

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* CRAIG N. WILSON and THOMAS McGRAIN

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Appeal 2008-4772  
Application 10/985,842  
Technology Center 3700

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Decided: December 22, 2008

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Before TONI R. SCHEINER, RICHARD M. LEOVITZ, and  
FRANCISCO C. PRATS, *Administrative Patent Judges*.

LEOVITZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-12.  
Jurisdiction is under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

The claims are drawn to a container for liquids which comprises an  
outer shell and a rigid inner container. A handle is on the outer shell.  
According to the Specification:

the use of a rigid inner container to contain the fluid to be dispensed overcomes problems associated with the use of a flexible bag-type inner container. Such flexible, bag-type containers are more susceptible to puncture, leaking and bursting. The flexible, bag-type containers can be difficult to fill completely and/or to pour liquid from due to their being susceptible to the creation of vacuums within the bag.

(Spec. 6: 3-8).

The claims stand rejected by the Examiner as follows:

Claims 1-12 under 35 U.S.C. § 103(a) as obvious in view of Andrews (US 5,909,841, Jun. 8, 1999), and either of Johnson (US 5,765,711, Jun. 16, 1998) or Winstead (US 3,042,271, Jul. 3, 1962)(Ans. 3); and

Claims 1-12 under 35 U.S.C. § 103(a) as obvious in view of Andrews, Bartlett (US 6,877,654 B2, Apr. 12, 2005), and either of Johnson, Winstead, or Humphries (US 4,901,878, Feb. 20, 1990)(Ans. 4).

Claim 1 is representative of the claimed subject matter. As claims 2-12 were not argued separately, they stand or fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii). Claim 1 reads as follows:

1. A container for liquids, comprising:

an outer shell having a top, a bottom and sidewalls, the outer shell having an opening in one of said sidewalls;

a rigid inner container within said outer shell defining an aperture;

a mouth secured to said inner container surrounding said aperture and defining a fluid passageway, said mouth sized and shaped such that fluid can be poured through said mouth from a source having an outlet spaced above said mouth; and

a handle extending outward from said top of said outer shell, said handle having sufficient strength to provide essentially all support for said container when said inner container is filled with liquid in a first position wherein said opening is facing upwards and in a second position wherein

said opening is facing sideways, one of said sidewalls facing downward in said first position and the bottom facing downward in said second position.

#### PRINCIPLES OF LAW

“During [patent] examination, the examiner bears the initial burden of establishing a prima facie case of obviousness.” *In re Kumar*, 418 F.3d 1361, 1366 (Fed. Cir. 2005).

In making an obviousness determination, [o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. *See In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). As our precedents make clear, however, 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.

...

Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

*KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-1741 (2007).

A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be

discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. The degree of teaching away will of course depend on the particular facts; in general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant.

. . .

Gurley's position appears to be that a reference that "teaches away" can not serve to create a prima facie case of obviousness. We agree that this is a useful general rule. However, such a rule can not be adopted in the abstract, for it may not be applicable in all factual circumstances. Although a reference that teaches away is a significant factor to be considered in determining unobviousness, the nature of the teaching is highly relevant, and must be weighed in substance.

*In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

Appellants first argue that the Board's finding of a motivation to combine lacks substantial evidence because the Board failed to demonstrate that the characteristics . . . are preferred over other alternatives disclosed in the prior art. This argument fails because our case law does not require that a particular combination must be the preferred, or the most desirable, combination described in the prior art in order to provide motivation for the current invention. "[T]he question is whether there is something in the prior art as a whole to suggest the *desirability*, and thus the obviousness, of making the combination," not whether there is something in the prior art as a whole to suggest that the combination is the *most desirable* combination available. *See In re Beattie*, 974 F.2d at 1311 (internal quotation omitted; emphasis added). . . . [A] finding that the prior art as a whole suggests the desirability of a particular combination need not be supported by a finding that the prior art suggests that the combination claimed by the patent applicant is the preferred, or most desirable, combination.

*In re Fulton*, 391 F.3d 1195, 1200 (Fed. Cir. 2004).

## OBVIOUSNESS OVER ANDREWS AND JOHNSON OR WINSTED

### Issue

The issue in this rejection is as follows: Would it have been obvious to the ordinary skilled worker to have placed a handle on the outer shell of a liquid container which encases a rigid inner receptacle for liquid as in claim 1?

### Findings of Fact (FF)

1. Appellants do not dispute the Examiner's findings that the Andrews patent describes a container for liquids comprising an outer shell and a handles extending from the outer shell which meets all the limitations of the corresponding outer shell recited in claim 1.
2. The container described by Andrews has a "flexible bag" within the outer shell to hold liquid (Andrews, Abstract; at col. 1, l. 64 to col. 2, l. 26), not a "rigid inner container" as recited in claim 1 (Ans. 4).
3. The Examiner ascertained that it was known in the art to construct an inner container for liquid from a rigid material (Ans. 5). This finding is supported by the preponderance of the evidence as follows:
4. The Johnson patent describes a composite package comprising a paperboard container and an inner preformed receptacle positioned within the container (Johnson, Abstract). The receptacle has a handle 56 which fits through the top of the paperboard container (Johnson, at col. 4, ll. 40-42).
5. Johnson states that the inner receptacle can be made from metal, metal alloys, and glass (Johnson, at col. 5, ll. 53-62), materials which would have been recognized by persons of skill in the art as rigid.

6. Winstead describes an inner container for liquid which can be inserted into an outer carton (Winstead, at col. 5, ll. 69-73).

7. The inner container described in Winstead can be made from “a rigid plastic” (Winstead, at col. 2, ll. 51-53) having “self-sustaining rigidity” (*id.* at col. 6, ll. 51-53).

8. The Examiner provided a reason that would have prompted persons of ordinary skill in the art to have replaced the flexible inner bag in Andrew’s liquid container with a rigid inner container as in claim 1. This reason, which is supported by the preponderance of the evidence, is as follows:

9.

It would have been obvious to substitute an inner rigid material container for the inner flexible container in Andrews, Sr. et al as taught by either Johnson et al or Winstead to provide better protection for the contents, to prevent leaks and to allow use and/or filling of the inner container outside of the box, i.e. to provide a freestanding inner container.

(Ans. 4.)

#### Analysis

Claim 1 is drawn to a container for liquids comprising an outer shell with a handle and a “rigid inner container within said outer shell.” The Andrews patent describes an outer shell which meets all the limitations of the claimed outer shell (FF1). Inside Andrews’ outer shell is an inner flexible bag for holding a liquid (FF2). The difference between the Andrews patent and the claimed invention is that the patent does not disclose a *rigid* container within the outer shell as required by claim 1. The Examiner’s position is that it would have been obvious to persons of ordinary skill in the art to have made the claimed invention by replacing the flexible bag in Andrews’s outer shell with a rigid container.

The Examiner has the burden of establishing prima facie obviousness of the claimed subject matter. *In re Kumar*, 418 F.3d at 1366. In this case, it is the Examiner's burden to produce evidence that the ordinary skilled worker would have had reason<sup>1</sup> to substitute Andrews's flexible inner bag with a rigid container. To satisfy this procedural duty, the Examiner ascertained that it was known in the art to construct an inner container for liquid from a rigid material (FF3-7). The Examiner then reasoned that persons of ordinary skill in the art would have been prompted to have utilized a rigid container in Andrews's outer shell "to provide better protection for the contents, to prevent leaks and to allow use and/or filling of the inner container outside of the box, i.e. to provide a freestanding inner container" (Ans. 4; *see* FF8-9). As the Examiner's position is well-reasoned and supported by the preponderance of the evidence, we conclude that prima facie obviousness of the claimed subject matter has been established.

Appellants contend that the Examiner erred because it would not have been obvious "to use a rigid container with the handle on the shell and not the rigid container" (App. Br. 6; Reply Br. 1-2). They assert that "all prior art containers place the handle on the most rigid part of the container" (*id.*). "For example, Johnson, et al. places the handle on the inner container, which is more rigid than the outer shell, and Andrews, Sr. et al. places the handle on the outer shell, which is more rigid than the flexible bag inner container" (*id.* at 6-7). The "cited references exhibit a clear pattern: when a reference

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<sup>1</sup> "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. at 1740-1741.

teaches a handle, it is placed on the most rigid component of the overall container” (Reply Br. 2). “The Examiner has not shown why it would be obvious to break from this pattern in favor of the claimed invention” (*id.*).

The Examiner’s case is based on the straightforward and logical reason that it would have been obvious to replace a flexible bag with a rigid container for the latter’s known advantages (FF9). Appellants have not disputed this reasoning. Prompted to make this change to Andrews’s liquid container, persons of ordinary skill in the art would have made a container with all the features of the claimed invention, including a handle on the outer shell. Even were it true that placing the handle on the inner container would have been preferred as asserted by Appellants, a “finding that the prior art as a whole suggests the desirability of a particular combination need not be supported by a finding that the prior art suggests that the combination claimed by the patent applicant is the preferred, or most desirable, combination.” *In re Fulton*, 391 F.3d at 1200. In other words, an invention may be suggested by the prior art and therefore obvious, even if inferior to alternatives that would be made by following other prior art suggestions.

#### Conclusion of Law

Based on the evidence of record, we conclude that it would have been obvious to the ordinary skilled worker to have made a liquid container having a rigid inner fluid receptacle encased in an outer shell with a handle extending from the outer shell. Thus, we affirm the rejection of claim 1. Claims 2-12 fall with claim 1 because separate reasons for their patentability were not provided. 37 C.F.R. § 41.37(c)(1)(vii).

OBVIOUSNESS OVER ANDREWS, BARTLETT, AND  
HUMPHRIES, JOHNSON OR WINSTEAD

Issue

Does Bartlett teach away from the claimed container comprising an outer shell and rigid inner container?

Findings of Fact

10. Bartlett describes a container comprising an outer shell and an inner liner (Bartlett, at col. 5, ll. 15-16).

11. The inner container is semi-rigid and “has the characteristics that when pulled into its rectangular shape it has sufficient strength to stand without collapsing” (Bartlett, at col. 5, ll. 60-62).

Analysis

The Examiner’s reasoning that claim 1 is unpatentable is the same as in the previous rejection, i.e., that it would have been obvious to have used a rigid material for the inner container instead of a flexible bag (Ans. 4-5). Bartlett appears to have been cited for teaching the desirability of using a more rigid material than taught by Andrews – one that collapses upon folding, but still retains the advantages of providing strength and protection for the liquid contents as taught in Johnson, Winstead, and others (*id.* at 6; FF11).

Appellants contend that the Examiner erred “because Bartlett, teaching a semi-rigid inner container, teaches away from using a rigid container” (App. Br. 8).

As a general principle, a “teaching away” from a claimed invention must be considered when making an obviousness determination. *See In re Gurley*, 27 F.3d at 553. “[I]n general, a reference will teach away if it

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suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." *Id.* In this case, Bartlett does not teach or suggest that a rigid material would be inoperable as a liquid container. Thus, we do not consider Appellants' argument persuasive.

#### Conclusion of Law

Bartlett does not teach away from the claimed container comprising an outer shell and rigid inner container. We affirm the rejection of claim 1. Claims 2-12 fall with claim 1 because separate reasons for their patentability were not provided. 37 C.F.R. § 41.37(c)(1)(vii).

#### TIME PERIOD

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

AFFIRMED

Ssc:

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