

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

Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RUSSELL W. HECKMAN, JAMES A. HERMAN,
LARRY P. SHIPLE and WALTER E. TRAXLER

Appeal No. 1999-0509
Application No. 08/693,585

ON BRIEF

Before MCCANDLISH, Senior Administrative Patent Judge, ABRAMS and NASE, Administrative Patent Judges.

MCCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiners' final rejection of claims 22, 23 and 25 through 35. The only other claims still pending in the application have been withdrawn from consideration as being directed to a non-elected invention.

The invention disclosed in appellants' application relates to the attachment of a heat-shrinkable label to an article such as a glass or plastic container. Claims 22, 23 and 25-31 are directed to a method of applying a label to a container, claims 32-34 are directed to the product produced by any one of the foregoing method claims and claim 35 is directed to a method of applying segments of heat shrinkable material to an article.

A copy of the appealed claims is appended to appellants' brief.

The following references are relied upon by the examiner in support of his rejections under 35 U.S.C. ' 102(b) and 35 U.S.C. ' 103:

Hoffmann	4,416,714	Nov. 22, 1983
Karabedian	4,626,455	Dec. 2, 1986
Dickey	4,923,557	May 8, 1990

In addition to the foregoing references, the examiner relies on certain admitted prior art, namely *Containers with recessed portions* (answer, page 5).

The grounds of rejection are as follows:

1. Claims 22, 23, 25-28 and 32 stand rejected under 35 U.S.C. ' 103 as being unpatentable over Dickey.
2. Claim 29 stands rejected under 35 U.S.C. ' 103 as being unpatentable over Dickey in view of Karabedian.
3. Claims 30 and 31 stand rejected under 35 U.S.C. ' 103 as being unpatentable over Dickey in view of Hoffmann.
4. Claims 33 and 34 stand rejected under 35 U.S.C. ' 103 as being unpatentable over Dickey in view of the admitted prior art mentioned supra.
5. Claim 35 stands rejected under 35 U.S.C. ' 102(b) as being anticipated by Dickey or, in the alternative, under 35 U.S.C. ' 103 as being unpatentable over Dickey.

Considering first the ' 102(b) rejection of claim 35, it is well established patent law that for a reference to be properly anticipatory, each and every element of the rejected claim must be found either expressly described or under the principles of inherency in the applied reference.

See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997), In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1990), and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ. 385, 388 (Fed. Cir. 1984).

Claim 35 relates to the application of a heat shrinkable material to an article that is formed with a body portion having an outer convex surface centered about the article's central vertical axis. Claim 35 recites that the convex surface has a continuous curvature to present a sector of maximum diameter between the top and bottom edges of the convex surface. According to the method steps in claim 35, the heat shrinkable segment is adhesively attached to the sector of maximum diameter along a narrow area of the sector while wrapping the segment around the convex surface so that major portions of the segment on either side of the narrow area are unattached, presumably to the sector prior to heat shrinking those major portions onto the convex surface.

The Dickey patent also discloses a method of attaching a heat shrinkable material in the form of a label to an article, namely a container. In addition to the container configurations in the illustrated embodiments (i.e., the right-circular cylindrical container of Figure 2 and the cup shaped container of Figure 9), Dickey discloses that the body portion of the container may be elliptical in vertical cross-section (emphasis added) (column 3, line 10). The elliptical shape corresponds to a flattened circle having its widest or greatest dimension along the x axis (sometimes called the major axis) of the ellipse to define convex end portions that are bisected by the x axis. These convex end portions in the vertical cross section of Dickey's elliptical container body define a convex surface to present a sector of maximum diameter lying along the x axis and hence

between the top and bottom edges of the convex surface. Such a convex surface responds to the convex surface defined in claim 35. The preamble of claim 35 thus reads on Dickey's elliptically contoured container body.

Dickey's heat shrinkable label corresponds to the heat shrinkable segment defined in clause Aa of appealed claim 35. In Dickey's illustrated embodiments, a wrapping station is located upstream from an oven 66 for wrapping the label around the container prior to heat shrinking the label onto the container. The label to be applied to the container is advanced by a vacuum drum 36 to the wrapping station where it is wrapped around the container sector of maximum diameter as shown, for example, in Figure 2 of Dickey's drawings. Like appellants' method as defined in clause Ab of claim 35, Dickey's label is adhesively attached to the maximum diameter sector of the container while wrapping the label around the container.

According to Dickey's disclosure as shown, for example, in Figure 2, major portions of the wrapped label extend at both ends beyond the container's sector of maximum diameter. These major portions are spaced from the container to remain unattached to the container prior to heat shrinking the label as defined in clause Ac of claim 35. After the wrapping step, the container bearing the wrapped label is advanced to oven 66 where the label is heat shrunk onto to the container in the manner recited in clause Ad of claim 35.

The method of wrapping the label around Dickey's elliptical container body is inherently the same as that described for the embodiment of Figure 2 because of the equipment disclosed for wrapping the label around the container. In this regard, Dickey's vacuum drum 36 will necessarily locate the label at a position where it will engage and be

wrapped around the maximum diameter sector of the elliptical container. Since the maximum diameter sector of the elliptical container is relatively narrow, major portions of the label extending at both ends beyond the container's sector of maximum diameter will necessarily be spaced from the container to remain unattached to the container prior to heat shrinking the label onto the container. Thus, Dickey's disclosure inherently meets the limitations defined in clauses Ab@ and Ac@ of claim 35.

Based on the foregoing analysis, we are satisfied that the Dickey patent expressly or inherently discloses each limitation in claim 35 to thus anticipate the subject matter of claim 35. See In re Schreiber, 128 F.3d at 1477, 44 USPQ2d at 1431. We will therefore sustain the ' 102(b) rejection of claim 35.

We will also sustain the ' 103 rejection of claim 35 since anticipation is the epitome of obviousness. See In re May, 574 F.2d 1082, 1089, 197 USPQ 601, 607 (CCPA 1978).

Even if it is assumed for the sake of argument that Dickey lacks an inherent disclosure of the method limitations discussed supra, we nonetheless are of the opinion that the subject matter of claim 35 would have been obvious within the meaning of ' 103. As is evident from Figure 2 of Dickey's drawings, the maximum diameter portion of the container is closest to the label on the vacuum drum 36 so that the label will be brought without difficulty into contact with the maximum diameter portion, while allowing the regions of the label extending beyond the maximum diameter portion to remain out of contact with the container until heat is applied to heat shrink the label. One of ordinary skill in the art would have recognized that this method of attachment is for the self-evident purpose of simplifying the wrapping operation. In this regard, skill in the art is

presumed, not the converse. In re Sovish, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985). For these additional reasons, we will sustain the ' 103 rejection of claim 35.

In sustaining the rejections of claim 35 under ' 102(b) and ' 103, we are not unmindful of appellants' arguments on pages 9-12 of the main brief. These arguments, however, are not persuasive.

Contrary to appellants' contention on page 9 of the main brief, Dickey's elliptical container body does have a convex outer surface that responds to appellants' claimed convex surface as discussed supra. Also, step A_b of claim 35 is met by Dickey for the reasons discussed supra.

In reaching our conclusion that claim 35 is unpatentable, we have given weight to the preamble of the claim. However, we have found that the preamble, which defines the particular configuration of the claimed article, does not distinguish from Dickey. There is substantial evidence to support this finding as discussed supra.

Finally, for the reasons set forth supra, we disagree with appellants' argument on page 11 of the main brief that Dickey's teachings relating to the illustrated embodiments do not apply to the unillustrated embodiment having the elliptically contoured container body. With particular regard to the ' 103 rejection, an express disclosure or suggestion of applying Dickey's label wrapping method to the unillustrated embodiments is not required to meet the test for obviousness. See In re Sernaker, 702 F.2d 989, 994, 217 USPQ 1, 7 (Fed. Cir. 1983). Instead, the suggestion may be implied. Id. Moreover, an applied reference must be evaluated for the reasonable inferences that one skilled in the art would have drawn from the reference, not just the specific disclosures in the reference. In re Shepard, 319 F.2d 194, 197, 138 USPQ 148, 150 (CCPA 1963). In the

present case, one skilled in the art would have drawn the inference that the label wrapping method for Dickey's embodiment of Figure 2 is also applicable to the unillustrated elliptically contoured embodiment for the reasons discussed supra. Additionally, as noted supra, there is an implicit suggestion for applying that label wrapping method to the elliptically contoured embodiment for the purpose of simplifying the label wrapping operation.

We will not sustain the ' 103 rejections of method claims 22, 23 and 25-31 and product claims 32-34. Dickey contains no teaching or suggestion of a container having a compound curvature as defined in claim 22. This container construction is also incorporated into product claims 32-34. With regard to the examiner's position as set forth on page 4 of the answer, it does not follow from Dickey's teaching of a variety of different container configurations that it would have been obvious to apply Dickey's label wrapping method to any undisclosed container configuration. Furthermore, the limitations relating to the container configuration in the preamble of claim 22 cannot be ignored. In the first place, claim 22 is limited to a method of applying a label to a particular container configuration. In addition, the material (in this case a container of a particular shape) on which a process is carried out must be accorded weight in determining the patentability of that process, See In re Pleuddemann, 910 F.2d 823, 825-28, 15 USPQ2d 1738, 1740-42 (Fed. Cir. 1990).

In summary:

1. The examiner's decision to reject claims 22, 23 and 25 through 34 under 35 U.S.C. ' 103 is reversed.
2. The examiner's decision to reject claim 35 under 35 U.S.C. ' 102(b) is affirmed.
3. The examiner's decision to reject claim 35 under 35 U.S.C. ' 103 is affirmed.

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

AFFIRMED-IN-PART

HARRISON E. MCCANDLISH)	
Senior Administrative Patent Judge)	
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