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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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THIERRY BOCHET

Appeal No. 1999-2092
Application No. 08/798,718¹

ON BRIEF

Before COHEN, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 42 through 51, which are all of the claims pending in this application.

We AFFIRM-IN-PART and REMAND.

¹ Application for patent filed February 12, 1997.

BACKGROUND

The appellant's invention relates to a bag. An understanding of the invention can be derived from a reading of exemplary claim 42, which appears in the appendix to the appellant's brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Salvadori	4,363,406	Dec.
14, 1982		

Claims 42 to 46, 48 and 50 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Salvadori.

Claims 47, 49 and 51 stand rejected under 35 U.S.C. § 103 as being unpatentable over Salvadori.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 34, mailed April 20, 1998) and the answer (Paper No. 38,

mailed September 9, 1998) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 37, filed August 20, 1998) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Claim 42

We sustain the rejection of claim 42 under 35 U.S.C. § 102(b).

Initially we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference.

See Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)).

Salvadori discloses a fluid drainage bag. As shown in Figures 1, 2 and 4-6, the fluid drainage bag 10 includes a body 12 preferably formed of two overlapping sheets 13 and 15 of polyvinyl chloride plastic. An internal fluid chamber 14 is formed within the bag body 12 by suitable means, such as

electronic welding, which joins the peripheral edges of the overlapping sheets together. An inlet fitting 16 defining an inlet port communicates with the internal chamber 14, and a flexible inlet tube 18 (shown in phantom lines in Figure 1) is connected at one end to a patient and at the opposite end to the inlet fitting 16 so that fluid may be conducted from the patient into the internal fluid chamber 14. Opening means 22 is integrally attached to the bag body 12 for forming a tear in the polyvinyl chloride material of the bag body 12 to open a permanent outlet passage (see Figures 4 and 5) in the internal fluid chamber 14 through which fluid may be drained from the bag 10. After drainage, the bag 10 is then discarded.

Salvadori teaches (column 2, line 15, to column 3, line 56) that

[w]hile the bag 10 having integral opening means 22 may be variously constructed, in the illustrated embodiment the internal fluid chamber 14 is formed so as to include a main body portion 26 having an outlet port 28 which is normally sealed within the confines of the bag body 12. More particularly, a truncated outlet extension portion 30 is formed within the confines of the bag body 12. The outlet extension 30 extends from the outlet port 28 and has a sealed end 34 which is spaced

from the outlet port 28. As will soon be described, the opening means 22 is operative for tearing the bag body 12 to separate the outlet extension 30 from the outlet port 28 to thereby open the outlet port 28 to permit drainage of the fluid from the main body portion 26 of the internal fluid chamber 14.

The material of sheets 13 and 15 in the area of outlet port 28 at the base of outlet extension 30 is not weakened by a score line or similar means to maintain the sealed integrity of the outlet extensions until the tearing operation is performed.

While the outlet port 28 and associated outlet extension 30 may be variously located on the bag body 12, in the preferred embodiment shown in FIGS. 1, 2, 4, 5 and 6, the bag body 12 includes seams 36, 38 and 39 which define, respectively, the top peripheral edge and the opposite peripheral side edges of the bag 10. Another seam 54 extends from the side seam 39 in a path below and generally parallel to the top edge seam 36, and generally defines the uppermost extent of the main body portion 26 of the internal fluid chamber 14. Seam 54 terminates in a spaced relationship from the side seam 38, and seam 55 thereafter extends in a generally upwardly sloping path from seam 54 until the top edge seam 36 is joined. By virtue of this construction, the confines of the outlet extension 30, the outlet port 28, and the sealed end 34 of the outlet extension 30 are defined within a corner section 40 of the bag 10.

Also by virtue of this construction, an upper portion 59 of the bag body 12 is formed, being isolated from communication with the interior fluid chamber 14 by the seams 54 and 55. The opening means 22 includes a tap member 42 which is integrally formed on the upper portion 59 adjacent to seam 55.

More particularly, a portion of the upper portion 59 is crimped (see FIG. 6), such as by electronic welding. This crimping weakens the polyvinyl chloride material to form a preformed tear seam 46. As is best shown in FIGS. 1 and 2, the preformed tear seam 46 extends between a first tearing edge 48 (see FIG. 2) which intersects the top edge seam 36 and a second tearing edge 50 which joins

seam 55. The tab member 42 is thereby defined intermediate the preformed tear seam 46, the top edge seam 36, and seam 55 and normally occupies a coplanar relationship with the upper portion 59 of the bag body 12.

By grasping the tab member 42 between one's thumb and forefinger and then pulling the tab member 42 laterally toward the side edge seam 38, the bag body 12 tears along the preformed tear seam 46. The tab member 42 is thereby lifted away from its coplanar relationship with the bag body 12 (see FIG. 4). The second tearing edge 50 thereafter acts as a stress point 52 which, as the tab member 42 is progressively pulled laterally toward the side edge seam 38, breaks the seam 55 and initiates a tear line 44 (see FIG. 5) which proceeds from the second tearing edge 50 across the outlet extension 30 until the side edge seam 38 of the bag 10 is reached. At this point, the tab member 42 has separated the entire corner section 40 from the bag body 12 and, in doing so, has separated the outlet extension 30 from the outlet port 28. A permanent drain opening is thus formed through which fluid may be drained from the bag 10.

To guide and otherwise facilitate this tearing action occasioned by laterally pulling upon the tab member 42, the second tearing edge 50 joins seam 55 at an angle (designated as angle x in FIG. 2) which is measured between the seam line 54 and the preformed tear seam 46 immediately adjacent to the second tearing edge 50. By virtue of this angle, the action of the stress point 52 in breaking the seam 55 and initiating the tear line 44 across the outlet extension 30 is enhanced. Furthermore, the tear line 44 thereafter proceeds from the stress point 52 across the outlet extension 30 at generally the same angle to increase the size of the drain opening formed. While this angle may be varied, in the preferred embodiment, the angle is approximately 45° .

Additionally, the width of the seam 55 is increased immediately above the juncture of the second tearing edge 50 and the seam 55 to thereby strengthen the seam 55 at this point. The reinforcement of the seam 55 at this point directs the tearing action at the stress point 52

away from the path of seam 55 and into the outlet extension 30. Thus, undesired tearing along the path of seam 55 is prevented.

It should be appreciated that the particular construction of the preferred embodiment protects the tab member 42 from being accidentally ruptured or damaged during the manufacturing process. More particularly, during the manufacturing process the two sheets 13 and 15 of polyvinyl chloride material are electronically welded together forming the seams 36, 38, 39, 54 and 55 and resulting in the presence of excess polyvinyl chloride material extending outwardly from the peripheral seams 36, 38 and 39. This excess material is usually removed by cutting or tearing. By shielding the major portion of the tab member 42 within the confines of the upper portion 59, the tab member 42 is protected against accidental tearing or damage during removal of this excess material.

In our view, claim 42 is anticipated by Salvadori. In that regard, claim 42 is readable on Salvadori as follows:
A bag (Salvadori's bag 10) comprising a pair of flexible tearable walls (Salvadori's sheets 13 and 15) defining between them a central volume (Salvadori's chamber 14) for containing a product, said walls being secured together along and transversely of an elongated margin of substantial width extending between an outer edge of said bag and said central volume (Salvadori's seams 36 and 54 secure the sheets 13 and 15 together and define therebetween an elongated margin of substantial width extending between outer seam 36 and the

chamber 14), and a line of weakness disposed in said margin (Salvadori's opening means 22 and preformed tear seam 46), said line of weakness having a central portion extending lengthwise of said margin (as shown in Figure 5, the horizontally disposed portion of Salvadori's preformed tear seam 46) and opposite end portions (the end portions of Salvadori's preformed tear seam 46 leading to first tearing edge 48 and second tearing edge 50), said central portion being disposed intermediate and spaced from opposite longitudinal edges of said margin (the horizontally disposed portion of Salvadori's preformed tear seam 46 is disposed intermediate and spaced from opposite longitudinal edges (i.e., seams 36 and 54) of the margin), a first said end portion extending away from said central volume at an angle and intersecting said outer edge (the end portion of Salvadori's preformed tear seam 46 leading to first tearing edge 48 from the horizontally disposed portion of Salvadori's preformed tear seam 46), a second said end portion extending toward said central volume and away from said central portion at an angle in a direction opposite the direction in which said first end portion extends (the end portion of Salvadori's

performed tear seam 46 leading to second tearing edge 50 from the horizontally disposed portion of Salvadori's performed tear seam 46).

The argument (brief, pp. 5-6) presented by the appellant does not convince us that the subject matter of claim 42 is novel. First, as set forth above, we discern no difference between claim 42 and the teachings of Salvadori. Second, we disagree with the appellant's position that for Salvadori to anticipate claim 42, Salvadori must disclose a margin "as shown in our drawings or in some form equivalent thereto." It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Moreover, limitations are not to be read into the claims from the specification. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir.

1989). Thus, it would be improper to read limitations from the drawings into claim 42. When the margin limitation of claim 42 is given its broadest reasonable interpretation consistent with the specification all that is required is a margin at one edge of the bag having the claimed line of weakness, which limitations are readable on Salvadori. Claim 42 does not require the recited margin to extend about the entire periphery of the bag as shown in the drawings.

For the reasons set forth above, the decision of the examiner to reject claim 42 is affirmed.

Claim 43

We sustain the rejection of claim 43 under 35 U.S.C. § 102(b).

Claim 43 adds to parent claim 42 the limitation that "said second end portion being spaced from said central volume by a substantial width of said margin." In our view, claim 43 is anticipated by Salvadori. In that regard, claim 43 is readable on Salvadori since Salvadori's second end portion

(the end portion of Salvadori's preformed tear seam 46 leading to second tearing edge 50) is spaced from the chamber 14 by a substantial width of the margin (i.e., the width of seam 54 at stress point 52).

Contrary to the argument of the appellant (brief, p. 9), the limitations of claim 43 are found in Salvadori for the reasons set forth above; thus, the decision of the examiner to reject claim 43 is affirmed.

Claim 45

We will not sustain the rejection of claim 45 under 35 U.S.C. § 102(b).

Claim 45 adds to parent claim 42 the limitation that the bag further comprises "a bridge that interrupts said first end portion of said line of weakness."

The examiner's position (final rejection, p. 2) with respect to the limitation of claim 45 is that "the first end portion of Salvadori is considered to show strengthening

'bridge' to the same degree as claimed." The appellant argues (brief, p. 6) that he does not "find anything that interrupts the first end portion of the line of weakness of Salvadori that could be said to comprise a bridge." The examiner responded to this argument (answer, p. 4) by stating that "the first end portion of Salvadori shows a 'bridge' to the same degree as claimed."

We agree we with the appellant that Salvadori does not disclose "a bridge that interrupts said first end portion of said line of weakness." In that regard, Salvadori's preformed tear seam 46 does not include any structure that would constitute a bridge that interrupts the first end portion thereof (i.e., end by first tearing edge 48).

Since all the limitations of claim 45 are not found in Salvadori for the reasons set forth above, the decision of the examiner to reject claim 45 is reversed.

Claim 47

We sustain the rejection of claim 47 under 35 U.S.C. § 103.

Claim 47 adds to parent claim 42 the limitation that the bag "is polygonal and said line of weakness occupies the greater portion^[2] of the length of one side of the polygonal bag."

The examiner ascertained (final rejection, p. 3) that Salvadori discloses the claimed invention except for the line of weakness occupying the greater portion of the length of the margin. The examiner then determined that

[i]t would have been an obvious matter of design choice to make the central portion of the Salvadori line of weakness longer such that it occupies a greater portion of the margin, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

² We believe the broadest reasonable interpretation consistent with the specification of the phrase "greater portion" is "more than 50%."

The appellant argues (brief, pp. 6-7) that "SALVADORI does not disclose the line of weakness occupying the greater portion of the length of one side of a polygonal bag" and that "there is nothing in SALVADORI that would suggest this change."

We agree with the examiner that the claimed subject matter would have been obvious at the time the invention was made to a person having ordinary skill in the art. In that regard, we note that Salvadori is silent with respect to the ratio of the length of the preformed tear seam 46 to the length of one side of the polygonal bag 10. Thus, it was left up to the skilled artisan to determine that ratio.³

This accords with the general rule that discovery of an optimum value of a result effective variable (in this case, the optimum ratio (i.e., greater portion)) is ordinarily within the skill of the art. See In re Boesch, 617 F.2d 272,

³ We observe that the conclusion of obviousness may be made from "common knowledge and common sense" of the person of ordinary skill in the art (see In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)).

276, 205 USPQ 215, 219 (CCPA 1980) and In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). As stated in In re Huang, 100 F.3d 135, 139, 40 USPQ2d 1685, 1688 (Fed. Cir. 1996):

[t]his court and its predecessors have long held, however, that even though applicant's modification results in great improvement and utility over the prior art, it may still not be patentable if the modification was within the capabilities of one skilled in the art, unless the claimed ranges "produce a new and unexpected result which is different in kind and not merely in degree from the results of the prior art."

Additionally, as stated in In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990):

[t]he law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. . . . These cases have consistently held that in such a situation, the applicant must show that the particular range is *critical*, generally by showing that the claimed range achieves unexpected results relative to the prior art range [citations omitted].

In the present case, however, the appellant has not even alleged, much less established, that the claimed ratio (i.e., the length of the line of weakness to the length of one side

of the polygonal bag) produces unexpected results. Therefore, we are of the opinion that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to have Salvadori's preformed tear seam 46 occupy the greater portion of the length of one side of the polygonal bag 10. Accordingly, the examiner's rejection of claim 47 under 35 U.S.C. § 103 is sustained.

Claim 51

We will not sustain the rejection of claim 51 under 35 U.S.C. § 103.

Claim 51 adds to parent claim 42 the limitation that the walls are "secured together over all the area between said opposite longitudinal edges of said margin."

The examiner ascertained (final rejection, p. 4) that Salvadori discloses the claimed invention except for the walls of the bag being secured together over all the area between

the opposite longitudinal edges of the margin. The examiner then determined that

[i]t would have been an obvious matter of design choice to secure the walls of Salvadori together over all the area between the opposite longitudinal edges of the margin, since applicant has not disclosed that bag walls secured together over all the area between the opposite longitudinal edges of the margin solves any stated problem or is for any particular purpose and it appears that the Salvadori bag would perform equally well with walls secured together over all the area between the opposite longitudinal edges of the margin.

The appellant argues (brief, pp. 7-9) that the rejection cannot be sustained since the margin as claimed in claim 51 permits easy manufacture of the bag, easy separation of the bags, and easy filling and closing of the bags. Moreover, the appellant asserts that the claimed "secured-together margin, plus a line of weakness" is not suggested by the teachings of Salvadori.

We agree with the appellant that the claimed subject matter would not have been obvious at the time the invention was made to a person having ordinary skill in the art from the teachings of the applied prior art. A case of obviousness is

established by presenting **evidence** that would have led one of ordinary skill in the art to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). **Evidence** of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual **evidence**. That is, the showing must be clear and particular. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). A broad conclusory statement regarding the obviousness of

modifying a reference, standing alone, is not "evidence."
E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576,
1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993); In re Sichert,
566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977). See also
In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed.
Cir. 1999). In this case, the examiner has not presented
sufficient **evidence** establishing the obviousness of the
subject matter of claim 51.

For the reasons set forth above, the decision of the
examiner to reject claim 51 under 35 U.S.C. § 103 is reversed.

Claims 44, 46 and 48 to 50

In accordance with the appellant's Grouping of Claims⁴ and
37 CFR § 1.192(c)(7), claims 44, 46 and 48 to 50 fall with
claims 42 and 47. Thus, it follows that the decision of the
examiner to reject claims 44, 46 and 48 to 50 is also
affirmed.

⁴ See pages 3-4 of the appellant's brief.

REMAND

We remand this application to the examiner for further consideration of the patentability of claims 45 and 51 under 35 U.S.C. § 103. With regard to claim 45, the examiner should assess available evidence in the bag art to determine if it is known in the bag art to have a line of weakness made from a series of perforations that provide a bridge portion between adjacent perforations. With regard to claim 51, the examiner should assess available evidence in the bag art to determine if it is known in the bag art to have a margin secured together over all the area between opposite longitudinal edges of the margin. If those items are known in the bag art, the examiner should cite that evidence (e.g., prior art) and then consider whether or not such evidence can be combined with Salvadori to render claim 45 or claim 51 unpatentable under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 42 to 44, 46, 48 and 50 under 35 U.S.C. § 102(b) is affirmed; the decision of the examiner to reject claim 45 is reversed; the decision of the examiner to reject claims 47 and 49 is affirmed; and the decision of the examiner to reject claim 51 under 35 U.S.C. § 103 is reversed. In addition, the application has been remanded to the examiner for further consideration of claims 45 and 51.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (Seventh Edition, July 1998).

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

AFFIRMED-IN-PART; REMANDED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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APPEAL NO. 1999-2092 - JUDGE NASE
APPLICATION NO. 08/798,718

APJ NASE

APJ COHEN

APJ STAAB

DECISION: **AFFIRMED-IN-PART;**
REMANDED

Prepared By: Gloria Henderson

DRAFT TYPED: 03 Dec 99

FINAL TYPED: