

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte WESLEY C. FORT

Appeal No. 2002-1147
Application No. 09/305,799

ON BRIEF

Before COHEN, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2 and 5 to 15, which are all of the claims pending in this application.¹

We REVERSE.

¹ Claim 2 was amended subsequent to the final rejection.

BACKGROUND

The appellant's invention relates to sift proof containers designed to prevent leakage of particulate contents or infestation by insects (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Smitherman	5,540,774	July 30, 1996
Jenkins	5,688,218	Nov. 18, 1997

Claims 1, 2 and 6 to 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Jenkins.

Claims 1, 2 and 5 to 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Jenkins in view of Smitherman.²

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer

² Since the rejection of claim 2 under 35 U.S.C. § 112, second paragraph, set forth in the final rejection (Paper No. 5, mailed September 26, 2000) was not set forth in the examiner's answer we assume that this ground of rejection has been withdrawn by the examiner. See Ex parte Emm, 118 USPQ 180, 181 (Bd. App. 1957).

(Paper No. 8, mailed July 6, 2001) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 7, filed April 26, 2001) and reply brief (Paper No. 9, filed September 10, 2001) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1, 2 and 5 to 15 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting **evidence** that would have led one of ordinary skill in the art to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560,

562 (CCPA 1972). **Evidence** of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998), cert. denied, 119 S. Ct. 1804 (1999). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." Thus, when an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002). See also In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Obviousness rejection based on Jenkins alone

We will not sustain the rejection of claims 1, 2 and 6 to 15 under 35 U.S.C. § 103 as being unpatentable over Jenkins.

In this rejection, after setting forth the pertinent teachings of Jenkins, the examiner ascertained³ (brief, p. 4) that

Jenkins meets all claimed limitations except for: (1) the adhesive at portions 46 and 48 being confined to the corner portions of the minor flaps extending partially toward the opposed edges and the minor flaps as set forth in claims 1, 9 and 10 and (2) the adhesive portion at 70 is confined to the corners of the first major flap 24 as set forth in claims 8, 9, and 10.^[4]

The examiner then concluded that such differences would have been obvious to a person of ordinary skill in the art since such changes would be within the level of ordinary skill in this art.

In this rejection, the examiner has not set forth any **evidence** of any suggestion, teaching, or motivation as to why it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified Jenkins to arrive at the claimed invention. Accordingly, the examiner has not presented a prima facie case

³ After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

⁴ The examiner did not ascertain the differences between Jenkins and independent claim 15.

of obviousness. Therefore, the decision of the examiner to reject claims 1, 2 and 6 to 15 under 35 U.S.C. § 103 is reversed.

Obviousness rejection based on Jenkins and Smitherman

We will not sustain the rejection of claims 1, 2 and 5 to 15 under 35 U.S.C. § 103 as being unpatentable over Jenkins in view of Smitherman.

In this rejection, the examiner ascertained (brief, p. 6) that

Jenkins meets all claimed limitations except for: (1) the adhesive at portions 46 and 48 being confined to the corner portions of the minor flaps extending partially toward the opposed edges and the minor flaps as set forth in claims 1, 9 and 10, (2) the adhesive portion at 70 is confined to the corners of the first major flap 24 as set forth in claims 8, 9, and 10, and (3) the inner opposed edges of the first and second [minor] flaps being spaced at a substantial distance apart as set forth in claim 5.⁵

The examiner then concluded that such differences would have been obvious to a person of ordinary skill in the art from the teachings of Smitherman.

The appellant argues that the applied prior art does not suggest the claimed subject matter. We agree.

⁵ Once again the examiner did not ascertain the differences between Jenkins and independent claim 15.

In our view, the teachings of Smitherman provide no teaching, suggestion, incentive or motivation for a person of ordinary skill in the art at the time the invention was made to have modified Jenkins' adhesive line 46 (which extends across both minor flaps 28 and 30 from side panel 16 to side panel 18 as shown in Figures 2 and 5) to be substantially confined to the corner portions as set forth in independent claims 1, 9, 10 and 15. Smitherman teaches to prevent material from leaking about the corners of his container 24 by using a double portion of adhesive 18 at the contact area between the outside portions 32 of the minor end flaps 22 and the major inside end flap 20, which double portion of adhesive 18 does not extend across both minor end flaps 22 as shown in Figure 1. Smitherman does not teach one skilled in that art that the double portion of adhesive 18 at the contact area between the outside portions 32 of the minor end flaps 22 and the major inside end flap 20 is substantially confined to the corner portions as set forth in independent claims 1, 9, 10 and 15. Therefore, Smitherman does not provide any teaching, suggestion, incentive or motivation whatsoever for an artisan to have modified Jenkins to arrive at the claimed subject matter.

For the reasons set forth above, the decision of the examiner to reject claims 1, 2 and 5 to 15 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2 and 5 to 15 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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