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Indiana University Maurer School of Law Intellectual Property Legal Clinic 211 South Indiana Avenue Bloomington, IN 47405			ATTEL, NINA KAY	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KRISTIL MITCHELL

Appeal 2019-005968
Application 15/046,989
Technology Center 3700

Before JOHN C. KERINS, WILLIAM A. CAPP, and
MICHAEL L. WOODS, *Administrative Patent Judges*.

Opinion for the Board filed by WOODS, Administrative Patent Judge

Opinion Concurring filed by CAPP, Administrative Patent Judge

WOODS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 2–21. Appeal Br. 3. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Kristi L. Mitchell. Appeal Br. 3.

CLAIMED SUBJECT MATTER

The application is titled “Bag for Toy Organization.” Spec. 1. Claims 2 and 14 are independent. Claims App. (filed Nov. 30, 2018). We reproduce claim 2, below, which is illustrative of the claimed subject matter:

2. A bag for holding toys comprising:
 - a front panel having a first perimeter;
 - a rear panel having a second perimeter, the front panel being substantially parallel to the rear panel, the front panel and the rear panel being substantially transparent;
 - a mesh panel connecting the front panel and the rear panel, the mesh panel having a front perimeter and a rear perimeter, the front perimeter of the mesh panel extending around the first perimeter, the rear perimeter of the mesh panel extending around the second perimeter,
 - the mesh panel, the front panel, and the rear panel defining an interior space sized to hold toys;
 - substantially rigid tubing* stitched the rear perimeter of the mesh panel and the second perimeter, the front perimeter of the mesh panel being connected to the first perimeter by the substantially rigid tubing stitched to the front perimeter of the mesh panel and the first perimeter;
 - a first support strap extending between the first perimeter and the second perimeter;*
 - a second support strap extending between the first perimeter and the second perimeter;* and
 - a closure coupled to the mesh panel extending from the first support strap to the second support strap.

Id. at 2 (emphases added to limitations addressed in this Decision).

REFERENCES

The evidence relied upon by the Examiner is:

Name	Reference	Date
Fenster	US 7,334,941 B2	Feb. 26, 2008
Gattino	US 2008/0063318 A1	Mar. 13, 2008
Rappaport	US 8,002,115 B2	Aug. 23, 2011
Kern	US 2013/0156351 A1	June 20, 2013
Carrier	US 8,777,076 B1	July 15, 2014
Whitaker	US 2015/0000805 A1	Jan. 1, 2015
Spivack	US 2015/0246751 A1	Sept. 3, 2015
Gardner	US 2015/0321795 A1	Nov. 12, 2015

REJECTIONS²

The following rejections are before us on appeal:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis
2–21	112(a)	Written Description
2, 7–11	103	Whitaker, Gardner
3–6	103	Whitaker, Gardner, Gattino
12, 13	103	Whitaker, Gardner, Kern, Rappaport
14–19	103	Whitaker, Spivack, Gardner
20	103	Whitaker, Spivack, Gardner, Fenster or Carrier
21	103	Whitaker, Spivack, Gardner, Kern, Rappaport

Final Act. 2–14.

² Claims 4, 5, and 14 are also objected to for containing informalities. Final Act. 2. Appellant attempts to overcome these objections in an amendment after final. *See* Appeal Br. 4 (“The objections to claims 2, 4, and 14 [sic] are addressed by amendment . . .”). Appellant’s amendment was not entered. Adv. Act. (dated Sept. 11, 2018). We do not decide these objections as they are petitionable matters. *See* MPEP § 706.01 (“[T]he Board will not hear or decide issues pertaining to objections and formal matters which are not

OPINION

I. Written Description Rejections

The Examiner rejects claims 2–21 under 35 U.S.C. § 112(a) as failing to comply with the written description requirement. Final Act. 3. In rejecting these claims, the Examiner determines that limitations from independent claims 2 and 14 and limitations from dependent claims 4 and 9 lack adequate written description support. *See id.* at 3–4. We address each of these rejections separately, below.

a. Independent Claims 2 and 14

As to independent claims 2 and 14, the Examiner determines that the limitation “substantially rigid tubing” was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Final Act. 3.

To overcome this rejection, Appellant sought unsuccessfully to amend the claims to eliminate the term “substantially rigid.” *See* Appeal Br. 8; *see also* Ans. 4 (“The amendment filed August 27, 2018 included amending claims 2 and 14 to eliminate the limitation ‘substantially rigid’ . . . was not entered”). Other than Appellant’s failed attempt to amend the claims, Appellant presents no arguments. *See* Appeal Br. 8; *see also* Ans. 4 (confirming the same).

properly before the Board.”); *see also* MPEP § 1201 (“The Board will not ordinarily hear a question that should be decided by the Director on petition . . .”).

Because Appellant offers no substantive analysis or argument in the Appeal Brief to show that the Examiner erred in rejecting claims 2 and 14 under 35 U.S.C. § 112(a), any such arguments that Appellant could have made are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv); *see also Hyatt v. Dudas*, 551 F.3d 1307, 1313–14 (Fed. Cir. 2008) (holding that the Board may treat arguments the appellant failed to make for a given ground of rejection as waived).

Therefore, we sustain the Examiner’s rejection of independent claims 2 and 14 under 35 U.S.C. § 112(a).

b. Dependent Claim 4

The Examiner also determines that the additional limitations recited in dependent claim 4 lack adequate written description support. Final Act. 3–4. Appellant does not present arguments to contest this rejection. *See* Appeal Br. 8; *see also* Ans. 4 (confirming the same). As such, Appellant waives any arguments that could have been made (37 C.F.R. § 41.37(c)(1)(iv)) and we further sustain the rejection of claim 4 under 35 U.S.C. § 112(a).

c. Dependent Claim 9

The Examiner also determines that the additional recitations of “wherein the first [and second] support strap[s] extend[] from an *upper half* of the first perimeter to an *upper half* of the second perimeter” also lack adequate written description support. *See* Final Act. 3–4 (emphases added). In finding that these claim limitations lack written description support, the Examiner apparently takes issue with the location of the two “support

straps” as extending from the “*upper half* of the first perimeter to an *upper half* of the second perimeter.” *See id.*

Appellant contests the rejection, and submits that these limitations are adequately supported by Figures 1 and 2 of the Specification. *See Appeal Br. 8.*

In the Answer, the Examiner states that “figures 1 and 2 are not ‘to scale’, are merely perspective views of the bag from different angles, and the figures do not include a plan side view of the mesh panel.” Ans. 5.

Appellant has the better position. We find that Figure 1 provides written description support for the claimed limitations. *See Cooper Cameron Corp. v. Kvaerner Oilfield Prods., Inc.*, 291 F.3d 1317, 1322 (Fed. Cir. 2002) (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1565 (Fed. Cir. 1981)) (“under proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by § 112”).

To illustrate our point, we reproduce an annotated version of Figure 1, below.

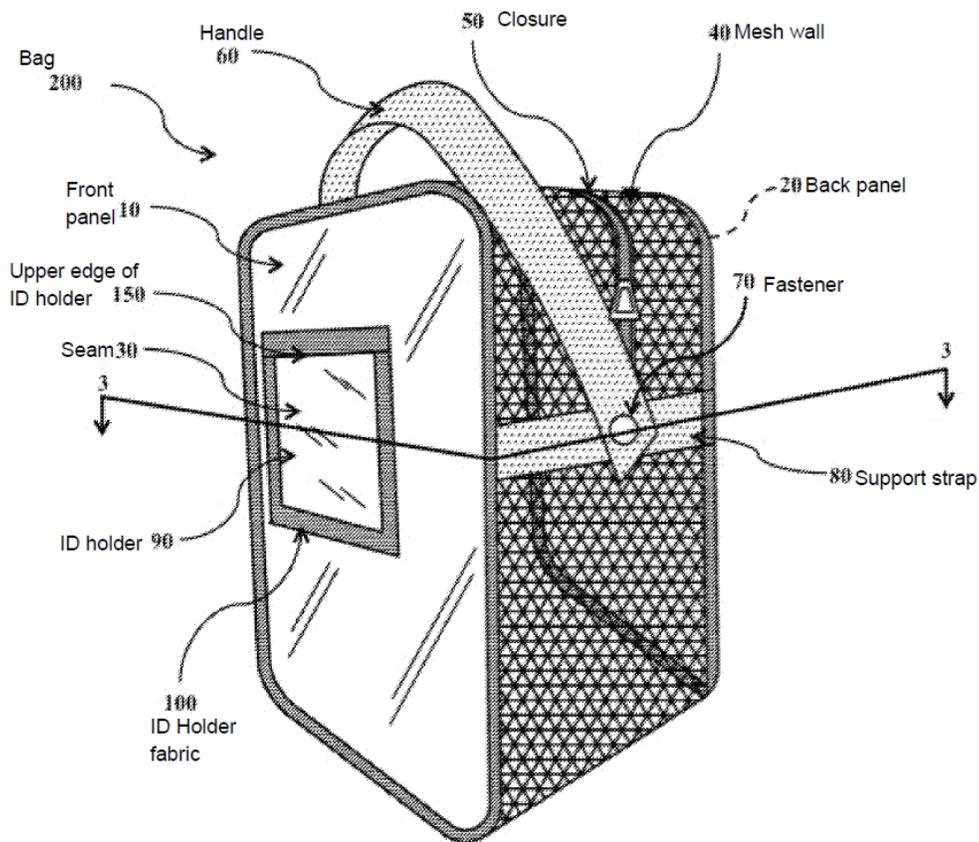


FIG. 1

As shown above, annotated Figure 1 depicts bag 200 with front panel 10 having a first perimeter, back panel 20 having a second perimeter, and support straps 80 on each side of the bag. *See Spec.* ¶¶ 17, 19, 21. We find that this figure reasonably conveys that the applicant had possession of the claimed “wherein the first [and second] support strap[s] extend[] from an *upper half* of the first perimeter to an *upper half* of the second perimeter.”

Accordingly, we do not sustain the *additional* rejection of dependent claim 9 under § 112(a) as failing to comply with the written description requirement.

d. Summary of Claims 2–21

We sustain the rejection of independent claims 2 and 14 for failing to comply with the written description requirement under 35 U.S.C. § 112(a). Because dependent claims 3–13 and 15–21 depend from claim 2 or 14, the dependent claims inherit the same written description infirmity. Accordingly, we affirm the rejection of claims 2–21 under 35 U.S.C. § 112(a) as failing to comply with the written description requirement.

II. Prior Art Rejections

The Examiner rejects claims 2–21 based on Whitaker and other secondary references. *See* Final Act. 4–14. In rejecting independent claim 2, the Examiner finds that Whitaker discloses, *inter alia*, “a first support strap extending between the first perimeter and the second perimeter” and “a second support strap extending between the first perimeter and the second perimeter.” *See id.* at 5 (citing Whitaker Figs. 1–4, ¶¶ 13–18). In rejecting independent claim 14, the Examiner similarly finds that Whitaker discloses “a first support strap extending from the front panel to the second rear panel” and “a second support strap extending from the front panel to the second rear panel.” *See id.* at 9 (citing Whitaker Figs. 1–4, ¶¶ 13–18).

We reproduce Whitaker’s Figure 1, below:



FIG. 1

Figure 1 “is a front perspective view of a transparent bag with removable flap.” Whitaker ¶ 6. Whitaker’s paragraphs 13–18—which the Examiner cites to in support of the rejection—constitute the entire Detailed Description of Whitaker. *See id.* ¶¶ 13–18. We also note that Whitaker’s figures do not include the reference numerals referenced in its specification. *See id.* ¶¶ 13–18, Figs. 2–7.

In contesting the rejection, Appellant argues, “Whitaker teaches a perimeter strap that is *continuous around the entire perimeter of the bag*. The examiner conflates this perimeter strap with the ‘attachment strip.’” Appeal Br. 9 (citing Whitaker ¶¶ 14, 17) (emphasis added).

In response to Appellant’s argument, the Examiner submits an annotated version of Whitaker’s Figure 3 (Ans. 6), which we reproduce, below:

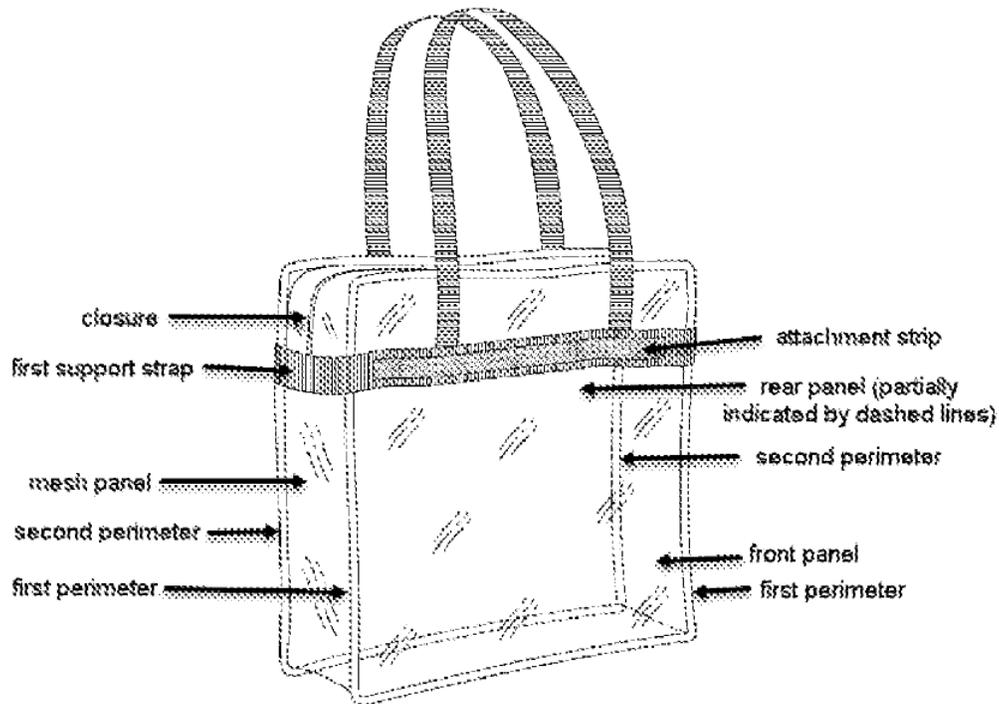


FIG. 3
annotated figure

Figure 3 “is a front perspective view of a bag with the flaps removed.” Whitaker ¶ 8. According to the Examiner, “Whitaker does in fact teach a strap (support strap) that *extends continuously around a perimeter of the bag* and an attachment strip that extends discontinuously around the perimeter of the bag . . . the examiner does not conflate the strap with the attachment strip.” Ans. 6 (emphasis added). The Examiner explains, however, that the “claim does not require that the first and second support straps be discontinuous, distinct or otherwise separately defined straps.” *Id.* at 6–7.

We disagree with the Examiner's interpretation that the claims do not require separate straps. Indeed, the claims explicitly recite a "first support strap" and a "second support strap" and the Examiner's interpretation that Whitaker's single, continuous support strap satisfies both claimed elements is unreasonably broad. *See, e.g., Engel Indus., Inc. v. Lockformer Co.*, 96 F.3d 1398, 1404–05 (Fed. Cir. 1996) (concluding that where a claim provides for two separate elements, a "second portion" and a "return portion," these two elements "logically cannot be one and the same").

Furthermore, and although we give claim language their broadest reasonable interpretation, we read such 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). As we read the claim language, namely, the first and second support straps in light of the Specification, we find that the Specification describes *two* support straps 80, one on each side of bag 200. *See, e.g., Spec.* ¶¶ 21, 22.

In light of how "first support strap" and "second support strap" are recited in the claims and described in the Specification, the Examiner's determination that Whitaker's single continuous strap satisfies the claimed "first support strap" and "second support strap" is unreasonable and constitutes reversible error.

Accordingly, we do not sustain any of the prior art rejections based on Whitaker.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Reversed	Affirmed
2–21	112, first paragraph	Written Description		2–21
2, 7–11	103	Whitaker, Gardner	2, 7–11	
3–6	103	Whitaker, Gardner, Gattino	3–6	
12, 13	103	Whitaker, Gardner, Kern, Rappaport	12, 13	
14–19	103	Whitaker, Spivack, Gardner	14–19	
20	103	Whitaker, Spivack, Gardner, Fenster, Carrier	20	
21	103	Whitaker, Spivack, Gardner, Kern, Rappaport	21	
Overall Outcome				2–21

TIME PERIOD FOR RESPONSE

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Ex parte KRISTIL MITCHELL

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OPINION CONCURRING

CAPP, *Administrative Patent Judge*

I concur in the result reached by the majority. However, I write separately to comment on the merits of the art rejection.

Whitaker discloses a carry bag with a support strap that, among other things, provides structure to support the attachment points for the handles. The claim calls for two support straps. Claims App. I am not persuaded by the Examiner's allegation and argument that one strap is really two straps. Neither, however, am I impressed with Appellant's position that merely bifurcating a single strap, which is known in the art via Whitaker, into two separate straps rises to the level of a patentable invention where all of the other elements of the invention are known in the prior art. However, the Board enters a new ground of rejection at its discretion, and no inference should be drawn from a failure to exercise that discretion. *See* 37 C.F.R. § 41.50(b); *see also* Manual of Patent Examining Procedure (MPEP) § 1213.02.

Appeal 2019-005968
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In the event that prosecution of this application continues after resolution of this appeal, I leave it to the Examiner whether to find additional art showing separate support straps for each of two handles or providing additional reasons as to why a person of ordinary skill in the art would have considered it obvious to modify Whitaker to have two support straps instead of a single strap.