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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/718,363	05/01/2007	Quang Phung	11961-004US1 P73112US00	5539
26161	7590	11/21/2016	EXAMINER	
FISH & RICHARDSON P.C. (BO) P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			HELVEY, PETER N.	
			ART UNIT	PAPER NUMBER
			3782	
			NOTIFICATION DATE	DELIVERY MODE
			11/21/2016	ELECTRONIC

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* QUANG PHUNG

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Appeal 2014-008079  
Application 11/718,363  
Technology Center 3700

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Before: CHARLES N. GREENHUT, ANNETTE R. REIMERS, and  
BRENT M. DOUGAL, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from a rejection of claims 1–3 and 6–9. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm, designating our affirmance as a new ground of rejection under 37 C.F.R. § 41.50(b).

CLAIMED SUBJECT MATTER<sup>1</sup>

The claims are directed to a pack for holding food items. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A pack for holding a food item or items, comprising a bag having a pair of sides joined at opposing edges by a respective seam, and a channel shaped holder for the bag formed in card and comprising a pair of side walls to which the sides of the bag are adhered, and a base hinged at first fold lines to the side walls, one side wall of the holder being extended to provide a lid having a fold line with the top of the side wall to enable the lid to be folded over the top of the holder to close the upper end of the bag disposed within the holder, the lid terminating in a flap having a fold line with the lid to enable the flap to be folded downwardly along the other side wall of the channel and means being provided for securing the flap to the other side wall to hold the lid closed over the channel, characterized in that the base of the holder has a plurality of spaced second fold lines extending parallel to the first fold lines to allow the base to take up a generally convex or concave shape with the side walls of the holder spaced apart to hold the side walls of the bag apart; in that the side of the bag adjacent the side wall of the holder on which the lid is formed extends further than the other side of the bag over the underside of the lid to which it is adhered to fold over the top of the bag with the lid; and in that the other side of the bag extends above the side wall to which it is adhered to provide a flap which can be folded over the contents of the bag when the bag is closed by the lid.

REJECTION

Claims 1–3 and 6–9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dold (US 2,987,402) in view of Gordon et al. (US 4,575,000), Stegner (US 3,399,818), and Song (US 4,494,785).

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<sup>1</sup> We refer to the claim listing of Jan. 16, 2013 as the copy appended to the Brief does not appear to be correct.

OPINION

The claims are argued as a group, standing or falling with claim 1. *See* 37 C.F.R. § 41.37(c)(iv).

In order to arrive at the subject matter of claim 1, we understand the Examiner to propose folding the Dold device, oriented as depicted in Figure 1, along lines 13 and 14, instead of, or prior to, folding overhanging flaps 27, 28 inwardly as depicted in Figures 2 and 3. Final Act. 2–3 (discussing Dold and folding in the “opposite order” as taught by Gordon). This operation would have resulted in a structure where the inner, polyvinylidene chloride or “Saran,” wrap 25 forms a folded bag-like structure albeit with unjoined sides. We understand the Examiner to also rely on Gordon to demonstrate that it was known in the art to close the free ends of a wrapper 10 by creating a seam, for example, by using locking panels 30, 32. Final Act. 3; Ans. 7. Applying Gordon’s seaming technique to the Dold device, as depicted in Figure 1, folded about a horizontal axis would yield a structure similar in many respects to that depicted in Appellant’s Figures 2–4. This includes, as the Examiner correctly explains (Ans. 5–6), and Appellant appears to recognize (Reply Br. 1–2 (shifting the focus of their argument from the “extends further” limitation (App. Br. 4–5) to the “seam” limitation)), a height of one side of the wrap 25 that “extends further” than the other.

The only reasoning articulated by the Examiner for applying Gordon’s teachings to Dold is that “it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art.” Final Act. 3 (citing *In re Einstein* 8 USPQ 166, 167 (CCPA 1931)); App. Br. 7.

First, our reviewing court cautioned in *In re Ochiai*, 71 F. 3d 1565, 1572 (Fed. Cir. 1995):

reliance on per se rules of obviousness is legally incorrect and must cease. Any such administrative convenience is simply inconsistent with section 103, which, according to Graham and its progeny, entitles an applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention as claimed in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations.

Second, the Examiner's reasoning only appears to relate to the proposed modification to the folding order and not to employing Gordon's seaming technique.

Despite the shortcomings discussed above, we nevertheless agree with the Examiner's conclusion, which is essentially, that plastic bags would have been an obvious alternative to Dold's Saran wrap for packaging food. The use of such a bag is the product of providing the Dold wrapper pre-folded about panel 18 and seamed along the side edges. This would have been an obvious modification because one skilled in the art would have recognized that it would have been more convenient to package certain commodities, particularly those with increased flowability, using a plastic bag instead of a piece of Saran wrap. Such a modification yields the predictable results of more easily containing certain commodities during packaging.

The Examiner recognizes that Dold's device, modified as described above in light of the teachings of Gordon, would still lack a side of the bag on the side 12 of the holder opposite the lid 17 extending above that side 12 of the holder. *See, e.g.*, Application Figures 2, 3. For this feature the Examiner relies on Stegner, which as the Examiner correctly finds, discloses extending the walls 12 of bag material 10 above side panels 20. Final Act. 3; Stegner Fig. 2. Once again, however, the Examiner appears to rely on a per se rule as opposed to a particularized inquiry as a basis for determining

obviousness. *See* Final Act. 3 (citing *In re Reese*, 129 USPQ 402) (“such a modification would have involved a mere change in the proportions of components. A change in proportion is generally recognized as being within the level of ordinary skill in the art.”); App. Br. 7.

While it is true that Stegner depicts (Fig. 2) and discusses (col. 2, ll. 56–58) the bag 10 extending above paperboard support 18 side panels 20 and receptacle 30, Stegner does not explain why Stegner’s bag may be made from “paper, cloth, foil, laminated materials, or plastic materials such as polyethylene and polyvinyl chloride.” Stegner col. 3, ll. 18–19. One skilled in the art would reasonably infer that bag 10 extends over the support and receptacles so as to provide an additional closure further protecting the contents of the bag. This is particularly true where the bag is composed of plastics that may create a better moisture barrier than the paperboard support 18 or box 30. Dold’s device would similarly benefit from this modification, thereby ensuring the packaged commodity is fully encased in the bag.

We additionally note that the extension of the bag above the holder sidewall is dictated in part by the size of the sidewall, 17 in Dold, and in part by the height of the bag. The function of the sidewall 17 is to cooperate with the flap 21 having a locking tab 23 inserted into slit 22 to form a wall of the finished product (Fig. 10). There does not appear to be any criticality as to the relative sizes of flap 21 and sidewall 17 or the amount of overlap they exhibit. Nor does there appear to be anything more than a routine optimization involved in sizing the bag appropriately for its expected contents. In situations where an applicant seeks to rely on a seemingly uncritical or arbitrarily selected dimension as a basis for distinguishing the claimed invention over the prior-art the applicant bears the burden to come forward with evidence or argument showing criticality of the feature relied

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upon so that the Examiner may consider such evidence in judging obviousness. *In re Woodruff*, 919 F.2d 1575, 1578 (Fed. Cir. 1990) (citation omitted). Appellant has not made any such showing.

Turning to Song, the Examiner correctly found Song discloses a technique for making a holder concave or convex.<sup>2</sup> Final Act. 2. However the Examiner provides circular reasoning for applying this technique to Dold that essentially presumes the conclusion:

it further would have been obvious to a person having ordinary skill in the art to provide the secondary fold lines taught by Song to the panels of the holder assembly taught by Dold, in order to allow the holder to take on a convex or concave shape as taught by Song

Final Act. 4; App. Br. 7.

Song states that the purpose of the disclosed sandwich holder is “the comfortable enjoyment of the round sandwich by the consumer.” Col. 1, ll. 11–13. Perhaps Dold’s package could be used for a round commodity intended to be consumed directly from the package. However, as Dold does not discuss this, Song’s stated purpose, arguably, may not be particularly relevant to Dold’s device. Nevertheless, it has been recognized that “familiar items may have obvious uses beyond their primary purposes.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1742, 167 L.Ed.2d 705 (2007). Dold is depicted as packaging an unspecified commodity which appears to be a frankfurter or some other type of sausage. Sausages or the like generally exhibit some convexity. Applying Song’s technique of forming a package with a concavity corresponding to the convexity of its contents would cause

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<sup>2</sup> As concavity or convexity is, in this instance, dependent upon perspective alone, for the sake of brevity we will hereinafter refer to this feature only as concavity.

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Dold's outer wrap 12 to conform more closely to the shape of the packed commodity. This would have the predictable result of decreasing stress on the outer wrap and minimizing excess material, both of which would predictably make Dold's outer wrap have a neater appearance and be less prone to damage. For these reasons, we are also in agreement with the Examiner's conclusion that, in light of Song, it would have been obvious to provide Dold's panel 18 with a convex or concave shape.

Many of Appellant's arguments do not appear to address the Examiner's rejection as we have either understood it or modified it. We do think it is clear that the cited references are reasonably relevant or derive from the so-called analogous arts, to the extent Appellant argues otherwise. *See App. Br. 7.* As we have acknowledged some shortcomings in the Examiner's rejection and set forth additional facts and reasoning, pursuant to our authority under 37 C.F.R. § 41.50(b), we designate our affirmance of the Examiner's rejection as including a "new ground" so as to afford Appellant a full and fair opportunity to respond.

## DECISION

The Examiner's rejection is affirmed and our affirmance is designated as including a "new ground" of rejection under 37 C.F.R. 41.50(b).

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise

one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

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

AFFIRMED; 37 C.F.R. 41.50(b)