Federal Circuit Addresses Obviousness Rationales and Counterarguments

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Recently, the Federal Circuit issued its opinion in ***CW Zumbiel v. Kappos.*** The Federal Circuit affirmed the Board of Patent Appeals and Interferences' ("BPAI") finding that multiple claims in U.S. Patent No. 6,715,639 ("the '639 patent") were obvious and therefore invalid. The '639 patent is directed to a "carton with an improved dispenser." The carton is for holding cans or bottles and the improved dispenser is a flap that permits dispensing of the cans or bottles without compromising the structure of the carton so that the remaining cans or bottles are secure within the container. The '639 patent issued to Graphic Packaging International, Inc. ("Graphic"). Upon issuance CW Zumbiel Co., Inc. ("Zumbiel") challenged the validity of the '639 patent by instituting an inter partes reexamination. During the inter partes reexamination, the Examiner rejected multiple claims for obviousness, while maintaining the patentability of other claims. Graphic appealed the Examiner's rejections to the BPAI, which subsequently affirmed the patentability of some claims and the rejection of the other claims based on obviousness over Ellis, U.S. Patent No. 3,178242, in view of German Gebrauchsmuster No. G85 14718.4. Zumbiel appealed the BPAI's finding that some claims were patentable and Graphic cross-appealed the finding that other claims were obvious.

One limitation that was found obvious was the "finger-flap," which opens across the top panel of the carton. Graphic argued that the limitation would not be obvious over the combination of references because they open in different ways—Ellis is laid on its side and opens on the back while the German patent opens from the top. The Federal Circuit affirmed the BPAI's finding of obviousness quoting the BPAI, which stated, "'providing the finger opening on the top wall of the carton would be a predictable variation that enhances user convenience, as evidenced by German '718, and is within the skill of a person of ordinary skill in the art.'"
Another limitation that was found obvious was the "fold-line" limitation, which provides a fold-line so that the flap can be folded back to cover the opening. Graphic argued that the German reference did not teach such a flap, but rather was directed to a container allowing

simultaneous removal and replacement of bottles through an opening that could either be a perforated line or a fold line. The Federal Circuit affirmed the BPAI's finding that the fold-line limitation was obvious over the cited references as the combination teaches that a tear-line can be replaced by a fold-line, which would be obvious to one of skill in the art.

Zumbiel disputed the BPAI's determination that claim 2 was not obvious. Claim 2 was directed to the placement of the finger-flap between the first and second cans. Zumbiel argued that the placement would have been obvious in light of the combination of references. The Federal Circuit, however, affirmed the BPAI's finding that the prior art reference at issue—Palmer, U.S. Patent No. 2,718,301—only taught where to place a handle formed by the perforated tear-line on the container, not where to place perforation for an opening. Moreover, the Federal Circuit noted that one of the references actually taught away from the placement of the tear-line in claim 2. Therefore, the combination of references could not render claim 2 obvious.

Ultimately the Federal Circuit affirmed the BPAI's findings in whole. The opinion demonstrates examples teaching away, predictable variations in light of the knowledge of one skilled in the art of the invention, and a proper combination of references.

Dissent

Judge Prost dissented in part arguing that claim 2 should have been found obvious based in light of the *KSR* decision and the applicability of common sense in the obviousness determination. The dissent, quite candidly, sets out the invention of the '639 invention, its common sense understanding, and the teachings of the prior art that had existed for "almost fifty years." Judge Prost took issue with the finding that placement of the tear-line was unobvious:

> The secret lies in the proper positioning of the tear line. That is, according to the Board, ordinary box makers would not have put the tear line between the first two cans in the top row. Where else could have they put it? There are just four other options: (1) above the first can, (2) above the second can, (3) in front of the first can, (4) behind the second can. The first two alternatives are just offensive to common sense: With the cans right below, there would be no room to push the flap through (the flap is positioned at the center of the tear line). The third and fourth options are not quite as illogical, but even without expertise in box making, one may intuit that they make awkward designs (the third opens too little, the fourth too much). More importantly, however, whether some of the alternatives would work just as well

> or not, the patentee's choice of tear-line-placement involves no more than the exercise of common sense . . . .

As such, Judge Prost concludes that the invention of claim 2 would have been obvious, particularly when viewed in light of the prior art.

The full text of the Federal Circuit opinion is available **here** **here**.