

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. 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 DON L. BIERLY

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Appeal No. 2000-0487  
Application No. 08/856,228

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ON BRIEF

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Before ABRAMS, McQUADE, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 7 to 9, 11, 12, 14, 15 and 20. Claim 2 to 6 and 13 have been objected to as depending from a non-allowed claim. Claims 10 and 16 to 19 have been withdrawn from consideration under 37 CFR § 1.142(b) as being drawn to a nonelected invention. Claim 1 has been canceled.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a display carton and a slide-out tray. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record (the applied prior art) relied upon by the examiner in rejecting the appealed claims are:

Whiley 1941	2,238,545	Apr. 15,
Lee 1944	2,339,176	Jan. 11,
Bekoff 1956	2,771,986	Nov. 27,
Jones 1962	3,070,222	Dec. 25,
Chaussadas 1989	4,875,586	Oct. 24,
D'Arques	FR 1,492,902 <sup>1</sup>	Aug. 25, 1967

Claim 20 stands rejected under 35 U.S.C. § 103 as being unpatentable over Bekoff.

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<sup>1</sup> In determining the teachings of D'Arques, we will rely on the translation provided by the USPTO. A copy of the translation is attached for the appellant's convenience.

Claims 7 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over D'Arques in view of Bekoff.

Claims 8, 9, 11 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over D'Arques in view of Bekoff, Jones, Chaussadas and Lee.

Claim 14 stands rejected under 35 U.S.C. § 103 as being unpatentable over Jones in view of Lee and Chaussadas.

Claim 15 stands rejected under 35 U.S.C. § 103 as being unpatentable over Jones in view of Lee, Chaussadas and Whiley.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 13, mailed June 29, 1999) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 12, filed May 20, 1999) and reply brief (Paper No. 14, filed August 20, 1999) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

**Claims 7 to 9, 11, 12 and 20**

We will not sustain the rejection of claims 7 to 9, 11, 12 and 20 under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, 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). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173

USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by **evidence**, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Independent claim 20 reads as follows:

A display carton for holding at least one article, said display carton being formed by a foldable blank, comprising:

a plurality of panels forming a hollow interior of said carton upon erection of said blank to receive said article; and

at least one panel forming a face of the carton having a cutout opening allowing for the partial visual and tactile inspection of said article, said cutout opening being surrounded by a printed silhouette of said article on said face;

the combined visual appearance of the article through said opening and said silhouette providing a substantially full visualization of the article;

whereby said article may be inspected and fully visualized by simulation without opening said carton.

We have reviewed the applied prior art cited by the examiner in the rejection of the claims 7 to 9, 11, 12 and 20

and find ourselves in agreement with the examiner and the appellant that the applied prior art does not teach or suggest a cutout opening being surrounded by a printed silhouette of the article on the face of the carton as set forth in claim 20 (the printed silhouette limitation). To supply this omission in the teachings of the applied prior art, the examiner made determinations (answer, p. 4) that the printed silhouette limitation would have been obvious to an artisan to better attract customers. However, this determination has not been supported by any **evidence** that would have led an artisan to arrive at the claimed invention.<sup>2</sup>

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<sup>2</sup> Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998), cert. denied, 119 S. Ct. 1804 (1999). A broad conclusory statement regarding the obviousness of  
(continued...)

In our view, the only suggestion for modifying the applied prior art in the manner proposed by the examiner to meet the printed silhouette limitation stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under

35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject independent claim 20, as well as dependent claims 7 to 9, 11 and 12, is reversed.

#### **Claims 14**

We sustain the rejection of claim 14 under 35 U.S.C. § 103.

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<sup>2</sup>(...continued)  
modifying a reference, standing alone, is not "evidence." See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Independent claim 14 reads as follows:

A slide-out tray formed of a blank having a planar body and a plurality of horizontal fold lines for securing an article in a carton, comprising:

a fold over cover and a folded pop-in divider formed from spaced slits spanning one of said horizontal fold lines for securing an upper portion of said article; and  
a tube for securing a lower portion of said article including a recess in said tube.

Jones discloses a display and shipping package. As shown in Figure 4, the package is formed from a blank 16 having a plurality of fold lines 18-24. As shown in Figures 1-3 and 6, the package includes (1) a base portion 11 formed from bottom wall 28, front wall 29, top wall 30 and a portion of rear wall 12, (2) openings 32-35 formed in the top wall 30 of the base portion 11 to receive base portions of tumblers 36, (3) diagonal wall 13 with elliptical openings 40-43, (4) top wall 14, and  
(5) top end flange 15.

Chaussadas' invention relates to a carton accommodating a plurality of like articles, such as bottles, wherein a keel is used to maintain the relative spacing of the adjacent bottles

in the group within the carton. As shown in Figure 2, a carton C accommodates a plurality of bottles B arranged in a group. The carton comprises a top panel 18, base panels 12,24 and spaced side wall panels 16,20 interconnecting and hinged to opposed side edges of the top panel and the base panels. One of the bottles Bc is arranged centrally of the group and a locking and separating keel 38 is provided by the top panel which has portions displaced out of the plane of the top panel to hold the central bottle centrally of the group while maintaining the relative spacing of adjacent bottles in the group. As shown in Figure 1, the keel 38 includes step panel 44 hinged to side panel portion 38b along fold line 46 and step panel 50 hinged to side panel portion 38c along fold line 52.

Lee discloses a carton for bottles. As shown in Figures 1-3, the carton is formed from a single blank of cardboard and includes panels 29 and 30 that are cut to produce spacers 31 and the upper end wall panel 24 is provided with a terminal panel 33 having elliptical openings 34.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Jones and claim 14, we agree with the examiner (answer, p. 5) that the only difference is the limitation that the slide-out tray includes a "folded pop-in divider formed from spaced slits spanning one of said horizontal fold lines" for securing an upper portion of the article.

With regard to this difference, the examiner determined (answer, p. 5) that "it would have been obvious in view of Lee and Chaussadas to place dividers between the articles of Jones to prevent article movements."

The argument advanced by the appellant (brief, pp. 14-15; reply brief, pp. 4-5) is unpersuasive for the following reasons.

First, we agree with the examiner (answer, p. 8) that claim 14 is directed to the slide-out tray per se and not to the combination of a slide-out tray in a carton. In that regard, we note the appellant employs only intended use phraseology in claim 14 (**for** securing an article in a carton; **for** securing an upper portion of said article; and **for** securing a lower portion of said article).<sup>3</sup>

Second, we do not agree with the appellant that claim 14 is patentable since Jones fails to show a slide-out tray for a carton. It is our determination that Jones clearly discloses a display and shipping package that is inherently capable of being placed/inserted in a carton. Thus, the limitation of claim 14 of a slide-out tray for a carton is fully met by Jones.

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<sup>3</sup> A statement of intended use does not qualify or distinguish the structural apparatus claimed over the reference. In re Sinex, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962). There is an extensive body of precedent on the question of whether a statement in a claim of purpose or intended use constitutes a limitation for purposes of patentability. See generally Kropa v. Robie, 187 F.2d 150, 155-59, 88 USPQ 478, 483-87 (CCPA 1951) and the authority cited therein, and cases compiled in 2 Chisum, Patents § 8.06[1][d] (1991).

Third, the appellant has argued deficiencies of each reference on an individual basis, however, it is well settled that nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. See In re Merck & Co. Inc., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986).

Fourth, we agree with the appellant that the combined teachings of Jones and Lee would not have suggested the claimed invention and that it would not have been obvious to place the Jones' tray inside the carton of Chaussadas. However, it is our opinion that when the combined teachings of the Jones and Chaussadas are considered,<sup>4</sup> it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Jones' package to have a top panel keel as suggested and taught by Chaussadas for the self-evident advantages thereof.

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<sup>4</sup> Thus, we regard the examiner's application of the teachings of Lee to be mere surplusage.

Lastly, the appellant argues that claim 14 is patentable since (1) Jones requires an over wrap; (2) Jones has no fold over cover; and (3) Jones does not engage and secure the upper portion of the article. We find this argument unconvincing since (1) claim 14 does not preclude an over wrap; (2) Jones does not disclose an over wrap; (3) Jones has a fold over cover (i.e., top wall 14 and top end flange 15); and (4) Jones does engage and secure the upper portion of the article via the uppermost portion of openings 40-43 in diagonal wall 13, top wall 14 and top end flange 15 as shown in Figure 3.

For the reasons set forth above, the decision of the examiner to reject claim 14 under 35 U.S.C. § 103 is affirmed.

**Claim 15**

Claim 15 which depends from claim 14 has not been separately argued by the appellant. Accordingly, we have determined that claim 15 must be treated as falling with independent claim 14. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). Thus, it follows that

the examiner's rejection of claim 15 under 35 U.S.C. § 103 is also sustained.

CONCLUSION

To summarize, the decision of the examiner to reject claims 7 to 9, 11, 12, 14, 15 and 20 under 35 U.S.C. § 103 is affirmed with respect to claims 14 and 15 and reversed with respect to claims 7 to 9, 11, 12 and 20.

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

AFFIRMED-IN-PART

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
JOHN P. McQUADE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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