

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. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex Parte* MEIXNER HANS-WERNER

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Appeal No. 1996-1945  
Application 07/960,421

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ON BRIEF

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Before, KIMLIN, KRATZ and JEFFREY T. SMITH, *Administrative Patent Judges*.

JEFFREY T. SMITH, *Administrative Patent Judge*.

*Decision on appeal under 35 U.S.C. § 134*

Applicants appeal the decision of the Primary Examiner finally rejecting claims 2, 3, 5-16, 18-24, and 26-34. We have jurisdiction under 35 U.S.C. § 134.<sup>1</sup>

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<sup>1</sup> The claims on appeal have been amended by an after final amendment, paper no. 16, filed February 17, 1995. The Examiner has indicated that the amendment has been entered into the record. (See Examiner's Answer, page 1).

**BACKGROUND**

The invention is directed to a recyclable packaging receptacle which is useful for storing solid and liquid food products. The recyclable package is formed from a metal sheet which has at least one side coated with a plastic coating. Claim 26 which is representative of the invention is reproduced below:

26. A self-supporting recyclable packaging receptacle, comprising:

a bendable initially flat metal sheet having margins around the periphery thereof, said metal sheet further having a top and bottom major surface;

a plastic coating material applied to at least one of said top and bottom major surfaces of said metal sheet, said plastic coating releases no environmentally incompatible pollutants apart from CO<sub>2</sub>;

fold and creases in said metal sheet formed by bending and creasing said metal sheet, said folds and creases bringing at least two of said margins of said metal sheet together in an adequate contacting relationship for welding;

a weld formed by heat-sealing said contacting margins; and

metal sidewalls and metal end walls formed by said folds and creases which produce the self-supporting shape of said self supporting packaging receptacle, and wherein said receptacle is recyclable, and said metal is meltable.

As evidence of obviousness, the Examiner relies on the following reference:

Moretti  
European Patent Application

EP 0196721

Oct. 8, 1986

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### ***THE REJECTION***

The Examiner entered the following ground of rejection:

Claims 2-3, 5-16, 18-24 and 26-34 are rejected as unpatentable under 35 U.S.C. § 103 over Moretti. (Examiner's Answer, page 3).

### ***OPINION***

We will limit our discussion to claim 26, the sole independent claim.

It is well established that the examiner has the initial burden under § 103 to establish a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). To that end, the examiner must show that some objective teaching or suggestion in the applied prior art, or knowledge generally available in the art, would have led one of ordinary skill in the art to arrive at the claimed invention. *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996).

The Examiner asserts the claimed invention is unpatentable over Moretti.

Specifically the Examiner states:

'721 [Moretti] discloses packaging receptacles comprising an intermediate metal layer (9) and dual thermoweldable plastic layers (8, 10). The plastic is polyethylene, the metal is aluminum, page 3, line 30. The metal is oxidizable. The polyethylene layer would inherently release no

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environmentally hazardous pollutants. It is the position of the Examiner that applicants claimed structure having end walls and four side walls, and the overlapping contacting relationship of the margins for welding is an obvious structural change that would have been obvious to one having ordinary skill in the art as this is tantamount to a change of shape from a bag to a box. (Examiner's Answer, paragraph bridging pages 3 and 4).

The Examiner appears to have applied a *per se* obviousness standard. However, there is no *per se* test for obviousness. *In re Ochiai*, 71 F.3d 1565, 1569, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995). The question is not whether the modification could be made to change the shape from a bag to a box, but rather “whether it was obvious to do so in light of all the relevant factors.” *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997). “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); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989). The Examiner has not provided any reason for modifying the structure of Moretti to arrive at the claimed invention. The package of Moretti is in the form of a bag, which does not include metal sidewalls and metal end walls. The Examiner asserts making a box out of a bag is “a very simple maneuver, not involving an inventive step.” (Examiner's Answer, page 4, lines 18-19). The Examiner does not specifically indicate why one of ordinary skill in the art, based on the

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disclosure of Moretti, would have found it obvious to make a recyclable packaging receptacle which includes metal sidewalls and metal end walls formed by folds and creases resulting in a self-supporting packaging receptacle.

The Examiner has not addressed Appellant's comments regarding the patentability of the dependent claims.

In the absence of sufficient factual evidence or scientific rationale to establish why and how a skilled artisan would have arrived at the subject matter of claims 2-3, 5-16, 18-24 and 26-34 from the applied reference, we find that the initial burden of establishing the *prima facie* obviousness of the claimed subject matter has not been met. The 35 U.S.C. § 103 rejection of claims 2-3, 5-16, 18-24 and 26-34 is reversed.

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**CONCLUSION**

The rejection of claims 2-3, 5-16, 18-24 and 26-34 as unpatentable under 35  
U.S.C. § 103 over Moretti is reversed.

**REVERSED**

	)	
EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
PETER F. KRATZ	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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Administrative Patent Judge	)	

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