

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte GREGORY K. WILLIAMS and SEAN A. BRADY

---

Appeal No. 1998-1647  
Application 08/668,503<sup>1</sup>

---

HEARD: December 7, 1999

---

Before FRANKFORT, STAAB and GONZALES, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 25-28, 30, 31, 33, 34, 44 and 45. Claims

---

<sup>1</sup> Application for patent filed July 2, 1996. According to appellants, the application is a continuation of Application 08/252,125, filed June 1, 1994, now abandoned; which is a continuation of Application 08/050,942, filed April 21, 1993, now abandoned.

Appeal No. 1998-1647  
Application 08/668,503

29, 32, 35-43, 46 and 47, the only other claims remaining in the

application, have been withdrawn from further consideration under 37 CFR § 1.142(b) as not being readable on the elected invention.<sup>2</sup> We reverse.

By way of background, the appealed subject matter in the present application is related to the appealed subject matter in Appeal No. 1997-4002 in appellants' copending application 08/459,880, which appeal is decided currently herewith.

Appellants' invention pertains to a patch bag, that is, a bag having a patch applied to one of its surfaces to increase its resistance to puncture. As explained on page 1 of appellants' specification, the invention is designed for the packaging of bone-in cuts of meat. In this environment, the patch prevents or reduces the likelihood that a bone will completely puncture or rupture the bag and patch combination. According to appellants, the edge portion of the bag is particularly vulnerable to puncture in the packaging of

---

<sup>2</sup>The requirement for election was made in Paper No. 6 of parent application 08/252,125.

certain cuts of bone-in meat. Accordingly, an objective of appellants' invention is to provide a patch bag wherein the patch "may fold around the edge of the

bag in [its] lay flat position" (specification, page 5) to provide increased protection against puncture at this location. Appellants disclose on pages 8-10 of the specification a method of making a patch bag having a patch that folds around an edge of the bag.<sup>3</sup> This method may be used to make end-seal patch bags (see Figure 3) wherein the end of the bag is sealed and a patch 8 folds around a side edge of the bag. The disclosed method may also be used to make side-seal bags (see Figure 4) where the sides of the bag are sealed and a patch 8 folds around a bottom end of the bag. The appealed claims of the present application are directed to an end-seal bag, i.e., a bag of the type illustrated in Figure 3. Independent claim 25, a copy of which is found in an

---

<sup>3</sup>Said method is the subject of appellants' U.S. Patent 5,540,646, based on application 08/407,793, a division of application 08/050,942. The '942 application is the grandparent of the present application.

Appeal No. 1998-1647  
Application 08/668,503

appendix to the brief, is illustrative of the appealed subject matter.

The references of record relied upon by the examiner in support of a rejection under 35 U.S.C. § 103 are:

Kuehne	4,534,984	Aug. 13, 1985
Ferguson	4,765,857	Aug. 23, 1988

Claims 25-28, 30, 31, 33, 34, 44 and 45 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ferguson in view of Kuehne.

The rejection is explained in the examiner's answer (Paper No. 27, mailed October 2, 1997).

The opposing viewpoints of appellants are set forth in the brief (Paper No. 26, filed August 27, 1997) and the "reply brief" (Paper No. 29, filed December 4, 1997).<sup>4</sup>

---

<sup>4</sup> With respect to appellants' "reply brief," the following quote from M.P.E.P § 1208.03 is noted:

Amendments, affidavits, and/or other evidence must be submitted in papers separate from the reply brief, and the entry of such papers is subject to the provisions of 37 CFR 1.116 and 37 CFR 1.195. A paper that contains an amendment (or evidence) is not a reply brief within the meaning of 37 CFR

Independent claim 25 calls for an end-seal bag having a patch "covering at least a segment of at least one member selected from the group consisting of the first side edge and the second side edge" of the bag. Claim 44, the only other independent claim on appeal, contains identical language. The examiner concedes that Ferguson does not meet this claim limitation ("Ferguson's patches do not cover at least a segment of a side edge." (answer, page 3)). However, the examiner directs our attention to column 3, lines 30-35, of

---

1.193(b). Such paper will not be entitled to entry simply because it is characterized as a reply brief.

Since appellants' Paper No. 29, styled "Reply Brief Under 37 CFR 1.193," inappropriately includes evidence of nonobviousness in the form of three declarations under 37 CFR 1.132, it is not a reply brief within the meaning of 37 CFR 1.193(b) and therefore was not entitled to entry as a matter of right. Notwithstanding the above, the examiner entered appellants' "reply brief" (see Paper No. 30, mailed December 19, 1997). However, in so doing, the examiner inappropriately failed to discuss the impact of the three attached declarations, which presumably were also entered since they were included as an integral part of Paper No. 29. While the above circumstances would normally necessitate a remand to the examiner for the purpose of having him state on the record why the declarations do not overcome the standing § 103 rejection, in this particular instance the examiner's views with respect to said declarations are moot in that we do not consider that a *prima facie* case of obviousness of the claimed subject matter has been established.

Appeal No. 1998-1647  
Application 08/668,503

Ferguson wherein the dimensions of the patch 8 and the bag 12 are disclosed. The examiner observes that Ferguson's patch comes within  $\frac{1}{4}$ " of a side edge of the bag, such that there would be a maximum of  $\frac{1}{4}$ " of uncovered bag material between the patch and a side edge. The examiner considers that

[i]t would have been . . . obvious [to one of ordinary skill in the art] to extend Ferguson's patches  $\frac{1}{4}$  of an inch to cover at least a segment of one or more side edges because doing so is simply a matter of degree and results in the protection of the bag material up to and including at least one side edge of the bag. [Answer, page 3.]

In responding to appellants' argument, the examiner further states that the claimed subject matter would have been obvious because "it is clear that a patch can be adhered to Ferguson's bag in any desired location" (answer, page 4). Further insight into the examiner's rationale in rejecting the claims is found in the final rejection (Paper No. 22), wherein the examiner states that

workers skilled in the food packaging art must be presumed to know something about packaging bone-in cuts of meat apart from what Ferguson and Kuehne disclose. Providing Ferguson's patches with an additional  $\frac{1}{4}$  inch of material along each of their side edges to provide protection all of the way to

Appeal No. 1998-1647  
Application 08/668,503

the side edges of the bag would simply have been obvious to an artisan, given that Ferguson is already providing protection for 17½ inches of the bag walls for the same reason. [Final rejection, page 3.]

We have carefully reviewed the appealed claims, appellants' specification, the applied references, and the respective viewpoints of appellants and the examiner. As a consequence of our review, we conclude that the standing § 103 rejection is not sustainable.

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). In making such

a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *Id.*

We fully appreciate that in Ferguson, the patch 8 is sized such that it covers and protects a substantial portion

Appeal No. 1998-1647  
Application 08/668,503

of one or both sides of a flattened, lay-flat bag (column 3, lines 6-10). While Ferguson's patch 8 approaches the edges of the bag in its flattened lay-flat position, it is clear that it does not in any sense cover an edge of the lay-flat bag. Concerning Kuehne, the examiner does not contend, and it is not apparent to us, that this reference makes up for the above noted deficiency in Ferguson. Thus, we conclude that the examiner has failed to advance any factual basis to support his conclusion that it would have been obvious to one of ordinary skill in the art to modify Ferguson in the manner proposed. The mere fact that Ferguson's patch could be extended up to or past a side edge of the bag does not suffice. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (the circumstance that the prior art *could*

be modified to meet a claim would not have made the modification obvious unless the prior art suggested the desirability of the modification). Here, neither Ferguson nor

Appeal No. 1998-1647  
Application 08/668,503

Kuehne contains a suggestion for the modification proposed by the examiner.<sup>5</sup>

Furthermore, Ferguson provides no guidance whatsoever as to how the patch is applied to the bag. Hence, even if the patch of Ferguson were extended up to or past a side edge of the bag as proposed by the examiner, it is not apparent to us that the extended patch would necessarily "cover" at least a segment of that side's edge, as called for in each of the independent claims on appeal. Stated differently, even if the proposed modification of Ferguson were to be made, it is not clear to us that the claimed subject matter would result, the examiner's view to the contrary notwithstanding.

---

<sup>5</sup> In this regard, the examiner's reliance on case law such as *In re Shepard*, 319 F.2d 194, 138 USPQ 148 (CCPA 1963); *In re Jacoby*, 309 F.2d 513, 135 USPQ 317 (CCPA 1962); and *In re Bozek*, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969) to fill this gap in the evidentiary basis for the rejection is not sufficient.

Appeal No. 1998-1647  
Application 08/668,503

In light of the above, we will not sustain the standing  
35 U.S.C. § 103 rejection of claims 25-28, 30, 31, 33, 34, 44  
and 45 as being unpatentable over Ferguson in view of Kuehne.

The decision of the examiner is reversed.

*REVERSED*

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JOHN F. GONZALES	)	
Administrative Patent Judge	)	

Appeal No. 1998-1647  
Application 08/668,503

LJS/pgg  
Rupert B. Hurley Jr.  
100 Rogers Bridge Road  
Post Office Box 464  
Duncan, SC 29334