

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* KEVIN C. MCDONOUGH

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Appeal No. 97-3402  
Application No. 08/513,705<sup>1</sup>

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ON BRIEF

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Before CALVERT, COHEN and ABRAMS, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

**DECISION ON APPEAL**

This is an appeal from the decision of the examiner finally rejecting claims 1-3, 6, 7, 9, 11-19 and 21-23, which constitute all of the claims remaining of record in the application.

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<sup>1</sup>Application for patent filed August 11, 1995.



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The rejection is explained in Paper No. 6 (the final rejection), and in the Examiner's Answer.

The opposing viewpoints of the appellant are set forth in the Brief.

#### **OPINION**

After consideration of the positions and arguments set forth by both the examiner and the appellant, we have concluded that the teachings of the reference relied upon fail to establish a *prima facie* case of obviousness with respect to the claimed subject matter. This being the case, we will not sustain the rejection. Our reasons for this decision follow.

The claims are rejected under 35 U.S.C. § 103, and therefore the examiner bears the initial burden of presenting a *prima facie* case of obviousness (see *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)), which is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art (see *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)).

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All four independent claims recite an outer bag and an inner liner joined to the outer bag, and require that the inner liner be "larger in size than the outer bag." As the appellant explained in the specification, there is a reason for this, and it is "to allow for complete filling and stretching of the bulk bag container to occur" (specification, page 7). The appellant argues that this is a patentable distinction over the bulk bag disclosed by Futerman, equating "larger in size" to "larger in volume" (Brief, page 5). This interpretation is supported by the examples set forth on pages 9 and 10 of the specification, wherein the dimensions of the inner liner are appreciably greater than those of the outer bag (pages 9 and 10).

This feature is not taught by Futerman, which also is directed to a bulk storage container having an outer bag and an inner liner. The reference teaches that the circumference of the liner is "slightly less" than that of the outer bag (column 2, lines 50 and 51). Notwithstanding this, the examiner has taken the position that since in Futerman the length of the inner liner is greater than the outer bag, the volume of the inner liner will be greater even when

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considering that the circumference of the inner liner is less than the outer bag, and thus the conditions of the appellant's claims are met. We do not agree with this reasoning.

The inner bag disclosed by Futerman has no bottom (column 2, lines 49 and 50), and Futerman teaches making the sides of the inner bag longer than those of the outer bag so that they can fold inward at the bottom corners of the outer bag to "ensure that the base seams [of the outer bag] are covered without any need to stitch the liner to the base of the bag" (column 3, lines 1-5). The examiner has proposed to modify the Futerman bag by adding a bottom (Paper No. 4) in order to meet another condition of the claims. Even considering, *arguendo*, that such would have been obvious, it is our view that one of ordinary skill in the art would have had no reason to maintain the extra length of the sides, for the presence of a bottom would have alleviated the problem solved by that extra length. The inner bag of the modified Futerman container therefore would have had a circumference less than that of the outer bag and a length no greater than that of the outer bag, with the result being that its size would not be larger than that of the outer bag.

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It therefore is our opinion that the teachings of the reference fail to establish a *prima facie* case of obviousness with regard to the claimed limitation that the inner liner be larger in size than the outer bag.

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The decision of the examiner is reversed.

**REVERSED**

	IAN A. CALVERT	)	
	Administrative Patent Judge)	)	
	)	)	
	)	)	
	IRWIN CHARLES COHEN	)	BOARD OF
PATENT	Administrative Patent Judge)	)	APPEALS AND
	)	)	INTERFERENCES
	)	)	
	NEAL E. ABRAMS	)	
	Administrative Patent Judge)	)	

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