

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOHN J. McGLEW and HENRY L. McVICKAR III

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Appeal No. 1998-2065  
Application 08/713,788

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ON BRIEF

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Before STAAB, McQUADE and BAHR, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

John J. McGlew et al. appeal from the final rejection of claims 1, 2, 6, 7 and 9 through 16, all of the claims pending in the application.<sup>1</sup> We reverse.

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<sup>1</sup> Claims 1, 7 and 13 have been amended subsequent to final rejection.

The invention relates to a garbage/trash bag which "is easy to close for removal of the trash and garbage and for the containment of the trash and garbage within the trash bag but which also has an effective means for keeping the top end of the trash bag in position relative to a trash can" (specification, pages 2 and 3). Claims 1, 6 and 13 are representative and read as follows:

1. A garbage bag, comprising:

a top end defining a loop space; and

a loop element disposed in said loop space, said loop element being substantially ring shaped and including at least an elastic portion for maintaining said loop at a first diameter whereby said loop may be stretched to a second diameter which is greater than said first diameter, said elastic portion includes an elastic element forming a ring and fibrous material connected to said elastic element, surrounding said elastic element, said fibrous material being disposed between said elastic element and said garbage bag forming said loop space.

6. A garbage bag according to claim 1, wherein said loop element comprises an elastic portion and a plastic portion.

13. A garbage bag, comprising:

a top end defining a loop space; and

a loop element disposed in said loop space, said loop element being substantially ring shaped and including at least an elastic portion having a first diameter and a plastic portion, said loop being stretchable to a second diameter

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which is greater than said first diameter, said elastic portion including an elastic ring and said plastic portion surrounding at least a portion of said ring, said plastic portion being formed of a material selected to stretch upon a stretching of said elastic portion wherein said elastic portion is elastically deformable and said plastic portion is plastically deformable, said plastic portion including a non elastic loop extension.

Claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,232,118 to Samuel.

As explained by the examiner,

Samuel discloses everything except the fibrous material connected to the elastic element. An elastic element with fibrous material attached is nothing more than "apparel elastic." It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute apparel elastic for Samuel's elastic element 20 because apparel elastic and element 20 are equivalent elements which perform the same function [examiner's answer, Paper No. 10, page 3].

Claims 6, 7 and 9 through 16 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which fails to provide "an adequate written description of a loop element having an elastic portion and a plastic portion. It is not clear what the structures of these two elements are or how or where they are attached" (examiner's answer, page 3).

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Claims 13 through 16 also stand rejected under 35 U.S.C. § 112, first paragraph, because "[t]hese claims are directed to new matter. There is no support in the original disclosure for the limitation requiring a 'loop extension' as recited in the last line of claim 13" (examiner's answer, page 3).

Having carefully reviewed the content of the appealed claims, the disclosure in the instant application, the teachings of the Samuel reference and the respective viewpoints advanced in the appellants' main and reply briefs (Paper Nos. 8 and 11) and the examiner's answer (Paper No. 10), we have come to the conclusion that none of the appealed rejections is well founded.

Turning first to the 35 U.S.C. § 103(a) rejection of claims 1 and 2, Samuel discloses a trash bag "provided with a stretchy elastic top to stretch over the mouth of a container to securely hold the top around the outside of the container and means are provided for effecting a pull tie to secure the bag closed" (Abstract). In a first embodiment (see Figures 1 and 4), the bag 11 includes a folded-over channel 16 at its

upper end and an elastic loop 20 within the channel. The folded-over channel may be slotted as at 22 to allow access to the elastic loop whereby it can be utilized to tie the bag closed. In a second embodiment (see Figures 5 and 6), the bag 110 includes two folded-over channels 160, 161, a string tie 30 within one channel and a separate elastic loop 200 within the other channel.

As indicated above, the examiner concedes that Samuel does not meet the limitations in claim 1 requiring the claimed garbage bag to comprise a fibrous material connected to and surrounding the elastic element and disposed between the elastic element and the garbage bag forming the loop space. According to the appellants' specification, the fibrous material "enhances the strength/elongation characteristics of the elastic loop element (to ensure good support of the bag end relative to the trash/garbage can), and/or reduces friction relative to the bag and/or provides at least a portion which is graspable by the user, for cinching or tying the bag end" (page 4; also see page 7). The Samuel trash bag does not have any such fibrous material, a deficiency which

finds no cure in the fact that apparel elastic is admittedly old and well known (see page 7 in the main brief). The examiner's conclusion that it would have been obvious to substitute apparel elastic for Samuel's elastic loop 20 because they are equivalent elements which perform the same function is unsound for two reasons. First, the examiner has not proffered any evidence establishing that Samuel's elastic loop 20 and apparel elastic are, or would have been recognized as, functional equivalents. Second, expedients which are functionally equivalent to each other are not necessarily obvious in view of one another. In re Scott, 323 F.2d 1016, 1019, 139 USPQ 297, 299 (CCPA 1963). Here, there is nothing in the teachings of Samuel and the conventional knowledge of apparel elastic which would have made it obvious to one of ordinary skill in the art to modify the Samuel trash bag in the manner proposed by the examiner.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 1, or of claim 2 which depends therefrom, as being unpatentable over Samuel.

With regard to the 35 U.S.C. § 112, first paragraph,

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rejection of claims 6, 7 and 9 through 16, the examiner's explanation is not clear as to whether the rejection is based on a purported failure of the appellants' specification to comply with the written description requirement or the enablement requirement of this section of the statute.<sup>2</sup> For the sake of completeness, we have analyzed the rejection in terms of both.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventors had possession at that time of the later claimed subject matter, rather than the presence or absence of

literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The content of the drawings may also be

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<sup>2</sup> The written description and enablement requirements of 35 U.S.C. § 112, first paragraph, are separate and distinct. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

considered in determining compliance with the written description requirement. Id.

The recitation in claims 6, 7 and 9 through 16 of a loop element having an elastic portion and a plastic portion finds clear support in the original disclosure in the paragraph bridging specification pages 3 and 4, in the brief and detailed descriptions of Figure 9 on specification pages 6 and 9, respectively, and in original claims 6 and 7. Thus, the disclosure of the application as originally filed would reasonably convey to the artisan that the appellants had possession at that time of a garbage bag comprising a loop element having an elastic portion and a plastic portion. Hence, the recitation of such a loop element in claims 6, 7 and 9 through 16 does not pose a written description problem.

Insofar as the enablement requirement is concerned, the dispositive issue is whether the appellants' disclosure, considering the level of ordinary skill in the art as of the date of the application, would have enabled a person of such skill to make and use the claimed invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212

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USPQ 561, 563-64 (CCPA 1982). In calling into question the enablement of the appellant's disclosure, the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement. Id.

Although the appellants' disclosure of a loop element having an elastic portion and a plastic portion is somewhat lacking in detail, it is not apparent, nor has the examiner cogently explained, why such disclosure would not have enabled a person of ordinary skill in the art to make and use without undue experimentation a garbage bag having this relatively simple and straightforward structure. Thus, on the record before us, the appellants' disclosure of a loop element having elastic and plastic portions does not pose an enablement problem.

In light of the foregoing, we shall not sustain the standing 35 U.S.C. § 112, first paragraph, rejection of claims 6, 7 and 9 through 16.

As for the additional 35 U.S.C. § 112, first paragraph, rejection of claims 13 through 16, the examiner's characterization of the "loop extension" limitation in claim

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13 as "new matter" lacking support in the original disclosure indicates that the rejection is predicated on an alleged failure of the specification to comply with the written description requirement. Although the appellants' original disclosure does not expressly mention a "loop extension," it does provide the requisite support for this limitation in the original detailed description of Figure 9 on specification page 9. While this description is somewhat garbled, it is readily apparent that the segment of non-elastic (plastic) portion 74 on the right side of Figure 9 constitutes an "extension" which is associated with the "loop" formed by elastic portion 72 and non-elastic portion 74 on the left side of Figure 9, i.e., a loop extension. Thus, here again the disclosure of the application as originally filed would reasonably convey to the artisan that the appellants had possession at that time of a garbage bag comprising a "loop extension" as recited in claim 13.

Therefore, we shall not sustain the standing 35 U.S.C. § 112, first paragraph, rejection of claim 13 or of claims 14 through 16 which depend therefrom.

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In summary, the decision of the examiner to reject claims  
1, 2, 6, 7 and 9 through 16 is reversed.

REVERSED

LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
JOHN P. McQUADE	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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