

The opinion in support of the decision being entered today was **not** written for publication and is **not** precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JERRY E. BUCHANAN

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Appeal No. 2000-0522  
Application No. 08/934,826

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ON BRIEF

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Before CALVERT, NASE, and JENNIFER D. BAHR, Administrative Patent Judges.  
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-6, which are all of the claims pending in this application.

BACKGROUND

The appellant's invention relates to a convertible package and bowl (claims 1-3) and a self sealable bowl (claims 4-6) comprised of flexible sheet material. According to the appellant, an important feature of the invention is its capability to be "converted into an effective serving bowl" (specification, page 2), in that, as explained on page 4 of the specification, the flexible container may be opened widely into a generally squared off configuration and remain so opened. The appellant's specification informs us that this feature is achieved by limiting the height of the sides to less than twice the width of the bottom of the package. An understanding of the invention can be derived from a reading of exemplary claims 1 and 4, which appear in the appendix to the appellant's brief.

The sole prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Akai et al. (Akai) (Japanese patent application)	2-4651	Jan. 9, 1990 <sup>1</sup>
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An additional prior art reference of record relied upon by this panel of the Board in remanding the application to the examiner is:

Erickson et al. (Erickson)	4,837,849	Jun. 6, 1989 <sup>2</sup>
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<sup>1</sup> We derive our understanding of this reference from the translation submitted by the appellant with Paper No. 6.

<sup>2</sup> This reference was cited by the appellant in Paper No. 2 and a copy is of record in the application file.

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The following rejection is before us for review.

Claims 1-6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Akai.

Reference is made to the brief and reply brief (Paper Nos. 13 and 15) and the final rejection and answer (Paper Nos. 5 and 14) for the respective positions of the appellant and the examiner with regard to the merits of this rejection.

#### 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 reference, and to the respective positions articulated by the appellant and the examiner. For the reasons which follow, we cannot sustain the examiner's rejection.

At the outset, we have considered the appellant's arguments on pages 4-8 of the brief that Akai's Figure 1, which shows the seals (fused portions 11) diverging outwardly from the bottom to the top, is not consistent with Figures 2 and 3, which show the seals extending parallel to one another. However, for the reasons cited on page 4 of the answer, we agree with the examiner that there is no such inconsistency in these drawings. While the seals (fused portions 11) are parallel to one another with both the top and the bottom pleat collapsed or with both the bottom pleat expanded and the top open, these seals will inherently diverge outwardly when the pleat is expanded and the top is sealed. Moreover, we also note that the appellant's claim 1 does not require that the seals diverge outwardly in

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both the open and closed configurations.<sup>3</sup> Likewise, we also note that claim 4 does not require that the generally trapezoidal shaped sides present themselves in both the open and closed configurations of the bowl. In fact, the appellant's disclosed bowl exhibits trapezoidal sides only in the closed configuration, as noted by a comparison of Figures 1 and 2.

The examiner concedes that Akai does not clearly teach that the ratio of the height of the opposed sides to the larger width of the bottom of the package disclosed therein is "less than 2 to 1," as required by each of the independent claims. However, the examiner takes the position that

[i]t would have been an obvious matter of design choice in Akai to make the ratio of the height of the sides to the larger width of the rectangular bottom is [sic] less than 2 to 1, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955) [final rejection, page 2].

Akai is silent with regard to the dimensions of the package (stand pack) and the relative height and width thereof. Further, while there is no indication that the drawings are to scale, the height of the illustrated package (Figure 1) appears to be more than twice the length of either of the two dimensions of the bottom. Accordingly, we agree with the examiner's finding that Akai cannot be said to disclose the recited ratio.

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<sup>3</sup> Limitations not appearing in the claims cannot be relied upon for patentability. *In re Self*, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982).

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Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Evidence of a suggestion, teaching or motivation to combine 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, although the suggestion more often comes from the teachings of the pertinent references. The range of sources available, however, does not diminish the requirement for actual evidence. In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

We do not share the examiner's opinion that the modification of Akai to make the ratio of the height of the sides to the larger width of the bottom less than 2 to 1 involves a mere change in size of a component. The modification proposed by the examiner to meet the claimed ratio would involve modification of one dimension relative to another. Moreover, as evidenced by the appellant's specification (page 4, lines 1-5), the appellant's selection of a height-to-width ratio within the claimed

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range was not arbitrary but, rather, was discovered to solve a stated problem (making a package capable of remaining open by itself). In making the rejection, the examiner has not provided any showing of a suggestion or motivation to modify the reference as proposed to arrive at the claimed invention.

The examiner's reliance on In re Rau, 253 F.2d 437, 117 USPQ 215 (CCPA 1958) on page 5 of the answer for the proposition that a patent cannot be granted for an applicant's discovery of a result which would flow logically from the teaching of the prior art does not save the examiner's rejection, because, in this instance, the examiner has adduced no evidence in support of the rejection showing that the claimed ratio, from which the discovered advantage would presumably flow, would have been obvious to one of ordinary skill in the art.

In light of the foregoing, we shall not sustain the examiner's rejection of independent claims 1 and 4, or claims 2, 3, 5 and 6 which depend therefrom.

REMAND TO THE EXAMINER

Pursuant to 37 CFR § 1.196(e), we remand this application to the examiner to consider, on the record, whether the teachings of Erickson would have provided suggestion to one of ordinary skill in the art to modify the Akai package to arrive at the claimed invention. Erickson (column 1, lines 6-9), like Akai (translation, pages 3 and 5), is directed to a plastic package or bag capable of standing up by itself before, during and after being filled. Moreover, Erickson (Figures 7 and 8) specifically teaches, for an approximate 6 cup capacity, a preferred height of 6 inches, a preferred width of 10 inches and a preferred gusset height of 2 inches (thereby rendering the larger width of the rectangular flat bottom approximately 6 inches with the bottom wall expanded). For a 2.9 cup capacity, Erickson teaches a bag having a 5 inch height, an 8 inch width and a gusset height of 2 inches (thereby rendering the larger width of the rectangular flat bottom approximately 4 inches with the bottom wall expanded) to be particularly stable (column 8, lines 4-16). In the case of the 6 cup capacity bag taught by Erickson, the height-to-width ratio is 1, while, in the case of the 2.9 cup capacity, the ratio is 1.25. The examiner should consider whether these teachings would have provided suggestion to one of ordinary skill in the art at the time of the appellant's invention to make the Akai package so as to have a height of 6 inches and larger bottom width of 6 inches, for a 6 cup capacity, or a height of 5 inches and a larger bottom width of 4 inches, for a 2.9 cup capacity, so as to produce stable packages having such capacities. Such packages would have a height-to-width ratio within the claimed range and, thus, would also

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appear to inherently possess the capability of being transformed into a bowl which remains opened (appellant's specification, page 4).

If the examiner finds that the combined teachings of Akai and Erickson would have suggested to one of ordinary skill in the art the claimed invention, the examiner should issue an Office action so rejecting the claims. If, on the other hand, the examiner finds that the teachings of these references are not sufficient to have suggested the claimed invention, the examiner should explain, on the record, why this is the case.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 1-6 under 35 U.S.C. § 103 is reversed and the application is remanded to the examiner for consideration of the issue discussed above.

REVERSED AND REMANDED

IAN A. CALVERT	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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