



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/983,482	08/02/2013	Paul Bui Vinh Tran	SW8-108 US-WO	1019
116840	7590	10/31/2019	EXAMINER	
Paul Tran 23679 Calabasas Road, Suite 943 Calabasas, CA 91302			KUMAR, RAKESH	
			ART UNIT	PAPER NUMBER
			3651	
			MAIL DATE	DELIVERY MODE
			10/31/2019	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PAUL BUI VINH TRAN

Appeal 2018-003578
Application 13/983,482
Technology Center 3600

Before PHILIP J. HOFFMANN, AMEE A. SHAH, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

SILVERMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner’s decision rejecting claims 87, 101–107, 112, and 113.² We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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

² Portions of the Appeal Brief indicate that dependent claims 88–92 and 108–111 might be included in this Appeal. *See* Appeal Br. 5, 9. The Appellant had canceled these claims. *See* Response to Office Action (Aug. 17, 2016) 2–3, 5. *See also* Answer 3, 6.

ILLUSTRATIVE CLAIM

87. A sheet dispenser for dispensing a sheet from a stack of interleaved sheets of material, comprising

a housing for holding a container for said stack, said housing having a top wall which is adjacent to and parallel to a top wall of said container,

wherein said top wall of said housing cooperates with said top wall of said container to form a space therebetween which is sufficient to allow said sheet to travel therein in a direction which is parallel to said top wall of said container to exit said housing, said space is about 0.5 to about 1-inch in height.

CITED REFERENCES

The Examiner relies upon the following references:

Trenner	US 1,208,701	Dec. 21, 1916
Sigl et al. (hereinafter "Sigl")	US 4,638,921	Jan. 27, 1987

REJECTION

Claims 87, 101–107, 112, and 113 are rejected under 35 U.S.C. § 103(a) as unpatentable over Trenner and Sigl.

FINDINGS OF FACT

The findings of fact relied upon, which are supported by a preponderance of the evidence, appear in the following Analysis.

ANALYSIS

The outcome of this Appeal turns on whether the prior art teaches or suggests claim 1's limitation of "said space is about 0.5 to about 1-inch in height." The Examiner states:

Although, Trenner fully discloses a space between the top wall of the housing . . . and the container top wall . . . for

allowing the sheet product to move therein towards the outlet of the dispenser, Trenner does not specifically disclose the space is about 0.5 to 1.0 inches in height.

Final Action 4. *See also* Answer 7. Nevertheless, the Examiner provides the following explanation for the prior art's suggestion of claim 1's limitation of a container having a "space" between the "housing" and the "top wall," wherein the "space is about 0.5 to about 1-inch in height":

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Trenner in view of Sigl to have adjusted the space between the top wall of the housing and the top wall of the container to comprise a space in a range of about 0.5 to 1.0 inches in height, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. [*In re Aller*, 220 F.2d 454 (CCPA 1955)].

Final Action 4.

The Examiner relies upon the principle, set forth in *Aller*, 220 F.2d at 456, that "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." Yet, an "exception" to this principle exists "where the parameter optimized was not recognized in the prior art as one that would affect the results." *Ex parte Whalen II*, 2008 WL 2957928, at *8 (BPAI July 23, 2008) (precedential) (citing *In re Antonie*, 559 F.2d 618, 620 (CCPA 1977)).

Here, the Examiner has not pointed to any teaching in the cited references, or provided any explanation based on technical reasoning, that would support the conclusion that those skilled in the art would have considered it obvious to attain an optimum or workable dimension for the

claimed “space” in the recited range of “about 0.5 to about 1-inch.” *See* Appeal Br. 8. Notably, the Appellant points out that Trenner characterizes the corresponding portion of the identified embodiment as a narrow passage, so as to maintain an environment free from contaminants. *Id.* at 7–8. Indeed, consistent with the purpose described in the reference, Trenner indicates that the dispensing passage should be narrow:

[M]y invention, as has been explained, relates to a container from which sterile material is dispensed through a passage which prevents the entrance into the container of pathogenic organisms, and deleterious or infectious insects or dust. Whatever form my container takes for the several uses to which it is adapted, it consists of what may be termed a closed casing within which the sterile articles are held, this casing being provided with an exit passage which, broadly speaking, prevents the entrance into the container of pathogenic organisms, dust-laden air, etc. This passage may take the form of a relatively long, narrow or thin duct either between walls which are relatively rigid, though yielding, or between walls which are quite yielding. In the first form the passage is arranged so that the material in being taken therethrough moves in a downwardly direction for the purpose of better preventing the entrance into the container of pathogenic organisms, etc.

Trenner 3, ll. 96–119.

Because the Examiner has not adequately established the predicate findings necessary to rely upon the cited principle of *Aller*, we do not sustain the rejection of independent claim 87 and its dependent claims 101–107, 112, and 113.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
87, 101–107, 112, 113	103(a)	Trenner, Sigl		87, 101–107, 112, 113
Overall Outcome				87, 101–107, 112, 113

REVERSED