

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

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN R. NOTTINGHAM, JOHN W. SPIRK, JR.
and DALE PANASEWICZ

Appeal No. 1998-2314
Application No. 07/902,957

ON BRIEF

Before COHEN, ABRAMS, and BAHR, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 15, 16, 18, 19, 26-32 and 36-40.

We REVERSE.

BACKGROUND

The appellants' invention relates to a microwave popcorn package comprising container panels bonded together at their edges and so configured and graphically illustrated as to resemble, when inflated by the action of making the popcorn, an animate object, a recognizable character or article, or an animal . An understanding of the invention can be derived from a reading of exemplary claims 1 and 37, which appear in the appendix to the Brief.

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

Stoner	1,348,761	Aug. 3, 1920
Hirtzler	1,715,757	Jun. 4, 1929
Walker	2,082,671	Jun. 1, 1937
Clark <u>et al.</u> (Clark)	2,516,552	Jul. 25, 1950
Miller	2,698,496	Jan. 4, 1955
Panzer	3,442,043	May 6, 1969
Reese	3,835,308	Sep.10, 1974
Brandberg <u>et al.</u> (Brandberg '045)	3,973,045	Aug. 3, 1976
Brandberg <u>et al.</u> (Brandberg '425)	4,038,425	Jul. 26, 1977
Roccaforte <u>et al.</u> (Roccaforte)	4,453,665	Jun. 12, 1984
Bohrer <u>et al.</u> (Bohrer)	4,678,882	Jul. 7, 1987
Winter	4,716,061	Dec. 29, 1987
Watkins <u>et al.</u> (Watkins)	4,735,513	Apr. 5, 1988
Larson	4,865,854	Sep. 12, 1989
Mendenhall <u>et al.</u> (Mendenhall)	4,874,620	Oct. 17, 1989
Ylvisaker	4,892,744	Jan. 9, 1990
Burkes	Des. 161,734	Jan. 30, 1951

The following rejections stand under 35 U.S.C. § 103:

- (1) Claims 1, 15, 16, 18, 19, 26, 36 and 37 on the basis of Brandberg '045 in view of Roccaforte, Mendenhall, Ylvisaker, Winter, Hirtzler, Reese, Burkes, Clark, Miller, Panzer, Stoner and Walker.
- (2) Claims 27 and 29-31 on the basis of the references applied against claim 1 et al. taken further in view of Brandberg '425.
- (3) Claims 28 and 38 on the basis of the references applied against claim 27 et al. taken further in view of Watkins and Bohrer.
- (4) Claims 25 and 32 on the basis of the references applied against claim 1 et al. taken further in view of Larson.
- (5) Claims 39 and 40 on the basis of the references applied against claim 38 taken further in view of Larson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (Paper No. 26) for the examiner's complete reasoning in support of the rejections, and to the Corrected Appeal Brief (Paper No. 23) for the appellants' arguments thereagainst.

OPINION

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

All of the rejections are under Section 103. The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

The objective of the appellants' invention is to provide an entertainment medium by utilizing the radiant energy environment of the cooking chamber of a microwave oven to cause food such as popcorn to self-inflate the containers in which it is cooked into a shape that simulates an article such as an animate object, a recognizable character or article, or an animal. In furtherance of this objective, independent claims 1 and 15 recite, in somewhat different terms, an inflatable container and a mass of unpopped popcorn in the container. The inflatable container is pre-formed so as to be substantially fully inflatable into a predetermined three-dimensional external shape by inflation gas generated in the

container, with the external shape being “other than in the form of a bag or envelope and simulating the external configuration of an animate object.” The inflatable container also has “graphic material on the exterior thereof . . . combining with said three-dimensional shape to visually detail the animate object,” and comprises a pair of flexible panels preformed to the predetermined three-dimensional external shape of the animate object,¹ with at least one of the panels having the graphic material.

These claims stand rejected on the basis of the following rationale: The examiner points out that Brandberg '045 discloses a microwave popcorn package comprising an inflatable container and a mass of unpopped popcorn in the container which will generate an inflation gas when popped, which results in the creation of a particular three-dimensional external shape, and various other shapes for inflated microwave popcorn containers are known in the art, as illustrated by Roccaforte, Mendenhall, Ylvisaker and Winter. The examiner then asserts “[i]t is well established in the packaging art to shape and/or design a container so that the container simulates a recognizable object other than the container itself,” and “[t]o impart to any container any shape one desires through conventional shaping, cutting, and the use of graphic design for its esthetic/entertainment appeal is therefore seen to have been an obvious matter of design” (Answer, page 5). On

¹We note an apparent inconsistency in claim 1, in that while the three-dimensional shape is “of an animate object” in lines 12, 15 and 19, it is referred to as “the recognizable character or article” in line 21. This is worthy of correction .

the basis of the foregoing, the examiner concludes that it would have been obvious to modify the Bandberg '045 container to a shape and with a graphic design that imparts "a character simulation." Cited in support of this theory are Hirtzler (container of cardboard shaped like a baseball for candy or coin), Reese (lamp covering that can be inflated to simulate a character such as Santa Claus), Burkes, Clark and Miller (inflatable toys such as Santa Claus and animals), Panzer (paper bag with face image operated by the user's hand), and Stoner and Walker (wrappings for candy). Finally, the examiner opinion that the prior art is replete with many arrangements of panels for forming microwave popcorn containers.

Neither Brandberg '045, the primary reference nor, for that matter, any other of the applied prior art references, discloses a container in which the cooking of a food substance therein causes the container to expand into the three-dimensional representation of an animate object, much less disclosing a microwave popcorn container that does so, and none teaches that graphics be placed on the outside of such a container to combine with the three-dimensional shape in the representation. It is axiomatic that the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The examiner has provided no evidence in support of his conclusion that the presence of containers having three-

dimensional representations of animate objects or characters in other fields would have motivated one of ordinary skill in the art to modify the inflatable popcorn container of Brandberg '045 in such a manner as to meet the terms of claims 1 and 15. We fail to perceive any teaching, suggestion or incentive in the applied references which would have led one of ordinary skill in the art to do so. From our perspective, the only suggestion for modifying the microwave popcorn container of Brandberg '045 in the manner proposed by the examiner is found in the hindsight afforded one who first viewed the appellants' disclosure. This, of course, is not a proper basis for a rejection under Section 103. In re Fritch, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

It therefore is our conclusion that the combined teachings of the references applied against claims 1 and 15 fail to establish a prima facie case of obviousness with regard to the subject matter recited therein. This being the case, we will not sustain the rejection of independent claims 1 and 15 or, it follows, of dependent claims 16, 18 and 19.

Independent claim 26 recites essentially the same subject matter as claims 1 and 15, except for specifying that the three-dimensional external shape be "a recognizable character or article other than a bag or envelope." The same rejection as was made against claim 1 is applied against this claim, and it fails for the same reason as was explained above with regard to claim 1. The rejection of claim 26 is not sustained.

Claims 36 and 37 recite a microwave popcorn package comprising at least two flexible non-planar sheets of material cut and bonded together in a configuration which resembles a sports ball (claim 36) or an animal (claim 37) when inflated by gas generated by the microwave cooking of the popcorn. The examiner has rejected these claims on the same theory as the rejection of claims 1, 15 and 26, and the rejection fails on the basis of the same reasoning that we expressed above in refusing to sustain those rejections. The rejection of claims 36 and 37 is not sustained.

In rejecting claim 27, which depends from claim 26, and claims 29-31, which depend from claim 27, the examiner relies on the thirteen references applied against claim 26 taken further in view of Brandberg '425, which was cited for its teaching of a microwave popcorn package that includes a receptacle with a bottom and side walls. Be that as it may, Brandberg '425 does not overcome the problem of lack of suggestion to modify the bag of Brandberg '045 in the manner proposed by the examiner that we find to be present in the rejection of claim 26. This being the case, we will not sustain the rejection of claims 27 and 29-31.

We reach the same conclusion with regard to the rejection of claim 28, which depends from claim 27, wherein Watkins and Bohrer are added to the references cited against claim 1 et al. Claim 28 interposes a susceptor between the inner surface of the bottom wall of the receptacle and the mass of unpopped popcorn to transfer the

microwave energy to the popcorn. While Watkins and Bohrer teach the use of susceptors, neither of them alleviate the fundamental problem with the basic combination of references, and we will not sustain the rejection of claim 28.

Independent claim 38 recites a microwave popcorn package comprising, inter alia, artistic panels bonded together at their edges to form a sealed container having a three-dimensional appearance of an animal when inflated, a tray having a floor and walls bonded to the artistic panels, and susceptor material within the tray. Although it does not include the graphic material on the external shape, claim 38 requires that the shape be in the form of an animal, and it therefore is our view that the rejection suffers from the same lack of suggestion to modify Brandberg '045 that was explained above with regard to claim 1. This deficiency is not overcome by Watkins or Bohrer. The rejection of claim 38 is not sustained.

Claims 25 and 32 add to claims 16 and 26, respectively, gripping tabs for facilitating access to the popcorn in the container when it is fully inflated. Larson was added to the references cited against the independent claims from which claims 25 and 32 depend for its teaching of providing such tabs on microwave popcorn containers. Larson does not, however, overcome the problem in the basic combination of references, and therefore we shall not sustain the rejection of claims 25 and 32.

Larson also has been added to reject dependent claims 39 and 40, which are dependent from independent claim 38. On the basis of the reasoning set forth immediately above, the rejection of these claims is not sustained.

SUMMARY

None of the rejections are sustained.

The decision of the examiner is reversed.

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	
)	
)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

Appeal No. 1998-2314
Application No. 07/902,957

Page 11

NEA:pgg
CALFEE HALTER & GRISWOLD, LLP
800 SUPERIOR AVENUE
SUITE 1400
CLEVELAND , OH 44114

APPEAL NO. 1998-2314 - JUDGE ABRAMS
APPLICATION NO. 07/902,957

APJ ABRAMS

APJ COHEN

APJ BAHR

DECISION: **REVERSED**

Prepared By:

DRAFT TYPED: 17 Jul 02

FINAL TYPED: