nothing more than the predictable use of prior art elements according to their established functions and thus would have been obvious.

#### Rejections (4) and (5)

In rejecting claims 1-4, 6, 7, 13, 14, 21, and 23, the Examiner starts with the receptacle of Danielson, disclosed for containing small totable products, such as compact batteries, vitamins, pharmaceuticals, keys, etc. (Danielson, col. 1, ll. 14-20) and determines that it would have been obvious to provide card securing means, of the type taught by Alden, on the outside of the receptacle and to make the receptacle transparent to permit the products contained inside to be viewed without opening the receptacle (Answer 4-5 and 11). Appellant argues that the references provide no suggestion to include card securing means on Danielson's receptacle (Appeal Br. 9) or suggestion to make Danielson's receptacle transparent (Appeal Br. 9-10). Accordingly, the issue presented with respect to rejection (4) is whether Appellant has demonstrated the Examiner erred in determining these modifications would have been obvious to one of ordinary skill in the art.

As noted above, while there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness, a specific teaching or suggestion for the modification need not be expressly

found in the references, as we “can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l.*, 127 S.Ct. at 1741, 82 USPQ2d at 1396. As noted by the Examiner (Answer 11), Alden evidences that a label or card may be secured on the exterior surface of a container for shipping or for identification. We further point out, as discussed above, that Alden teaches that providing a non-adhesive securement of the identification/address label offers the advantage that the container can be used hundreds of times or more without the problem of adhesive labels building up and eventually requiring removal (Alden, col., ll. 14-15 and 35-55). One of ordinary skill in the art at the time of Appellant’s invention would have appreciated, first, that a non-adhesive, reusable label system identifying the owner or recipient of the small totable products, such as vitamins or pharmaceuticals, or the identity of the products themselves, to prevent a mixup with the vitamins or drugs of others, would be desirable and, further, that such a label system as taught by Alden could be easily implemented on Danielson’s container to permit subsequent use by other owners or recipients or for different items or drugs for subsequent illnesses with predictable results. We therefore conclude that providing card securing means on the receptacle of Danielson is nothing more than the predictable use of prior art elements according to their established functions and, thus, would have been obvious to one of ordinary skill in the art.

As for making Danielson’s receptacle transparent, Perrin and Hobbs establish that the use of transparency for containers for the purpose of permitting the contents of the container to be seen whether the container is open or closed was known at the time of Appellant’s invention. The advantage of transparency is both notorious and technology-independent.

One of ordinary skill in the art at the time of Appellant's invention would have readily appreciated that transparency of Danielson's receptacle would likewise permit the contents of the container to be seen without opening the container, thereby permitting the user to easily inventory the contents and thus making the receptacle easier to use.

In light of the above, Appellant's arguments do not demonstrate error on the part of the Examiner in determining that it would have been obvious to provide a plurality of card securing members on Danielson's receptacle and to make Danielson's receptacle transparent. Rejection (4) is sustained as to claims 1-4, 6, 7, 13, 14, and 21.

With respect to rejection (4) as to claim 23, Appellant additionally argues that the Examiner ignores the limitation in claim 23 that the container is filled with small objects (Reply Br. 4) and that the Examiner has failed to show where a step of distributing to a recipient is found in the prior art (Reply Br. 4). The first of these arguments is belied by Danielson's express disclosure of use of the receptacle for small totable products (Danielson, col. 1, ll. 17-20). While the step of distributing a receptacle to a recipient is not likewise expressly taught by Danielson, the preparation of a receptacle with vitamins or pharmaceuticals in it, by a caregiver, parent or guardian, for example, for another (the user) and distribution of such receptacle to such user (the recipient) is a readily foreseeable use of Danielson's receptacle and thus would have been obvious to one of ordinary skill in the art. Rejection (4) is sustained as to claim 23.

Our discussion above with respect to rejection (3) applies equally to rejection (5). For the same reasons, we sustain rejection (5). Specifically, the improvement of texturing for aesthetic purposes is technology-

independent and would similarly improve a receptacle for holding small totable objects, such as the one disclosed by Danielson.

#### Rejections (6) and (7)

The issue to be decided with respect to rejection (6) is whether Appellant has demonstrated the Examiner erred in determining it would have been obvious to provide a plurality of card securing members on Masoud's business card holder (Appeal Br. 12). The Examiner contends it would have been obvious to provide card securing members, as taught by Alden, if not for mailing, then for identification purposes (Answer 13).

We find no express teaching in either Masoud or Alden of the use of Alden's card securing members (depressed panel 22 and retaining flanges 24) on a business card holder for mailing or identification purposes. As discussed above, however, while there must be some articulated rationale to support the legal conclusion of obviousness, a specific teaching or suggestion for the modification need not be expressly found in the references. Rather, we can take account of the inferences and creative steps that a person of ordinary skill in the art would employ. We start with the presumption that one of ordinary skill in the art of business cards and business card holders and distribution would have been aware of the common commercial practice of customers ordering business cards imprinted with personalized information and manufacturers shipping or mailing such cards, along with any accessories therefore, to the customer. Against such background, the concept of securing a mailing label or address card to a surface of the card holder of Masoud to associate it with the customer for whom it was intended in preparation for shipping the business

cards and card holder to the customer would not have been a great leap for one of ordinary skill in the art.<sup>5</sup> Moreover,

[c]ommon sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle. . . . A person of ordinary skill is also a person of ordinary creativity, not an automaton.

*KSR Int'l.*, 127 S.Ct. at 1742, 82 USPQ2d at 1397. In this instance, it would have been readily apparent to one of ordinary skill in the art that a personalized card, such as a business card or non-adhesive address label system, as taught by Alden, would have other obvious uses beyond its primary (disclosed) purpose as a mailing label and that one such use would be identification of the recipient or owner of the container on which the card is secured or identification of the contents therein. Moreover, the implementation of a non-adhesive card label system of the type taught by Alden on Masoud's container would have involved merely providing a depressed panel and retaining flanges on the lid 102 of Masoud's card holder and, thus, would not have been beyond the capabilities of one of ordinary skill in the art. In light of the above, we conclude that the modification of Masoud's card holder to provide a plurality of card securing members on the lid thereof is merely a predictable variation of Masoud's card holder.

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<sup>5</sup> In this regard, we take official notice of the practice of attaching one copy of the prepared business cards to the container delivered to the customer to both associate the container with the customer and to permit immediate inspection of the business card by the customer for accuracy.

Consequently, Appellant's argument does not demonstrate the Examiner erred in determining that such a modification would have been obvious. Rejection (6) is sustained as to claims 1-11, 13, 14, and 21.

With respect to rejection (6) as to claim 23, Appellant further argues that "[t]he Examiner has not set forth with the required particularity how the elements of the method claim are met by the combination of [the applied references]" (Appeal Br. 12-13). The Examiner has explained how the elements of the method step are met (Answer 12) and Appellant has not specifically challenged that position. Appellant thus has failed to demonstrate Examiner error in rejection (6) as applied to claim 23. The rejection is sustained.

Finally, our discussion above with respect to rejection (5) applies likewise to rejection (7). Specifically, the improvement of texturing for aesthetic purposes is technology-independent and would similarly improve a business card holder, such as the one disclosed by Masoud. Rejection (7) is sustained.

Appeal 2007-1593  
Application 10/462,972

SUMMARY

The decision of the Examiner to reject claims 1-11, 13, 14, and 21-23 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

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