

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JASON GOLDENBERG

Appeal No. 2005-1063
Application No. 10/126,910

ON BRIEF

Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to appellant's request for rehearing of our decision mailed June 24, 2005, wherein we affirmed the examiner's rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Jelling (U.S. 3,181,773) and Paulsen (U.S. 5,950,818). Claim 1 is the only claim pending in the application.

We have carefully considered each of the points of argument raised by appellant in the request for rehearing, however, those arguments do not persuade us that we overlooked or misapprehended any points raised in the appeal, or that our merits based

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determination on the patentability of claim 1 of the present application is in error.

Appellant's main point of argument appears to be that there is inadequate teaching, suggestion, or motivation for the combination of Jelling and Paulsen, because what is disclosed in Paulsen allegedly leads away from a combination with Jelling. We do not agree. The issue to be resolved is whether it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to add serial numbering to the disposable bags in each of the rolls (50, 52, 54) of Jelling so as to provide the user of Jelling's device with a means for ascertaining the number of bags used and/or remaining on each roll. As noted on pages 6 and 7 of our earlier decision, from the broad teachings in Paulsen of providing serial numbering on the bags of the roll therein "to designate the number of bags used and/or remaining in said dispenser" (col. 1, lines 13-15), we find adequate suggestion/motivation to utilize serial numbering on the bags in Jelling for the purpose of keeping track of the bags used and/or remaining on each roll. The fact that the number of bags on the roll in Paulsen is most likely smaller than that in Jelling and probably does not involve hundreds of bags is, in our opinion, irrelevant. The advantage to be gained in Jelling from utilizing

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a serial numbering scheme as broadly suggested in Paulsen would have been readily apparent to one of ordinary skill in the art and does not appear to depend on the particular number of bags contained on a roll.

As for appellant's belief that a combination of primary and secondary references requires not only a suggestion in the latter for the combination with the former, but also "that the suggestion requirement be reciprocal" (request, page 1). We know of no such requirement. In evaluating the propriety of an obviousness determination it is only necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination, or modification. It is a long-standing premise of patent law that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference, nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art at the time of appellant's invention. See, e.g., In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

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In this case, we have concluded that the combined teachings of the applied references would have suggested the subject matter of claim 1 on appeal to those of ordinary skill in the art at the time of appellant's invention.

In light of the foregoing, appellant's request is granted to the extent of reconsidering our decision mailed June 24, 2005, but is denied with respect to making any changes therein.

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

DENIED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

CEF/jrg

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