

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SUZANNE BETTS

Appeal No. 98-0383
Application No. 08/549,869¹

ON BRIEF

Before McCANDLISH, *Senior Administrative Patent Judge*, 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 and 6. Claims 2-5 have been canceled. No claims have been allowed.

¹Application for patent filed October 30, 1995.

The appellant's invention is directed to a sheet of wrapping paper having pressure sensitive adhesive material adhered to a portion thereof (claim 6), and to the combination of the sheet with a gift box (claim 1). The claims before us on appeal have been reproduced in an appendix to the Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Culberg <i>et al.</i> (Culberg) 13, 1970	3,489,333	Jan.
Weder <i>et al.</i> (Weder '229) 1991	5,007,229	Apr. 16,

Additional reference applied by the Board:

Weder (Weder '638) 1992	5,111,638	May 12,
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THE EXAMINER'S REJECTIONS

Claim 1 stands 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 appellant regards as the invention.²

Claims 1 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Weder '229 in view of Culberg.

The examiner's rejections are explained in the Answer.

The arguments of the appellant in opposition to the examiner's positions are set forth in the Brief.

OPINION

The Rejection Under 35 U.S.C. § 112, Second Paragraph

This rejection is directed to claim 1, and is based upon the examiner's belief that the phrase "having a variety of shapes and sizes," used to describe the gift box, "is considered indefinite because it is not clear what specific shape of the gift box is being claimed" (Answer, page 4). The appellant has acquiesced to this rejection, and we therefore shall sustain it.

²Although not made the subject of a rejection, the examiner noted in the Answer that the appellant's amendment of December 17, 1996, added new matter to the specification and to the claims. The appellant has, however, stated that this material would be removed at the earliest opportunity.

The Rejection Under 35 U.S.C. § 103

The examiner has rejected both claims as being unpatentable over Weder '229 in view of Culberg. We have evaluated this on the basis that 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)). This is not to say, however, that the claimed invention must expressly be suggested in any one or all of the references. Rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art (see *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025, 226 USPQ 881, 886-87 (Fed. Cir. 1985)), considering that a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.

Claim 6 is the broader of the two claims, and we shall begin our analysis there. This claim is directed to a self adhering wrapper for use with a gift box. The wrapper has a front surface and a back surface. A "pressure sensitive adhesive material" is adhered to the periphery of the back surface, wherein "the adhesive material attached thereto may be wrapped about the . . . [gift box] whereby portions of the adhesive material contactingly engage and attach to portions of the wrapping material for generally detachably securing the sheet of material." A continuous detachable backing strip is releasably adhered to the adhesive portion, to be peeled off before positioning the material around the gift box.

As to claim 6, the examiner's position is that Weder '229 discloses all of the subject matter recited except for the protective backing strip over the adhesive, which in his view is taught by Culberg and would have been an obvious addition to the wrapping paper of Weder '229. The examiner apparently is of the view that the "cling material" utilized by Weder '229 to self adhere the wrapper to the gift box can be considered to be the "pressure sensitive adhesive material" required by claim 6. The cling material is described in the patent as being film of

the type commonly used in food wrap, and among the appellant's arguments against the propriety of this rejection is that the Weder '229 cling material is not a "pressure sensitive adhesive" as commonly defined in the art or as described in the appellant's specification. We agree, and we note here that the examiner's attempt to cast this argument aside is ill-founded, in that the reference does not teach, as the examiner has implied on page 7 of the Answer, that adhesive can be used instead of the cling material, but teaches that adhesive can be used to attach the cling material to the wrapper.

Thus, Weder '229 fails to disclose or teach the claimed pressure sensitive adhesive or the detachable backing strip installed thereupon. Culberg has been cited for its teaching of placing a backing strip over a pressure sensitive adhesive, but the examiner has not utilized it beyond that point. Such being the case, the examiner's application of the these two references to the claimed subject matter falls short of establishing a *prima facie* case of obviousness with regard to the subject matter recited in claim 6. We therefore will not sustain this rejection.

Claim 1 is directed to the combination of a gift box and a sheet of flexible wrapping material for placing around the gift box. It recites the same requirements for the wrapping material, in somewhat different language, but including the "pressure sensitive adhesive material." The same rejection has been applied against it and, as was the case with claim 6, it also is fatally defective for the same reasons as were explained above.

There is an additional reason why the rejection of claim 1 cannot be sustained. This claim also requires the presence of a "protective contact portion" on the front surface of the wrapping material, which portion is defined as a material from which pressure sensitive adhesive can be removed without damage to the underlying surface. As described in the last four lines of the claim, when the wrapping material is wrapped about the gift box the pressure sensitive adhesive portion can contactingly engage portions of the front of the wrapping paper where the protective contact material is located, thereby being detachably secured thereto. This structure is not taught by either of the references.

The examiner's rejection of claim 1 is not sustained.

New Rejection By The Board

Pursuant to our authority under 37 C.F.R. § 1.196(b), we enter the following new rejection:

Claim 6 is rejected under 35 U.S.C. § 103 as being unpatentable over Weder '638³ in view of Culberg. As described by the appellant on page 4 of the specification as one of four examples of the prior art, Weder '638 discloses a method for wrapping an object with a material "having pressure sensitive adhesive thereon" (lines 4-5), which "do not describe [a] self adhering wrapper that is pre-sized and comes with a container and a sheet of material with an adhesive strip for wrapping a variety of items" (sentence bridging pages 4 and 5). With regard to this, we note that claim 6 does not positively recite a container, which causes the statements in this claim relating the sizing of the sheet of wrapping material to a box to be of no patentable significance, and it does not even mention wrapping a variety of items.

³This reference was cited on page 4 of the appellant's specification as an example of the prior art, and thus is not unknown to the appellant.

Claim 6 is directed to a self adhering wrapper which comprises a rectangular sheet of material having a front surface and a back surface, a pressure sensitive material adhered only to the periphery of the back surface and forming a continuous uninterrupted rectangular adhesive frame about the rectangular sheet, and a continuous detachable attached backing strip releasably adhered over the adhesive portion of the periphery only of the wrapping material to thereby form a continuous rectangular frame having a periphery co-extensive with the periphery of the adhesive material and the rectangular sheet.

Weder '638 discloses a number of embodiments of wrapping sheets having pressure sensitive adhesive portions on one side. Of particular interest are the ones shown in Figures 11 and 12, which are sheets of wrapping material provided around their entire peripheries with a continuous uninterrupted rectangular frame of pressure sensitive adhesive material. The usefulness of these sheets in wrapping packages is specifically mentioned (column 9, line 23; column 10, line 3). While with specific regard to Figure 11 the patent states that when used as a wrapping for packages "it is preferable in some applications"

to use the type of pressure sensitive adhesive which will bond only to itself (column 9, lines 30-33), the definition of "pressure sensitive adhesive" which appears early on in this reference in the description of the embodiment shown in Figures 1 and 2 is "any substance, inorganic or organic, natural or synthetic, that is capable of bonding to other surfaces or to other surfaces coated with a like pressure sensitive adhesive" (column 3, lines 17-19, emphasis added). Therefore, while a limitation to this effect is not recited in the appellant's claim 6, it is clear that Weder '638 would have suggested to the artisan that both types of pressure sensitive adhesive can be used in wrapping packages.

Weder '638 discloses all of the subject matter positively recited in claim 6 except for the detachable attached backing strip over the pressure sensitive adhesive, which is removed prior to wrapping the package. Culberg provides evidence that this feature was known in the art at the time of the appellant's invention. As shown in Figures 1-5 and explained in the specification, backing sheets 17, 19 and 24 cover pressure sensitive adhesive strips 15 until the point at which the surfaces of the wrapping sheet are to be adhered, at which

time the backing strips are removed. It is our view that it would have been obvious to one of ordinary skill in the art to utilize a continuous detachable backing strip over the pressure sensitive adhesive of Weder '638, suggestion being found in the self evident advantages of protecting the adhesive from contamination and preventing bonding from occurring until the proper moment, which would have been known to the artisan, who is considered to possess skill rather than lack it. See *In re Sovish*, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985).

It therefore is our conclusion that the combined teachings of Weder '638 and Culberg establish a *prima facie* case of obviousness with regard to the subject matter of claim 6.

SUMMARY

The examiner's rejection of claim 1 under Section 112 is sustained.

The examiner's rejection of claims 1 and 6 under Section 103 is not sustained.

A new rejection of claim 6 under Section 103 has been made.

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The decision of the examiner is affirmed-in-part.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 C.F.R. § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 C.F.R. § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 C.F.R. § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 C.F.R. § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 C.F.R. § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART
37 C.F.R. § 1.196(b)

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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)	BOARD OF PATENT
IRWIN CHARLES COHEN)	APPEALS
Administrative Patent Judge)	AND
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