

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ANJANA BATRA

Appeal No. 2001-2251
Application No. 09/345,857

ON BRIEF

Before ABRAMS, FRANKFORT, and STAAB, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

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

We REVERSE AND REMAND TO THE EXAMINER.

BACKGROUND

The appellant's invention relates to a package in combination with a disposable consumer product. An understanding of the invention can be derived from a reading of exemplary claim 1, which reads as follows:¹

1. A package in combination with a disposable consumer product contained therein, said package having at least one external face with a first indicia disposed thereon, said disposable consumer product being contained within said package and dispensable therefrom, said disposable consumer product having second indicia non-identically matching said first indicia and disposed directly on said consumer product, at least one of said first and second indicia comprising a latticework defined by individual cells, said individual cells having decorative markings therein.

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

Walker	2,082,671	Jun. 1, 1937
Hay	Des. 149,874	Jun. 8, 1948
Schulz	Des. 354,856	Jan. 31, 1995
Sporing <u>et al.</u> (Sporing)	Des. 400,716	Nov. 10, 1998

Claims 1-18 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Claims 2 and 3 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

¹The remaining claims have been reproduced in an appendix to the Brief. It should be noted, however, that claim 4 as set forth therein is incorrect; in all occurrences "tissue" should read –tissues– and "latticework" should read –latticework–.

Claims 1-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schulz in view of either Hay or Walker.

Claims 1-18 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sporing in view of either Hay or Walker.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 15) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 13) for the appellant's arguments thereagainst.

OPINION

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

The Rejection Under Section 101

The examiner has rejected claims 1-18 for several reasons focusing on the "decorative printed matter" recited therein, which in the examiner's view cause them not to conform to 35 U.S.C. § 101. However, as is pointed out by the appellant on page 3

of the Brief, the claims define a package and a product contained therein, and not merely the disposition of indicia, and therefore we agree that they are in conformance with Section 101. This rejection is not sustained.

The Rejection Under The Second Paragraph Of Section 112

Claims 2 and 3 stand rejected because claim 2 “is redundant in view of the last amendment of claim 1, which substantially incorporates the subject matter of claim 2 into claim 1 at lines 6 and 7” (Answer, page 4).

Lines 6 and 7 of claim 1 state that at least one of the first and second indicia comprise “a latticework defined by individual cells, said individual cells having decorative markings therein.” Claim 2 further restricts the decorative markings to being “nonalphameric.” Since claim 1 provides no limitations regarding the form that the decorative markings should take, it is clear to us that claim 2 is not indefinite by virtue of being redundant, for it further limits claim 1. Therefore it does not run afoul of 35 U.S.C. § 112, second paragraph.

This rejection is not sustained.

The Rejections Under Section 103

Claims 1-18 stand rejected as being obvious in view of the combined teachings of Schulz in view of either Hay or Walker, and Spring in view of either Hay or Walker. 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).

According to the examiner, Schulz and Spring each disclose a consumer product having a latticework first indicia thereon, and Hay and Walker each disclose a package in combination with a consumer product contained therein, the package having an external face with first indicia disposed thereon and the consumer product having a second indicia thereon which is "matching (harmonizing with) the first indicia." The examiner then opines that it would have been obvious to provide the package with an indicia having the claimed relationship with the latticework indicia on the consumer product "to provide a purely aesthetic design appearance combination between the contents and the package," considering that the design features "fail to provide any new or unexpected utility." See Answer, page 5.

We agree with the examiner that both Schulz and Sporing disclose consumer products having latticework indicia thereon, and that it is well-known to place such products in a package for sale and/or use. However, in Walker the consumer product has no indicia at all on its surface and thus could not have suggested to one of ordinary skill in the art that the product and its package should both have indicia, much less indicia related in the manner required in claim 1. As far as Hay is concerned, it appears from the drawing of this design patent that there is a ribbon tied in a bow on the outside of the package and a sculptured piece of soap on the inside, and even if these are considered to be “indicia,” we fail to appreciate that the relationship required by claim 1 is present or that one of ordinary skill in the art would have been motivated by Hay to relate the indicia to one another in that fashion. We are not persuaded otherwise by the examiner’s argument that the bow “provides a harmonizing effect” to the spaced pieces of soap and therefore would have provided the requisite suggestion to the artisan (Answer, page 7). Nor do we share the examiner’s view that the indicia need not be considered in evaluating the claims because of “failing to provide any new or unexpected utility” (Answer, page 5).

Suffice it to say that we find neither Schulz in view of Hay or Walker nor Sporing in view of Hay or Walker to establish a prima facie case of obviousness with regard to the subject matter recited in claim 1, and we therefore will not sustain either of those rejections of claim 1 or, it follows, of claims 2 and 3, which depend therefrom.

We reach the same conclusion, for the same reasons, with regard to the like rejections of independent claims 4 and 11. Claim 4 requires that the package and the product each have lattices defined by individual cells, with at least some cells of the lattice on the product having decorative markings matched to the cells of the lattice on the package. Claim 11 requires the same elements, however, the lattices are non-identically matched and each has individual cells having a shape derivable from the decorative markings.

The Section 103 rejections of independent claims 4 and 11 and dependent claims 5-10 and 12-18 will not be sustained.

REMAND TO THE EXAMINER

This application is remanded to the examiner for consideration of the following:

(1) Whether a further search would be appropriate for prior art in areas where indicia or portions thereof that appear on the consumer product also appear on the outer surface of the package, such as packaged facial tissues, paper towels, napkins, candy, cookies, and the like.

(2) Whether the “indicia” recited in the claims on appeal is “printed matter” and, if so, whether or not it is functionally related to the substrate in a new and unobvious way so as to distinguish over the prior art in terms of patentability. See In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (CAFC 1983).

(3) Whether further consideration of the patentability of any of the appealed claims is justified in light of (1) and (2).

Upon completion of the above, the examiner should take whatever action is deemed appropriate in order to resolve any outstanding questions of patentability of the appealed claims in light of the prior art.

In addition, we note that 37 CFR § 1.83 (a) has not been complied with, in that the claimed combination of a package and a disposable consumer product has not been illustrated in the drawings.

SUMMARY

None of the rejections are sustained.

The decision of the examiner is reversed.

The application is remanded to the examiner for action consistent with the above comments.

REVERSED AND REMANDED

NEAL E. ABRAMS
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

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APPEAL NO. 2001-2251 - JUDGE ABRAMS
APPLICATION NO. 09/345,857

APJ ABRAMS

APJ STAAB

APJ FRANKFORT

DECISION: **REVERSED AND
REMANDED**

Prepared By: Lesley Brooks

GAU: 3700

OB/HD

DRAFT TYPED: 09 Jun 03

FINAL TYPED: