

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES R. SPERRY, LAURENCE B. SPERRY, CRAIG E. ROBERT, MICHAEL J.
SECKLER, BRIAN K. FARISON and ABRAHAM N. REICHENTAL

Appeal No. 97-2491
Application 08/514,010¹

HEARD: April 9, 1999

Before CALVERT, STAAB, and NASE, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 33, 34 and 36-50, all the claims then pending in the application. Subsequent to the final rejection, appellants filed an

¹ Application for patent filed August 11, 1995. According to the appellant, the application is a continuation of Application 08/121,751, filed September 15, 1993, now abandoned, which is a continuation of Application 07/843,609, filed February 28, 1992, now abandoned.

Appeal No. 97-2491
Application 08/514,010

amendment, which was not entered, and a terminal disclaimer, which “has been entered and overcomes the [provisional] double patenting rejection” (advisory letter (Paper No. 11)).² As a consequence, claims 36-39, 42 and 43 have now been “objected to”³ and claims 44-50 have been allowed (advisory letter (Paper No. 11)), leaving only claims 33, 34, 40 and 41 for review.

By way of background, this is the second appeal of the presently disclosed subject matter. In Appeal No. 96-0980 in parent application SN 08/121,751, a merits panel of this Board affirmed the examiner’s § 103 rejection of certain claims as being unpatentable over the same Sperry and Willden references relied upon by the examiner in the present appeal. Familiarity with the decision in the prior appeal is presumed.

Appellants’ invention pertains to an apparatus for forming foam-in-place packaging cushions, and in particular to an apparatus for forming foam-in-place packaging cushions that uses center-folded plastic film material to form the outer plastic bag of the cushions. Claim 33, a substantially correct copy of which is found in an appendix to the brief⁴, is illustrative of the subject matter on appeal.

²The application upon which the provisional obviousness type double patenting rejection was based is now abandoned.

³Presumably, these claims would be allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claims.

⁴Claim 33, as reproduced in the appendix to the brief, is incorrect in that the words “a roller that bears against said web” appearing in the last paragraph thereof should read “means.”

Appeal No. 97-2491
Application 08/514,010

The references of record relied upon by the examiner in support of a rejection under 35 U.S.C. § 103 are:

Sperry	4,800,708	Jan. 31, 1989
Willden et al (Willden)	4,999,975	Mar. 19, 1991

Claims 33, 34, 40 and 41 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sperry in view of Willden.

The examiner found that “Sperry substantially teaches the claimed invention, but provides means for feeding two webs to be sealed together instead of feeding one center-folded web to be sealed for forming cushions” and that “Willden et al teaches the conventionality of feeding one center-folded web for forming cushions in an analogous system” (final rejection (Paper No. 7), page 4). Based on these findings, the examiner concluded that it would have been obvious to one of ordinary skill in the art “to provide means for feeding and sealing the edge of a center-folded web for forming cushions in the system of Sperry in order to provide a simplified system which does not require dual web feeding means or dual edge sealers” (final rejection (Paper No. 7), page 4). Implicit in the rejection is the examiner’s position that the Sperry device modified in the manner proposed would result in an apparatus that corresponds to the claimed subject matter in all respects.

The complete statement of the examiner’s position is found in the final rejection and in the examiner’s answer (Paper No. 14).

The opposing viewpoints of appellants are set forth in the brief (Paper No. 13). In addition, appellants rely on evidence of nonobviousness in the form of a declaration by Abraham N. Reichental and videotape exhibits to show commercial success of the claimed invention demonstrated by a competitor's copying.⁵ A copy of the Reichental declaration is appended to this opinion.

In arguing the patentability of claims 33, 34, 40 and 41 as a group (brief, page 5), appellants do not dispute the examiner's implied position that the modified Sperry device would result in the claimed subject matter. Instead, appellants challenge the examiner's foundation position that it would have been obvious to modify Sperry in the manner proposed in view of Willden's teachings. In this regard, appellants note on pages 6-7 of the brief that there are several ways of forming foam-filled cushions for packaging cushions, including (1) a technique that includes a device for first forming the bags from a tube of plastic material, (2) a method like that of Sperry where bags are formed from two separate sheets of plastic material that are joined longitudinally and transversely to produce single bags, and (3) an approach such as that of the

appealed claims where a single center-folded sheet of plastic material is used to form bags by sealing

⁵The evidence of nonobviousness was originally submitted by appellants in parent application SN 08/121,751, and was incorporated by reference into the present application for the first time by reference thereto in the unentered amendment filed subsequent to the final rejection. Although said amendment was not entered, the examiner nevertheless indicated that the evidence has been considered (answer, pages 7-8). In view of the late stage of prosecution at which this evidence came before the examiner in this case, it would appear that the examiner was not obligated to consider it in the answer.

the edge opposite the center fold, as well as forming transverse seals to complete each bag. According to appellants “[e]ach of these systems has its respective advantages and disadvantages” (brief, page 6). Appellants contend that techniques (1)-(3) “are mutually exclusive of one another in many respects” such that the examiner’s reliance on Willden as a teaching reference to modify the bag forming technique (2) of Sperry “is inappropriate” (brief, page 7).

We have carefully considered the issues raised by the rejection of claims 33, 34, 40 and 41 in light of the examiner’s remarks and appellants’ arguments and evidence of nonobviousness, including those arguments outlined above. As a result, we conclude that a prima facie case of obviousness of the claimed subject matter has been established which has not been rebutted by appellants’ evidence of nonobviousness. Our reasons follow.

It is well settled that the test for obviousness under 35 U.S.C. § 103 is not what the references individually teach, or for that matter, fail to teach. Instead, the test for obviousness is what the *combined* teachings of the applied references would have suggested to one of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

It is our view that one of ordinary skill in the art would have readily appreciated the various advantages and disadvantages of the known prior art techniques (1) and (2) for forming bags outlined by appellants on pages 6-7 of the brief, as well as the center-folded technique disclosed by Willden. This may be fairly inferred from the teachings of the references themselves.

See, for example, column 1, lines 40-62 of Sperry where certain advantages and disadvantages of technique (1) are discussed, and column 2, lines 44-48 of Willden where advantages of technique (3) are set forth. In particular, Willden expressly teaches that the use of a center-folded sheet of plastic material to form the bags has the advantage of eliminating the need for forming a separate second side seam (column 2, lines 44-48; column 11, lines 55-58). From our perspective, one of ordinary skill in the art would have found the utilization of the single center-folded sheet bag forming technique of Willden rather than the two separate sheets bag forming technique of Sperry to be nothing more than a straightforward trade-off between the known advantages and disadvantages of known bag forming techniques, with the suggestion for using Willden's single center-folded sheet bag forming technique in Sperry being for the purpose of achieving Willden's expressly stated advantage of eliminating the need for providing the additional means required for forming a separate second side seam.

Appellants' further argument on pages 7-8 of the brief to the effect that Willden's use of a labyrinth side seal teaches away from the concept of a linear or longitudinal side seal, as now claimed, is noted but is not persuasive of error on the examiner's part. All of the features of the secondary reference need not be bodily incorporated into the primary reference (*see In re Keller*, 642 F.2d at 425, 208 USPQ at 881) and the artisan is not compelled to blindly follow the teaching of one prior art reference over the other without the exercise of independent judgment (*Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 889, 221 USPQ 1025, 1032 (Fed. Cir. 1984)).

Here, the primary reference to Sperry teaches the provision of means for forming linear or longitudinal side seals, and the advantages thereof, namely, the ability to provide vent openings 42 close to the eventual top edge of the bag by a relatively simple procedure (column 2, lines 7-9 and 27-32; column 4, lines 51-66; column 5, lines 45-55). Further, Willden does not “teach away” from the use of linear or longitudinal side seals, as argued by appellants, but rather teaches that the labyrinth side seal disclosed therein is merely preferred (column 2, line 49).

Thus, when the combined teachings of Sperry and Willden are considered, we are satisfied that a prima facie case of obviousness of claims 33, 34, 40 and 41 has been made out under the test set forth in *In re Keller supra*.

Having arrived at the conclusion that the applied prior art is sufficient to establish a prima facie case of obviousness of the claimed subject matter, we recognize that evidence of nonobviousness submitted by appellants must be considered en route to a final determination of obviousness/nonobviousness under 35 U.S.C. § 103. *See Stratoflex Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983). Accordingly, we consider anew the issue of obviousness under 35 U.S.C. § 103, carefully evaluating the objective evidence of nonobviousness supplied by appellants. *See In re Oetiker*, 977 F.2d 1443, 1445-46, 24 USPQ2d 1443, 1444-45 (Fed. Cir. 1990); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Appellants' evidence of nonobviousness attempts to establish that Insta-Foam Products, Inc. (the assignee of Willden) intentionally copied the device which is the subject of the present application. In this regard, Abraham N. Reichental states in his declaration that "the ProPacker [apparatus of Insta-Foam Products, Inc.] is essentially an identical copy of Sealed Air's VERSAPACKER™ device which is the subject of this pending patent application" (paragraph 11), that in declarant's opinion "the ProPacker illustrated in Exhibit B is more than a literal copy of the VERSAPACKER™ device and indeed is actually built from Sealed Air parts" (paragraph 12), and that "it is inconceivable that a person, even one skilled in the art, would independently come up with identical parts for the feeding, cutting and sealing . . . of the plastic film in a foam-in-bag packaging device" (paragraph 13). Reichental then lists in paragraph 15 nine specific details "claimed and disclosed in the pending application that identically appear on Insta-Foam's ProPacker." Reichental continues that "Insta-Foam . . . has abandoned the technology illustrated in the Willden patent and instead has offered the identical (and indeed possibly pirated) copy of Sealed Air's VERSAPACKER™ device" (paragraph 16), that Insta-Foam's "identical copying of the invention . . . which is the subject of the specification, claims and drawings of the above application demonstrates that the disclosure and claims are nonobvious" (paragraph 17), and that "Insta-Foam's abandonment of their own patented technology in favor of a direct copy of Sealed Air's disclosed and claimed technology demonstrates the commercial success and nonobviousness of the claimed subject matter in the pending application" (paragraph 18).

First of all, we note that Reichental's references to "the subject of this pending patent application" (paragraph 11), "the specific details claimed and disclosed in the pending application" (paragraph 15), "the invention . . . which is the subject of the specification, claims and drawings of the above application" (paragraph 17), and "the claimed subject matter in the pending application" (paragraph 18) refer to parent application SN 08/121,751 and not the present application. In that the presently appealed claims differ in several respect from the claims pending in the parent application at the time the Reichental declaration was executed, it is not clear how Reichental's statements relate to the obviousness issues presented here. Second, there is no evidence in the record, and in particular videotape Exhibits A and B appended to the Reichental declaration, to support declarant's opinion that Insta-Foam has abandoned the technology illustrated in the Willden patent (paragraph 16), and in particular that Insta-Foam has abandoned their own patented technology in favor of the presently claimed technology (paragraph 18). As to the remainder of Reichental's assertions, we have carefully reviewed videotape Exhibits A and B but find them to be insufficient to establish (a) whether the VERSAPACKER™ device of Exhibit A forms the plastic bag by using the claimed single center-folded sheet bag forming technique as opposed to some other bag forming technique, and (b) whether either the VERSAPACKER™ device of Exhibit A or the ProPacker device of Exhibit B seals the sides of the bag using means that provide a substantially linear seal along the bag edge that is periodically interrupted to provide an unsealed portion, as now claimed, as opposed to some other type of sealing

means that

provides a different seal such as the labyrinth seal disclosed in the Willden patent. Additionally, the “specific details” enumerated by declarant Reichental in paragraph 15 are either not apparent from the videotapes, or are not relevant to the obviousness issues raised in the present appeal because they are not part of the invention as presently claimed, or both. In this regard, we particularly note that declarant Reichental makes no mention whatsoever of the single center-folded sheet bag forming technique that forms the fundamental issue in the present appeal. Accordingly, appellants’ evidence does not tie the alleged copying to any distinctive feature, much less the center-folded sheet bag forming technique argued in the present appeal as the distinctive feature of the claimed invention.

In light of the foregoing, appellants’ evidence of nonobviousness is entitled to relatively little weight in that it does not persuasively establish that Insta-Foam abandoned the technology embodied in the Willden patent and instead copied appellants’ technology as embodied in the claimed invention.⁶

Furthermore, even assuming that appellants had sufficiently demonstrated copying, that evidence is not necessarily controlling. *See Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988), *cert. denied*, 493 U.S. 814 (1989). As the court stated

⁶Alleged copying is not persuasive of nonobviousness when the copy is not identical to the claimed product. *See Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 317, 227 USPQ 766, 771 (Fed. Cir. 1985).

Appeal No. 97-2491
Application 08/514,010

in *Cable Elec. Prods. v. Genmark, Inc.*, 770 F.2d 1015, 1028, 226 USPQ 881, 889 (Fed. Cir. 1985):

Rather than supporting a conclusion of obviousness, copying could have occurred out of a general lack of concern for patent property, in which case it weighs neither for nor against the nonobviousness of a specific patent. It may have occurred out of contempt for the specific patent in question, only arguably demonstrating obviousness, or for the ability or willingness of the patentee financially or otherwise to enforce the patent right, which would call for deeper inquiry. Even wide-spread copying could weigh toward opposite conclusions, depending on the attitudes existing toward patent property and the accepted practices in the industry in question.

Therefore, without more evidence, the mere fact of competitor copying, even if established, offers only equivocal evidence of nonobviousness.

In view of the foregoing, we are satisfied that when all the evidence and arguments are considered, the evidence of nonobviousness fails to outweigh the evidence of obviousness as in *Richardson-Vicks Inc. v. Upjohn Co.*, 122 F.3d 1476, 1483, 44 USPQ2d 1181, 1186 (Fed. Cir. 1997) and *EWP Corp. v. Reliance Universal, Inc.*, 755 F.2d 898, 907, 225 USPQ 20, 25 (Fed. Cir. 1985). Accordingly, we sustain the standing rejection of claims 33, 34, 40 and 41 under 35 U.S.C. § 103.

Appeal No. 97-2491
Application 08/514,010

The decision of the examiner is affirmed.

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

AFFIRMED

IAN A. CALVERT)
Administrative Patent Judge)
)
)
) BOARD OF PATENT
LAWRENCE J. STAAB)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
JEFFREY V. NASE)
Administrative Patent Judge)

Appeal No. 97-2491
Application 08/514,010

LJS/pgg
Philip Summa
Bell Seltzer Pak & Gibson
Post Office Drawer 34009
Charlotte, NC 28234