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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAPHNE LYNN VANBUREN

Appeal 2010-012172
Application 11/200,332
Technology Center 3600

Before CHARLES N. GREENHUT, ANNETTE R. REIMERS, and
HYUN J. JUNG, *Administrative Patent Judges*.

JUNG, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Daphne Lynn VanBuren (Appellant) appeals under 35 U.S.C. § 134 from a rejection of claims 1, 11-14, 26, and 27 under 35 U.S.C. § 103(a) as unpatentable over Pehr (US 6,349,849 B1; iss. Feb. 26, 2002) and common knowledge. Ans. 4. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE and enter a NEW GROUND OF REJECTION of claims 1, 11-14, 26, and 27.

THE CLAIMED SUBJECT MATTER

Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A product comprising:
 - a stack having a top and a bottom, the stack comprising a plurality of individual sheets, and the stack enclosed within a dispenser having a single dispensing opening through which all of the sheets within the stack are dispensed;
 - the stack having at least one first sheet portion comprising from 2 to about 30 sheets of a first sheet material and a second sheet portion comprising at least 30 sheets of a second sheet material;
 - wherein the first sheet material is different from the second sheet material and wherein the first sheet portion is located only at the top of the stack.

ANALYSIS

The Examiner finds that Pehr discloses the subject matter of claims 1, 11-14, 26, and 27 except that Pehr does not disclose the specific quantities or different material of sheets. Ans. 4. The Examiner finds that it is common

knowledge to provide a new product with the purchase of an existing product and concludes that it would have been obvious to provide sample sheets at either the top or bottom of a stack of sheets. *Id.*

The Appellant argues that Pehr and common knowledge do not disclose providing two different tissue products in a dispenser having only one dispensing opening, as recited by the claims. Br. 4. The Appellant states that Pehr is directed to a common problem associated with pop-up tissue dispensers known as “fall back” where pulling one tissue fails to pull the next tissue partially through an opening at the top of the dispenser. *Id.* The Appellant states that Pehr’s second opening allows a user to withdraw tissues at a lower point in the dispenser to avoid “fall back.” *Id.*

The Appellant also cites column 4, lines 4-7, of Pehr, as disclosing a slot in a top wall and another slot in a bottom wall so that two different types of tissues can be dispensed. *Id.* However, the Appellant argues that these two slots are necessary to dispense the two different types of tissues. *Id.* at 5.

The Examiner responds that removing one of the two openings of Pehr still renders obvious a single opening. Ans. 4-5. The Examiner finds that having a single opening does not involve an inventive step and Pehr discloses two types of tissues being dispensed. *Id.* at 5.

The Appellant’s arguments are persuasive. The Examiner makes no findings and does not provide a reason that one of ordinary skill in the art would modify Pehr to have one opening. *See* Ans. 4. Also, the Examiner’s finding that having a single opening instead of two, as Pehr explicitly discloses, does not involve an inventive step fails to explain why one skilled in the art would remove the second opening to arrive at the claimed

invention. *See* Ans. 5. Based on the record before us, the Examiner's conclusion of obviousness lacks articulated reasoning with rational underpinnings.

Accordingly, we cannot sustain the Examiner's rejection of claims 1, 11-14, 26, and 27 under 35 U.S.C. § 103(a) as unpatentable over Pehr and common knowledge.

New Ground of Rejection

We enter a new ground of rejection of claims 1, 11-14, 26, and 27 under 35 U.S.C. § 103(a) as unpatentable over Pehr.

Pehr discloses a product, tissue dispenser 1. Pehr, col. 3, ll. 7-9, and figs. 1-3. Column 3, lines 7-9, of Pehr discloses that the tissue dispenser 1 is "for sequentially dispensing a plurality of tissues contained therein." Lines 34-36 of the same column discloses that the "tissues **5** initially generally fill the box **17** and are normally initially at least at the level of the phantom line tissue level **37**, shown in FIG. 2." Figure 2 shows a tissue 43 being withdrawn from the top of a stack of tissues with a bottom near a bottom wall 11 of the tissue dispenser 1. Thus, Pehr discloses a product comprising "a stack having a top and a bottom, the stack comprising a plurality of individual sheets," as recited by claims 1, 11, and 12.

Also, Pehr discloses that "each of the slots **34** and **35** is wide enough to allow a user to push their hand down through the slot **34** and **35** into the box **17** to withdraw an initial tissue from the tissues **5** therefrom to start a continuous feed through either slot **34** or **35**." Pehr, col. 3, ll. 30-34. Pehr further discloses that "[a]s the level of tissues in the box **17** diminishes, such as is shown by the solid tissue level **39** in FIG. 2, an insufficient amount of each succeeding tissue **5** may be drawn through the top slot **34** to leave the

succeeding tissue **5** extending from the box **17**” and “[i]n this situation, the user illustrated by the hand **42** in FIG. **1** reaches into the box **17** through the slot **35** and withdraws a first tissue **5**, such as tissue **43**, from the lower slot **35.**” *Id.* at col. 3, ll. 42-49. Thus, Pehr teaches that a top slot 34 is constructed to be wide enough so that all the tissues can be withdrawn through that slot 34 either by continuous feed or by a user pushing their hand down through the slot 34. *See also id* at col. 1, ll. 23-25. Also, Pehr teaches that the use of the second slot 35 is conditional. The second slot 35 is used in situations when a succeeding tissue after the withdrawn tissue does not adequately extend from the top slot 34. However, these situations may happen and “is especially troublesome with the larger boxes that hold 500 or more tissues.” *See id.* at col. 1, ll. 16-27. Thus, a skilled artisan would understand Pehr as teaching that all the tissues can be withdrawn from the top slot 34 without having to resort to the additional second slot 35.

Therefore, Pehr discloses “the stack enclosed within a dispenser having a single dispensing opening through which all of the sheets within the stack are dispensed,” as recited by claims 1, 11, and 12. In reaching this finding, we construe “a single dispensing opening through which all of the sheets within the stack are dispensed” as limiting the “single dispensing opening” through its manner of use and not necessarily requiring a particular structure.

Pehr further discloses that “[f]or example, there could be a slot in the top wall **10** and in the bottom wall **11**” and that “[i]n this manner tissues of different type, for example, a different color could be withdrawn from opposite ends of the dispenser **1** by simply turning the dispenser **1** over.” *Id.* at col. 4, ll. 2-7. Appellant defines “a first sheet material is different from a second sheet material” so that a “variation in the color of the sheet materials

through dying is not considered a difference for the purposes of this invention if the sheet materials are otherwise identical in nature.” Spec. 4:13-19. Pehr cites different tissue colors as an example; however, we find no indications that differences other than tissue color cannot be used for the tissues in the dispenser 1 of Pehr. Thus, the skilled artisan would understand that the “tissues of different type, for example . . .” is not limited to merely differences in tissue color. Therefore, Pehr discloses “the stack having at least one first sheet portion . . . of a first sheet material and a second sheet portion . . . of a second sheet material, wherein the first sheet material is different from the second sheet material,” as recited by claims 1, 11, and 12. Because Pehr discloses that two different types of tissues can be withdrawn from slots in the top and bottom walls such that one of the two types can be withdrawn from the top or bottom slot, Pehr also discloses “wherein the first sheet portion is located only at the top of the stack,” as recited by claim 1, and “wherein the first sheet portion is located only at the bottom of the stack,” as recited by claim 11.

As for claim 12’s recitation of “wherein one first sheet portion is located at the top of the stack, another first sheet portion is located at the bottom of the stack, and the second sheet portion forms the middle of the stack,” we find that such an arrangement is a duplication of one of the “tissues of different type” as taught by Pehr, such that one such tissue type is located at the top of the stack, another type is located under the first type, and another of the first type is located under the second type with no new unexpected result and thus has no patentable significance. *See In re Harza*, 274 F.2d 669, 774 (CCPA 1960) (“the mere duplication of parts has no patentable significance unless a new an unexpected result is produced”).

Pehr does not explicitly disclose that the first sheet portion comprises from 2 to about 30 sheets of a first sheet material and that the second sheet portion comprises at least 30 sheets of a second sheet material, as required by claims 1, 11, and 12. Claims 13 and 14 depend from claims 1, 11, or 12 and recite “wherein the first sheet portion comprises between about 5 to about 20 sheets” and “wherein the first sheet portion comprises between about 5 to about 10 sheets,” respectively. Pehr does teach that paper tissues are frequently sold in a container that has a withdrawal slot in the top of the container, and larger boxes hold 500 or more tissues. Pehr, col. 1, ll. 9-11 and 26-27. We cannot find, and the Appellant does not point to, any indication that the difference in the number of tissues as taught by Pehr and the recited number of sheets would result in the claimed product performing differently from the tissue dispenser 1 of Pehr, and thus, we find that the recited number of sheets is not a patentable distinction from Pehr. *See Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 1345 (Fed. Cir. 1984); *cert. denied*, 469 U.S. 830 (1984) (holding that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device) and *In re Chu*, 66 F.3d 292, 298-99 (Fed. Cir. 1995) (“design choice” is appropriate where the applicant fails to set forth any reasons why the differences between the claimed invention and the prior art would result in a different function).

Dependent claim 26 recites “wherein the first and second sheet materials are folded for reach-in dispensing.” Br., Claims App’x. The Appellant argues Pehr fails to disclose a tissue product having a dispenser

designed for “reach-in” dispensing. Br. 6. The Appellant asserts that a reach-in opening is not merely a slot and is not covered with a plastic film containing a slit. *Id.* The Appellant further argues that Pehr is limited to “pop-up” style dispensers. *Id.* As discussed above, Pehr discloses that “each of the slots **34** and **35** is wide enough to allow a user to push their hand down through the slot **34** and **35** into the box **17** to withdraw an initial tissue from the tissues **5** therefrom to start a continuous feed through either slot **34** or **35**.” Pehr, col. 3, ll. 30-34. The ability of a user “to push their hand down through the slot **34** and **35** into the box **17**” is indicative of “reaching-in.” While defining the slot or dispenser as “reach-in” might limit the dispenser or slot, the Appellant fails to apprise us why “folded for reach-in dispensing,” as recited by claim 26, creates any structural difference in the sheet materials. The Appellant’s argument is therefore not commensurate with the scope of the claim.

The Appellant also argues that individual sheets within the stack inside a reach-in dispenser are not interfolded. Br. 6. The Appellant’s argument suggests that “reach-in” folding implicitly requires the absence of interfolding. However, the claim merely requires “the first and the second sheet materials are folded for reach-in dispensing.” Br., Claims App’x. The Appellant’s arguments appear to be incorporating limitations from the Specification into the claim, *i.e.*, “folded for reach-in dispensing into a C-fold or other folded configuration where withdrawal of a preceding sheet does not partially withdraw the next sheet into the dispensing opening 56 or interfolded for pop-up dispensing into a V-fold as illustrated or other folded configuration where withdrawal of a preceding sheet partially withdraws the next sheet into the dispensing opening 56.” Spec. 6, ll. 6-11; *see also* fig. 1.

Therefore, Appellant's argument is unpersuasive because the scope of claim 26 cannot be narrowed by reading limitations from disclosed embodiments into the claim where such limitations have no express basis in the claim.

As for dependent claim 27, the Appellant does not provide any separate arguments. Br. 7. Furthermore, the Appellant states that "the teachings of Pehr are limited solely to 'pop-up' style dispensers." Br. 6. The Appellant thus appears to concede that the tissues of the Pehr dispenser disclose "wherein the first and second sheet materials are interfolded for pop-up dispensing," as recited by claim 27.

We therefore conclude that the subject matter of claims 1, 11-14, 26, and 27 would have been obvious in view of Pehr. Because our conclusion is based on reasoning and findings of fact that differ from the rejection articulated by the Examiner, we reenter the rejection as a new ground of rejection under 37 C.F.R. § 41.50(b) to provide the Appellant with a full and fair opportunity to respond to the rejection.

DECISION

For the above reasons, the Examiner's rejection of claims 1, 11-14, 26, and 27 is reversed.

We enter a new ground of rejection of claims 1, 11-14, 26, and 27 under 35 U.S.C. § 103(a) as unpatentable over Pehr.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

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37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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) (2010).

REVERSED; 37 C.F.R. § 41.50(b)

Vsh