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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JAMES ALEXANDER HALLAM, DENNIS EDWARD FRYER,  
MARTIN CHRISTOPHER BUNCE, PETER BOOTH,  
and JAMES MALLION

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Appeal 2018-009093  
Application 13/040,455  
Technology Center 3600

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Before JOSEPH A. FISCHETTI, BRUCE T. WIEDER, and  
KENNETH G. SCHOPFER, *Administrative Patent Judges*.

SCHOPFER, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner's decision to reject claims 1–7, 9–11, and 13–21. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM IN PART.

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<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Kimberly-Clark Worldwide, Inc. Appeal Br. 1.

## BACKGROUND

The Specification “relates to a tissue carton comprising a stack of compressed tissues.” Spec. 1, 1. 3.

## CLAIMS

Claims 1, 14, and 17 are the independent claims on appeal. Claims 1 and 14 are illustrative of the appealed claims and recite:

1. A carton comprising:
  - a. a top face and a bottom face extending inwardly from a first and a second sidewall, the top face comprising a top panel having an interior surface and a removable surfboard, the top panel comprising from about 15 to about 50 percent of the top face surface area;
  - b. a carton opening located in the top panel; and
  - c. a dispensing window disposed adjacent to at least a portion of the interior surface of the top panel and covering at least a portion of the carton opening, the dispensing window having a dispensing opening disposed thereon; wherein the area of the carton opening is from about 50 percent to about 85 percent of the area of the top surface.
  
14. A carton for dispensing a compressed stack of tissues comprising:
  - a. [a] top face having a surface area and comprising a top panel having an interior surface, the top panel comprising from about 15 to about 50 percent of the top face surface area;
  - b. a carton opening disposed on the top panel, the carton opening having an area that is from about 50 percent to about 85 percent of the area of the top face;
  - c. a pair of side panels;
  - d. a flexible dispensing window disposed about the entire periphery of the carton opening, the window further

attached to the interior surface of the top panel and a portion of at least one side panel;

e. a dispensing opening disposed on the dispensing window;

f. a removable surfboard overlaying at least a portion of the dispensing window;

g. a compressed stack of tissues; and

h. a bottom face.

Appeal Br. 10–11.

### REJECTIONS

1. The Examiner rejects claims 1, 2, 4, 5, 13, and 21 under 35 U.S.C. § 103(a) as unpatentable over Trunick<sup>2</sup> in view of Szymonski.<sup>3</sup>
2. The Examiner rejects claim 3 under 35 U.S.C. § 103(a) as unpatentable over Trunick in view of Szymonski and Gao.<sup>4</sup>
3. The Examiner rejects claims 6, 7, 17, and 19 under 35 U.S.C. § 103(a) as unpatentable over Trunick in view of Szymonski and Harwood.<sup>5</sup>
4. The Examiner rejects claims 9 and 11 under 35 U.S.C. § 103(a) as unpatentable over Trunick in view of Szymonski and Thoms.<sup>6</sup>
5. The Examiner rejects claim 10 under 35 U.S.C. § 103(a) as unpatentable over Trunick in view of Szymonski and Nasrallah.<sup>7</sup>
6. The Examiner rejects claims 14–16 under 35 U.S.C. § 103(a) as unpatentable over Trunick in view of Szymonski, Gao, and Harwood.

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<sup>2</sup> Trunick, US 3,576,243, iss. Apr. 27, 1971.

<sup>3</sup> Szymonski et al., US 7,661,554 B2, iss. Feb. 16, 2010.

<sup>4</sup> Gao et al., US 2005/0269343 A1, pub. Dec. 8, 2005.

<sup>5</sup> Harwood, US 3,172,563, iss. Mar. 9, 1965.

<sup>6</sup> Thoms, US 2003/0168467 A1, pub. Sept. 11, 2003.

<sup>7</sup> Nasrallah, US 8,210,393 B1, iss. July 3, 2012.

7. The Examiner rejects claims 18 and 20 under 35 U.S.C. § 103(a) as unpatentable over Trunick in view of Szymonski, Gao, Harwood, Hirasawa,<sup>8</sup> and Nasrallah.

## DISCUSSION

### *Rejections of claims 1–7, 9–11, 13, and 21*

As an initial matter, we note that we previously rendered a decision regarding this application in which we entered a new ground of rejection regarding claim 1 as unpatentable over Trunick. *See* Decision at 4–5, mailed Jan. 28, 2016. Our previous decision was based on a version of claim 1 reciting, *inter alia*, “a dispensing window covering at least a portion of the carton opening; wherein the area of the carton opening is from about 50 percent to about 85 percent of the area of the top panel.” *Id.* at 2. With respect to that claim, we found that Trunick disclosed a dispensing window as defined by flaps 36, 37, 38, and 39 and a carton opening as defined by score lines 32, 33, 34, and 35. *Id.* at 4.

Here, Appellant has amended claim 1 to now recite, *inter alia*, “a dispensing window disposed adjacent to at least a portion of the interior surface of the top panel and covering at least a portion of the carton opening, the dispensing window having a dispensing opening thereon.” With respect to the claim as presently worded, the Examiner finds that Trunick teaches a dispensing window as claimed. *See* Final Act. 2–3. However, we are persuaded by Appellant’s argument that Trunick does not disclose a dispensing window as claimed. Appellant argues that Trunick does not disclose a carton with a dispensing window disposed adjacent to a portion of

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<sup>8</sup> Hirasawa et al., US 7,886,933 B2, iss. Feb. 15, 2011.

the interior surface of the top panel and also covering at least a portion of the carton opening. Appeal Br. 2. Appellant acknowledges that Trunick discloses an embodiment in which flaps 36, 37, 38, and 39 are folded under and thus, are disposed adjacent to an interior surface of the top panel. *Id.* at 3. However, Appellant asserts that in such an embodiment the carton does not include a window that covers a portion of the carton opening. *Id.* at 3.

As presently worded, we find that one of ordinary skill in the art would understand that the claimed “dispensing window” is not merely an open space, but is a specific structure that is disposed adjacent to the interior of the top panel and extends over, i.e., covers, a portion of the carton opening. This interpretation is supported by the claim language itself, which further requires the structure of a dispensing opening on the dispensing window and thus indicates that the dispensing window is not an opening itself. The Specification supports this interpretation. Specifically, the Specification refers to a dispensing window 35 that is a separate structure from the carton opening 30, with a separate dispensing opening. Spec. 5, ll. 9–12. In short, when read in light of the Specification, one of ordinary skill would understand the claim to require a dispensing window that is a separate structure from the carton opening.

Under this interpretation, we find reversible error in the Examiner’s finding that Trunick discloses a “dispensing window (33, 35, 36, 38) disposed adjacent to at least a portion of the interior surface of the top panel (17) and covering at least a portion of the carton opening (42), the dispensing window (33, 35, 36, 38) having a dispensing opening (31) disposed thereon (see Fig. 1 ).” Final Act. 3. Specifically, the Examiner has not identified a dispensing window in Trunick that is disposed adjacent to an

interior portion of the top panel, covers a portion of the carton opening, and includes a dispensing opening disposed thereon. At best, Trunick's flaps 33, 35, 36, and 38 may be said to be adjacent to the top panel when folded under, but they do not also cover a portion of the opening or include a dispensing opening thereon in this configuration.

Based on the foregoing, we are persuaded of reversible error in the rejection of claim 1, and thus, we do not sustain the rejection of claim 1. With respect to dependent claims 2–7, 9–11, 13, and 21, the Examiner does not rely on the art of record in a manner that cures the deficiency in the rejection of claim 1, and thus, we also do not sustain the rejections of these claims.

*Rejection of claims 14–16*

With respect to claim 14, the Examiner finds that Trunick discloses a carton as claimed except that Trunick

fails to teach a flexible dispensing window disposed about the entire periphery of the carton opening, the window further attached to the interior surface of the top panel and a portion of at least one side panel; a dispensing opening disposed on the dispensing window; a removable surfboard overlaying at least a portion of the dispensing window; a compressed stack of tissues.

Final Act. 8–9. The Examiner concludes that it would have been obvious to include a flexible dispensing window with a dispensing opening as claimed based on the teachings of Szymonski and Gao. *Id.* at 9. The Examiner also determines that the use of a removable surfboard would have been obvious in view of Szymonki. *Id.* And finally, the Examiner determines that it would have been obvious to include a compressed stack of tissues in the carton based on the teachings of Harwood. *Id.* at 10.

As discussed below, we are not persuaded of reversible error in the Examiner's rejection of claim 14.

Appellant first argues that Trunick's device would be inoperable if combined with Szymonski because adding Szymonski's window "would prevent a user from folding Trunick's flaps to stabilize the carton as suggested." Appeal Br. 3. Appellant asserts that the proposed combination would require a substantial reconstruction and redesign in Trunick and change its principle of operation. *Id.* at 3-4. Appellant raises substantially the same argument regarding the Examiner's reliance on Gao. *Id.* at 6.

We are not persuaded of reversible error. The Examiner makes clear that the proposed combination would replace Trunick's window flaps with Szymonski's window. *Ans.* at 7. Thus, the presence of foldable flaps would be eliminated in the combination. Further, we agree with the Examiner that removing these flaps would not render Trunick inoperable or require a substantial reconstruction. *Id.* Specifically, we agree with the Examiner that the device would still be usable as a dispenser, with or without such flaps, and we fail to see why removing such flaps would require a substantial redesign or reconstruction. *Id.*

Appellant also argues that "there would have been no motivation [to] modify Trunick's carton with Szymonski's window." Appeal Br. 5.

Appellant asserts:

Trunick provides "a smooth, rounded, finished edge," by folding under the flaps, "which reduces the effort to withdraw tissues packaged therewithin since the sharp edges with the uncut sections which normally impede and snag the tissues are no longer present." Trunick at col. 3, II. 1-5. Thus, Trunick provides a sufficient solution to smooth dispensing and there would have been no motivation to resort to a dispensing window as presently claimed.

*Id.* We are not persuaded of error. Rather, we agree with the Examiner that Szymonski provides adequate reasoning to support the combination proposed. Final Act. 9. In particular, Szymonski discloses that plastic sheet windows with dispensing slots are generally used in disposable sheet dispensers to eliminate problems in dispensers including pulling out multiple sheets at a time and “presenting sheets for subsequent removal,” i.e., preventing subsequent sheets from falling back into the container. Although Trunick may provide “a smooth, rounded, finished edge” for ease of withdrawal of tissues, it is not clear to us that this prevents the problems addressed in Szmonski.

Finally, Appellant argues that one of ordinary skill would be “dissuaded from applying a surfboard to the carton” of Trunick because “Trunick specifically discusses the disadvantages of using surfboards including resulting sharp edges, increased drag, increased snags and a non-uniform appearance. Appeal Br. 54, (citing Trunick at col. 1, ll. 21–40). Trunick discusses certain problems associated with cartons having top panels with removable portions defined by perforations. *See* Trunick, col. 1, ll. 9–49. For example, Trunick discloses that removing these removable portions often results in sharp and ragged edges, exposure of different colored material, and bowing of edges around the carton opening. *Id.*

A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). We are not persuaded that Trunick teaches away from the combination proposed by the Examiner. Rather than teaching away from the

use of *any* surfboards, Trunick discusses particular disadvantages that may occur from the use of certain perforated, removable, rectangular carton tops. *See* Trunick col. 1, ll. 15–49. Without further explanation, we are not persuaded that one of ordinary skill in the art would have been discouraged from the use of the structure of Szymonski in the proposed combination because it is not clear to us that Szymonski’s device results in any of the problems discussed in Trunick.

Based on the foregoing, we are not persuaded of reversible error with respect to the rejection of claim 14. Accordingly, we sustain the rejection of claim 14. We also sustain the rejection of dependent claims 15 and 16 for the same reasons.

*Rejection of Claim 17*

With respect to independent claim 17, Appellant first relies on the argument addressed above that Trunick’s folded edges are not compatible with Szymonski and Gao. Appeal Br. 6. As discussed above, we are not persuaded of error by this argument. Second, Appellant argues that the Examiner erred in relying on Harwood. *Id.* at 7. However, Appellant’s argument regarding Harwood is directed to the percentage of compression required by claim 19. *Id.* Claim 17 does not require a specific range of compression and only requires that the carton is “configured to house a stack of compressed interfolded tissues.” Appeal Br. 12. With respect to this claim, the Examiner relies on Harwood’s teaching of a compressed stack of tissues. Final Act. 10 (citing Harwood col. 10, ll. 30–40). Appellant’s argument regarding the percentage of compression does not address this claim or the Examiner’s reliance on Harwood with respect to this claim, and

thus, we find it unpersuasive. Accordingly, we are not persuaded of reversible error, and thus, we sustain the rejection of claim 17.

*Rejection of Claim 18*

Claim 18 depends from claim 17 and further recites “wherein the dispensing window covers the carton opening and at least two sides of the container.” Appeal Br. 12. Appellant does not present separate arguments regarding the rejection of this claim.<sup>9</sup> *See Id.* at 8. Accordingly, we sustain the rejection of claim 18 for the reasons we sustain the rejection of independent claim 17, from which claim 18 depends.

*Rejection of Claim 19*

Claim 19 depends from claim 17 and requires that “the stack has a compressed height (h3) that is from about 30 percent to about 60 percent less than the height of an identical uncompressed stack of interfolded disposable sheets (h1).” Appeal Br. 12. The Examiner determines that this limitation would have been obvious in view of Harwood’s teachings. Final Act. 6 (citing Harwood col. 10, ll. 30–40). Appellant argues that Harwood teaches a range outside of the claimed range and Harwood does not provide motivation to compress the tissue stack further. Appeal Br. 7.

We are not persuaded of error. Notably, as Appellant acknowledges, Harwood discloses compression of a tissue stack from about 12 to 29 percent. Harwood col. 8, ll. 66–75. We consider the disclosed range in Harwood to be substantially close to the claimed range such that a prima facie case of obviousness exists. *See Titanium Metals Corp. of America v.*

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<sup>9</sup> Although Appellant lists claim 18 under a separate heading, no arguments regarding the specific requirements of the claim are advanced.

*Banner*, 778 F.2d 775, 783, (Fed. Cir. 1985) (holding that prior art percentages were sufficiently close that one skilled in the art would expect them to have the same properties); *see also* MPEP § 2144.05. Here, we find that compression of about 29 percent is sufficiently close to the claimed range starting at 30 that one of ordinary skill in the art would understand them to have substantially the same properties. Further, Appellant has not set forth a showing that the claimed range is critical to overcome this rejection. *See In re Woodruff*, 919 F.2d 1575 (Fed. Cir. 1990). Accordingly, we sustain the rejection of claim 19.

*Rejection of Claim 20*

Claim 20 depends from claim 17 and further recites “a dispensing opening disposed on the dispensing window, the dispensing opening having a width from about 10 to about 15 mm and a length from about 60 percent to about 80 percent of the length of the carton opening.” Appeal Br. 12. The Examiner finds that providing a dispensing opening with the claimed width would have been obvious in view of Hirasawa. Final Act. 11. Specifically, the Examiner finds that Hirasawa teaches “a width from about 10 to about 20mm” and that a width of 20 mm is about 15 mm. *Id.* (citing Hirasawa col. 6, ll. 29–32). We are persuaded by Appellant’s argument that Hirasawa does not support the Examiner’s conclusion that providing the claimed width of opening would have been obvious. As noted by Appellant, Hirasawa discloses an opening width above 20 mm and also explains that opening widths below 20 mm do not allow for a finger to be inserted therein. Hirasawa col. 6, ll. 29–32 (“The maximum width W1 of the taking-out opening is at least 20 mm or more, preferably, 38 mm or more. In a range of less than 20 mm, a function as the finger inserting portion 28 can not be

obtained.”). Given this disclosure, we agree with Appellant that one of ordinary skill in the art would not conclude that 15 mm is about 20 mm, as the Examiner argues, or that an opening of 15 mm would have the same properties as an opening above 20 mm. The Examiner does not adequately support or explain the finding that an opening of about 15 mm “is capable of providing a functional dispenser” in light of the evidence in Hirasawa to the contrary.

Based on the foregoing, we do not sustain the rejection of claim 20.

### CONCLUSION

We AFFIRM the rejections of claims 14–19. We REVERSE the rejections of claims 1–7, 9–11, 13, 20, and 21.

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).

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 2, 4, 5, 13, 21	103(a)	Trunick, Szymonski		1, 2, 4, 5, 13, 21
3	103(a)	Trunick, Szymonski, Gao		3
6, 7, 17, 19	103(a)	Trunick, Szymonski, Harwood	17, 19	6, 7
9, 11	103(a)	Trunick, Szymonski, Thoms		9, 11
10	103(a)	Trunick, Szymonski, Nasrallah		10

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
14-16	103(a)	Trunick, Szymonski, Gao, Harwood	14-16	
18, 20	103(a)	Trunick, Szymonski, Gao, Harwood, Hirasawa, Nasrallah	18	20
<b>Overall Outcome</b>			14-19	1-7, 9- 11, 13, 20, 21

AFFIRMED IN PART