



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,887	09/06/2005	Brian Leslie Smalley	R031 1160.1	4424
26158	7590	01/22/2013	EXAMINER	
WOMBLE CARLYLE SANDRIDGE & RICE, I.L.P. ATTN: IP DOCKETING P.O. BOX 7037 ATLANTA, GA 30357-0037			COLLINS, MICHAEL	
			ART UNIT	PAPER NUMBER
			3651	
			NOTIFICATION DATE	DELIVERY MODE
			01/22/2013	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPDocketing@WCSR.COM

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRIAN LESLIE SMALLEY and ZOE WILKINS

Appeal 2011-005421
Application 10/523,887
Technology Center 3600

Before CHARLES N. GREENHUT, PATRICK R. SCANLON,
MICHELLE R. OSINSKI, *Administrative Patent Judges.*

OSINSKI, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants¹ appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1, 2, 4, 6, 9, 60-66, 70-73, 75, and 76. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

CLAIMED SUBJECT MATTER

The claimed subject matter relates to dispensing packages for canned products such as food and drink. Spec. 1, ll. 1-3. Claims 1 and 64 are the independent claims on appeal. Claim 1, reproduced below, with emphasis added, is illustrative of the claimed subject matter:

1. A paperboard carton for articles arranged in an end-on-end relationship, the carton comprising:
 - six sides, the six sides including a first side disposed between a second side and a third side, the first side being perpendicular a fourth side, the second side, and the third side, the second side and the third side being parallel,
 - a two-piece dispenser that includes a first portion and a second portion; the first portion defined at least partially along its perimeter by a first tear line;
 - the first portion extending at least partially into the first side, the second side, and the third side;
 - the first portion being removable from the carton along the first tear line to create a first opening for article removal,* the second portion being adjacent the first portion and being defined

¹ Appellants identify the real party in interest as Graphic Packaging International, Inc. App. Br. 1.

at least partially along its perimeter by the first tear line, a first provision, and a second provision;

the first provision having a first end proximate the first portion and a second end distal the first portion, the second end of the first provision being intersected by a first intersection line that prevents the first provision from extending beyond its intended length;

the second provision having a first end proximate the first portion and a second end distal the first portion, the second end of the second provision being intersected by a second intersection line that prevents the second provision from extending beyond its intended length;

the second portion being separable along the first provision and the second provision to create a second opening in the carton; and

wherein the second opening and the first opening together define an enlarged opening, the enlarged opening enabling easier article removal from the carton than the first opening alone.

REJECTIONS

Appellants seek review of the following rejections:

(1) the rejection of claims 1, 6, 9, 60-66, 70-73, 75, and 76 under 35 U.S.C. § 102(b) as anticipated by Hoy (US 5,878,947, iss. Mar. 9, 1999) (Ans. 3-8); and

(2) the rejection of claims 2 and 4 under 35 U.S.C. § 103(a) as unpatentable over Hoy (Ans. 9).

ANALYSIS

*Rejection of claims 1, 6, 9, 60-66, 70-73, 75, and 76
under 35 U.S.C. § 102(b) as anticipated by Hoy*

Appellants argue claims 1, 6, 9, 60-66, 70-73, 75, and 76 as a group. App. Br. 5-7. We select independent claim 1 as the representative claim. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2011).

Appellants contend that Hoy fails to disclose a “first portion being *removable* from the carton along the first tear line to create a first opening for article removal.” Claims App’x. (emphasis added); App. Br. 5-7. In particular, Appellants contend that “stop 56 [formed by the Examiner-identified first portion comprising strips 58, 60 and flap 62] remains attached to the carton so that it can perform its function of stopping the cans as they roll out of the carton.” App. Br. 6. Appellants point out there are *tear* lines on only three sides of strips 58, 60, whereas there is merely “a *fold* line on the fourth side . . . so that the strips [58, 60] can be folded relative to strip 62.” *Id.* (emphasis added). Since the strips 58, 60 are hingedly connected to the carton, the Appellants contend that the examiner has failed to show a first portion that is removable from the carton as claimed. *Id.* at 6-7.

The Examiner found that “the reference discloses a package made of paperboard.” Ans. 10 (citing Hoy, col. 1, l. 6). The Examiner further found that “the lines of perforation [for the dispenser tray 50 “to be torn out”] in combination with the material provides a disclosure which enables a first portion [strips 58, 60 and flap 62] to be removed from the carton.” *Id.*; Hoy, col. 3, ll. 7-9. The Examiner further found that “the stop 56 [formed by the Examiner-identified first portion comprising strips 58, 60 and flap 62] does not need to be completely removed in order to anticipate the claims because

Appellant does not claim removal in such a way that requires actual separation from the carton.” *Id.* at 12.

The combination of tear-out lines and/or fold lines surrounding strips 58, 60 and flap 62, coupled with the paperboard material of the carton, as pointed out by the Examiner, support that the first portion of strips 58, 60 and flap 62 are reasonably capable of being removed or gotten rid of from the carton along such tear-out lines and/or fold lines.² It is immaterial whether Hoy discloses the actual removal of strips 58, 60 and flap 62 since the claims do not require actual removal of the first portion, but rather merely require that the first portion be “removable” or capable of being removed. Claims App’x. The United States Patent and Trademark Office gives claims their broadest reasonable interpretation consistent with the specification, reading claim language in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. Of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

Appellants additionally contend that “[e]ven if the strip 58, 60 of *Hoy* (the ‘first portion’) were considered removed from the carton, it would not create a first opening for removal of articles 52.” Reply Br. 7. In particular, Appellants contend that “the first opening [created by removal of strips 58,

² We find the definition of “removable” is “to be capable of being removed.” Reply Br. 6 (citing MERRIAM-WEBSTER’S COLLEGIATE DICTIONARY (11th ed. 2004)). We adopt the definition of “remove” advanced by the Appellants—“to get rid of”—as the broadest *reasonable* interpretation in light of the disclosure in Appellants’ Specification, which distinguishes between the removable portion 33 and the stop wall 28 that remains fixed to the carton but can also have an outwardly flexing portion. *Id.* at 5-6 (citing Spec. 3, ll. 24-25 and Spec. 4, ll. 23-25); *see also* Spec. 5, ll. 14-20.

60] would not enable any article removal at all.” *Id.* Claim 1 does not include structural limitations (*e.g.*, size or shape) with regard to the recited articles. The removal of Hoy’s strips 58, 60 creates a first opening capable of article removal when utilized with articles of appropriately configured sizes and shapes. *See* Ans. 4. The burden shifted to Appellants to show that removal of Hoy’s strips 58, 60 would not necessarily create a first opening that would allow for article removal. *See In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997) (once the Examiner finds that the prior art structure would be capable of performing all of the functions claimed, the burden shifts to the applicant to show that this is not the case). Appellants’ arguments are not persuasive because they are based specifically on Hoy’s articles 52, rather than simply “articles” without any structural limitations as recited.

For the foregoing reasons, we find that the Examiner did not err in finding that the subject matter of claim 1 was disclosed by Hoy, and we sustain the rejection of claims 1, 6, 9, 60-66, 70-73, 75, and 76 under 35 U.S.C. § 102(b).

*Rejection of claims 2 and 4
under 35 U.S.C. § 103(a) as unpatentable over Hoy*

Claims 2 and 4 depend from claim 1. Claim 2 recites a carton according to claim 1 “wherein a divider pad is secured to the inside of the carton,” and claim 4 recites “the divider pad has a fold down gluing panel.” Claims App’x. The Examiner acknowledges that Hoy fails to teach a carton where a divider pad is secured to the inside of the carton or wherein the divider pad has a fold down gluing panel. Ans. 9. However, the Examiner

concludes that “adding [the divider pad] would have been obvious because the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art.” *Id.* (citing *In re Leshin*, 227 F.2d 197 (CCPA 1960)).

Appellants contend that the instant case is distinguishable from the facts of *In re Leshin*. Reply Br. 7-8. In particular, Appellants contend that “the question [in the present case] is not the selection of a known material [as in *Leshin*, but] rather . . . whether it would have been obvious to add the claimed additional structure to the *Hoy* carton.” *Id.* The reasoning to support a conclusion of obviousness may, in appropriate circumstances, properly come from legal precedent established by prior case law. *See, e.g., In re Eli Lilly & Co.*, 902 F.2d 943 (Fed. Cir. 1990). However, we find that the facts in the prior legal decision of *Leshin* are not sufficiently similar to the instant case to support the Examiner’s sole reliance on legal precedent in making a conclusion of obviousness. “The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the *claimed* invention would have been obvious.” *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), cited with approval in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

For the foregoing reasons, we find that the Examiner erred in concluding that the subject matter of claims 2 and 4 would have been obvious over *Hoy* for the reasons stated, and we do not sustain the rejection of claims 2 and 4 under 35 U.S.C. § 103(a).

Appeal 2011-005421
Application 10/523,887

DECISION

The Examiner's rejection of claims 1, 6, 9, 60-66, 70-73, 75, and 76 under 35 U.S.C. § 102(b) is AFFIRMED.

The Examiner's rejection of claims 2 and 4 under 35 U.S.C. § 103(a) is REVERSED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

Klh