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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEVE A. FLAM

Appeal 2019-001903
Application 13/774,203
Technology Center 3700

Before EDWARD A. BROWN, WILLIAM A. CAPP, and
MICHAEL J. FITZPATRICK, *Administrative Patent Judges*.

CAPP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Steve A. Flam (hereinafter “Appellant”)¹ seeks our review under 35 U.S.C. § 134(a) of the final rejection of claims 1, 4–7, 11–15, and 17–19. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

THE INVENTION

Appellant’s invention relates to packaging materials. Spec. ¶¶ 1–6. Claim 1, reproduced below, is illustrative of the subject matter on appeal.

¹ We use the word “Appellant” to refer to “Applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies Innpact Inc. as the Applicant and real party in interest. Appeal Br. 2.

1. An attachment for protecting a substantially flat article comprising:

a first portion having a body, said body having a top that defines a top surface, a bottom that defines a bottom surface, an inner side wall, an outer side wall, a first arm, and a second arm, said first and second arms intersecting at a 90 degree angle, a plurality of finger-like projections attached to said outer side wall, one of said plurality of finger-like projections being a corner projection, each one of said plurality of finger-like projections comprising a first surface that lies in the same plane as the bottom surface and a second surface that lies above the top surface, wherein the length of each one of the finger-like projections extends from the first surface to the second surface;

a second portion having a body, said body having a top that defines a top surface, a bottom that defines a bottom surface, an inner side wall, an outer side wall, a first arm, and a second arm, said first and second arms intersecting at a 90 degree angle, a plurality of finger-like projections attached to said first outer side wall, one of said plurality of finger-like projections being a corner projection, each one of said plurality of finger-like projections comprising a first surface that lies in the same plane as the bottom surface and a second surface that lies above the top surface, wherein the length of each one of the finger-like projections extends from the first surface to the surface;

wherein said first and second portions are identical and wherein an end of said first arm of said first portion is directly connected to and separable from an end of said first arm of said second portion and whereby, once said first portion is separated from said second portion and placed thereover with the flat article fitted therebetween, said finger-like projections of said first portion may pass by said finger-like projections of said second portion until said top of said first portion and the top of said second portion each contact the flat article captured therebetween, said corner projection of said first portion mating with said corner projection of said second portion, a gap between said top of said first portion and said top of said second portion being of any size less than the lengths of said finger-like projections.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Pezely	US 3,302,782	Feb. 7, 1967
Kuhn	US 5,711,426	Jan. 27, 1998
Beliveau	US 2002/0056656 A1	May 16, 2002
Eyal	US 6,478,354 B1	Nov. 12, 2002
Liverman	US 2005/0115864 A1	June 2, 2005

The following rejections are before us for review:

1. Claims 17 and 18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.
2. Claims 1, 6, 7, 13, 14, 17, and 18 are rejected under 35 U.S.C. § 103 as being unpatentable over Liverman, Pezely, and Kuhn.
3. Claims 4, 5, 11, 12, and 19 are rejected under 35 U.S.C. § 103 as being unpatentable over Liverman, Pezely, Kuhn, and Beliveau.
4. Claim 15 is rejected under 35 U.S.C. § 103 as being unpatentable over Liverman, Pezely, Kuhn, and Eyal.

OPINION

Indefiniteness of Claims 17 and 18

The Examiner rejected claims 17 and 18 because each claim is recited as depending from claim 16, which has been cancelled. Final Action 2–3, Claims App. Appellant does not contest this ground of rejection. Appeal Br. 11. The rejection is hereby summarily sustained.

*Unpatentability of Claims 1, 6, 7, 13, 14, 17, and 18
over Liverman, Pezely, and Beliveau*

Claims 1 and 6

Appellant argues claim 1, but presents no separate arguments for the patentability of claim 6. Appeal Br. 11–15. We analyze claim 1 such that claim 6 will stand or fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner finds that Liverman discloses the invention substantially as claimed except for: (1) the finger-like projections lying in the same plane as the bottom surface of the first and second portions; and (2) arms of the first and second portion between directly connected and separable. Final Action 4–6. The Examiner relies on Pezely as disclosing projections lying in the same plane as claimed. *Id.* at 5. The Examiner relies on Kuhn as disclosing arms that are connected and separable. Final Action 6. The Examiner concludes that it would have been obvious to a person of ordinary skill in the art at the time of the invention to dispose the projections in the same plane as the bottom surface of the body. *Id.* According to the Examiner, a person of ordinary skill in the art would have done this to reduce the width of the container. *Id.* The Examiner also concludes that it would have been obvious to a person of ordinary skill in the art at the time of the invention to make arm ends connected and separable. *Id.* According to the Examiner, a person of ordinary skill in the art would have done this to ensure that both portions are delivered together. *Id.*

Appellant argues that it would be impossible to attach the components of Liverman to one another at “ends of the arms” as claimed. Appeal Br. 11–13. Appellant contends that Liverman’s columns would prevent the arms of the portions from coming into direct contact with one another.

Reply Br. 5. Appellant, relying on a dictionary definition, construes “end” as “the extreme or last part *lengthwise*.” *Id.* at 13 (emphasis added).

In response, the Examiner maintains that Appellant has not specifically claimed the location of the ends in relation to the structural components of the portions of the end protector. Ans. 18. According to the Examiner, “whether a specific location constitutes an end is simply a matter of perspective.” *Id.* Thus, “any location on a portion may be interpreted as an end.” *Id.* The Examiner directs our attention to Figure 2 of Liverman and finds that “any of the outer surfaces of the arms of either one of the upper or lower portions of the attachment may be interpreted as an ‘end’ because each of them are at ‘the extreme or last part lengthwise’ of their respective portions when viewed from a particular perspective.” *Id.*

The dispute between Appellant and the Examiner calls on us to construe the following claim term:

an end of said first arm of said first portion is directly connected to and separable from an end of said first arm of said second portion.

Claims App. During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Under the broadest reasonable interpretation standard, claim terms are given their ordinary and customary meaning as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). The person of ordinary skill in the art is deemed to read the claim term in the context of the particular claim in which the disputed term appears

as well as in the context of the entire patent, including the Specification.

Phillips v. AWH Corp., 415 F.3d 1303, 1313 (Fed. Cir. 2005).

Appellant's attachment 10 is comprised of first portion 12 and second portion 14. Spec. ¶ 19, Fig. 1. Each such portion includes a body 16 and a plurality of finger-like projections 18 and 22 respectively. *Id.* In the embodiment depicted in Figure 1, the separable connection between the first and second portions is shown at break away notch 24, which connection is disposed at the junction of first body portion 16 and second body portion 20. *Id.* However, Appellant's disclosure disclaims that the embodiment of Figure 1 is limiting.

In the following figures, the same reference numerals will be used to refer to the same components. In the following description, various operating parameters and components are described for different constructed embodiments. These specific parameters and components are included as examples and are *not meant to be limiting*.

Spec. ¶ 17.

It is not clear from reading Appellant's Specification whether body 16 and finger-like projections 18 are considered mutually exclusive physical components of first portion 12 or whether they may share (or encompass overlapping) structure within such portion. *See generally* Spec. In other words, does body 16 of first portion 12 include or exclude finger like projections 18? The same can be said and asked of the components of second portion 14. *Id.*

Appellant's attachment 10 is a three-dimensional object with a height, width, and depth. *See* Figs. 1 and 2. Each of the plurality of finger-like projections 18, 22, similarly has a three-dimensional shape. *Id.* Notably, the claim term "arm" was added to the claims by amendment during prosecution

and does not appear anywhere in the original Specification. *See generally* Spec. Thus, there is no enumerated element in the drawings that identifies the location of an “arm” *per se*.

Under the circumstances and applying the broadest reasonable interpretation, the claimed “arm” could correspond to any of several features depicted on attachment 10, including some or all of projections 18, 22. Further, we are not constrained to adopt Appellant’s dictionary definition of “end” limiting the claim to a “lengthwise” end of the arm. Our supervising court cautions against indiscriminate reliance on definitions found in dictionaries, because it can often produce absurd results. *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998) (*quoting Liebscher v. Boothroyd*, 258 F.2d 948, 951 (CCPA 1958)). *Phillips* explains that reliance on dictionary definitions focuses the inquiry on the abstract meaning of words rather than on the meaning of claim terms within the context of the patent.

[H]eavy reliance on the dictionary divorced from the intrinsic evidence risks transforming the meaning of the claim term to the artisan into the meaning of the term in the abstract, out of its particular context, which is the specification. *Id.* at 1321. Thus, although Appellant’s chosen dictionary definition restricts the meaning of arm to the extreme or last part “lengthwise,” this is only one of several definitions offered by that dictionary, which dictionary is but one of many dictionaries. Appeal Br. 13.² *Phillips* recognizes the problem posed by multiple dictionary definitions.

Dictionaries, by their nature, provide an expansive array of definitions. General dictionaries, in particular, strive to collect

² <https://www.merriam-webster.com/dictionary/end> accessed October 4, 2019.

all uses of particular words, from the common to the obscure. By design, general dictionaries collect the definitions of a term as used not only in a particular art field, but in many different settings.

Phillips, 415 F.3d at 1321. As observed by the court, a “claim should not rise or fall based upon the preferences of a particular dictionary editor.” *Id.* at 1322. Thus, even if Appellant’s proposed dictionary definition may be considered reasonable, it is not necessarily the broadest, reasonable construction.

In view of the foregoing, it is within the broadest reasonable construction of the “*end of the arm*” limitation to include any component of an attachment portion that resembles an “arm,” including all or a portion of finger-like projections 18. Moreover, an “end” of such arm may include any lateral extent of such arm which may or may not coincide with the length of such arm.

Construing “arm” and “end” broadly, but reasonably, the Examiner’s finding that the portions of Liverman can be connected at their ends is supported by a preponderance of the evidence. Appellant’s argument that Liverman’s columns prevent the arms from coming into direct contact is predicated on an overly narrow claim construction and is, therefore, unpersuasive. Reply Br. 5. Consequently, we sustain the Examiner’s unpatentability rejection of claims 1 and 6.

Claims 7, 13, 14, 17, and 18

Claim 7 is an independent claim that is substantially similar in scope to claim 1. Claims App. Claim 13 depends therefrom. *Id.* Claim 14 is an independent claim that is substantially similar in scope to claim 1, except that it is a method claim. *Id.* Claims 17 and 18 are treated, for purposes of

the art rejection, as depending from 14. *Id.*, Final Action 3, Appeal Br. 11. Claims 7, 13, 14, 17, and 18 are not separately argued. Appeal Br. 16–17. Thus, they fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv) (failure to separately argue claims).

*Unpatentability of Claims 4, 5, 11, 12, and 19
over Liverman, Pezely, Kuhn, and Beliveau*

These claims depend, directly or indirectly, from either claims 1, 7, or 14 and are not separately argued. Appeal Br. 15, 16, 18. We sustain the Examiner’s rejection thereof. 37 C.F.R. § 41.37(c)(1)(iv).

*Unpatentability of Claim 15
over Liverman, Pezely, Kuhn, and Eyal*

Claim 15 depends from claim 14 and is not separately argued. Appeal Br. 17. We sustain the Examiner’s rejection. 37 C.F.R. § 41.37(c)(1)(iv).

CONCLUSION

In summary:

Claims Rejected	Basis	Reference(s)	Aff’d	Rev’d
17, 18	§ 112		17, 18	
1, 6, 7, 13, 14, 17, 18	§ 103	Liverman, Pezely, Kuhn	1, 6, 7, 13, 14, 17, 18	
4, 5, 11, 12, 19	§ 103	Liverman, Pezely, Kuhn, Beliveau	4, 5, 11, 12, 19	
15	§ 103	Liverman, Pezely, Kuhn, Eyal	15	
Summary			1, 4-7, 11-15, 17-19	

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