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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte WEN FEI CHU, LYNNE CHERYL HANNEN, and
EMMA LYNN SARTINI

Appeal 2015-005297
Application 13/675,069
Technology Center 1700

Before: BRADLEY R. GARRIS, BEVERLY A. FRANKLIN, and
LILAN REN, *Administrative Patent Judges*.

REN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants¹ appeal under 35 U.S.C. § 134(a) from a rejection of
claims 1–14 and 16–20.² We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ The Procter & Gamble Company of Cincinnati, Ohio is identified as the
real party in interest. (Appeal Brief, filed November 24 2014 (“App. Br.”),
1.)

² Final Rejection mailed May 30 2014 (“Final Act.”)

CLAIMED SUBJECT MATTER

The claims are directed to a “rolled absorbent paper product having an emboss design pattern visible on an outside layer that facilitates identification of a manufacturer.” (Spec. 2, ll. 7–8.)³ Claims 1, 13 and 20, reproduced below, are illustrative of the claimed subject matter:

1. A rolled absorbent paper product, said product comprising:

a. an absorbent paper substrate having at least one ply with an emboss pattern comprising *two visually distinct emboss design elements disposed in a plurality of predetermined, spaced-apart positions across said ply*;

b. said two emboss design elements comprising a first emboss design element occupying all but at least one of said positions in a first repeating pattern, and a second emboss design element occupying said at least one of said positions not occupied by said first emboss design element;

c. said second emboss design element being a word comprising a line emboss defining line-embossed letters wherein each line-embossed letter comprises an open area within said line emboss; and,

d. *said first and second emboss design elements each have an emboss area of from about 7% to about 25% and a difference in emboss area relative to each other of less than about 10%.*

³ Application 13/675,069, *Absorbent Paper Product Having Source Identifying Emboss Element*, filed December 13 2012. We refer to the “’069 Specification,” which we cite as “Spec.”

13. A rolled absorbent paper product, said product comprising:

a. an absorbent paper having a plurality of individual sheets each comprising at least one ply having an emboss pattern comprising *two visually distinct emboss design elements* disposed in a plurality of predetermined, spaced apart positions across said ply, wherein adjacent of said individual sheets are separated by a line of weakness;

b. *said two emboss design elements comprising a first emboss design element occupying all but at least one of said positions in a first repeating pattern, and a second emboss design element occupying said at least one of said positions not occupied by said first emboss design element;*

c. said second emboss design element being a word comprising letters; and,

d. *wherein said second emboss element at least partially traverses at least one said line of weakness.*

20. A rolled absorbent paper product, said product comprising:

a. a multi-ply absorbent paper having a plurality of individual sheets each comprising at least one ply having an emboss pattern comprising two visually distinct emboss design elements disposed in a plurality of predetermined, spaced-apart positions across said ply, wherein adjacent of said individual sheets are separated by a line of weakness;

b. said two emboss design elements comprising a first emboss design element occupying all but at least one of said positions in a first repeating pattern, and a second emboss design element occupying said at least one of said positions not occupied by said first emboss design element;

c. said second emboss design element being one of a logo, trademark, or brand name identifying a manufacturer or marketer of said rolled absorbent product, said second emboss design element comprising line-embossed letters wherein each line-embossed letter comprises an open area within said line

emboss, said line-embossed letters being comprised of line embossments having no MD oriented letter segments; and,

d. wherein said rolled absorbent paper product comprises a plurality of second emboss design elements that *each at least partially traverse one of said lines of weakness and at least one second emboss design element that does not traverse one of said lines of weakness.*

(Claim Appendix, App. Br. 15, 17–18, 19–20 (emphases added).)

REFERENCES

The prior art references relied upon by the Examiner in rejecting the claims on appeal are:

Schulz '873	CA 2 835 873	October 31, 2000
Schulz '608	US 4,659,608	Apr. 21, 1987
Schulz '057	US 5,436,057	July 25, 1995
Kershaw	US 6,348,131 B1	Feb. 19, 2002
Maciag	US 2004/0258886 A1	Dec. 23, 2004
Mellin	US 2010/0294445 A1	Nov. 25, 2010

REJECTIONS⁴

Claims 13, 14, 16–19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schulz '608 in view of Maciag. (Final Act. 5.)⁵

Claims 1–12 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schulz '608 in view of Maciag and Kershaw, further evidenced by Schulz '873, Mellin, and Schulz '057. (Final Act. 8.)

Claims 1–3 and 5–10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schulz '057 in view of Maciag. (Final Act. 18.)

⁴ All rejections under 35 U.S.C. § 102(b) has been withdrawn. Examiner's Answer mailed April 10 2015 ("Ans."), 12.

⁵ Claim 15 has been withdrawn and the rejection of claim 15 is therefore moot. (See Ans. 12.)

Examiner finds that Figure 1 illustrates that one of the shapes/profiles 17 “at least partially traverses at least one said line of weakness” which is line 13, as recited in claim 13. (Final Act. 5.)

Based on Maciag’s teaching that an “embossed image . . . comprises any perceptible pattern” which “may include . . . words,” the Examiner finds that a skilled artisan would have combined the references to have “an absorbent article with embossments of words and images in a themed relationship.” (Final Act. 6–7 (citing Maciag ¶¶ 4, 33).)

Appellants argue that the Examiner erred because Schultz ’608 does not teach or suggest “an emboss design element that differs in visual appearance from the first emboss design element.” (App. Br. 6.) While acknowledging that “certain of Schultz’ emboss designs do, in fact, cross a perforation line,” Appellants argue that this prior art teaching “is inconsequential” as “such a condition is inevitable with repeating design of a closely spaced single design element as shown in Schultz[.]” (*Id.* at 7.)

The ’069 Specification provides that “visually distinct emboss design elements are design elements that can be visually distinguished as discrete, separate design elements.” (Spec. 4:6–7.) The ’069 Specification therefore does not limit the claim term “two visually distinct emboss design elements” to two elements “that differ[] in visual appearance” as Appellants assert. (*Compare* App. Br. 6.) All claim 13 recites is “two emboss design elements” that “can be visually distinguished as discrete, separate design elements” as provided by the ’069 Specification. (Spec. 4:6–7.)

The ’069 Specification further provides that “virtually any emboss design element can be utilized for either first or second emboss design elements.” (Spec. 4:11–12.) To the extent that Appellants consider

component 17 in Schultz '608 “a single design element” (App. Br. 6), prior art component 17 includes at least two “visually distinctive” shapes or profiles as illustrated in Figure 1. No reversible error has been identified in the Examiner’s finding in this aspect of the obviousness analysis.

Appellants also argue that Schulz '608 fails to teach that its product may be used to “help[] ensure that the manufacturer’s and/or marketers’ identification is reinforced as the user is reminded of the source of the rolled absorbent product.” (App. Br. 7.) Claim 13, however, does not recite that either “emboss element” may be used to identify the source of the product. In any event, “[i]t is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable.” *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997).⁷

Appellants next argue that because Maciag teaches “printed” letters instead of embossed ones, a skilled artisan would not have combined the references. (App. Br. 8.) According to Appellants, “it is impossible for the skilled person to be taught or motivated to modify Schulz to have embossments of letters and words.” (*Id.*) Appellants, however, do not identify reversible error in the Examiner’s finding that Maciag discloses various “embossed images” having “any perceptible pattern in the tissue-towel substrate.” (Maciag ¶ 33; *see also* Reply 4.) Appellants do not

⁷ Moreover, any differences between the claimed invention and the prior art are no more than an aesthetic design change. *See* MPEP 2144.04(I). Appellants have not argued that this aesthetic difference has a mechanical function (*see* App. Br. 7), and it therefore does not patentably distinguish the claimed invention from the prior art. *See In re Seid*, 161 F.2d 229, 231 (CCPA 1947) (finding that a particular shape and arrangement lacks mechanical function and therefore cannot be relied on to distinguish structural claims over the prior art).

identify reversible error in the Examiner’s finding that Maciag discloses a “relationship of images and patterns” such as “a specific business or group of business” including “the trademarks of . . . products, and images representing those products” (Maciag ¶ 44; *see also* Reply 4.)

“If a person of ordinary skill can implement a predictable variation [of a known work], § 103 likely bars its patentability.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007). Appellants in this case have not provided sufficient evidence to show that the Examiner reversibly erred in analyzing the combined prior art teachings.

For the first time in the Reply Brief, Appellants raise the argument that the combined prior art teachings do not teach or suggest a product having “two emboss design elements comprising a first emboss design element occupying all but at least one of said positions in a first repeating pattern, and a second emboss design element occupying said at least one of said positions not occupied by said first emboss design element” as recited in claim 13. (Reply. 2–3.)⁸

An argument raised for the first time in a Reply Brief can be considered waived if Appellants do not explain why it could not have been raised previously. 37 C.F.R. § 41.41(b)(2) (2013); *see also Ex parte Nakashima*, 93 USPQ2d 1834 (BPAI 2010) (informative) (explaining that arguments and evidence not timely presented in the principal Brief will not be considered when filed in a Reply Brief, absent a showing of good cause explaining why the argument could not have been presented in the Principal Brief); *Ex parte Borden*, 93 USPQ2d 1473, 1477 (BPAI 2010) (informative) (“Properly interpreted, the Rules do not require the Board to take up a

⁸ Reply Brief dated April 10, 2015 (“Reply”).

belated argument that has not been addressed by the Examiner, absent a showing of good cause.”).

Appellants here have not provided an explanation as to why the argument was not raised previously. In any event, Appellants do not provide factual evidence to explain why Schulz ’608 fails to meet this limitation of the claim. (*See* Reply 3 (stating, without citation to the record, that the prior art component 17 “does not replace the so-called first design element . . . and is not positioned where the first element is expected to be”).) No reversible error has been identified in the Examiner’s findings here. *In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (“[I]t has long been the Board’s practice to require an applicant to identify the alleged error in the examiner’s rejections . . .”).

Claim 1

The Examiner issued two obviousness rejections of claim 1: a first obviousness rejection over Schulz ’608 in view of Maciag, and Kershaw, further evidenced by Schulz ’873, Mellin, and Schulz ’057 (“first obviousness rejection of claim 1”) and a second obviousness rejection over Schulz ’057 and Maciag (“second obviousness rejection of claim 1”).⁹ We address each rejection in turn.

For the first obviousness rejection of claim 1, the dispositive issue is whether the combined prior art teachings would have rendered a paper product having “first and second emboss design elements each hav[ing] an

⁹ Consistent with the provisions of 37 C.F.R. § 41.37(c)(1)(iv) (2013) and Appellants’ arguments, claims 2–12 stand or fall with claim 1 with regard to the first obviousness rejection of claim 1 whereas claims 2, 3, and 5–10 stand or fall with claim 1 with regard to the second obviousness rejection of claim 1. (App. Br. 10, 14.)

emboss area of from about 7% to about 25% and a difference in emboss area relative to each other of less than about 10%” as recited in claim 1 obvious.

The Examiner acknowledges that the combined teachings of Schultz ’608 and Maciag do not disclose the claim limitation at issue and finds that Kershaw teaches an absorbent paper product having “an emboss pattern comprising a plurality of design elements, wherein up to about 50 percent of the surface area of said absorbent sheet is embossed.” (Kershaw 11:34–36; *compare* App. Br. 9 with Final Act. 10.) The Examiner also finds that Schultz ’873 discloses a paper product having up to about half of the total area embossed. (Ans. 18.) The Examiner finds that Mellin discloses a substrate having two emboss elements making up more than 7% of the embossed area. (*Id.*)

The Examiner further cites Schultz ’057 which discloses, among others, a paper product having a “stitchlike debossment” and “a signature debossment” such as a “tulip” design “inside the overlapping pattern of the stitchlike debossment.” (Schultz ’057 4:34–40.) Schultz ’057 discloses various arrangements of the debossments. In one embodiment, for example, “the stitchlike debossment should have an area of less than 10%” whereas the “signature debossment should have an area of less than 5%.” (5:4–7.)

Appellants argue that a skilled artisan would not have found the recited “emboss area of from about 7% to about 25%” and the difference of “less than 10%” obvious in light of the teaching in Kershaw. (App. Br. 9.) Appellants, however, do not address the combined prior art teachings including those of Schultz ’057, Schultz ’873, and Mellin. (App. Br. 9–10; Reply 5–6.)

Because Appellants do not address the combined prior art teachings, no reversible error has been identified in the Examiner's findings here.

For the second obviousness rejection of claim 1, Appellants argue that Schultz '057 does not teach or suggest a paper product having "two visually distinct emboss design elements disposed in a plurality of predetermined, spaced-apart positions across said ply." (App. Br. 12.)

Appellants, however, do not point to evidence in the record in support of their argument. Appellants do not dispute the Examiner's finding that Schultz '057 discloses "an embossed tissue having dots arranged in a diamond pattern around embossed flowers." (*Compare* Ans. 18 *with* Reply 3.) Appellants repeat the same argument for claim 13 with regard to teaching of Maciag which we have addressed *supra*. No reversible error has been identified here. *Jung*, 637 F.3d at 1365 ("[I]t has long been the Board's practice to require an applicant to identify the alleged error in the examiner's rejections . . .").

Claim 20

The dispositive issue here is whether the combined prior art teachings would have rendered a paper product having "plurality of second emboss design elements that each at least partially traverse one of said lines of weakness and at least one second emboss design element that does not traverse one of said lines of weakness" as recited in claim 20 obvious.

Appellants' argument with regard to claim 20 mirrors that for claim 13. (*Compare* App. Br. 10–12 *with* App. Br. 7–8.) For those reasons provided with regard to claim 13, no reversible error has been shown here.

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DECISION

The Examiner's rejections of claims 1–14 and 16–20 are affirmed.

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