

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte XAVIER J. QUINONES,
JEFFREY B. SHERRY
and
JAMES R. HANSEN

Appeal No. 1996-1992
Application 07/898,373¹

ON BRIEF

Before WILLIAM F. SMITH, ROBINSON, and LORIN, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

¹ Application for patent filed June 9, 1992. According to applicants, this application if a continuation of Application 07/564,928, filed August 8, 1990.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's decision refusing to allow claims 1-54, 57-61, and 63-68, all of the claims pending in the application. Claims 1, 57, 63, and 66 are illustrative of the subject matter on appeal and read as follows:

1. A cellulosic food casing comprising an elongated cellulosic thin walled tube having a moisture content of less than 100 wt.% based upon the weight of bone dry cellulose (BDC), said tube having first and second longitudinal portions and a colorant or opacifier which is longitudinally and continuously dispersed in at least said first portion throughout said tube wall to provide said portion with optical values which are different from said other portion, said portions having a surface area ratio of said first portion to said second portion of at least about 1:1 or greater and wherein said first and second portions have Hunter L, a, b values and opacity values which values meet at least one of the following conditions:

- i) an average opacity value of said first portion that is at least about 0.5 greater than the average opacity value of said second portion;
- ii) a difference in average opacity between said first portion and said second portion which is less than 10, and a difference between said first and second portions in their respective averages of either said L values or said a values or said b values of at least about 5; or
- iii) a difference of at least about 10 or greater in average opacity between said first portion and said second portion, and the sum of the absolute values of a and b of the first portion following extraction of said casing with water and methanol is at least 10.

57. A food casing comprising a shirred elongated tube of at least 50 feet in length having adjacent first and second longitudinal portions of at least four inches in length wherein at least one colorant or opacifier is dispersed in at least one of said portions throughout a wall of said tube to provided it with optical values which are different from the other portion, and wherein the second portion has a transverse width less than or equal to that for said first portion and said first and second portions have Hunter L, a, b values and opacity values meeting at least one of the following conditions:

- i) an average opacity value of said first portion that is at least about 0.5 greater than the average opacity value of said second portion;
- ii) a difference in average opacity between said first portion and said second portion which is less than 10, and a difference between said first and second portions in their respective average of either said L values or said a values or said b values of at least about 5; or
- iii) a difference of at least about 10 or greater in average opacity between said first portion and said second portion, and the sum of the absolute values of a and b of the first portion following extraction of said casing with water and methanol is at least 10.

63. A peelable food casing for formation of skinless frankfurters comprising a shirred nonfiber-reinforced elongated tube having adjacent first and second longitudinal portions of at least 50 feet in length wherein at least one colorant or opacifier is dispersed in at least one of said portions throughout a wall of said tube to provide it with optical values which are different from the other portion, and wherein the second portion has a transverse width less than that for said first portion and said first and second portions have Hunter L, a, b values and opacity values meeting at least one of the following conditions:

- i) an average opacity value of said first portion that is at least about 0.5 greater than the average opacity value of said second portion;
- ii) a difference in average opacity between said first portion and said second portion which is less than 10, and a difference between said first and second portions in their respective averages of either said L values of said a values or said b values of at least about 5; or
- iii) a difference of at least about 10 or greater in average opacity between said first portion and said second portion, and the sum of the absolute values of a and b of the first portion following extraction of said casing with water and methanol is at least 10; and

wherein said tube has a tube wall thickness between about 0.8 to about 2.0 mils and a tube circumference less than 115 mm with said second longitudinal portion having an opacity of less than about 5.0% and a transverse width of at least about 3/16 inch.

66. A high-speed machine peelable sausage casing comprising a Shirred elongated cellulosic tube having adjacent first and second longitudinal portions of at least 50 feet in length wherein non-migratory water-insoluble pigment is incorporated in said first portion of said cellulose casing by dispersion in a wall of said tube to provide it with optical values which are different from said second portion, and wherein said second portion is clear and colorless having an opacity of less than 5.0% and a transverse width of at least 3/16 inch, but less than the width of said first portion and said first and second portions have L, a, b and opacity values meeting at least one of the following conditions:

i) an average opacity value of said first portion that is at least about 0.5 greater than the average opacity value of said second portion;

ii) a difference in average opacity between said first portion and said second portion which is less than 10, and a difference between said first and second portions in their respective average of either said L values or said a values or said b values of at least about 5; or

iii) a difference of at least about 10 or greater in average opacity between said first portion and said second portion, and the sum of the absolute values of a and b of the first portion following extraction of said casing with water and methanol is at least 10.

The references relied upon by the examiner are:

Firth et al. (Firth)	2,857,283	Oct. 21, 1958
Canadian Patent Grabauskas et al. (Grabauskas)	603,307	Aug. 9, 1960

In addition, the examiner relies upon so-called "Applicant's disclosed prior art" identified as appearing at page 8 of the supporting specification.

Claims 1-54, 57-61, and 63-68 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Firth, Grabauskas, and the so-called "Applicant's disclosed prior art". We reverse.

DISCUSSION

Claim 1 is directed to a cellulosic food casing composition. As set forth in claim 1 on appeal, the casing is to have first and second longitudinal portions. A colorant or opacifier is longitudinally and continuously dispersed in at least one of the portions to provide that portion with optical values which differ from the other portion. The second portion is to have a transverse width less than that of the first portion. As seen from claim 1 on appeal, the optical values for the two portions of the casing are to have specified values. The advantages of using a casing are set forth in the paragraphs bridging pages 11-12 of the specification as follows:

The present invention seeks to provide a cellulosic casing and encased food product whereby the casing may advantageously have at least two longitudinal portions with different optical properties. In a most preferred embodiment of the invention a clear colorless, longitudinal portion is provided in an otherwise colored casing to allow either a manufacturer to view the encased product e.g. for color development during processing or a consumer to view the encased product e.g. for meat particle definition and quality. In this preferred embodiment the colored portion of the casing makes up an equal or greater surface of casing relative to the clear portion in order to assist the manufacturer in quality control. This colored portion helps ensure that casing or casing segments are not mixed with meat emulsion for admission to the feed hopper of a stuffing machine e.g. by contamination of meat in the strip-out tub with casing. The colored portion of the casing also helps identify unpeeled or partially unpeeled casing. Other

embodiments of the invention provide casing having multicolored longitudinal portions or portions having different opacities to help differentiate one encased product from another and to provide attractive packaging for applications where the casing is left on until ultimate use by a consumer. Clear or relatively transparent colored or colorless portions may be provided to allow visual identification or product type and quality.

Clear or relatively transparent colored or colorless portions may be provided to allow visual identification of product type and quality.--

Appellants acknowledged in the paragraph bridging pages 8-9 of the supporting specification that, prior to the present invention, sausage makers utilized striped casings. As explained on page 9 of the supporting specification, such casings typically were formed so that more than 50% of the surface area was clear, i.e., these casings had narrow opaque strips. However, appellants indicate that problems were associated with using casings having narrow strips.

Grabauskas exemplifies such prior art casings. The examiner on page 5 of the Examiner's Answer admits that "Grabauskas fails to specifically teach the recited surface ratios" and on pages 2-3 of the Supplemental Examiner's Answer admits that "Grabauskas fails to teach cellulosic food casings comprising first and second longitudinal portions wherein at least the first portion contains a colorant or opacifier and the surface area ratio of the first portion to the second portion is at least about 1:1 or greater, as presently claimed." However, the examiner asserts that "[i]t would have been obvious to

the ordinary artisan to have varied the surface ratios based upon the desired design choice used to differentiate encased products.” (Examiner’s Answer, page 5).

Firth, like Grabauskas, also exemplifies prior art casing. Appellants on page 10 of the specification discuss Firth. The appellants note the following:

A window dyed casing has also been disclosed in U.S. Patent 2,857,283. This patent discloses use of masking means on tubing prior to subjecting a clear tubing to a dye or combination of chemicals which may develop color. The masking means prevent coloration of the masked portion by chemical or mechanical means to produce a seamless casing having a clear longitudinal portion through which the contents of the casing can be visually examined. A casing in which the major area of its outer surface is dyed is disclosed. Such dye is applied to the surface only and does not extend throughout the thickness of casing wall and such dye is only applied to the casing after formation of the tube.

The examiner on page 3 of the Examiner’s Answer notes that “The reference (Firth) fails to meet the claims in that the dye is only coated on the surface and is not continuously dispersed throughout the casing.” The examiner in relying on “Appellants’ disclosed prior art” to show the obviousness of dispersing the coating through the casing noted that “page 8 of the specification, lines 9-20, sets forth a process for dyeing a casing wherein the dye is injected prior to extrusion in order that the dye will be dispersed throughout the casing”. (Examiner’s Answer, page 3). The examiner in the sentence bridging pages 3 and 4 of the Examiner’s Answer took the position that “uniformly dispersing the dye throughout the casing in Firth et al. would have been prima facie obvious to achieve a dyed casing with a more permanent dye.”

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We need not spend any further resources considering the examiner's prima facie case of obviousness in view of the examiner's treatment of appellants' evidence of nonobviousness, Mr. Sherry's declaration under 37 CFR § 1.132.

As set forth in In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986):

If a prima facie case is made in the first instance, and if the applicant comes forward with reasonable rebuttal, whether buttressed by experiment, prior art references, or argument, the entire merits of the matter are to be reweighed. In re Piasecki, 745 F.2d 1468,1472, 223 USPQ 785,788 (Fed. Cir. 1984).

Contrary to the examiner's statement on page 9 of the Examiner's Answer, it is clear from the record that the examiner has not given careful review and consideration to the declaration. First, the examiner in allegedly reviewing Mr. Sherry's declaration misstates the evidence. In the paragraph bridging pages 10-11 of the Examiner's Answer, the examiner states the following:

"In Appellants' brief Appellants argue that customers switched from clear, striped and uniformly colored casing to the present invention even though the inventive casing has a higher purchase price than the clear casing; even though striped casing was still available at the same price as the product of the claimed invention; and even though nonmigratory uniformly colored casing continued to be available from a major competitor (page 28, last paragraph of the brief), yet there is no mention of this in Appellants' Declaration or factual evidence with regard to pricing."

Yet, Mr. Sherry on pages 6 and 7 of the declaration mentions what the examiner says is not present in the declaration. Mr. Sherry declares the following:

Also, customers have switched from both striped casing and clear casing to Sentinel casing. The switch to Sentinel casing has come despite the continued availability of striped casing at the same price, and the continued availability in the U.S. market of nonmigratory uniformly blue casing from a major competitor. Of special note, is the fact that some customers of clear casing have switched to Sentinel casing even though Sentinel casing is priced higher (between 2 and 3% higher) than the corresponding clear casing.

On page 10 of the Examiner's Answer, the examiner states that "More generally, Appellants' declaration is full of opinions and fails to disclose factual evidence [sic] regarding the commercial success of the instantly (sic) invention." Yet, the table at page 5 sets forth factual evidence regarding sales data for casing such as that required by claims on appeal as well as striped casing which appears to be representative of Grabauskas. In addition, the table sets forth sales data for a uniformly colored casing. The table shows that in the first quarter of 1990 no casing of the present invention was sold. Yet, by the first quarter of 1992, 16.9% of the casing sold was of the claimed invention. Moreover, the table shows that in the first quarter of 1990, the striped casing market which appears to be representative of Grabauskas was 15.2%, however, by the first quarter of 1992, the striped casing had dropped to 9.2% of the casing market.

In addition, on pages 9-10 of the Examiner's Answer, the examiner states that "Appellants have not provided sufficient detailed factual evidence i.e., proof of sales ... to determine that commercial success was directly derived from the invention claimed...."

However, Appellants clearly declare on page 6 of the declaration that “Since introduction of casing embodying the Claimed Invention by Viskase Corporation, its U.S. sales have increased to well in excess of \$5,000,000 annually and the percentage of its share of Viskase Corporation U.S. sales of small diameter, peelable nonfibrous cellulose casing market has grown to over 10%.”

Second, in addition to misstating some of the factual evidence of Mr. Sherry’s declaration, the examiner does not address on the record some of the other evidence present by Mr. Sherry in the declaration. We note that Mr. Sherry has urged that the casings required by the claims on appeal have been copied by others and that one of assignee’s competitors has sought a license under patents which may issue to cover the casing of the present invention. In addition, Appendix D of the Sherry declaration is a letter to assignee from a customer stating that the casing used in the present process is a significant improvement. This data is relevant in determining the obviousness of the claimed invention and the examiner has not on the record considered the evidence related to copying by competitors, license request by competitors, or the letter from a customer in Appendix D which states that the presently claimed claim is a “significant improvement.”

The examiner has not reweighed the entire merits of the matter, as required. The filing and admission of the Sherry declaration shifted the burden of going forward to the examiner. By statute, this Board serves as a board of review, not a de novo examination

tribunal. 35 U.S.C. §7(b) (“The [Board] shall, on written appeal of an applicant, review adverse decisions of examiner’s upon application for patents...”). It is the examiner’s initial responsibility to fully and fairly evaluate evidence of nonobviousness and notify appellants of the reasons why such evidence is insufficient. Appellants then would have an opportunity to respond and submit further evidence if needed. Since the examiner did not do so, the case forwarded to this Board by the examiner is not amenable to review. What is needed is a fact-based explanation from the examiner setting forth in detail why the proffered evidence of nonobviousness is insufficient. Since the examiner did not do so, the rejection cannot be sustained.

The decision is reversed.

REVERSED

WILLIAM F. SMITH)
Administrative Patent Judge)
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DOUGLAS W. ROBINSON) BOARD OF PATENT
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