

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

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Appeal No. 2001-0557  
Application 09/376,548

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ON BRIEF

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Before COHEN, ABRAMS , and FRANKFORT, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-12, 14-18 and 20, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

### BACKGROUND

The appellants' invention relates to a package for an athletic glove (claims 1-10 and 20), to the combination of an athletic glove and a package (claims 11, 12 and 14-16), and to a method for maintaining an athletic glove (claims 17 and 18). An understanding of the invention can be derived from a reading of exemplary claims 1, 11 and 17, 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:

Marks	4,061,170	Dec. 6, 1977
Cavan	4,269,347	May 26, 1981
Schlaupitz <u>et al.</u> (Schlaupitz)	5,269,430	Dec. 14, 1993
Haarlander	5,718,336	Feb. 17, 1998

"Official Notice" of the conventional use of retention beads such as the ones in compact disk containers to hold information concerning the contents.

The following rejections stand under 35 U.S.C. § 103(a):<sup>1</sup>

- (1) Claims 1, 2, 5-10, 17 and 18 on the basis of Marks, Haarlander and Cavan.
- (2) Claims 3 and 4 on the basis of Marks, Haarlander, Cavan and Schlaupitz.
- (3) Claims 11, 12, 14 and 16 on the basis of Marks and Schlaupitz.
- (4) Claim 15 on the basis of Marks, Schlaupitz, Haarlander and Cavan.
- (5) Claim 20 on the basis of Marks, Haarlander, Cavan and Official Notice.

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<sup>1</sup>Rejections under 35 U.S.C. § 112, second paragraph, were withdrawn in the Answer.

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. 9) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 8) and Reply Brief (Paper No. 10) 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 standing rejections are under 35 U.S.C. § 103(a). A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art (see In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)). This is not to say, however, that the claimed invention must expressly be suggested in any one or all of the references, rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art (see, for example, Cable Elec. Prods. v. Genmark, 770 F.2d 1015, 1025, 226 USPQ 881, 886 (Fed. Cir. 1985)), considering that a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference (see In re Bozek, 416 F.2d 1385, 1390, 163

USPQ 545, 549 (CCPA 1969)). Insofar as the references themselves are concerned, we are bound to consider the disclosure of each for what it fairly teaches one of ordinary skill in the art, including not only the specific teachings, but also the inferences which one of ordinary skill in the art would reasonably have been expected to draw therefrom (see In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966) and In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968)).

(1)

Independent claim 1 stands rejected as being unpatentable over the combined teachings of Marks, Haarlander and Cavan. As manifested in claim 1, the appellant's inventive package for an athletic glove comprises, inter alia, a non-flaccid plastic body including a first body element joined to a second body element along a living hinge, with the second body element "being integrally formed with a relatively thinner window area bounded by a relatively thicker body area." It is the examiner's position that all of the subject matter recited in this claim is disclosed by Marks, except for the window, but the examiner is of the opinion that it would have been obvious to one of ordinary skill in the art to provide a window in the second body element in view of the teachings of Haarlander and Cavan. In this regard, the examiner opines that Haarlander's window is "on a container portion 22 which has a thinner area than the body area 44, 47," and Cavan suggests providing transparent windows that are flush with the exterior portion of the container, which would have motivated one of ordinary skill in the art to modify the Marks

glove container to meet these terms of the claim “to allow the container to be fabricated less expensively and [to] simplify mold design.” See Answer, pages 4 and 5. We do not agree.

Marks does not disclose a window. Haarlander discloses a window in a lunchbox for the purpose of allowing a display insert to be viewed. The Haarlander window is separate from the panel (40) that frames it, the supporting gasket (47), and the body element upon which it is mounted. Cavan discloses a carton in which a window is provided in one end to permit the contents of the carton to be viewed. While the outer window is flush with the outer surface of the carton, it is not integrally formed therewith.

From our perspective, the combined teachings of the three applied references would not have suggested the claimed second body element being integrally formed with a relatively thinner window area bounded by a relatively thicker body area. This being the case, a prima facie case of obviousness has not been established with regard to the subject matter recited in claim 1, and we will not sustain the rejection of claim 1 or, it follows, of claims 2 and 5-10, which depend therefrom.

We reach the opposite conclusion, however, with regard to independent method claim 17, which in the first step establishes a package made of non-flaccid plastic defining

a body being movable between an open configuration and a closed configuration, and goes on to present the window in terms of the step of

providing at least one relatively thinner portion of the body and a relatively thicker portion of the body, the thinner portion defining a window through which the glove can be viewed.

The appellant has not disputed the examiner's contention that all of the subject matter recited in this claim except for the window is disclosed by Marks. Cavan explicitly teaches providing a window in a panel of a carton body in order to permit the contents of the carton to be viewed from the outside (column 3, lines 14 and 15). The window disclosed by Cavan comprises a relatively thinner portion of the body which is surrounded by a thicker portion, and thus it meets the terms of claim 17, which does not require that the thinner and thicker portions be integrally formed, as was the case in claim 1. It is our opinion that Cavan would have motivated one of ordinary skill in the art to provide a window having the characteristics recited in claim 17 in one of the panels of the Marks athletic glove container. In addition, it seems to us that one of ordinary skill in virtually any art would have found it obvious to provide a window in a container for the self evident advantages of doing so, of which a most profound one

clearly would be to determine what is inside without opening the container, for skill is presumed on the part of the artisan, rather than the lack thereof. In re Sovish, 769 F.2d

738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

Thus, from our perspective, the teachings of the applied references establish a prima facie case of obviousness with regard to the subject matter of independent claim 17, and we therefore will sustain the rejection of this claim. We also will sustain the rejection of dependent claim 18, the patentability of which was not separately argued before the Board.

The appellants' argument that the rejection was improper because Cavan is not analogous art we find not to be persuasive. The test for analogous art is first whether the art is within the field of the inventor's endeavor and, if not, whether it is reasonably pertinent to the problem with which the inventor was involved. See In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). A reference is reasonably pertinent if, even though it may be in a different field of endeavor, it logically would have commended itself to an inventor's attention in considering his problem because of the matter with which it deals. See In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992). It is our view that the Cavan reference would have commended itself to the attention of one of ordinary skill in the art of packaging who wished to solve the problem of determining what was inside a package and what its appearance was without opening the package.

(2)

Claims 3 and 4, which depend from claim 1, stand rejected on the basis of the references applied against claim 1 considered further with Schlaupitz, which was cited for

its teaching of providing finger holds projecting outwardly from body elements to facilitate moving the elements between open and closed configurations. Be that as it may, Schlaupitz does not overcome the shortcoming discussed above with regard to the three references applied against claim 1, and therefore we also will not sustain the rejection of claims 3 and 4.

(3)

Marks and Schlaupitz have been applied against independent claim 11, which is directed to the combination of an athletic glove and a package for the glove. The package is recited as defining an interior holding the glove, the package being formed with plural holes for ventilating the glove and including a plastic body having a first body element joined to a second body element. The claim further sets out “a first finger hold made integrally with the first body element and a second finger hold made integrally with the second body element.” Marks discloses a package for an athletic glove which comprises a body having joined first and second elements in which there are holes for ventilation. The package is closed by “[a]ppropriate closure means . . . such as Velcro strips coacting with one another, a zipper, or snaps” (column 2, lines 5 and 6). We agree with the examiner that one of ordinary skill would have found it obvious to equip each of the body elements of Marks with a finger hold made integrally therewith, in view of the explicit teaching of Schlaupitz that such will provide assistance in the opening and closing of the body elements (column 5, line 10 et seq.). In response to the appellant’s argument that the

rejection is not based upon “actual evidence,” we point out that the suggestion provided by Schlaupitz is clearly articulated in the specification which, of course, is evidence of the state of the art at the time of the appellant’s invention. Moreover, we take note of the fact that Marks discloses flanges (unnumbered) extending outwardly around the edges of each of the body elements and integral therewith, which inherently would function as finger holds.

Thus, we conclude that the teachings of Marks and Schlaupitz establish a prima facie case of obviousness with regard to the subject matter of claim 11, and we will sustain this rejection. The patentability of dependent claims 12, 14 and 16 has not separately been argued before the Board, and therefore the rejection of these claims also is sustained.

(4)

Dependent claim 15 adds to independent claim 11, through claims 12 and 14, the requirement that “the second body element is integrally formed with a relatively thinner window area bounded by a relatively thicker body area.” The claim stands rejected on the basis of the same references applied against claim 1, taken further with Schlaupitz. When we evaluated the patentability of claim 1, we decided that this construction of the window area was not rendered obvious by the combined teachings of Marks, Haarlander and Cavan. Consideration of Schlaupitz does not alter this conclusion.

The rejection of claim 15 is not sustained on the basis of the same reasoning we

expressed with regard to claim 1.

(5)

Finally, claim 20, which depends from claim 1, stands rejected as being unpatentable over Marks, Haarlander and Cavan, which were applied against claim 1, plus the examiner's taking of "Official Notice" that the use of retention beads to retain a printed card or paper in a package is well known. Even if the latter assertion on the part of the examiner were considered to be the case, it does not alter the fact that the three other references together fail to render the subject matter of claim 1 obvious.

The rejection of claim 20 is not sustained.

#### SUMMARY

The rejection of claims 1, 2 and 5-10 on the basis of Marks, Haarlander and Cavan is not sustained.

The rejection of claims 17 and 18 on the basis of Marks, Haarlander and Cavan is sustained.

The rejection of claims 3 and 4 on the basis of Marks, Haarlander, Cavan and Schlaupitz is not sustained.

The rejection of claims 11, 12, 14 and 16 on the basis of Marks and Schlaupitz is sustained.

The rejection of claim 15 on the basis of Marks, Schlaupitz, Haarlander and Cavan is not sustained.

The rejection of claim 20 on the basis of Marks, Haarlander, Cavan and Official Notice is not sustained.

The decision of the examiner is affirmed-in-part.

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

AFFIRMED-IN-PART

IRWIN CHARLES COHEN  
Administrative Patent Judge

NEAL E. ABRAMS  
Administrative Patent Judge

CHARLES E. FRANKFORT  
Administrative Patent Judge

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