Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ALAN W. WHITTEMORE and RICHARD J. PONZO

Appeal No. 2001-2229
Application No. 09/346,226

ON BRIEF

Before FRANKFORT, McQUADE and BAHR, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Alan W. Whittemore et al. appeal from the final rejection of claims 1, 6, 8 and 16, all of the claims pending in the application.

THE INVENTION

The invention relates to “shrink wrap gift bags configured, arranged and manufactured for standard gift boxes

so that upon the application of heat from a conventional hair dryer, or similar heat source, the packaging neatly conforms to the box configuration and results in an aesthetically appealing outer wrapping" (specification, page 1).

Representative claim 1 reads as follows:

1. A heat shrinkable gift bag comprising:

a monolithic sheet of heat shrinkable opaque, polyvinyl chloride film,

said sheet of heat shrinkable film having a gauge thickness of about 90 gauge,

said sheet of heat shrinkable film having a balanced shrink ratio in x and y orientations of said film to provide a uniform and consistent shrink profile upon the application of heat thereto,

said sheet of film having an activated shrink temperature of about 140EF,

said sheet of heat shrinkable film having inner and outer surfaces,

said sheet of heat shrinkable film having a decorative pattern printed on said outside surface,

said heat shrinkable film being formed into a side-weld bag wherein said inner surface of said plastic film is folded over on itself along a transverse line to define a rear bag panel and a front bag panel, said front bag panel being shorter than said rear bag panel to thereby form an extended lip, said front and rear bag panels being welded along opposing side edges thereof to thereby provide a closed bottom end, closed side edges and an open top end forming a mouth of said heat shrinkable gift bag; and

a self-adhesive strip disposed on said extended lip for use in closing the mouth of the bag.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Rosenblatt et al. (Rosenblatt)	3,483,965	Dec. 16, 1969
Watanabe	3,512,457	May 19, 1970
Dixon	5,186,988	Feb. 16, 1993
Ashmore	H9	Jan. 7, 1986

THE REJECTION

Claims 1, 6, 8 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dixon in view of Ashmore, Rosenblatt and Watanabe.

Attention is directed to the appellants' brief (Paper No. 8) 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 this rejection.

DISCUSSION

Dixon, the examiner's primary reference, discloses a roll of gift bags designed to accommodate odd-shaped packages having various corners and angles. Each bag 24 consists of pair of decorative polyethylene sheets 22 and 23 which are connected at their side and bottom edges and unconnected at their tops to form an open mouth for receiving a gift, and a tie (see Figure 2) for closing the bag. In the embodiment relied on by the examiner (see Figures 3 and 4),

> the polyethylene plastic material has several locations which can be heat shrunk using the application of hot air so the final package will snugly fit an odd shaped package. The material 12' shown in FIG. 3 includes areas 50 which have only a two ply thickness of material on the outer sheet 22 and on the inner sheet 23 at areas 50; whereas, these sheets have multi-ply thicknesses at areas 52 other than and adjacent to the areas 50. Thus, the application of heat to the bag may cause all areas to shrink, however, the areas 50 will shrink more than the adjacent areas 52 due to the multi-ply thickness of the areas 52 adjacent to the areas 50. In this manner, the entire bag will shrink and thus fit snugly about a package, however, certain areas will shrink more than other areas and be snugger in certain areas of the packages [column 4, lines 41 through 56].

As tacitly conceded by the examiner, the Dixon bag fails to meet the limitations in independent claim 1, and the corresponding limitations in independent claim 8, requiring

the heat shrinkable gift bag to have an extended lip and a self-adhesive strip on the extended lip for closing the mouth of the bag, and to be made of opaque polyvinyl chloride film having a gauge thickness of about 90 gauge, a balanced shrink ratio in x and y orientations to provide a uniform and consistent shrink profile and an activated shrink temperature of about 140EF.

To cure these deficiencies, the examiner turns to Ashmore, Rosenblatt and Watanabe. Ashmore discloses a heat shrinkable food packaging film which is biaxially stretched or oriented and tends to return to its unstretched dimensions when heated. Rosenblatt discloses a heat shrinkable book packaging film made of opaque polyvinyl chloride which is biaxially oriented and has a shrink temperature of from about 145EF to about 185EF. Watanabe discloses a thermoplastic bag (see Figures 5 through 8) having an extended lip b carrying a band of pressure sensitive adhesive d for closing the mouth of the bag. In concluding that the subject matter recited in claims 1 and 8 would have been obvious within the meaning of § 103(a), the examiner urges that "[t]he exact thickness of the

plastic film would appear to be an obvious change of size of the gift bag" (answer, page 4), and that

> [t]o modify the bag of Dixon incorporating the conventional biaxial shrink film, shrink temperature of shrink film, and reclosing structure of plastic film bags as described by Ashmore, Rosenblatt and Watanabe would have been obvious in order to provide these features to the bag to derive the expected improved individual results as expected to one of ordinary skill in the art [answer, page 4].

One facet of the appellants' position to the contrary focuses on the limitation in claims 1 and 8 requiring the sheet of heat shrinkable film to have a balanced shrink ratio in x and y orientations to provide a uniform and consistent shrink profile. The argument by the appellants that the combined teachings of the applied references would not have suggested a gift bag of the sort claimed having this characteristic is persuasive.

The specification in the instant application defines a balanced shrink ratio as meaning "that the plastic shrinks an equal amount in both the x and y (machine and transverse) orientations of the film" (page 8).[1] The specification also

[1] Words defined in the specification must be given the same meaning when used in a claim. McGill, Inc. v. John Zink Co., 736 F.2d 666, 674, 221 USPQ 944, 949 (Fed. Cir.), cert.

indicates that this characteristic is aesthetically advantageous in that it "provides a uniform and consistent shrink profile which will not distort any printed indicia or decorative patterns on the plastic film 12 upon the application of heat" (page 9). As correctly pointed out by the appellants (see page 7 in the brief), the reference relied on by the examiner as teaching a heat shrinkable film having a balanced shrink ratio, Ashmore, does not actually do so. Although the biaxial orientation of Ashmore's sheet will result in shrinkage in both the x and y orientations (see Ashmore at column 1, lines 32 through 36), the reference does not factually support the examiner's findings that it discloses "an even shrinking across two dimensions" (answer, page 4), and that "biaxially oriented film would inherently shrink evenly in x and y directions" (answer, page 6).

More damaging to the examiner's case, however, is Dixon's readily apparent intention that the gift bags disclosed therein have non-uniform heat shrinkage characteristics (see

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denied, 469 U.S. 1037 (1984).

Dixon at column 4, lines 22 through 56). Even though heat shrinkable films having balanced shrink ratios might be known in the packaging art, and arguably would have been suggested by Ashmore, there is nothing in this knowledge per se or in the combined disclosures of the applied references which would have motivated the artisan to run counter to the teachings of Dixon by making the gift bags disclosed therein of a heat shrinkable film having a balanced shrink ratio. The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Here, the prior art does not contemplate the aesthetic advantage recognized by the appellants for the balanced shrink ratio recited in claims 1 and 8, or provide any other reason why this feature would have been desirable in the particular bag disclosed by Dixon.

Hence, the references proffered by the examiner do not justify a conclusion that the differences between the subject matter recited in independent claims 1 and 8 and the prior art are such that the subject matter as a whole would have been

obvious at the time the invention was made to a person having ordinary skill in the art.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 1 and 8, and dependent claims 6 and 16, as being unpatentable over Dixon in view of Ashmore, Rosenblatt and Watanabe.

SUMMARY

The decision of the examiner to reject claims 1, 6, 8 and 16 is reversed.

REVERSED

CHARLES E. FRANKFORT Administrative Patent Judge	)	
JOHN P. McQUADE Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)	

JPM/gjh

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APJ McQUADE

APJ BAHR

APJ FRANKFORT

REVERSED

July 24, 2002