

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte SCOTT A. FATH  
and CLAUDETTE M. CALDER

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Appeal No. 2000-2039  
Application 09/176,608

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ON BRIEF

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Before FRANKFORT, MCQUADE, and NASE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Scott A. Fath et al. appeal from the final rejection of claims 1, 5 through 7 and 11 through 15, all of the claims pending in the application.

THE INVENTION

The invention relates to "a cigarette pack blank and the cigarette pack made therefrom" (specification, page 2).

Representative claim 1 reads as follows:

1. A blank for use in forming a container comprising a body forming portion and a lid forming portion, the body forming

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portion including a back panel integrally connected to a left side panel and a right side panel, and the lid forming portion including a back panel integrally connected to a left side panel and a right side panel, an integral horizontally disposed hinge line between the back panel of the body forming portion and the back panel of the lid forming portion, and diagonal cut lines one between the left side panels and the other between the right side panels, each cut line extending to the hinge line and including a single uncut portion about midway along its length in the range of .020 to .065 inches.

#### THE PRIOR ART

The items relied on by the examiner as evidence of obviousness are:

Gorton	3,078,030	Feb. 19, 1963
Focke et al. (Focke)	5,392,905	Feb. 28, 1995
Manservigi et al. (Manservigi)	5,823,331	Oct. 20, 1998

The prior art cigarette box blank shown in Figure 1 of the appellants' drawings and described on pages 5 through 7 of the appellants' specification (the admitted prior art)

#### THE REJECTIONS

Claims 1, 5 through 7, 11, 12 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gorton.

Claims 13 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gorton in view of Focke and Manservigi.

Claims 1, 5 through 7, 11, 12 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the admitted prior art in view of Gorton.

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Claims 13 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the admitted prior art in view of Gorton, Focke and Manservigi.

Attention is directed to the appellants' main and reply briefs (Paper Nos. 8 and 10) and to the examiner's answer (Paper No. 9) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

#### DISCUSSION

In the main brief, the appellants state that "[f]or purposes of this appeal claims 1, 5-7 and 11-15 may be considered together as a group" (page 4). In accordance with this statement, and consistent with the arguments advanced in both briefs, claims 5 through 7 and 11 through 15 shall stand or fall with representative claim 1.

As indicated above, claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gorton, and as being unpatentable over the admitted prior art in view of Gorton.

Gorton discloses a box having a reclosable top, e.g., a "flip-top" cigarette box. Figures 1 through 3 depict an embodiment comprising a main box portion 20 and a reclosable top portion 22 connected by a scored hinge line 24. When the box is initially formed, the top portion 22 and main box portion 20 are

also connected by a diagonal "cut" line of perforations 36, 36a extending along each side of the box to the hinge line 24. The uncut portions between the perforations break when the box is opened for the first time. Figures 4 through 7 show the single integral blank from which the box is formed.

The appellants do not challenge the examiner's implicit determination (see page 3 in the answer) that the Gorton box blank responds to all of the limitations in claim 1 except for that requiring each of the diagonal cut lines to include "a single uncut portion about midway along its length in the range of .020 to .065 inches."

The appellants also do not challenge the examiner's finding (see page 4 in the answer) that the admitted prior art box blank meets all but the same diagonal cut line limitation in claim 1. As shown and described, the admitted prior art cut lines 54, 56 do not include any uncut portions.

In rejecting claim 1, the examiner concludes (see pages 3 through 5 in the answer) that Gorton's disclosure of perforations 36, 36a would have suggested modifying each of the diagonal cut lines in either the Gorton box blank or the admitted prior art box blank to embody "a single uncut portion about midway along its length in the range of .020 to .065 inches" as required by

the claim. According to the examiner, such modification would merely be an optimum desired result of routine experimentation. The examiner is also of the view (see pages 5 and 6 in the answer) that since claim 1 is written in an open-ended "comprising" format,<sup>1</sup> it does not exclude the diagonal cut lines from having more than one uncut portion.

The appellants do not dispute that Gorton would have suggested providing the admitted prior art blank with diagonal cut lines of perforations to prevent the ensuing box from opening prematurely, or that Gorton would have suggested uncut portions in the range of .020 to .065 inches. The appellants do contend, however, that claim 1 is limited to a box blank having only one uncut portion in each diagonal cut line (see pages 1 and 2 in the reply brief). In this light, the appellants argue that Gorton fails to disclose or suggest the claimed invention because

[w]hile Gorton may accomplish similar results when compared to the present invention, the manner in which those results are accomplished is entirely different. Instead of a single uncut portion, Gorton utilizes perforated lines 36, 36a, each of which includes a significant plurality of uncut portions. Line 36 extends from the front of the recloseable [sic, reclosable] box to the rear of the box, and as such line 36 includes at least 8 or 9 uncut portions. The

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<sup>1</sup> The transitional term "comprising" leaves a claim open for the inclusion of unspecified elements. See Ex parte Davis, 80 USPQ 448 (Bd. App. 1948).

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effort required to initially open the recloseable [sic] box of Gorton is significantly more than the effort involved in opening the cigarette pack of the present invention, and the added effort is totally unnecessary. Additionally, more opportunity exists in the Gorton construction for mishaps to occur since separation must be accomplished at 8 or 9 locations along each cut line whereas only one such separation is required with the cigarette pack of the present invention. Lastly, breaking a single uncut portion requires substantially less time when compared to 8 or 9 uncut portions [main brief, pages 5 and 6].

Thus, the only alleged difference between the subject matter recited in claim 1 and the prior art which is argued by the appellants lies in the claim recitation that each cut line includes a single uncut portion about midway along its length.

The open-ended nature of claim 1 and the particular claim language involved support the examiner's interpretation that the recitation of the "single" uncut portion does not exclude each cut line from having other uncut portions, e.g., at points other than about midway along their lengths. Inasmuch as each of Gorton's lines of perforations 36, 36a undoubtedly includes a "single" uncut portion which is located about midway along its length, this reference, taken alone or in combination with the admitted prior art, would have suggested a box blank meeting the claim limitation at issue.

Moreover, even if claim 1 were limited to a box blank having only one uncut portion in each diagonal cut line, it is well

settled that the discovery of an optimum value of a variable in a known process is normally obvious, there being exceptions where the parameter optimized was not recognized as being a result-effective variable or where the results of optimizing the variable are unexpectedly good. In re Antonie, 559 F.2d 618, 620, 195 USPQ 6, 8-9 (CCPA 1977). In the instant case, one of ordinary skill in the art certainly would have appreciated, as a simple matter of common sense, that the number of uncut portions in a diagonal cut line of the sort disclosed by Gorton is a result-effective variable affecting the strength of the breakable connection between the main and reclosable top portions of the box, and that a lone uncut portion located about midway along the length of the diagonal cut line would reduce the effort and time required to initially open the box as compared with a plurality of uncut portions. The appellants have not advanced any evidence to the contrary. Hence, here again, Gorton, taken alone or in combination with the admitted prior art, would have suggested a box blank meeting the claim limitation at issue, even under the more restrictive interpretation urged by the appellants.<sup>2</sup>

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<sup>2</sup> We note with interest the presence in the record of U.S. Patent No. 5,575,386 to Focke et al. which discloses a cigarette box and blank having diagonal cut lines wherein each cut line has but two uncut portions, one (39) midway along the length of the cut line and the other (38) at the front end of the cut line.

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In light of the foregoing, the appellants' position on appeal as it applies to representative claim 1 is not persuasive. Therefore, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 1 as being unpatentable over Gorton and the standing 35 U.S.C. § 103(a) rejection of claim 1 as being unpatentable over the admitted prior art in view of Gorton.

Since claims 5 through 7 and 11 through 15 stand or fall with claim 1, we also shall sustain the standing 35 U.S.C. § 103(a) rejection of claims 5 through 7, 11, 12 and 15 as being unpatentable over Gorton, the standing 35 U.S.C. § 103(a) rejection of claims 13 and 14 as being unpatentable over Gorton in view of Focke and Manservigi, the standing 35 U.S.C. § 103(a) rejection of claims 5 through 7, 11, 12 and 15 as being unpatentable over the admitted prior art in view of Gorton, and the standing 35 U.S.C. § 103(a) rejection of claims 13 and 14 as being unpatentable over the admitted prior art in view of Gorton, Focke and Manservigi.

The decision of the examiner is affirmed.

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

AFFIRMED

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
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	)	APPEALS AND
JOHN P. MCQUADE	)	
Administrative Patent Judge	)	INTERFERENCES
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JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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