

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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID B. EDWARDS, WILLIAM J. McCARTHY,
LEONARD E. HODAKOWSKI, CHI-YU R. CHEN,
SAMUEL T. GOUGE, and PAUL J. WEBER

Appeal No. 1998-1870
Application No. 08/447,063

ON BRIEF

Before COHEN, PATE, and NASE, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 30 through 38 and 41 through 50. These claims constitute all of the claims remaining in the application.

Appeal No. 1998-1870
Application No. 08/447,063

30, a copy of which appears in the APPENDIX to the brief (Paper No. 17).

As evidence of obviousness, the examiner has applied the documents listed below:

Hodakowski et al (Hodakowski)	5,080,226	Jan. 14, 1992
Edwards et al (Edwards) (PCT)	WO 89/12587	Dec. 28, 1989
Phillips et al (Phillips) (Great Britain)	922,317	Mar. 27, 1963
Chikaishi et al (Chikaishi) (Japan)	47-88331	Apr. 30, 1974
Uchiyama (Japan)	61-33739	Aug. 22, 1987

The following rejections are before us for review.¹

Appeal No. 1998-1870
Application No. 08/447,063

Claims 30, 32, 33, 35 through 38, 41, 49, and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Uchiyama in view of Chikaishi.

Claims 30, 31, 33 through 38, 41, 49, and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Phillips in view of Chikaishi.

Claims 30 through 33, 35 through 38, 41, and 44 through 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Edwards in view of Chikaishi.

Claims 42 and 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hodakowski in view of Chikaishi

The full text of the examiner's rejections and response to the argument presented by appellants appears in the final rejection and the answer (Paper Nos. 12 and 19), while the

Appeal No. 1998-1870
Application No. 08/447,063

In the main brief (page 4), appellants indicate that the claims do not stand or fall for the reasons given in the argument section. This statement is followed by the additional commentary in the reply brief (page 5). However, only claims 34, 49, and 50 are specifically referenced and addressed (main brief, page 11). Apart from these dependent claims, the other dependent claims are not each specifically referenced and addressed relative to the applied prior art teachings. Thus, as to these other dependent claims, appellants have simply not complied with 37 CFR § 1.192(c)(7) in explaining why each is separately patentable.

OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellants' specification and claims,² the applied teachings,³

² A copy of claim 40, in error, appears in the APPENDIX to

Appeal No. 1998-1870
Application No. 08/447,063

and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determinations which follow.

We sustain each of the examiner's rejections of appellants' claims under 35 U.S.C. § 103(a).

As appreciated by appellants (main brief, page 8), each of the examiner's obviousness rejections relies upon a common secondary reference to Chikaishi considered with a different base reference. Appellants' particular focus is upon the Chikaishi teaching and why an "ordinary artisan would not have looked to Chikaishi" (brief, page 8). More specifically, appellants' position is that Chikaishi is non-analogous art (main brief, pages 5 through 7 and reply brief, pages 1 through 3). As explained below, this panel of the Board, like the examiner

Appeal No. 1998-1870
Application No. 08/447,063

(answer, pages 5 and 6), is of the view that the Chikaishi document is clearly, highly relevant, and analogous prior art.

It is well settled that prior art relevant to an obviousness determination encompasses not only the field of the inventor's endeavor but also any analogous arts. Heidelberger Druckmaschinen AG v. Hantscho Commercial Products Inc., 21 F.3d 1068, 1071, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994). The test of whether a reference is from a nonanalogous art is first, whether it is within the field of the inventor's endeavor, and second, if it is not, whether it is reasonably pertinent to the particular problem with which the inventor was involved. In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). A reference is reasonably pertinent if, even though it may be in a different field of endeavor, it is one which because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992).

Appeal No. 1998-1870
Application No. 08/447,063

(polyvinylalcohol), and containing agrochemicals, is the fact of defects (e.g. bubbles) that may be present in film which can lead to weaknesses and become a source of leakage through pinholes at the point of the defect.

Faced with a film packaging problem due to film defects as above, we are convinced that an inventor would have been not only motivated to, but expected to, look to available film packaging knowledge for a solution to the film defect problem. Thus, it is our view that the Chikaishi reference would have been uncovered since it pertains to polyvinyl alcohol (PVA) films used in packaging various goods (pages 1 and 2). More specifically, this document teaches laminating two or more sheets of PVA film (page 6) and expressly reveals the knowledge in the art of solving the problem of film pinholes since, as explained in the document (page 6),

[i]f any small bubbles were present in one layer of the laminated film, such bubbles may be compensated by the

Appeal No. 1998-1870
Application No. 08/447,063

In light of the above, we share the examiner's assessment that the Chikaishi document is reasonably pertinent to the pinhole problem in a packaging film, as addressed by appellants, in that it is clearly a teaching that would have commended itself to an inventor in considering the specific problem of pinholes in packaging films. Accordingly, Chikaishi is fairly viewed as appropriate, highly relevant, and analogous prior art.

In applying the test for obviousness,⁴ we make the determination that it would have been obvious to one having ordinary skill in the art, from a combined consideration of the respective teachings of Uchiyama, Phillips, Edwards, and Hodakowski with the Chikaishi disclosure, to rely upon a laminated film in fabricating a known package containing an agrochemical. As we see it, the motivation on the part of one having ordinary skill in the art for reconfiguring a known single film package with a laminated film would have simply been to overcome the art recognized film pinhole problem with the art

Appeal No. 1998-1870
Application No. 08/447,063

recognized solution as taught by Chikaishi. Apart from claim 1, we are of the view that the overall knowledge of those practicing the art, as reflected in the applied teachings, would have been suggestive of the subject matter of dependent claims, in particular, the content of claims 34, 49, and 50. Like the examiner (answer, page 8), it is apparent to us that the combined teachings would have been suggestive to one having ordinary skill in the art of doubling the typical film used for bags containing agrochemicals thereby yielding a thickness falling within appellants' range in claim 34. Additionally, as to claims 49 and 50, the suggestion by Chikaishi (page 8) for a lamination of films of the same thickness would yield a ratio of 1, clearly falling within the respective ranges of claims 49 and 50. It is worthy of noting that, as to the content of, for example, claims 34, 49, and 50, the underlying specification does not indicate that the selection of a value within the respective claimed thickness and ratio ranges would achieve a particular advantage or yield an unexpected result.

Appeal No. 1998-1870
Application No. 08/447,063

Chikaishi reference is analogous prior art, notwithstanding appellants' argument to the contrary. We fully appreciate all of the points made by appellants in seeking to distinguish the Chikaishi document from the claimed invention. However, nothing argued diminishes the clear and explicit teaching by Chikaishi, in the packaging art, of the laminated film solution to the film pinhole problem.⁵ Since the rejections are clearly predicated only upon knowledge in the art at the time of the present invention, we disagree with appellants' assertion (main brief, page 10) that the combination of prior art teachings "is only possible because of hind-sight knowledge" of appellants' disclosure. Since the evidence before us clearly supports a conclusion of obviousness, the rejections are sound.

In summary, this panel of the board has sustained each of the examiner's rejections under 35 U.S.C. § 103(a).

Appeal No. 1998-1870
Application No. 08/447,063

The decision of the examiner is affirmed.



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

AFFIRMED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
WILLIAM F. PATE, III)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

ICC:lbg

Appeal No. 1998-1870
Application No. 08/447,063

EUGENE C. RZUCIDLO
MORGAN & FINNNEGAN, L.L.P.
345 PARK AVENUE
NEW YORK, NY 10154