

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte MIKE GENTILE, VERONIQUE SINS, J. MARK MORROW,
JAMES W. LOWRY and KENAN CLOUGHERTY

Appeal No. 2003-0102
Application No. 09/543,439

HEARD: MAY 20, 2003

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-12 and 23-34. Claims 13-22, the only other claims pending in this application, stand withdrawn from consideration.

We REVERSE.

BACKGROUND

The appellants' invention relates to a container for vacuum packaging products, the container including a flexible liner and at least one flexible end closure which are free to move inwardly against the product to provide cushioning to thereby prevent damage during transportation. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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

Bemiss	3,779,447	Dec. 18, 1973
Adamek	4,087,003	May 2, 1978
Markert	4,098,404	Jul. 4, 1978
Sansbury	4,158,425	Jun. 19, 1979
Curry, Jr. (Curry)	4,267,928	May 19, 1981

The examiner has withdrawn the rejection under 35 U.S.C. § 112, second paragraph, set forth in the final rejection (see page 3 of the examiner's answer, Paper No. 18).

The following rejection under 35 U.S.C. § 102(b) is before us for review:

claims 1, 5, 6, 8, 9 and 11 as being anticipated by Curry.

The following rejections under 35 U.S.C. § 103(a) are before us for review:

claims 1-4 and 6 as being unpatentable over Sansbury in view of Markert;

claims 5 and 8-11 as being unpatentable over Sansbury in view of Markert and Curry;

claim 7 as being unpatentable over Sansbury in view of Markert and Bemiss;

claims 9-11 as being unpatentable over Markert in view of Curry;

claim 12 as being unpatentable over Markert in view of Curry, Sansbury and Bemiss;

claims 1, 5, 6, 8, 9, 11, 23 and 27, 28 and 30 as being unpatentable over Curry in view of Adamek;

claims 1-4, 6 and 23-26 as being unpatentable over Sansbury in view of Markert and Adamek;

claims 5, 8-11, 27 and 30-33 as being unpatentable over Sansbury in view of Markert, Adamek and Curry;

claims 7 and 29 as being unpatentable over Sansbury in view of Markert, Adamek and Bemiss;

claims 9-11 and 31-33 as being unpatentable over Markert in view of Curry and Adamek¹; and

claims 12 and 34 as being unpatentable over Markert in view of Curry, Adamek, Sansbury and Bemiss.

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. 18) for the examiner's complete reasoning in support of the rejections and to

¹ Notwithstanding the examiner's statement of the rejection in both the final rejection and the answer as being based on Markert in view of Curry, it is apparent from a reading of the rejection as a whole that the rejection is based on the combination of Markert in view of Curry and Adamek. It is also apparent that appellants understood Adamek to be part of the rejection (see page 5 of the brief).

the brief and reply brief (Paper Nos. 17 and 20) 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.

The anticipation rejection

Each of independent claims 1 and 9 recites at least one flexible end closure secured to at least one of the opposed ends of the tubular body of the container, the at least one flexible end closure "being free to move inwardly against the product when vacuum is applied so as to provide cushioning support to the product." The examiner regards this limitation as merely an intended use (answer, page 3) and further points out that Curry (column 7, lines 1-2) discloses caps 11 made of "deformable plastic or laminated paper materials," which the examiner contends are capable of being moved inward when subjected to vacuum pressure.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary

skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Initially, we do not agree with the examiner that the language “being free to move inwardly against the product when vacuum is applied so as to provide cushioning support to the product” constitutes mere intended use. This language, when read in combination with the limitation “flexible” and in light of appellants’ underlying disclosure (specification, page 8, lines 9-26, and page 10, lines 2-11), requires that the at least one end closure be sufficiently flexible that it is moved inwardly when vacuum is applied.

We find no express teaching in Curry that the end caps 11 be flexible so as to move inwardly when the container is subjected to a vacuum. Further, Curry’s disclosure of deformable plastic or laminated paper material for the end caps is insufficient, in itself, to convey that such end caps are inherently² sufficiently flexible to move inwardly when vacuum is applied as called for in claims 1 and 9. As for Curry’s use of the term “deformable,” we share appellants’ view, as expressed on page 6 of the

² Under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

reply brief, that, taken in context, this more likely refers to the capability of the end caps to be bent (in the sense of crimping) or snapped (in the sense of a snap ring, for example) to fit snugly around the sides of the container to seal the ends and prevent leakage. As for Curry's disclosure of "laminated paper material" caps, while laminated paper could, depending upon the particular materials and dimensions used, have sufficient flexibility to meet the limitations of claim 1, inherency may not be established by mere probabilities or possibilities. "The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgirk v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)). In this instance, while the Caner and Kucherer patents referred to by the examiner on page 9 of the answer evidence that laminated foil membranes may be manufactured so as to flex under the application of vacuum forces, these patents in no way establish that all laminated paper articles or, in particular, the end caps 11 of Curry are made to so flex. We note, for example, that Curry's tubular support 9 is a "laminated paper structure" (column 6, line 38) and that it, unlike the liner 12, has not been characterized by Curry as flexible and would not be viewed by one skilled in the art of vacuum packing as being free to move inward under the application of vacuum as called for in claim 1.

Having concluded that Curry fails to disclose, either expressly or under the principles of inherency, at least one flexible end closure "being free to move inwardly against the product when vacuum is applied so as to provide cushioning support to the

product” as called for in claims 1 and 9, we cannot sustain the examiner’s rejection of independent claims 1 and 9 or dependent claims 5, 6, 8 and 11 as being anticipated by Curry.

The obviousness rejections

We shall not sustain the examiner’s rejection of claims 1, 5, 6, 8, 9, 11, 23, 27, 28 and 30 as being unpatentable over Curry in view of Adamek. This rejection depends in part on the examiner’s determination that Curry meets the limitation in independent claims 1, 9 and 23 of at least one flexible end closure “being free to move inwardly against the product when vacuum is applied so as to provide cushioning support to the product.” As discussed above, we have concluded that Curry fails to disclose this limitation and we find nothing in Adamek which cures this deficiency.

We turn next to the rejection of claims 1-4 and 6 as being unpatentable over Sansbury in view of Markert. Sansbury discloses a container for use in vacuum packaging comprising a paperboard tubular body, an inner liner 18 secured to opposed ends of the tubular body by adhesive stripes 22 and end caps 28. Sansbury discloses (column 4, lines 22-28) that

the vacuum or reduced pressure atmosphere within the liner causes an inward deformation of the liner into compacting engagement with the product substantially independently of the surrounding container body. The stresses, if any, which are transferred to the container body are at the opposed ends thereof which are in turn rigidified by the end caps.

As pointed out by Sansbury (column 2, lines 43-53), this construction permits a thin, lighter and cheaper body wall construction to be utilized in the vacuum packing environment.

The examiner concedes that Sansbury's container lacks a flexible end closure as called for in claim 1. To overcome this shortcoming, the examiner relies on the teachings of Markert of a vacuum package with a flexible end. According to the examiner, it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to provide a flexible end closure in Sansbury in view of Markert to provide additional support (see answer, page 4).

Markert, like Sansbury, is concerned with minimizing the impact of vacuum forces on the tubular wall of a tubular container used in vacuum packing. Markert accomplishes this by providing a flexible force or load transferring membrane 20 to seal one end of the container, with the other end being sealed by a conventional or standard metal cap 14. The inward pressure induced upon removal of the container from the vacuum chamber after vacuum filling causes the membrane 20 to flex upwardly, firmly compacting and conforming the goods 28 contained in the container against the inner surfaces of the conventional end cap 14 and the tubular body 12 to thereby provide a tight package with substantial additional rigidity and strength beyond that normally associated with a composite or layered container (column 1, lines 52-58).

From our perspective, Sansbury and Markert utilize two different approaches to achieve the same objective, namely, protecting the composite tubular body of the

container from damage from the inward forces applied during vacuum packing. Sansbury provides an inner liner which absorbs the forces, transmitting them only near the ends which are rigidified by the end caps, while Markert provides a flexible end cap which compacts the product against the tubular body and opposing end cap to thereby rigidify the container. We find no teaching or suggestion in either Sansbury or Markert to combine these approaches by providing a flexible end closure on the Sansbury container as proposed by the examiner. We thus conclude that the combination of Sansbury and Markert is insufficient to establish a prima facie case of obviousness of the subject matter of claim 1 and shall not sustain the rejection of claim 1 or claims 2-4 and 6 which depend therefrom. We have also reviewed the additional teachings of Adamek and find nothing therein which overcomes the shortcoming of the examiner's combination of Sansbury and Markert. It thus follows that we shall also not sustain the rejection of claims 1-4 and 6 and claims 23-26, which also call for both a flexible liner and a flexible end closure, as unpatentable over Sansbury in view of Markert and Adamek.

In light of our conclusion, supra, that Curry fails to disclose flexible end closures "being free to move inwardly against the product when vacuum is applied so as to provide cushioning support to the product," it follows that we find no suggestion in Curry to provide two flexible end closures on the Sansbury container. Accordingly, we also shall not sustain the rejection of claims 5 and 8-11 as unpatentable over Sansbury in

view of Markert and Curry or the rejection of claims 5, 8-11, 27 and 30-33 as unpatentable over Sansbury in view of Markert, Adamek and Curry.

Turning to the rejection of claim 7 as unpatentable over Sansbury in view of Markert and Bemiss, we find nothing in the teachings of Bemiss which cures the above-noted deficiency in the combination of Sansbury and Markert. It follows that we also shall not sustain this rejection.

Bemiss, likewise, provides no teaching or suggestion which would overcome the above-noted shortcomings of the combination of Sansbury in view of Markert and Adamek. We thus shall not sustain the examiner's rejection of claims 7 and 29 as unpatentable over Sansbury in view of Markert, Adamek and Bemiss.

The examiner's rationale in rejecting claims 9-11 as unpatentable over Markert in view of Curry is that Curry teaches two flexible end caps and, thus, would have suggested the provision of a second flexible closure on the container of Markert to manufacture the container more easily (answer, page 5). As discussed above, we find no teaching or suggestion in Curry of flexible end caps. Moreover, Markert teaches that the single flexible membrane 20 provided therein acts to compact the product against both the tubular body 12 and the opposite conventional metal cap 14 to rigidify the container in these areas. The provision of a second flexible end cap in place of the conventional metal cap 14 would undermine the rigidification at this location and would necessitate the provision of a second overcap 30. We thus conclude that one of ordinary skill in the art would not have been led by the teachings of Markert and Curry

to make the modification proposed by the examiner. Consequently, we cannot sustain the examiner's rejection of claims 9-11 as unpatentable over Markert in view of Curry. We have reviewed the additional teachings of Adamek and find nothing therein which would have suggested the provision of two flexible end caps on Markert's container. It thus follows that we shall also not sustain the examiner's rejection of claims 9-11 and claims 31-33, which also require two flexible end closures, as unpatentable over Markert in view of Curry and Adamek.

The above-noted shortcoming in the examiner's combination of Markert in view of Curry finds no cure in the additional teachings of Sansbury, Bemiss and Adamek. We therefore also cannot sustain the examiner's rejection of claim 12 as unpatentable over Markert in view of Curry, Sansbury and Bemiss or the rejection of claims 12 and 34 as unpatentable over Markert in view of Curry, Adamek, Sansbury and Bemiss.

CONCLUSION

To summarize, each of the examiner's rejections is reversed. Accordingly, the decision of the examiner to reject claims 1-12 and 23-34 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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