

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(2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JAMES M. HAAR  
and  
CHARLES P. HALL

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Appeal No. 95-4590  
Application 08/056,188<sup>1</sup>

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ON BRIEF

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Before FRANKFORT, PATE and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

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<sup>1</sup> Application for patent filed May 3, 1993.

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DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 21 through 24 and 26 as amended subsequent to the final rejection in a paper filed November 29, 1994 (Paper No. 9) and from the examiner's refusal to allow new claim 27 added in Paper No. 9. Claims 21 through 24, 26 and 27 are all of the claims remaining in the application. Claims 1 through 20 and 25 have been canceled.

Appellants' invention relates to a waterproof carrying bag that is suitable for use by boaters, rafters and the like. Independent claim 21 is representative of the subject matter on appeal and a copy of that claim is appended to this decision.

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

Eckert et al. (Eckert)	1,328,988	Jan. 27, 1920
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Hagert et al. (Hagert)	3,830,270	Aug. 20, 1974
Soubie	4,144,607	Mar. 20, 1979

Dry Enclosures, Seasafe #4055, sales brochure from Basic Designs, Inc.<sup>2</sup>

Claims 21, 22 and 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Seasafe #4055 in view of Soubie and Hagert.

Claim 23 stands rejected under 35 U.S.C. § 103 as being unpatentable over Seasafe #4055, Soubie and Hagert as applied to claim 21 above, and further in view of Eckert.

Claim 27 stands rejected under 35 U.S.C. § 103 as being unpatentable over Seasafe #4055 in view of Soubie.

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<sup>2</sup> As indicated by appellants in Paper No. 4, filed May 12, 1994, the Seasafe #4055 bag seen on the sales sheet was shown at a trade show in August 1991 and orders for the bag were taken in January 1992. Thus, the Seasafe #4055 bag is prior art against the present application which was filed May 3, 1993. It is further conceded by appellants that the Seasafe #4055 bag had a rigid cap which screwed onto a semi-rigid collar and that the bag relied upon a "jam-fit" between the cap and the collar for water protection. It is urged by appellants that none of these bags were shipped, because the sealing arrangement did not work.

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Claim 24 stands rejected under 35 U.S.C. § 103 as being unpatentable over Seasafe #4055, Soubie and Hagert.

Rather than reiterate the examiner's full explanation of the basis for the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding the

rejections, we make reference to the examiner's answer (Paper No. 14, mailed May 19, 1995) and the supplemental examiner's answer (Paper No. 16, mailed January 4, 1996) for the examiner's complete reasoning in support of the rejections, and to appellants' brief (Paper No. 13, filed April 7, 1995) and reply brief (Paper No. 15, filed July 24, 1995) for appellants' arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the re-

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spective positions articulated by appellants and the examiner. Upon evaluation of all the evidence before us, we have reached the determinations which follow.

Turning first to independent claim 27 on appeal, we are in agreement with the examiner that the Seasafe #4055 bag is fully responsive to the waterproof carrying bag of appellants' claim 27, except that it lacks a sealing gasket in the closure member. We observe that appellants do not contend otherwise. To supply the sealing gasket, the examiner cites the patent to

Soubie and points out that the bag of Soubie is intended for a similar purpose to appellants' bag and that it teaches a closure member (5) having a compressible sealing gasket (5b) for forming a secure, watertight seal with the neck or collar member (6) of the bag. See particularly, Figure 3 of Soubie. The examiner concludes that since the Seasafe #4055 bag does not disclose the details of the closure member and seal thereof, it would have been obvious to one of ordinary skill

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in the art, from a collective consideration of the teachings of the applied references, to incorporate the teachings of Soubie into the Seasafe #4055 bag so that the closure of the Seasafe #4055 bag forms a good, watertight seal. We concur.

Notwithstanding that appellants agree that the Seasafe #4055 bag has a deformable opening, a semi-rigid collar and a rigid screw-on cap, and that Soubie shows the use of a threaded cap with a compressible gasket in a similar bag, appellants urge that the applied references fail to teach a threaded cap or plug holding a deformable neck in the proper configuration for sealing engagement with a gasket carried by the cap or plug (reply brief, page 2). While it is true that the applied references do not provide any such express teaching, we are of the view that one of

ordinary skill in the art would have recognized that the arrangement of the semi-rigid collar and rigid cap of the Seasafe #4055 bag would provide such a characteristic by holding the neck portion of the semi-rigid collar in a

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configuration conforming to the closure member and thereby allow the neck portion to properly come into engagement with a seal positioned in the closure member in the manner taught by Soubie (Fig. 3). Thus, finding appellants' argument to be unpersuasive, we will sustain the examiner's rejection of claim 27 under 35 U.S.C. § 103.

Considering next the examiner's rejection of independent claim 21 under 35 U.S.C. § 103, we note that claim 21 differs from claim 27 by requiring that the bag as in claim 27 include certain additional features, such as, a tether (39) for retaining the closure member to the body of the bag when the closure member is removed from the neck portion, a transparent viewing port (40) in the sidewall of the bag, a plurality of grommets and rings (43) affixed to the sidewall of the bag for attachment of objects to the bag, a carrying strap (45) removably connected to two of the rings, and a valve (42) through which air may be introduced into the cavity of the bag to inflate the bag. To account for these additional features, the examiner notes that the Seasafe

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#4055 bag has a transparent viewing port in the sidewall, a plurality of grommets and rings affixed to the sidewall of the bag for attachment of objects to the bag and a carrying strap as claimed. The examiner also points out that Soubie includes a valve for allowing inflation of the bag therein so that it can better serve as a lifebuoy. Hagert is cited to show a tether (42) for retaining a closure member (14) to the body of a bag when the closure member is removed from a neck portion (24) of the bag.

Like the examiner, we consider that a person of ordinary skill in the art would have found it obvious from the combined teachings of the Seasafe #4055 bag, Soubie and Hagert to further include a valve in the Seasafe #4055 bag as taught by Soubie so as to gain the advantage of using the bag as an improved lifebuoy as taught by Soubie and also to provide a tether on the closure member of the Seasafe #4055 bag as taught in Hagert for the self-evident purpose of retaining the closure member to the body of the bag when the closure member is removed from the neck portion of the bag. Unlike

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appellants, we do not see that the examiner has in any way relied upon impermissible hindsight in combining the applied references as stated above.

From our perspective, the examiner has merely taken into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made and has not relied upon knowledge gleaned only from appellants' disclosure, thus, the reconstruction as stated above is proper. See In re McLaughlin, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

As for appellants' argument (brief, page 3) that none of the references applied by the examiner shows the grommet and ring structures specified by claim 21, we must agree with the examiner that appellants have not used the term "grommets" in its normal sense. By definition<sup>3</sup> a "grommet" is "1. a ring of rope or metal used to fasten the edge of a sail

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<sup>3</sup> Webster's New World Dictionary, 2nd College Edition, Prentiss Hall Press, 1986.

to its stay . . . 2. an eyelet, as of metal or plastic, protecting an opening in cloth, leather, etc." In appellants' specification (page 5) it is merely indicated that "the carrying bag has a number of grommets 43 secured to the body portion 12"; however, there is no other description of these elements. In Figure 1 of the drawings of the application, the "grommets" are shown by reference character (43), which essentially point to the rings that

are secured in some fashion to the sidewall of the body of the bag. Since the "grommet" structure shown in Figure 1 of appellants' drawings is clearly not an eyelet protecting an opening in the fabric sidewall of the bag, we therefore conclude that the "grommet" disclosed and shown by appellants is merely a ring structure secured to the bag which provides a point of attachment for other accessories, such as the handle (45) seen in Figure 1. Appellants' specification, at page 5, lines 16-27, appears to support such an understanding of appellants' "grommets." Given this understanding of the "grommets" set forth in appellants' claim 21 on appeal, we

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share the examiner's view that the ring structures of the Seasafe #4055 bag that are secured to the sidewall of the bag therein to allow other accessories, such as the handle, to be attached to the bag are fully responsive to the "grommets" of claim 21 on appeal.

With regard to claim 26 on appeal, we agree with the examiner (answer, page 6) that the sizing of the Seasafe #4055 bag to have a volume in the range of 250 to 6000 cubic inches would have been an obvious matter of design choice to one of ordinary skill in the art. The same is true for the sizing of the opening in the neck portion of the Seasafe #4055 bag.

Moreover, we agree with the examiner that when using the 3.4 inch diameter enclosure opening specified in the sales sheet to scale the size of the bag seen therein, it is apparent that the bag shown in the sales sheet is within the size range set forth in claim 26 on appeal. Appellants have not provided any evidence or argument to demonstrate that the sizing of the Seasafe #4055 bag is not within the claimed range, or to show

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that it would not have been obvious to one of ordinary skill in the art to size that bag in the manner claimed, nor supplied any evidence that the particular sizing of the claimed container is in any way significant or critical.

Based on the foregoing, we will sustain the examiner's rejection of claims 21 and 26 under 35 U.S.C. § 103.

As for the examiner's rejection of claim 22 under 35 U.S.C. § 103, we must agree with appellants that the closure member seen in Figure 3 of Soubie does not include an inner flange of the type claimed by appellants. Contrary to the examiner's position, we see no basis to conclude that the gasket (5b) of the closure of Soubie can be further compressed beyond the condition seen in Figure 3 so as to have the inner portion of

the groove that houses the gasket extend into the opening of the neck portion when the closure member is threaded onto the

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neck portion. There is simply nothing in Soubie which corresponds to the claimed inner flange (33) seen in appellants' Figure 2 of the application drawings. Accordingly, the examiner's rejection of claim 22 under 35 U.S.C. § 103 will not be sustained.

Turning to the rejection of claim 24 under 35 U.S.C. § 103 based on Seasafe #4055, Soubie and Hagert, we share appellants' view that the prior art applied by the examiner fails to teach or suggest the particular structure of the grommets as specified in claim 24 on appeal. In addition, we agree with appellants that there is no basis to conclude that the particular structure of the grommets as set forth in claim 24 on appeal would have been merely an obvious matter of design choice. Thus, the examiner's rejection of claim 24 under 35 U.S.C. § 103 will not be sustained.

On the other hand, we also find that appellants' originally filed disclosure provides no support for the particular structure of the grommets as now set forth in claim

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24 on appeal. As noted above in treating claim 21 on appeal, appellants'

specification (page 5) provides no specific description of the "grommets" that are affixed to the sidewall of the bag. Figure 1 of the drawings of appellants' application only schematically shows the grommets (43) and at best is ambiguous concerning the particular structure of these elements and their specific mounting to the sidewall of the bag. Thus, under 37 CFR § 1.196(b), we enter a new rejection of claim 24 under 35 U.S.C. § 112, first paragraph, as lacking written description in the originally filed disclosure.

The last of the examiner's rejections for our consideration is that of claim 23 under 35 U.S.C. § 103 as being unpatentable over Seasafe #4055, Soubie and Hagert as applied to claim 21 above, and further in view of Eckert. Claim 23 is directed to a bag of the type set forth in claim 21 on appeal, but with a plug-type closure member as seen in Figure 3 of the application drawings. Like the examiner

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(answer, page 3), we are of the opinion that one of ordinary skill in the art would have found it obvious to provide the Seasafe #4055 bag with a plug-type closure member and seal of the type seen in Eckert so as to provide an absolutely airtight and watertight closure therein and thereby protect the contents of the bag from damage by water, as

is taught in Eckert. As for appellants' argument that the Eckert patent itself is silent concerning the deformable neck portion of the bag, we must agree. However, we note, as the examiner has, that it is the Seasafe #4055 bag which includes the deformable neck portion and that it is the combined teachings of the references which must be considered in an obviousness determination. That is, the test for obviousness is what the combined teachings of the references would have suggested to those having ordinary skill in the art. See Cable Electric Products, Inc. v. Genmark, Inc., 770 F.2d 1015, 1025, 226 USPQ 881, 886-887 (Fed. Cir. 1985); In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983); In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

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On such a basis, we support the examiner's rejection of claim 23 under 35 U.S.C. § 103 and therefore sustain that rejection.

To summarize, the decision of the examiner rejecting claims 21, 22, 24 and 26 under 35 U.S.C. § 103 as being unpatentable over Seasafe #4055 in view of Soubie and Hagert is affirmed as to claims 21 and 26, but is reversed with respect to claims 22 and 24. The decision of the examiner to reject claim 23 under 35 U.S.C. § 103 as being unpatentable over Seasafe #4055, Soubie,

Hagert and Eckert, and that to reject claim 27 under 35 U.S.C. § 103 as being unpatentable over Seasafe #4055 in view of Soubie are each affirmed. Pursuant to 37 CFR § 1.196(b), a new rejection of claim 24 has been entered by this panel of the Board under 35 U.S.C. § 112, first paragraph.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences

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based upon the same record must be filed within one month from the date hereof (37 CFR § 1.197).

With respect to the new rejection under 37 CFR § 1.196(b), should appellants elect the alternate option under that rule to prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision. In the event appellants elect this alternate option, in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejections, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejections are overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should

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be returned to us for final action on the affirmed rejections,  
including any timely request for reconsideration thereof.

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

AFFIRMED-IN-PART, 37 CFR 1.196(b)

	CHARLES E. FRANKFORT	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	BOARD OF
PATENT		)	
	WILLIAM F. PATE III	)	APPEALS AND
	Administrative Patent Judge	)	
INTERFERENCES		)	
		)	
		)	
	JEFFREY V. NASE	)	
	Administrative Patent Judge	)	

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APPENDED CLAIM

21. In a waterproof carrying bag: a flexible body of water-impervious material having a generally cylindrical side wall and an internal storage cavity, a semi-rigid collar at one end of the body having a laterally deformable neck portion defining an opening which provides access to the internal cavity and can be extended in one lateral dimension by deformation of the neck portion to accommodate an object of greater lateral extent than the unextended opening, a closure member threadedly secured to the neck portion for covering the opening and holding the neck portion in a configuration conforming to the closure member, a sealing gasket carried by the closure member and adapted to provide a water-tight seal between the closure member and the collar when the closure member is threaded onto the neck portion and the neck portion is held in the conforming configuration by the closure member, a tether connected to the closure member for retaining the closure member to the body when the closure member is removed from the neck portion, a transparent viewing port in the side wall of the body for visual observation of contents in the internal cavity, a plurality of grommets affixed to the side wall and having rings for attachment of objects to the bag, a carrying strap removably connected to two of the rings, and a valve accessible externally of the bag through which air can be introduced into the cavity to inflate the bag.