

**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(2) is not binding precedent of the Board.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. 92

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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STEVEN AUSNIT

Junior Party,<sup>1</sup>

v.

HIROMICHI INAGAKI

Senior Party.<sup>2</sup>

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Patent Interference No. 103,640

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<sup>1</sup> Patent 4,894,975, granted January 23, 1990, based on Application 07/166,024, filed March 9, 1988. Assignor to Illinois Tool Works.

<sup>2</sup> Application Serial No. 08/245,524, filed May 18, 1994. Accorded the benefit of Serial No. 07/257,270, filed October 12, 1988, now abandoned, Serial No. 07/148,352, filed January 25, 1988, now U.S. Patent No. 4,874,257, granted October 17, 1989, Japanese application 62-17738, filed January 27, 1987, Japanese application 62-11027, filed January 28, 1987, Japanese application 62-12404, filed January 29, 1987 and Japanese application 62-63305, filed March 17, 1987. Assignor to Supreme Plastics Ltd.

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FINAL HEARING: May 2, 2000

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Before CALVERT, URYNOWICZ and PATE, **Administrative Patent Judges**.

PATE, **Administrative Patent Judge**.

**FINAL DECISION UNDER 37 CFR § 1.658**

This is a final decision in Interference No. 103,640. The junior party involved patent is U.S. Patent No. 4,894,975 to Steven Ausnit;<sup>3</sup> the senior party involved application is application No. 08/045,254 filed in the name of Hiromichi Inagaki. The patent is assigned to Illinois Tool Works, and the application is assigned to Supreme Plastics Ltd.

The subject matter is directed to a method and apparatus for making a reclosable bag from a sheet of plastic film on a vertically extending filling chute that is used for filling the formed bag. A continuous strip of plastic zipper

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<sup>3</sup> In this decision, the record of Ausnit and Ausnit's exhibits will be abbreviated AR and AX- followed by the appropriate page or exhibit number, respectively. Likewise, Inagaki's record and exhibits are denoted by IR and IX-, respectively.

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strip having a reclosable seal thereon is fed parallel to the sheet of plastic and is joined thereto. The two interlocking members of the reclosable seal remain joined by a separable web that must be severed by the user for access to the interior of the bag.

The count reads as follows:

***COUNT 1***

The method of forming a vertical tubular form fill reclosable bag from a sheet of plastic comprising the steps:

continuously feeding a supply of thin thermoplastic film from a supply means; wrapping the film into tubular shape over a filling spout bringing the lateral edges of the film together in adjacent relationship to form a tube;

feeding a continuous supply of plastic zipper strip having webs with first and second reclosable pressure interlocking members thereon into a space between said film edges; attaching the webs of said members to the film between said film edges so that said strip provides the sole means joining said edges and said strip provides a reopenable closure for a bag formed of said film; and

wherein said interlocking members are joined by one of said webs and said one web must be separated for access to the interior of a bag formed by said film.

The claims of the parties that correspond to the count

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are:

Ausnit:            Claims 1-19  
Inagaki:           Claims 11-26

The final hearing was held May 2, 2000. Both parties submitted main briefs. The junior party submitted a reply brief. Both parties were represented by counsel at the hearing.

***Background***

The Interference was declared on June 21, 1996. During a preliminary motion period, junior party Ausnit filed nine preliminary motions and Inagaki filed one. The Administrative Patent Judge (APJ) granted Ausnit Motion 1 for judgment that all claims of Inagaki were unpatentable to Inagaki under 35 U.S.C.

§ 103. The APJ considered and denied all other motions by either party. Additionally, the APJ placed Inagaki under an order to show cause. The motion decision and show cause order were mailed March 26, 1999. In response to the show cause order, Inagaki requested this final hearing. In response to Inagaki's hearing request, the APJ gave the parties a

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testimony time period for introduction of declaration evidence relied upon during the motion phase of the interference as well as for cross-examination of the declarants. The APJ's testimony letter also set a schedule for filing the record and the briefs.

***Evidence at Final Hearing***

As noted in the background section above, the APJ set a testimony period for the parties to make of record declarations filed in support of preliminary motions and for cross-examination of the witnesses making the declarations. However, we note in the record the presence of new declarations and cross-examination pertinent thereto, added by the senior party during the testimony period. Indeed, during oral argument the senior party repeatedly referred to the new evidence adduced during the testimony period.

Any new evidence adduced by the parties after the close of the preliminary motions period (excepting cross-examination of declarations filed during the motions period) will not be considered by this panel in our decision at

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final hearing. "Proof of any material fact alleged in a motion, opposition or reply must be filed and served with the motion . . . ." 37 CFR

§ 1.639. "[W]here the moving party is in possession of the necessary evidence, there is no legitimate reason why it should not be presented with the motion. If the motion is not accompanied by then available proof of a material fact, no further evidence should be received in the interference in connection with the issue raised in the motion." **Orikasa v. Oonishi**, 10 USPQ2d 1996, 2000 n.12 (Comm'r Pats. & Trademarks 1989). It was not the intention of the "new" rules to permit routine requests to take testimony in lieu of presenting timely affidavits and other available proof of material facts with the motion. **Id.** A good faith effort must be made to submit evidence to support a preliminary motion or opposition when the evidence is available. **Okada v. Hitotsumachi**, 16 USPQ2d 1789, 1790 (Comm'r Pats. & Trademarks 1990).

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Specifically, the second declaration by Edelman<sup>4</sup> will not be considered. In our view, there is no legitimate reason why the factual statements by Edelman could not have been included in the first Edelman declaration filed in opposition to the junior party's unpatentability motion under 37 CFR § 1.633(a). Allowing further direct testimony from Edelman by declaration would permit the senior party a second chance to establish patentability after having "tested the waters" by the first declaration. Such "testing of the waters" has specifically been targeted by this Board as not permitted under our interference rule 37 CFR § 1.639. **See Hanagan v. Kimura**, 16 USPQ2d 1791, 1793 (Comm'r Pats. & Trademarks 1990). It amounts to piecemeal prosecution and is antithetical to the orderly resolution of interferences.

With respect to the declaration of Denis Kissane,<sup>5</sup> entered into the record to establish secondary considerations, the facts presented in this declaration are of the type

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<sup>4</sup> The second Edelman declaration is found at IR75-IR79.

<sup>5</sup> The Kissane declaration is found at IR1 to IR11.

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readily available to the assignee of the involved application.

Here

again, there is no legitimate reason why this declaration was not tendered during the motion period. Accordingly, since this declaration was not submitted with the opposition to the Ausnit motion for judgment during the motion period, we will not consider it at final hearing.

#### ***Standard of Review***

On March 16, 1999, the Patent and Trademark Office issued an interim rule change of patent interference rule 37 CFR

§ 1.655(a). 64 FR 12900. The rule deals with the application of the abuse of discretion standard by a merits panel when considering an interlocutory order entered by a lone APJ acting in an interlocutory capacity. The rule has been changed to emphasize that a panel of the Board will resolve the merits of an interference as a panel without deference to any interlocutory order. Panels will, however, continue to

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apply the abuse of discretion standard but only with respect to procedural matters decided by the lone APJ acting in an interlocutory capacity. Accordingly, we consider the substantive issues dealt with by the APJ in his interlocutory capacity and raised by the parties in their briefs, giving them *de novo* consideration in this decision.

With regard to the date of effectiveness of the interim rule, the interim rule notice states that the amended rule is effective as of the date of publication, *viz.*, March 16, 1999. Accordingly, the review of the APJ's decisions on the preliminary motions has been decided in the following decision without deference to the prior decision by the lone APJ. It is noted that both parties have briefed and argued the issue under the abuse of discretion standard. However, the standard of review instituted by the interim, and now final, rule has been used by the panel in rendering this decision.

### ***Issues***

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The following issues are presented by the parties for consideration in their respective briefs:

i) whether the APJ should have granted the Ausnit motion for judgment based on 35 U.S.C. § 103;

ii) whether the APJ should have denied the Ausnit motion for judgment based on 35 U.S.C. § 135(b);

iii) whether the APJ should have denied the Ausnit motion for judgment based on *res judicata* or collateral estoppel;

iv) whether the APJ should have denied the Ausnit motions to have claims 10-19 and 19-26 designated as not corresponding to the count;

v) whether the APJ should have denied the Ausnit motion for judgment based on the ground of inequitable conduct;

vi) whether the APJ should have denied the Ausnit motion for judgment based on 35 U.S.C. § 112, second paragraph;

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vii) whether the APJ should have denied the Ausnit motions for judgment based on 35 U.S.C. § 112, first paragraph; and

viii) whether the APJ should have denied Inagaki benefit of Japanese application 62-17738.

***Ausnit Motion 1 for Judgment Based on Unpatentability under  
35 U.S.C. § 103***

Ausnit preliminary motion 1, filed pursuant to 37 CFR § 1.633(a) was for judgment that all Inagaki claims, **viz.**, claims 11-26, were unpatentable to Inagaki under 35 U.S.C. § 103. The references cited were Ausnit U.S. Patent Nos. 4,709,533; 3,226,787; and 3,172,443. The APJ granted the Ausnit motion. The following are our findings of fact with respect to Ausnit motion 1:

Ausnit '533 discloses a method and an apparatus for making reclosable plastic bags on a form, fill, and seal machine. Such a machine not only forms the bag, it also fills the bag after forming, and then seals the bag's contents inside. The

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apparatus of '533 works as follows: a thin plastic film 10 is continuously fed via roller 11 into and wrapped around a filling spout 12. As the film encircles the spout, lateral edges 13 and 14 are brought into adjacency to form a tube. A continuous supply of plastic zipper strip 18 having first and second reclosable pressure interlocking members 20 (male) and 21 (female) is fed into the space between the film edges 13 and 14.

Each of the interlocking members has a web above and below the interlocking member. For the male interlocking member, the webs are upper web 20a and lower web 20b. For the female, the upper and lower webs are 21a and 21b, respectively. The web areas of the strip are attached to the film forming a broad area of attachment for a strong bond. Ausnit differs from the subject matter at issue in the interference only to the extent that the upper webs 20a and 21a are not unitary but are fastened together as the bag is sealed forming a fin seal at 24 which must be severed by the user to gain access to the content of the formed and filled bag.

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Ausnit '787 discloses a fastener strip for a reclosable bag. As shown in Figures 4, 5 and 6, the strip has two interlocking members 44 and 45 so that when the sheet is folded the interlocking members face one another. The strip further includes web portions 47 and 48. The two interlocking members are joined together by a unitary central strip or web 46 which makes the strip, the webs, and the interlocking members an integral unit. When applied to the mouth of a bag, the interlocking members are interengagingly sealed and the central strip forms a folded seal outwardly of the interlocking members that must be removed, as shown in Figure 6, to gain access to the contents of the bag. Ausnit '787 differs from the subject matter of Inagaki's involved claims in that Ausnit '787 has no disclosure of a form, fill, and seal machine. This patent is directed only to the sealing strip configuration and its method of use.

Finally, Ausnit '443 is directed to another fastener strip for a reclosable bag. The strip has interlocking members 20 and 21 on webs 16 and 17. Outwardly of the

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interlocking members, flanges 25 and 26 are provided with a line of frangible connections such as spot welds 27 in the Figure 1 embodiment, or a seam 40 with holes 41 therein in the Figure 6 embodiment. Thus, the strips of Ausnit '443 are unitarily connected when formed (see Figure 5) and then applied to a bag.

It is our further finding that Ausnit '787 is evidence of a recognition in the art of the self-evident advantages possessed by the folded integral fastener strip disclosed therein. Foremost is the advantage that the two interlocking member strips as disclosed in Ausnit '787 cannot be misplaced one from the other while in transport or when feeding in the form, fill, and seal machine. The strips of Ausnit '787 are integrally connected, and so one interlocking member necessarily carries its complementary member nearby.<sup>6</sup> Secondly, it is self-evident that the folded strip of Ausnit '787 at the folded edge 54 has a neat and tidy appearance as

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<sup>6</sup> The strips of Ausnit '443 also possess this self-evident advantage.

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compared to the two flattened laminated layers of the fin seal of Ausnit '533. Thirdly, although the '787 patent shows two lines of perforation 49 and 50 for ease of opening, itself an advantage, we note that only one layer of material need be severed, either 49 or 50 to gain access to the contents of the bag. The consumer can gain access to the bag by severing at perforation 49, at perforation 50, or the consumer can remove the entire strip, as shown in Figure 6. In contrast, when opening the fin seal of Ausnit '533, the user must sever two layers of material to gain access to the bag, which layers, since they are laminated, necessarily reinforce one another. Thus, the force needed to open the fin seal is necessarily greater, due to the arrangement of the seal, all other factors being equal.

Alternatively, Ausnit '533 is evidence of recognition in the art of the desirability from an efficiency standpoint of the form, fill, and seal process in materials packaging. Ausnit '533 adds the further teaching that consumers desire a tamper-indicating seal outwardly of the closure strip in a form, fill and seal foodstuff container.

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A claimed invention is unpatentable as obvious "if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter

pertains." 35 U.S.C. § 103(a) (1994); **See *In re Gartside***, 203 F.3d 1305, 1319, 53 USPQ2d 1769, 1778 (Fed. Cir. 2000)

(**quoting *In re Dembiczak***, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999)). "The ultimate determination . . .

whether an invention is or is not obvious is a legal

conclusion based on underlying factual inquiries including:

(1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness." ***Dembiczak***, 175 F.3d at 998, 50

USPQ2d at 1616. The Federal Circuit further indicated "that

the best defense against the subtle but powerful attraction of

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a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *Id.* at 999, 50 USPQ2d at 1617. That suggestion may come from, *inter alia*, the teachings of the references themselves and, in some cases, from the nature of the problem to be solved. *See Gartside*, 203 F.3d at 1319, 53 USPQ2d at 1778 (*citing Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996)).

Since Ausnit '787 and Ausnit '443 supply to the art the teaching that the strips carrying the two interlocking members can be joined in a unitary strip, one with a bent or folded web between the interlocking members and the other with a seam or spot welded line, it would have been *prima facie* obvious to one of ordinary skill at the time of the senior party's invention, to use the unitary reclosable strip fastener of Ausnit '787 or '443 on the form, fill, and seal bag of Ausnit '533. The motivation for this modification would clearly have

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been found in the self-evident advantages the unitary strip has as enumerated above.

Furthermore, as we have mentioned above, Ausnit '533 teaches both the desirability and efficiency of the form, fill, and seal process in plastic packaging. Additionally, '533 teaches that consumers desire a tamper-indicating seal. In view of these teachings, it is our view that it would have been *prima facie* obvious to manufacture the container disclosed in Ausnit '787 on a form, fill, and seal machine as suggested by Ausnit '533. This is an additional suggestion or motivation found in the prior art.

We turn next to the objective evidence of nonobviousness. As noted previously, only the evidence filed by the senior party with the original opposition will be considered at this final hearing. This includes the first declaration by Edelman and the cross-examination pertinent thereto.

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In ¶1 and ¶2 of the first Edelman declaration,<sup>7</sup> Edelman identifies himself and his employer. We fully credit Edelman as an expert in, at least, plastic zipper profile extrusion, although his experience with form, fill, and seal machines is somewhat limited. IR118-119.<sup>8</sup> In ¶3 Edelman states the legal conclusion that it would not have been obvious to combine the teachings of the '787 and the '533 Ausnit patents. With respect to this paragraph, we are in agreement with the APJ that an expert's opinion on the legal conclusion of obviousness is entitled to no weight. "An expert's opinion on the ultimate legal conclusion is neither required nor indeed 'evidence' at all." *Mendenhall v. Cedarapids Inc.*, 5 F.3d 1557, 1574, 28 USPQ2d 1081, 1096 (Fed. Cir. 1993), *cert. denied*, 511 U.S. 1031 (1994) (*quoting Nutrition 21 v. United States*, 930 F.2d

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<sup>7</sup> The first Edelman declaration is found at Exhibit C, Paper No. 35, "Exhibits to Senior Party's Oppositions to Junior Party's Preliminary Motions 1-9."

<sup>8</sup> Here again, we point out that our consideration of the Edelman record has only been to the extent of considering the cross-examination that is pertinent to the first Edelman declaration.

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867, 871 n.2, 18 USPQ2d 1347, 1350-51 n.2 (Fed. Cir. 1991)).

**See also**

***Avia Group Int'l, Inc. v. L.A. Gear Cal., Inc.***, 853 F.2d 1557, 1564, 7 USPQ2d 1548, 1554 (Fed. Cir. 1988). In any event, we additionally point out that the declaration does not qualify the declarant as an expert in patent law.

In ¶3, Edelman premised his conclusion on an alleged incompatibility between Ausnit '787 and Ausnit '533. In ¶4 and ¶5 he elaborates thereon. We are in substantial agreement with his conclusions regarding the disclosure of the '533 patent in ¶4, but we do not agree that "it is not important what material is used to form the reclosable zipper," inasmuch as the bags herein claimed not only function as point of sale containers but also function as storage containers when the seal is broken and a portion of the contents has been removed by the consumer. In this respect there would, indeed, be some importance as to the air-proofness and moisture-proofness of the sealing strips. In ¶5, Edelman analyzes the '787 patent.

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While Edelman states that the closure strips are made of polyethylene or similar material,<sup>9</sup> his analysis is limited to polyethylene. Even if this restriction on the materials considered by Edelman with respect to '787 were valid, we must point out that the bag material in Ausnit '787 is "polyethylene or like material,"<sup>10</sup> so if the closure strips are made of polyethylene, the closures are as moisture-proof or air-proof as the bag wall. Thus, Edelman's conclusion of the unsuitability of polyethylene sealing strips in Ausnit '787 is undercut by the realization that the bags are made of the same or similar material. In our view, moisture-proofness and air-proofness as discussed by the references and Edelman is a relative concept. For the uses contemplated in Ausnit '787, polyethylene for either the bagwall or sealing strips may be sufficiently moisture-proof or air-proof. We do not see the relative property of moisture-proofness or air-proofness as

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<sup>9</sup> Ausnit '787, in column 2, lines 38-51, list several materials both for closure strips and container bags.

<sup>10</sup> See Ausnit '787 at col. 2, line 5.

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raising substantial incompatibility problems among the reference teachings. Therefore, we do not agree with the conclusion of incompatibility stated in ¶6.

In fact, the conclusion of ¶6 appears to be premised more on the argument that the polyethylene strips of Ausnit '787 could not be bodily incorporated into the bags of '533. We are in agreement with the APJ that bodily incorporation is not the proper standard for obviousness under 35 U.S.C. § 103. To justify combining reference teachings in support of a rejection

it is not necessary that a device shown in one reference can be

physically inserted into the device shown in the other. ***In re Keller***, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (***quoting In re Griver***, 354 F.2d 377, 148 USPQ 197 (1966)).

The test for obviousness is not whether the features of a secondary reference

may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be

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expressly suggested in any one or all of the references.

Rather, the test

is what the combined teachings of the references would have suggested to those of ordinary skill in the art. **Keller**, 642 F.2d at 425, 208 USPQ at 881 (**quoting In re Wood**, 599 F.2d 1032, 202 USPQ 171 (CCPA 1979)).

With respect to the heat sealing technologies discussed in ¶¶ 7, 8, and 9, here again, the testimony appears to be that the particular polyethylene film of Ausnit '787 could not be bodily inserted, without modification, into the form, fill, and seal machine of Ausnit '533. We reiterate that bodily incorporation is not the correct standard for § 103, and the particular heaters, like the precise polymer compositions, to be used in the claimed process or apparatus would have been a matter of choice for one of ordinary skill.

We have carefully considered the objective evidence of nonobviousness filed by the senior party during the motions period in opposition to the motion for judgment, and have reached the conclusion that it is entitled to little weight.

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Accordingly, considering all evidence both for and against obviousness, it is our conclusion that the evidence for obviousness substantially outweighs any evidence against obviousness. Therefore, we concur in the obviousness determination made by the APJ in his motion decision and with the **ex parte** panel of this Board that considered and affirmed a rejection<sup>11</sup> on this ground with respect to narrower claims in the senior party's parent application. Accordingly, we will enter judgment against the senior party on the ground of unpatent- ability, hereinbelow.

Having found all of the senior party's claims designated as corresponding to the count as unpatentable over the prior art, it is not necessary for us to consider the issues dealing with the junior party's other arguments regarding the unpatentability of the senior party's claims. Likewise, the issues raised by the junior party's 37 CFR § 1.633(c)(4) motions shall not be decided, inasmuch as the

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<sup>11</sup> Appeal No. 92-1368, Application Serial No. 07/257,270, decision mailed October 26, 1992. Adhered to on reconsideration mailed May 20, 1993.

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junior party will be adjudged entitled to all claims designated as corresponding to the count. Finally, the issue of the senior party's claim for benefit is mooted, since judgment shall be entered against him on patentability.

***Judgment***

Judgment in Interference No. 103,640 is entered against the senior party, Hiromichi Inagaki, on the ground of unpatent-ability. Hiromichi Inagaki is not entitled to a patent containing claims 11-26, which claims correspond to the count in interference. Judgment is entered in favor of Steven Ausnit, the junior party. Steven Ausnit is entitled to his patent containing claims 1-19, which claims correspond to the count in interference.

IAN A. CALVERT )  
Administrative Patent Judge )  
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