

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte
WILL L. CULPEPPER

Appeal 2008-3830
Application 10/962,382
Technology Center 3700

Decided: October 10, 2008

Before DEMETRA J. MILLS, RICHARD M. LEBOVITZ, and JEFFREY
N. FREDMAN, *Administrative Patent Judges*.

FREDMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a composite carton for use in a packaging machine which the Examiner has rejected as anticipated and obvious. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

Background

“Substantially tubular-shaped cartons (also called sleeve-type cartons) are often used for packaging multiples of articles such as beverage cans or bottles” (Spec. 1). The Specification notes that “[s]uch cartons are often packaged in a continuous-motion packaging machine wherein a continuous stream of articles such as beverage cans is loaded into one or more ends of a continuous stream of open-ended cartons” (Spec. 1).

Statement of the Case

The Claims

Claims 7-20 are on appeal. We will focus on claims 7 and 10, which are representative and read as follows:

7. A composite carton for use in a packaging machine comprising flight bars having a pitch, the composite carton comprising:
a first individual carton comprising an open end having a first width:
a second individual carton comprising an open end having a second width,

wherein the first carton and the second carton are detachably affixed to one another, so that the combined width of the first width of the open end of the first carton and second width of the open end of the second carton is equal to the pitch of flight bars and so that said detachably affixed first carton and second carton are collapsible as if a single carton.

10. The composite carton of claim 7, wherein the first width of the open end of the first carton is different from the second width of the open end of the second carton.

The prior art

The Examiner relies on the following prior art references to show unpatentability:

Rockefeller	US 3,252,646	May 24, 1966
Smith et al	US 3,447,733	Jun. 3, 1969

Gosling	US 3,677,458	Jul. 18, 1972
Yamaguchi	US 4,101,034	Jul. 18, 1978

The issues

The rejections as presented by the Examiner are as follows:

- A. Claims 7-9, 14-16, and 18 stand rejected under 35 U.S.C. § 102(b), as being anticipated by Gosling (Ans. 3).
- B. Claims 7-9, 14-16, and 18 stand rejected under 35 U.S.C. § 102(b), as being anticipated by Rockefeller (Ans. 3).
- C. Claims 7-9, 11, and 14-18 stand rejected under 35 U.S.C. § 102(b), as being anticipated by Smith (Ans. 3).
- D. Claims 10, 12, 13, 19, and 20 stand rejected under 35 U.S.C. § 103(a), as being obvious over Gosling, Rockefeller, Smith, and Yamaguchi (Ans. 4).

A. 35 U.S.C. § 102(b) rejection over Gosling

The Appellant argues that

Gosling does not disclose individual first and second cartons or a plurality of individual cartons detachably affixed to one another. Gosling discloses “a pair of article holding compartments joined to a common panel” in contrast to applicant's individual first and second cartons or plurality of individual cartons detachably affixed to one another.

(App. Br. 9.) Appellant then contends that the “distinction between the disclosure of Gosling and the claimed subject matter of the present invention is further demonstrated by the fact that the carton of the present invention provides the flexibility to package pre-existing, individual cartons of varying sizes on a machine set to a predetermined pitch P” (App. Br. 9).

The Examiner responds that the “claiming of ‘individual’ cartons as part of a composite carton does not limit the composite carton to initially

being formed from two separate cartons” (Ans. 5). The Examiner argues that the Gosling carton is an “‘individual’ carton[] insofar as . . . the structure of a carton [is] individual to itself. Whether they are initially separate or not is not considered to affect whether they are ‘individual’ or not within the composite carton being claimed” (*id.* at 5).

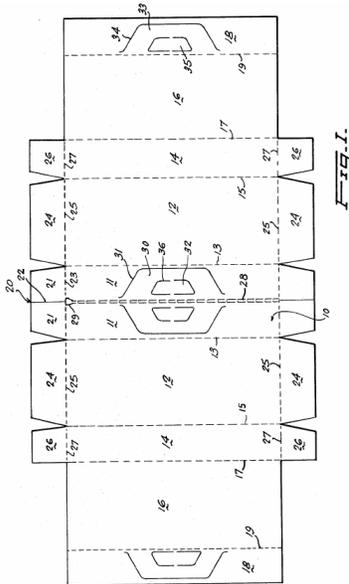
In view of these conflicting positions, we frame the anticipation issue before us as follows:

Does Gosling teach a composite carton with two cartons each having an open end with a width which are detachably affixed to one another?

Findings of Fact (FF)

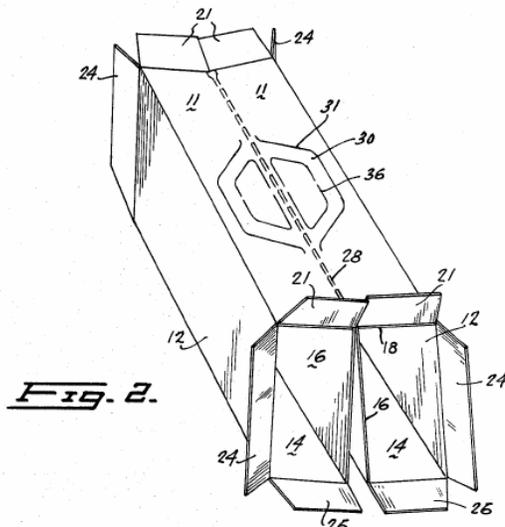
1. Gosling teaches a “twin carton which is adapted to be separated into two cartons. Essentially the carton of the invention consists of a pair of article holding compartments joined to a common panel” (Gosling, col. 1, ll. 39-42).

2. Gosling teaches that “the carton can be formed from a blank cut from a foldable sheet material” (Gosling, col. 2, ll. 15-16). Gosling shows the blank, in Figure 1, where the first and second carton are collapsed as if a single carton (Gosling, Fig. 1). Figure 1 is reproduced below.



“FIG. 1 is a plan view showing the inside face of a foldable blank from which a twin carton is formed” (Gosling, col. 2, ll. 32-33).

3. Gosling discloses the cartons in Figure 2, reproduced below, which show a first carton comprising an open end with a first width and a second carton comprising an open end with a second width.



“FIG. 2 is a perspective view of the carton erected for loading bottles through an open end thereof” (Gosling, col. 2, ll. 34-35).

4. Gosling teaches that “[i]f the retailer has a demand only for half a carton, he simply removes the tear-strip **28** by pulling the tab **29** leaving two smaller cartons as shown in **FIG. 4**” (Gosling, col. 3, ll. 26-28).

5. Gosling teaches that the first and second carton are detachably affixed to one another, where the “end flaps hold the two compartments firmly together while they are still joined by the common panel, but each flap will readily split along its line of weakness when the carton is being split into two sections” (Gosling, col. 1, ll. 53-57).

A. Discussion of 35 U.S.C. § 102(b) over Gosling

Gosling teaches a composite carton with a first and second individual carton which comprises open ends having widths (FF 1, 3). Gosling teaches that the cartons are detachably affixed to one another (FF 4-5). Gosling teaches that the cartons can be collapsed as if a single carton (FF 2).

In analyzing claim 7, our mandate is to give claims their broadest reasonable interpretation. *See, e.g., In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000) (“[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.”).

Appellant’s Specification does not define the term “detachably affixed”. Therefore, we reasonably interpret the claim using the ordinary meaning of the phrase “detachably affixed” as any attachment between the two cartons which may be detached. We find that Gosling clearly teaches two cartons which are “detachably affixed” to one another (FF 4-5).

We are not persuaded by Appellant’s argument that “the Gosling invention discloses a different structure that does not provide the advantages of the present invention” (App. Br. 9). However, the claims lack any

particular structural elements which differentiate the cartons of Gosling from those claimed. *See In re Omeprazole Patent Litigation*, 483 F.3d 1364, 1372 (Fed. Cir. 2007) (“Absent some clear intent to the contrary, this court does not import examples from the specification into the claims.”)

We also do not find that Appellant’s argument differentiates Gosling because “the carton of the present invention provides the flexibility to package pre-existing, individual cartons of varying sizes on a machine set to a predetermined pitch P” (App. Br. 9). This argument relies upon the intended use of the carton “in a packaging machine comprising flight bars having a pitch” (*see* Claim 7). In *Sullivan*, the “applicant conceded that his composition was distinguished from the composition disclosed in a prior art patent only by the statement of intended use. Our predecessor court held that that intended use for the known composition could not render the claim patentable”. *In re Sullivan*, 498 F.3d 1345, 1353 (Fed. Cir. 2007). Here, the only difference between the carton of Gosling and that of claim 7 is the intended use, which *Sullivan* states does not render the claim patentable. Further, we agree with the Examiner that the Gosling carton “is clearly capable of being used with flight bars in a packaging machine where the flight bars are appropriately sized to the composite carton. The claims are not limited to any particular size of flight bars and do not set forth any size which would define over the size of the carton” (Ans. 5).

We affirm the rejection of claim 7 as anticipated by Gosling. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 8, 9, 14-16, and 18 as these claims were not argued separately.

B. 35 U.S.C. § 102(b) rejection over Rockefeller

The Examiner argues that “Rockefeller disclose[s] a composite carton formed by first and second individual cartons (see . . . figs. 4 and 5 in Rockefeller). The cartons are detachably affixed to one another via the perforations (. . . 50 in Rockefeller)” (Ans. 3). The Examiner further contends that “[t]he cartons in . . . Rockefeller are ‘individual’ cartons insofar as they each include all the structure of a carton individual to itself. Whether they are initially separate or not is not considered to affect whether they are ‘individual’ or not within the composite carton being claimed” (Ans. 5).

Appellant argues that “Rockefeller discloses a body which is a shell that receives sleeves that define rectangular unit cells. Rockefeller does not disclose elements that are the equivalent of applicant's individual cartons detachably affixed to one another” (App. Br. 10). Appellant further contends that “Rockefeller teaches that each sleeve of that invention has its outer side wall adhered to the side of the shell-like container body 30” (*id.*).

In view of these conflicting positions, we frame the anticipation issue before us as follows:

Does Rockefeller teach a composite carton with two cartons each having an open end with a width which are detachably affixed to one another?

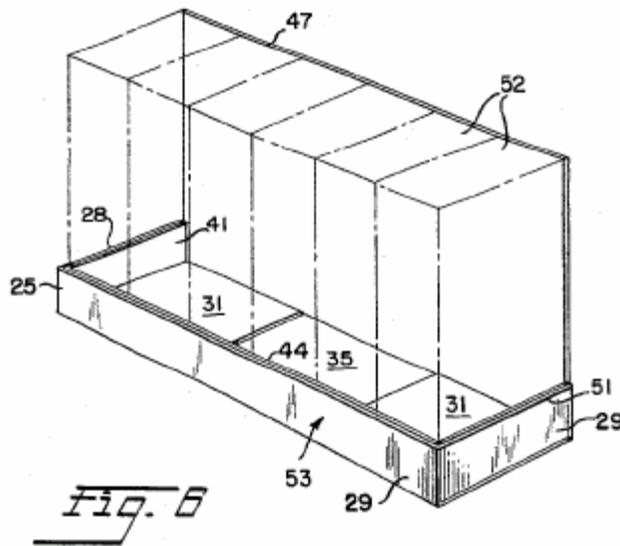
Findings of Fact

6. Rockefeller teaches “a novel shipping container assembly having such internal structure . . . that it may be cut away for display of the product, or it may be subdivided into individual units each capable of being cut away for display of the product” (Rockefeller, col. 1, ll. 14-19).

7. Rockefeller teaches that the container “is preferably fabricated for flat-folded shipment in collapsed condition” (Rockefeller, col. 2, ll. 1-2).

8. Rockefeller teaches, regarding Fig. 6, that the “container assembly **21** may be speedily subdivided into two complete container units each closed and capable of retaining the boxes in place as for shelf storage or further handling, by cutting through the vertical plane containing score lines **50** and seams **48**” (Rockefeller, col. 3, ll. 3-7).

9. Rockefeller discloses the cartons in Fig. 6 which is reproduced below.

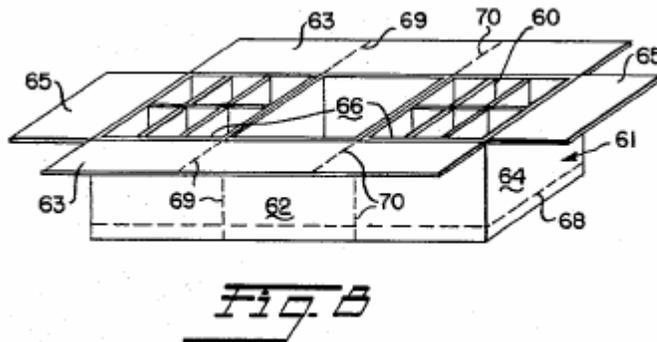


“FIGURE 6 is a substantially perspective view showing a subdivided container assembly unit with the upper portion removed for display” (Rockefeller, col. 1, ll. 52-54).

10. Rockefeller teaches that the “container assembly may be speedily subdivided into two complete container units each closed and capable of retaining the boxes in place as for shelf storage or further

handling, by cutting through the vertical plane containing score lines **50** and seams **48**” (Rockefeller, col. 3, ll. 3-7).

11. Rockefeller teaches a container with individual cartons having a first and second width as shown in Fig. 8, reproduced below.



“FIGURE 8 is a generally perspective view showing the container assembly of FIGURE 7 ready for filling and closing” (Rockefeller, col. 1, ll. 58-60).

B. Discussion of 35 U.S.C. § 102(b) over Rockefeller

Rockefeller teaches a carton with subdivisions which is collapsible as if a single carton (FF 6-9). Rockefeller further teaches the “detachably affixed” requirement by teaching that the “container assembly **21** may be speedily subdivided into two complete container units each closed and capable of retaining the boxes in place for shelf storage or further handling, by cutting through the vertical plane containing score lines **50** and seams **48**” (Rockefeller, col. 3, ll. 3-7; FF 8). Rockefeller also teaches the open ends with a first and second width (FF 11). We agree with the Examiner that Rockefeller anticipates claim 7.

We are not persuaded by Appellant’s argument that “Rockefeller does not disclose elements that are the equivalent of applicant's individual cartons

detachably affixed to one another” (App. Br. 10). As we discussed *supra*, Appellant’s Specification does not define “detachably affixed”. In our opinion, the statement by Rockefeller that the “container assembly may be speedily subdivided into two complete container units each closed and capable of retaining the boxes in place as for shelf storage” (Rockefeller, col. 3, ll. 3-5) is reasonably interpreted as satisfying the “detachably affixed” requirement, since the two units in Fig. 5 are attached to one another by the container and then capable of being separated as shown in Fig. 6 (FF 10). *See, e.g., In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000) (“During examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.”).

We also do not find persuasive Appellant’s argument that “the carton of the present invention as claimed is distinct from Rockefeller for the reasons discussed above and it is the structural distinction that enables it to be used in machines with flight bars having a pitch P” (App. Br. 10). This argument relies upon the intended use of the carton “in a packaging machine comprising flight bars having a pitch” (*see* Claim 7). *See In re Sullivan*, 498 F.3d 1345, 1353 (Fed. Cir. 2007). Further, we agree with the Examiner that the Rockefeller carton “is clearly capable of being used with flight bars in a packaging machine where the flight bars are appropriately sized to the composite carton. The claims are not limited to any particular size of flight bars and do not set forth any size which would define over the size of the carton” (Ans. 5).

We affirm the rejection of claim 7 as anticipated by Rockefeller. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 8, 9, 14-16, and 18 as these claims were not argued separately.

C. 35 U.S.C. § 102(b) rejection over Smith

The Examiner contends that “Smith et al discloses a composite carton formed by first and second individual cartons (see fig. 2) which are detachably affixed to one another by the spots of adhesive 149. The composite carton is capable of being collapsed by releasing the end flaps and subsequently rotating the sleeve body panels” (Ans. 3-4). The Examiner further argues that “the composite carton clearly has the capability of collapsing in the manner as specified in the [Gosling] Grounds of Rejection above. It is noted that the claims do not indicate any particular manner of collapsibility” (*id.* at 5).

Appellant argues “Smith/Nelson¹ does not disclose a key feature of applicant's invention, namely, structure that makes possible the collapsibility of the composite carton as if a single collapsible carton” (App. Br. 11). Appellant further contends that “[w]hat is key is that Smith/Nelson teaches the joining of individual structures 111, 113 wherein each module/container section/modular container section is inherently incapable of being collapsed by itself. In turn, the conjoined structure is inherently incapable of being collapsed. Thus, Smith/Nelson does not in any way disclose a collapsible composite carton” (App. Br. 11).

¹ Appellant here is referring to the Smith patent, US 3,447,733, that is the basis of the rejection.

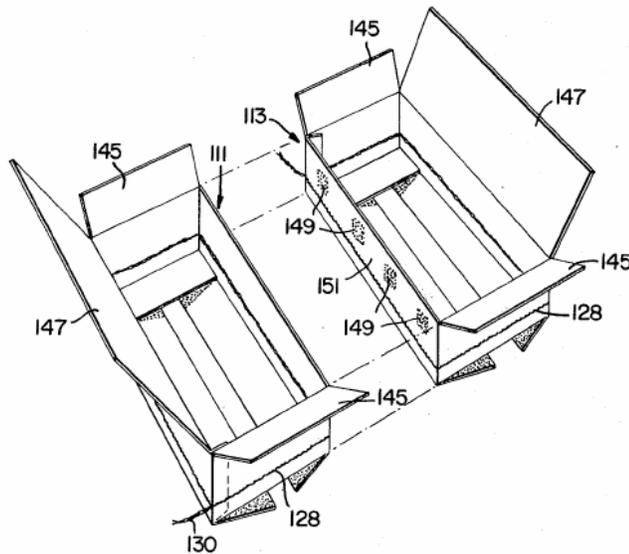
In view of these conflicting positions, we frame the anticipation issue before us as follows:

Does Smith teach a composite carton where the first and second cartons are collapsible as if a single carton?

Findings of Fact

12. Smith teaches “a pair of adhesively or otherwise removably interconnected container sections each having a ripcord to permit opening of the section when the sections have been separated from each other “(Smith, col. 1, ll. 30-34).

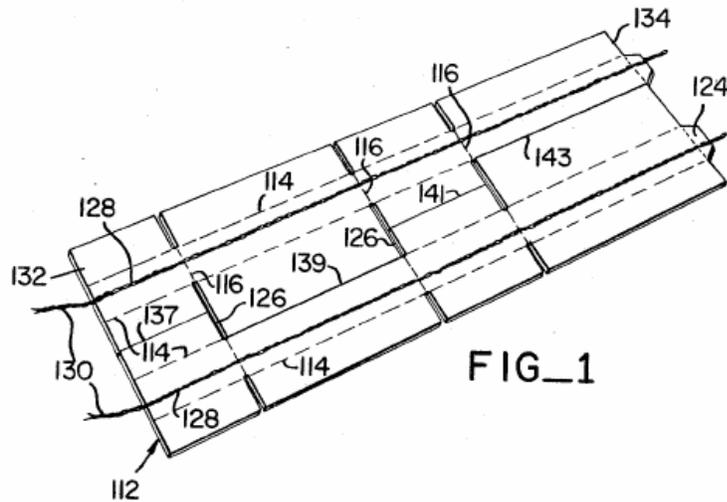
13. Smith discloses both cartons comprising open ends with a first and second width as shown in Fig. 2, reproduced below.



FIG_2

“FIG. 2 is a perspective view of a pair of shipping case modules formed by the blank of FIG. 1” (Smith, col. 2, ll. 27-28).

14. Smith teaches the collapsed blank for forming the first and second carton as shown in Fig. 1, reproduced below.



“FIG. 1 is a perspective view of a blank for forming the shipping case of this invention” (Smith, col. 2, ll. 25-26).

C. Discussion of 35 U.S.C. § 102(b) over Smith

Smith teaches a “detachably affixed” pair of cartons which have a first and second width (FF 12-13). Smith further teaches that the cartons, prior to assembly, are collapsible as if a single carton (FF 14).

We are not persuaded by Appellant’s argument that “Smith/Nelson does not disclose a key feature of applicant's invention, namely, structure that makes possible the collapsibility of the composite carton as if a single collapsible carton” (App. Br. 11). In fact, as shown in Fig. 1 reproduced above, the Smith carton begins as a collapsed single carton (FF 14). This interpretation is consistent with Appellant’s Specification, which states “the cartons are detachably affixed to one another in collapsed condition such that the composite collapsed carton formed thereby has dimensions substantially similar to a single carton loadable on the machine” (Spec. 3:15-17). This quotation from Appellant’s Specification is reasonably interpreted so that the term “collapsible as if a single carton” encompasses the cartons

prior to assembly. Since Smith teaches that the cartons may be collapsed together prior to assembly, we conclude that Smith teaches the limitation at issue. *See, e.g., In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000) (“[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.”).

We affirm the rejection of claim 7 as anticipated by Smith. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 8, 9, 11, and 14-18, as these claims were not argued separately.

D. 35 U.S.C. § 103(a) rejection over Gosling, Rockefeller, Smith, and Yamaguchi

Appellant argues regarding Gosling, Rockefeller, Smith that “[e]ach of these references is inapplicable at least in part for the reasons discussed above with reference to their ineffectiveness as the bases for a 102(b) rejection” (App. Br. 13). Appellant further contends that the “Office Actions do not point to portions of Gosling, Rockefeller or Smith et al and Yamaguchi that would indicate that the combination of references would provide a reasonable expectation of success in achieving the present invention” (App. Br. 14). Appellant also argues that the teaching, suggestion or motivation test (*see* App. Br. 14).

We have already determined that Gosling, Rockefeller, and Smith anticipate claim 7 as analyzed *supra* and therefore teach the limitations of claim 7. The obviousness case rests on whether a person of ordinary skill in the art would have considered it obvious to modify the cartons of Gosling, Rockefeller, and Smith to have cartons of different widths as taught by Yamaguchi (“The packing box is formed as a single box provided with

sectioned boxes of the same or different capacities” (Yamaguchi, col. 2, ll. 46-48)).

We conclude that the Examiner has set forth a prima facie case that claim 10 would have been obvious to the ordinary artisan in view of Gosling, Rockefeller, Smith, and Yamaguchi. In *KSR*, the Supreme Court indicated that “[w]hen 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.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007). In the instant case, using boxes of different sizes as taught by Yamaguchi would have been a predictable variation of the boxes of Gosling, Rockefeller or Smith.

We disagree with Appellant’s argument regarding reasonable expectation of success. Yamaguchi discloses cartons of different sizes (Yamaguchi, col. 2, ll. 46-48) and Gosling, Rockefeller, and Smith all teach cartons of the same size joined together. We conclude that the ordinary artisan would have had a reasonable expectation of success. *See In re O’Farrell*, 853 F.2d 894, 903-04, (Fed. Cir. 1988) (“Obviousness does not require absolute predictability of success. . . . For obviousness under § 103, all that is required is a reasonable expectation of success.”)

We affirm the rejection of claims 10 as obvious over Gosling, Rockefeller, Smith, and Yamaguchi. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 12, 13, 19, and 20, as these claims were not argued separately.

CONCLUSION

In summary, we affirm the rejection of claim 7 as anticipated by either Gosling or Rockefeller. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 8, 9, 14-16, and 18 as these claims were not argued separately.

We affirm the rejection of claim 7 as anticipated by Smith. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 8, 9, 11, and 14-18, as these claims were not argued separately.

We affirm the rejection of claims 10 as obvious over Gosling, Rockefeller, Smith, and Yamaguchi. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 12, 13, 19, and 20, as these claims were not argued separately.

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

AFFIRMED

cdc

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