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EXAMINER

HELVEY, PETER N.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte EBO JACQUES DE MUINCK

Appeal 2018-005980¹
Application 13/266,902²
Technology Center 3700

Before BRADLEY B. BAYAT, TARA L. HUTCHINGS, and
AMEE A. SHAH, *Administrative Patent Judges*.

BAYAT, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Our Decision references Appellant's Appeal Brief ("App. Br.," filed Nov. 30, 2017), Reply Brief ("Reply Br.," filed May 21, 2018), the Examiner's Answer ("Ans.," mailed Mar. 20, 2018), and the Final Office Action ("Final Act.," mailed Dec. 30, 2016).

² Appellant identifies "SCHOLLE IPN CORPORATION" as the real party in interest. App. Br. 2.

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the final rejection³ of claims⁴ 1–9, 12, and 13 under 35 U.S.C. § 103(a) as unpatentable over Appel⁵ and Sondaar.⁶ We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

Claimed Invention

Independent claims 1, 12, and 13 are directed to a foldable bag. Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A foldable bag, comprising
 - a front sheet and a back sheet circumferentially joined to each other in an unfolded condition wherein in the unfolded condition the bag has a bottom edge and an opposite top edge, and opposite side edges extending between the top edge and the bottom edge, wherein the bottom edge includes an inner bottom edge portion and outer bottom edge portions located at opposite sides of the inner bottom edge portion and extending up to the respective side edges, and wherein the bottom edge and opposing side edges join the front sheet directly to the back sheet and to define a cavity for fluid, so that the entirety of the back sheet is directly overlying the front sheet throughout the cavity;
 - and wherein in a folded condition in which the bag has a reversed T-shape including a bottom and an upward portion extending upwardly from the bottom, wherein
 - in the folded condition of the bag at the upward portion the side edges are inwardly creased between the front sheet and the back sheet such that they face to each other, and at the bottom the inner bottom edge portion extends substantially within the plane of the upward portion and each of the outer bottom edge portions extend

³ The rejection of claims 1–9 under 35 U.S.C. 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement is withdrawn. Ans. 4.

⁴ Claims 10 and 11 are withdrawn from consideration. Final Act. 1.

⁵ Appel, US 388,612, iss. Aug. 28, 1888.

⁶ Sondaar, US 2009/0297073 A1, pub. Dec. 3, 2009.

substantially parallel above the inner bottom edge portion whereupon filling of the bag in the folded condition returns the bag to the unfolded condition. (See App. Br., Claims Appendix, 7).

ANALYSIS

Obviousness

In rejecting claim 1, the Examiner finds Appel discloses all the claimed limitations except for “the front and back panels being circumferentially joined in the unfolded condition.” Final Act. 3. To cure this deficiency, the Examiner finds “S[]ondaar teaches a similar bag wherein the front and back sheets are circumferentially joined to each other in an unfolded condition (Fig. 2).” *Id.* at 4. According to the Examiner, “it would have been obvious to a person having ordinary skill in the art to construct the packaging taught by Appel with the circumferentially joined front and back sheets as taught by S[]ondaar, in order to reduce manufacturing costs.” *Id.*

Appellant argues that “the modification of Appel as suggested by the Examiner with the teachings of Sondaar would render Appel inoperable for its intended purpose.” App. Br. 5. In particular, Appellant argues Appel describes a method of forming a square-bottom bag from a bellows-sided tube, in which “the bellows are first created and then the bottom is sealed . . . [o]therwise, the square or rectangular form bottom will *not* be formed!” *Id.* (citing Appel 1:53–56; 2:75–95). Appellant contends that “[i]f the teachings of Appel are combined with Sondaar, as the Examiner suggests would be obvious, Appel would be inoperable for its intended purpose, namely, there would *not* be a square or rectangular bottom.” *Id.*

The Examiner responds that this argument is not persuasive in light of the Sondaar gusset folds (see Fig. 6) almost identically mirroring those taught by Appel (see Fig. 1). Nothing would prohibit the Appel square or rectangular bag bottom from being formed after the front and rear sheets were sealed together as taught by Sondaar, contrary to appellant's conclusory statement. The proposed modification would simply result in the Appel bag being formed from two sheets sealed together at the edges as taught by Sondaar rather than a single sheet folded upon itself as taught by Appel.

Ans. 4.

Responding to the Examiner, Appellant argues:

If the bag of Appel was formed after the sheets were sealed together, there would not be a way to form the rectangular base that is the very basis of Appel. That is, the very essence of Appel is to form a gusseted bag that is folded, and when unfolded, the bag assumes a rectangular base and a rectangular cross-sectional configuration (all formed from a hoop of material). This is accomplished by forming the bottom of the bag after the formation of the gussets, so that the gussets expand into a straight wall. To the contrary, with the present invention, the bag returns to a pillow type configuration, which is something quite different than that which is shown in Appel.

Reply Br. 2.

We are persuaded by Appellant's arguments. It is well established that where the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, the proposed modification would not have been obvious. *See Tec Air, Inc. v. Denso Mfg. Michigan Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999) (citations omitted); *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984).

Appel relates to the manufacture of bellows-sided square-bottom paper bags. Appel 1:10–12. Appel’s invention aims to improve upon ordinary bellows-sided square-bottom bags that require manipulation to assume a square or rectangular form when the bag is filled. *Id.* 1:16–27 (“[I]t is necessary, previous to filling the bag, to open the bag and form or partly form certain creases or folds in the material at the bottom by hand.”). According to Appel, efforts made to produce such bags without requiring hand manipulation in order to cause the bag bottom to assume a square or rectangular form when filled had failed because the proposed operations could not be performed by machinery and with sufficient rapidity to make such bags a commercial success. *Id.* 1:33–41. The object of Appel’s invention is “to produce bellows-sided square-bottom bags which shall be so constructed that when the bag is distended, as in the act of filling, the bottom will assume a square or rectangular form without the necessity of any hand manipulation.” *Id.* 1:42–48. Thus, Appel’s invention is directed to “a method of forming a square-bottom bag from a bellows-sided tube” at a very rapid rate by using a simple machinery, without the necessity of any hand manipulation. *Id.* 1:50–55.

If Appel is modified to replace the bellows-sided tube with two sheets circumferentially joined by spot welds, as suggested by the Examiner, we agree that a base as envisioned by Appel could not be formed, such that when the bag is filled, its bottom will assume a square or rectangular form without any hand manipulation. Indeed, the intended purpose and improvement of Appel’s invention involves a particular process for using a bellows-sided tube with machinery, which is “accomplished by simply distending or carrying apart the sides *c* of the tubular blank upon lines 3 4,

while the mouth of the bottom-forming end remains in a closed or practically closed position.” *Id.* 2:12–17; *see also id.*, Claim 1. Because the proposed modification advanced by the Examiner would make the bag of Appel unsatisfactory for its intended purpose and/or inoperative, the Examiner has not adequately shown that it would have been obvious to one of ordinary skill in the art to pursue such a modification to save on manufacturing costs.

We are persuaded the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a) as unpatentable over Appel and Sondaar. Therefore, we do not sustain the rejection of independent claim 1, as well as independent claims 12 and 13, which are substantially similar to claim 1 and are rejected based on the same rationale. *See* Final Act. 3–4. We also do not sustain the rejection of claims 2–9, which depend from independent claim 1. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“dependent claims are nonobvious if the independent claims from which they depend are nonobvious”).

DECISION

The rejection of claims 1–9, 12, and 13 under 35 U.S.C. § 103(a) as unpatentable over Appel and Sondaar is reversed.

REVERSED