

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2004-1240
Application No. 09/742,691

ON BRIEF

Before OWENS, JEFFREY T. SMITH, and PAWLIKOWSKI,
Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 3, and 4.

A copy of each of claims 1, 3, and 4 is set forth below.

Appeal No. 2004-1240
Application No. 09/742,691

1. A hair foil package dispenser comprising:
a container;
a roll of hair foil having a width between
approximately 3.5" to 6.0";
an opening in said container;
an integrated cutting blade.

3. The package dispenser of claim 1 wherein
said integrated cutting blade is made of metal or
plastic.

4. The package dispenser of claim 1 wherein
said container has an insert for placing a lid of said
container.

The examiner relies upon the following
references as evidence of unpatentability:

Budny	3,974,947	Aug. 17, 1976
Clatterbuck	4,095,730	Jun. 20, 1978
Fischer	4,715,519	Dec. 29, 1987

Appellant's specification, page 1, last full paragraph
and page 2, first full paragraph, and the image
reproduced on page 4 of the answer which represents a
prior art dispenser submitted by appellant
(hereinafter, "AAPA").

Appeal No. 2004-1240
Application No. 09/742,691

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by AAPA, or in the alternative, under 35 U.S.C. § 103 as being obvious over AAPA in view of Budny or Clatterbuck.

Claim 3 stands rejected under 35 U.S.C. § 103 as being obvious over AAPA in view of Budny.

Claim 4 stands rejected under 35 U.S.C. § 103 as being obvious over AAPA in view of Fischer.

Our reference to appellant's brief is the brief filed on August 11, 2003 (Paper No. 21). To the extent any given claim is separately argued by appellant, we consider such claim in this appeal. 37 CFR § 1.192 (7) and (8) (2003).

OPINION

For the reasons set forth in the answer, and below, we affirm each of the rejections.

I. 35 U.S.C. § 102(b)/103 rejection of claim 1

In the instant case, critical to the determinations made herein, is the meaning of the phrase "an integrated cutting blade", which is recited in claim 1.

Beginning on page 6 of the answer, the examiner refers to the reproduced image¹ (set forth on page 4 of

¹ On page 3 of the answer, the examiner indicates that this image is an image of a prior art dispenser submitted by appellant.

Appeal No. 2004-1240
Application No. 09/742,691

the answer), and states that this image shows a jagged edge that is integrated, and the jagged edge is inherently a cutting blade in that it cuts foil. Appellant argues that such a jagged edge is not an "integrated cutting blade". Brief, page 5 and Eric Polesuk's Second Declaration. Hence, the meaning of this phrase "an integrated cutting blade" is disputed.

We note that the meaning and scope of a claim is ascertained in light of the specification. That is, in determining the patentability of claims, the PTO gives claim language its "broadest reasonable interpretation" consistent with the specification and claims. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997) (citations omitted). There is a heavy presumption that a claim term carries its ordinary and customary meaning. Amgen, Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1325, 65 USPQ2d 1385, 1394 (Fed. Cir. 2003).

In the instant case, appellant's specification does not explicitly describe how the integrated cutting blade is attached to dispenser 5 depicted in Figure 1. Figure 1 does illustrate dispenser 5 having blade 50 thereon. Hence, a blade is connected to dispenser 5 in some way.

We turn to the dictionary as a useful tool for determining the ordinary and customary meaning of the word "integrated". The definition of the word "integrate" is "to unite with something else". See

Appeal No. 2004-1240
Application No. 09/742,691

page 606 of Merriam-Webster's Collegiate Dictionary, 10th Edition (2000). Hence, an integrated structure is a union of more than one piece. The examiner does not explain how the serrated edge depicted in the picture on page 4 of the answer is a piece that is united to something else (e.g., to the box). To the contrary, the reproduced image shows a unitary piece, not pieces united together. Hence, we find that the examiner has not properly interpreted appellant's claim (the examiner simply states that the cutting device [of the AAPA] is integrated "in that it is part of the box", answer, page 7).

We also find that the AAPA does not disclose an "integrated" cutting blade in view of our claim interpretation as discussed above. The AAPA is a unitary piece. Therefore, we determine that the AAPA does not anticipate the claimed invention.²

We turn now to the obviousness rejection of claim 1. The examiner relies upon AAPA in view of Budny or Clatterbuck. Both Budny and Clatterbuck disclose an "integrated" cutting blade in that the cutting means is united with another piece. See Figure 1 of Clatterback (knife edge 18 is secured to container 12) and see Figure 1 of Budny (cutting means 44 is

² As an aside, the word "blade" means "a cutting part of an implement." See page 120 of the Merriam-Webster's Collegiate Dictionary, 10th Edition (2000). As pointed out by the examiner, the serrated edge depicted, for example, in the reproduced image on page 4 of the answer, cuts foil. Hence, it is a cutting part of an instrument, and therefore falls within the aforementioned definition of a "blade".

Appeal No. 2004-1240
Application No. 09/742,691

secured to carton 10).

Budny also teaches that cutting means 44 is most preferably a metal or plastic cutter bar "for controllable tearing off desired lengths of the roll material". See column 3, lines 12-16. The roll material can be polymeric film, wax paper, metal foil, and the like. See Abstract. Hence, Budny provides sufficient motivation to substitute the serrated cutting edge of the AAPA for an integrated metal cutting blade for controllable tearing off of foil. In this way, the art recognized problem associated with the prior art (difficulties in achieving desirable tearing/cutting of foil, as, e.g., discussed in the Tanas Declaration) is alleviated. We note that obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggesting, or motivation to do so found either in the reference or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Here, Budny provides the motivation to do so. Hence, we determine that that combination of applied prior art supports a prima facie case of obviousness. We therefore affirm the obviousness rejection of claim 1.

Appeal No. 2004-1240
Application No. 09/742,691

II. The rejection of claim 3 under 35 U.S.C. § 103 in view of AAPA in view of Budny

On page 11 of the brief, appellant refers to his same arguments used in the above-discussed rejection of claim 1 of Section I of this decision, to address this rejection. Therefore, for the very same reasons that we affirmed the above-mentioned obviousness rejection, we affirm this rejection.

III. The rejection of claim 4 under 35 U.S.C. § 103 as being obvious over AAPA in view of Fischer

In the rejection of claim 4, the examiner relies upon Fischer for teaching the subject matter of claim 4. We address appellant's specific comments on Fischer on pages 11-12 of the brief. Here, appellant argues the particular limitation of claim 4 regarding "wherein said container has an insert for placing a lid of said container" is not suggested by Fischer. Brief, pages 11-12.

At the bottom of page 11 and at the top of page 12 of the brief, appellant argues that item 68 of Fischer is not an insert, nor does it form an insert for the lid. Appellant states that the opening, 69, formed by flap 68 is for the sheet material to be dispensed, not the lid to be placed. On page 16 of the answer, the examiner agrees that item 68 of Fischer is not an insert.

Appeal No. 2004-1240
Application No. 09/742,691

Appellant's specification discloses that "[i]nsert 30 is provided for placing the lid (not shown in the figure) of the package 5". Figure 1 depicts package dispenser 5. Hence, we are not certain as to how the lid is inserted into insert 30. We do know that, in determining the patentability of claims, the PTO gives claim language its "broadest reasonable interpretation" consistent with the specification and claims. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997) (citations omitted). There is a heavy presumption that a claim term carries its ordinary and customary meaning. Amgen, Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d at 1327, 65 USPQ2d at 1394. Here, it is therefore reasonable to interpret claim 4 as requiring an insert into which a lid is inserted.

We find that in column 5 beginning at line 20 of Fischer, top wall panel 18 (which is the lid for the box depicted in figure 2 of Fischer) has tuck flaps 62 and 64 that are inserted between rear wall end flaps 38, 40 and front wall end flaps 32, 34. The area between the rear wall end flaps 38, 40 and front wall end flaps 32, 34 are inserts because the tuck flaps 62 and 64 are inserted therein. In this manner, lift flap 68/overlap wall panel of dispenser 10 can be arranged as depicted in Figure 3 of Fischer. That is, lift flap 68/overlap wall panel of dispenser 10 is inserted into an insert(s), which is all that is

required by claim 4.

We observe that on page 12 of the brief, appellant argues that "the Declaration of Mr. Anders states that there is no motivation to modify the prior art to include the teaching of [Fischer]". We have reviewed the Anders Declaration and do not find such a statement. For argument sake, however, the prior art of Budny, for example, has a lid 22 having a wall section 24 which is detachably secured along a line of glue spots 26. Fischer teaches an equivalent means of detachable securement (use of inserts).

In view of the above, we affirm the obviousness rejection of claim 4.

IV. Rebuttal evidence

A prima facie case of obviousness is rebuttable by proof that the claimed invention possesses unexpectedly advantageous or superior properties.³ In re Papesch, 315 F.2d 381, 386-87, 137 USPQ 43, 47-48 (CCPA 1963). Objective indicia of unobviousness can be in the form of affidavits submitting evidence of secondary considerations, and must be considered by the examiner. See M.P.E.P. § 716. Such evidence of secondary considerations includes proof of commercial success of the claimed subject matter, a showing that

³ We review the rebuttal evidence with regard to the obviousness rejections of record.

Appeal No. 2004-1240
Application No. 09/742,691

the invention addresses a long-felt need, and proof of the failure of other to produce the invention. See M.P.E.P § 716; In re GPAC Inc., 57 F.3d 1573, 1580, 35 USPQ2d 1116, 1121 (Fed.Cir. 1995). With regard to the issue of "failure of others", as stated supra, the M.P.E.P. requires that the examiner determine whether failure by others was merely attributable to a lack of interest, M.P.E.P. § 716, and a showing of long-felt need should convince the examiner that it was not. Other types of secondary considerations include copying and initial disbelief and/or acclaim by experts. In order to credit such objective evidence, the appellant must establish a nexus between the evidence and the merits of the inventions. See GPAC, 57 F.3d at 1580, 35 USPQ2d at 1121 (Fed.Cir. 1995). Even when the required nexus is established, however, persuasive secondary considerations still may not outweigh a strong showing of obviousness based on the other Graham factors. See, e.g., Richardson-Vicks Inc. v. Upjohn Co., F.3d 1476, 44 USPQ2d 1181 (Fed. Cir. 1997). The weight of the legitimate inferences from the art of record are compared with the weight of the rebuttal evidence to determine whether the rebuttal evidence overcomes the prima facie case. In re Lindell, 385 F. 2d 453, 455, 155 USPQ 521, 524 (CCPA 1967).

Appellant discusses several Declarations in the brief. We have carefully read each of these

Appeal No. 2004-1240
Application No. 09/742,691

Declarations in their entirety, and have read both appellant's and the examiner's position on each of these Declarations, and our determinations are set forth below.

A. Eric Polesuk's Second Declaration

With regard to Eric Polesuk's Second Declaration, appellant summarizes the statements made in this Declaration, beginning on page 5 of the brief, as follows.

Polesuk submits that a jagged-like pattern formed in the cardboard of the box is not considered an integrated cutting blade; simply a rough edge. Second Declaration, paragraph 2. Polesuk also states that although self-dispensing boxes having an integrated cutting blade have been around in the food service industry for many years for the purpose of cutting rolls of aluminum foil and plastic film, no such device was used in the Beauty Industry and dispensed from a box having a width between approximately 3.5" to 6.0". Second Declaration, paragraph 3. Polesuk states that prior to the present invention, there was no self-dispensing box for the Beauty Industry having the features of the present invention, and concludes that it could not have been obvious to a person in the Beauty Industry who had knowledge of the prior art to have made the product of the present invention. Second Declaration, paragraph 3. Polesuk states that other persons in the Beauty Industry had been trying to solve the problem of efficiently dispensing hair foil for many years. Persons in the Beauty Industry had knowledge of dispensers for rolls of aluminum foil and plastic films used in the food service industry. These same persons had knowledge of the hair

Appeal No. 2004-1240
Application No. 09/742,691

foil dispensers (AAPA) which had jagged edges. But no one of skill in the Beauty Industry had ever created a dispenser as claimed in the present invention. Polesuk states that it was not until the product of the present invention was being sold in commerce that several competitors copied the product and began to use the integrated cutting edge as their major selling feature. Second Declaration, paragraph 4. Polesuk states that the commercial success of the hair foil package dispenser of the present invention is not based on any promotion or advertising or any other business events. Although Product Club offers for sale the product claimed in the present invention on their website, the sales of the product on their website are less than one half of one percent (.5%) of the total sales. The commercial success of the present invention is based on the self-dispensing package having the integrated cutting blade. Second Declaration, paragraph 5.

The above statements made by Eric Polesuk touch on several secondary considerations, e.g., commercial success and failure by others/long-felt need.

With regard to the issue of commercial success, an appellant should not make broad statements about commercial success, but rather should provide specific details. See, e.g., Ex parte Remark, 15 USPQ2d 1498, 1505 (Bd.Pat.App. & Int. 1990). For example, proof of commercial success is not simply a matter of producing sales figures. Appellant must provide evidence, such as market share, growth in market share, and replacement of earlier sales by others. Kansas Jack, Inc. v. Kuhn, 719 F.2d 1144, 1151, 219 USPQ 857, 861

Appeal No. 2004-1240
Application No. 09/742,691

(Fed. Cir. 1983). Also, evidence of commercial success can be downgraded where there is no showing that the sales represent a substantial share of any definable market or that the profitability is anything out of the ordinary in the industry involved. Cable Elec. Prods., Inc. v. Genmark, Inc., 770 F.2d 1015, 1026-1027, 226 USPQ 881,887 (Fed. Cir. 1985). Eric Polesuk's Second Declaration does not provide us with any of the above-mentioned evidence regarding appellant's burden in connection with commercial success. It would therefore be improper to infer that reported sales represent a substantial share of any definable market or that profitability is anything out of the ordinary in the pertinent industry. Ex parte Remark, 15 USPQ2d 1498, 1505 (Bd.Pat.App.&Int 1990).

With regard to the issue of "failure of others", as stated supra, the issue is whether the failure by others was merely attributable to a lack of interest, M.P.E.P. § 716, and a showing of long-felt need should show that the "failure by others" was not due to a lack of interest. Eric Polesuk does state that other persons in the Beauty Industry had been trying to solve the problem of efficiently dispensing hair foil for many years. This broad statement is not specific to any long-felt need of appellant's particular hair foil package dispenser having an integrated cutting blade. Because the "long-felt need" showing is weak, we also conclude that the "failure of others" showing

Appeal No. 2004-1240
Application No. 09/742,691

has little impact in favor of appellant's position.

B. Eric Polesuk's Third Declaration

With regard to Eric Polesuk's Third Declaration, appellant summarizes the statements made in this Declaration, beginning on page 5 of the brief, as follows.

Polesuk states that for the past 11 years, Product Club, the assignee of the present invention, has been a supplier of key sundry products for the Beauty Industry. Thousands of salons use the roll foil of the present invention and have benefited from the improved cutting mechanism found on every self-dispensing box. To satisfy the demand Product Club has created, Product Club stocks upward of 30,000 rolls of hair foil at its corporate distribution center. To accommodate the needs of both the big and small end-users, Product Club offers its rolls of hair foil in 3 different lengths, (sizes); 5" X 250'; 5" X 722', and 5" X 1,450'. Since the rolls of hair foil are offered in many different colors, the product line now consists of 11 SKU's (shelf counting units). In a very short amount of time, roll foil has become a significant portion of sales at Product Club and is up 300%, when comparing 1st half 2000, versus 1st half 2001, due to the product that is claimed in the present invention. The commercial success of the hair foil package dispenser claimed in the present invention is not based on an increase in advertising for this product or any other single business event. Product Club does attend annual tradeshows where its products are featured and does periodically advertise its products in industry journals. However, advertising dollars as a percent of sales has not increased for the roll of hair foil. Third Declaration, paragraphs 1-4.

Appeal No. 2004-1240
Application No. 09/742,691

We refer to the examiner's comments on pages 13-14 of the answer regarding this Declaration on the issue of commercial success, and add the following comments for emphasis.

As stated above, proof of commercial success is not simply a matter of producing sales figures. Appellants must provide evidence, such as market share, growth in market share, and replacement of earlier sales by others. Kansas Jack, Inc. v. Kuhn, 719 F.2d 1144, 1151, 219 USPQ 857, 861 (Fed. Cir. 1983). Also, evidence of commercial success can be downgraded where there is no showing that the sales represent a substantial share of any definable market or that the profitability is anything out of the ordinary in the industry involved. Cable Elec. Prods., Inc. v. Genmark, Inc., 770 F.2d 1015, 1026-1027, 226 USPQ 881,887 (Fed. Cir. 1985). Eric Polesuk's Third Declaration does not provide us with any of the above-mentioned evidence regarding appellant's burden in connection with commercial success. It would therefore be improper to infer that reported sales represent a substantial share of any definable market or that profitability is anything out of the ordinary in the pertinent industry. Ex parte Remark, 15 USPQ2d 1498, 1505 (Bd.Pat.App.&Int 1990).

Appeal No. 2004-1240
Application No. 09/742,691

C. Eric Polesuk's Other Declaration having Attachment A

Appellant discusses Attachment A, beginning on page 9 of the brief, summarized as follows. Appellant states that Attachment A shows the introduction dates of the competitor's dispensers, after the filing date of the present application. Appellant states that the fact that dispensers of foil were sold in the food industry was known by everyone who wraps their food products at home. Appellant states that Attachment A demonstrates that the success of the roll foil dispenser business is not related to the selling price, as in most cases, the prices of Product Club are higher than the competition. Appellant states that Attachment A also shows that the success of roll foil is not related to the colors, as the five colors chosen are industry standards. Appellant states that Attachment A shows that the success of the roll foil business is not related to the overall length of roll foil that is offered for sale as this is also industry standard. Brief, page 9. Appellant also states that a further indication of non-obviousness is copying. Appellant states that as shown by Attachment A, Product Club introduced the dispenser of the present application in January of 2000. The other companies in the industry who offered the dispenser with the metal cutting edge began introducing them from March 2001 to July 2001. Brief pages 9-10. See also

Appeal No. 2004-1240
Application No. 09/742,691

Attachment A on page 2 of Eric Polesuk's Declaration of Paper #18.

With regard to the issue of commercial success, we find that this Declaration fails for the same reasons discussed in Section IV. A. and B., above.

With regard to the issue of copying, more than just copying is generally needed to establish unobviousness. See In re GPAC Inc. 57 F.3d 1573, 1580, 35 USPQ2d 1116, 1121-22 (Fed. Cir. 1995). Also, Attachment A does not indicate the circumstances in which the other companies began selling their dispensers. It is possible that these companies independently designed their dispensers without knowledge of appellant's dispenser. Appellant does not provide proof that in fact copying took place.

D. Scott Anders Declaration

With regard to Scott Anders Declaration, appellant discusses this Declaration, beginning on page 7 of the brief, as follows.

Scott Anders is the president of a leading US company, which specializes in the manufacturing and production of aluminum products, including, institutional/industrial roll foil and a multitude of food service containers comprised of aluminum such as oven roasters, loaf pans, baking pans, pie pans, and take out containers. Anders Declaration, paragraph 1. One of the product lines sold by Scott Anders' company is institutional/ household roll aluminum foil,

Appeal No. 2004-1240
Application No. 09/742,691

which is sold exclusively into the food service industry and retail food outlets for wrapping food products. These rolls are offered in two industry standard widths, 12 inches and 18 inches, and come in various different lengths. Anders Declaration, paragraph 2. Scott Anders' company is vertically integrated in the production of roll foil as follows: rewinding and slitting of master parent rolls into commercially acceptable food service widths and lengths, fastening an integrated metal cutting edge to the foil dispenser boxes, assembling the boxes, filling the boxes with roll foil, and final pack-out for shipping to customers. Since the company applies their own metal cutting edge to the dispenser box, Scott Anders' company considers themselves to be experts in the area of foil dispensers. Anders Declaration, paragraph 3. Scott Anders has read and reviewed the Budny and Clatterbuck patents. Scott Anders has reviewed the hair foil package from Product Club covered by the present patent application. In the opinion of Scott Anders, Product Club's hair foil package represents a new, and non-obvious use, for an existing application. Anders Declaration, paragraph 4. Hair foil, which is claimed to be from 3.5 and 6 inches wide has never been used in the food service industry for the size is too small and not practical for wrapping food products. A roll of aluminum foil packaged in a self dispensing box, containing an integrated cutting blade, being of a width ranging from 3.5 to 6 inches, has never been utilized before in the food service industry, or any other category that he is aware of. Therefore, it is the opinion of Scott Anders that Product Club's product covered by the present patent application is unique and not obvious over Budny and Clatterbuck or any other prior art. Anders Declaration, paragraph 5. Food service roll foil has been around for decades, but always in a width greater than what is claimed in Product

Appeal No. 2004-1240
Application No. 09/742,691

Club's patent application. It is apparent that the use of foil in the beauty industry requires very specific sizing that the food industry has never required. Anders declaration, paragraph 6.

In this Declaration, Scott Anders states that he has reviewed the secondary references of Budny and Clatterbuck, and provides his personal opinion that appellant's claimed invention represents a new and unobvious use for an existing application. Scott Anders also attests that it is his opinion that appellant's claimed invention is unobvious over the prior art.

Hence, the Scott Anders Declaration represents an expression of a personal opinion as to the patentability of appellant's claimed subject matter. While "some weight ought to be given to a persuasively supported statement of one skilled in the art on what was not obvious to him", legitimate inferences from the art of record are weighed against opinions expressed by a declarant. In re Lindell, 385 F. 2d 453, 455, 155 USPQ 521, 524 (CCPA 1967).

In the instant case, the obviousness rejection of claim 1 includes the combination of the AAPA in view of Clatterbuck or Budny. We refer to our discussion of the prima facie case of obviousness involving the combination of the AAPA in view of Clatterbuck or Budny as set forth on pages 5-6 of this decision. As we stated therein, the obviousness rejection is

Appeal No. 2004-1240
Application No. 09/742,691

supported soundly by sufficient motivation found in the prior art. Therefore, the legitimate inferences from the art of record are too strong to be affected by the weight to which the Anders affidavit is entitled. In re Lindell, 385 F. 2d 453, 455, 155 USPQ 521, 524 (CCPA 1967).

E. Declarations of Sorbie, Tanas, and Benbassette

With regard to the Declarations of Sorbie, Benbassette and Tanas, appellant states that these declarants state that there were no foil dispensers with integrated cutting blades used to dispense hair foil for the Beauty Industry, having the features of the claimed invention. Brief, page 9. Appellant states that these declarants indicate that the integrated metal cutting edge was instrumental in their buying decisions. Brief, page 10. We refer to pages 10 -11 of the brief, and to each Declaration, regarding the specific statements made by each of these declarants. Each of these Declarations are summarized below.

The Sorbie Declaration contains statements applauding the integrated metal cutting edge that enables "to cut the foil quickly, efficiently, and precisely".

The Tanas Declaration contains statements pointing out that previous products produced an inaccurate edge to the foil and generated a lot of

Appeal No. 2004-1240
Application No. 09/742,691

waste. Tanas states that "[i]n order to solve this problem, I was forced to purchase several expensive devices to properly dispense the foil. The systems in addition to their cost, are bulky and take up valuable counter space at the workstation. Earlier this year, I tried a roll of hair foil from the Product Club. The metal edge allows us to cut foil and to achieve the end result we need, without the expense and inconvenience of the system we had previously bought".

The Benbassette Declaration contains statements applauding the metal cutting edge of Product Club's dispenser that provides for cutting of foil accurately and expeditiously and thus saves time, while minimizing waste. Benbassette states that "[t]he prior art product we switched from, utilized a corrugated cutting edge that our operators found to be too cumbersome to work with."

The examiner's position on each of these declarations is set forth on page 12 of the answer.

The Declarations of Sorbie, Tanas, and Benbassette represent the personal opinion of each declarant. We therefore evaluate these declarations in the same manner as we evaluated the opinion of Scott Anders in the Anders Declaration, discussed, supra. Each of the declarants states that they purchased appellant's roll foil product because of the integrated cutting blade. Such statements are relevant regarding whether appellant has established

a nexus between the evidence and the merits of the invention, i.e., that the customer bought the product because of the features of the claimed invention. Evidence showing that the customer bought the product because of features of the claimed invention is necessary. In re Huang, 100 F.3d 135, 139, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996).

The Tanas and Benbasette Declarations do touch upon the long-felt need consideration. For example, Tanas indicates that an art recognized problem was that corrugated cutting edges produced an inaccurate edge to the foil and generated a lot of waste. The problem was such that Tanas had to purchase "several expensive devices to properly dispense the foil". Benbasette states that "[t]he prior art product we switched from, utilized a corrugated cutting edge that our operators found to be too cumbersome to work with."

F. The Weight of the Prima Facie Case of Obviousness Versus the Weight of the Rebuttal Evidence

As stated, supra, persuasive secondary considerations still may not outweigh a strong showing of obviousness based on the other Graham factors. See, e.g., Richardson-Vicks Inc. v. Upjohn Co., supra. The weight of the legitimate inferences from the art of record are compared with the weight of the rebuttal evidence to determine whether the rebuttal evidence

Appeal No. 2004-1240
Application No. 09/742,691

overcomes the prima facie case. In re Lindell, 385 F. 2d 453, 455, 155 USPQ 521, 524 (CCPA 1967.

In the instant case, as stated, supra, the prima facie case is supported soundly by the art of record. On the other hand, appellant has not provided convincing "commercial success" or "copying" evidence, as discussed above. Some of the Declarations touch upon the "long-felt need" consideration with some merit (Tanas, Benbassette Declarations). However, the rebuttal evidence as a whole does not outweigh the thrust of the prima facie case of obviousness. We therefore determine that the rebuttal evidence does not overcome the prima face case of obviousness.

Appeal No. 2004-1240
Application No. 09/742,691

V. Conclusion

The anticipation rejection is reversed.

Each of the obviousness rejections is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 35 CFR § 1.136(a).

AFFIRMED

TERRY J. OWENS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD PATENT
JEFFREY T. SMITH)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
BEVERLY A. PAWLIKOWSKI)	
Administrative Patent Judge)	

BAP:psb

Appeal No. 2004-1240
Application No. 09/742,691

Philip M. Weiss
Weiss & Weiss
Suite 201
310 Old Country Road
Garden City, NY 11530