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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte EVON L. CROOKS

Appeal 2019-000345
Application 14/484,813
Technology Center 1700

Before MICHAEL P. COLAIANNI, GEORGE C. BEST, and
DEBRA L. DENNETT, *Administrative Patent Judges*.

BEST, *Administrative Patent Judge*.

DECISION ON APPEAL

The Examiner finally rejected claims 7–14 of Application 14/484,813 under 35 U.S.C. § 103 as obvious. Final Act. 1, 2, 4 (June 30, 2017).

Appellant seeks reversal of the rejections pursuant to 35 U.S.C. § 134(a).¹

We have jurisdiction under 35 U.S.C. § 6(b).

For the reasons set forth below, we *affirm*.

¹ 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 R.J. Reynolds Tobacco Company. Br. 1 (Appellant did not number the pages of their Brief. For ease of reference, we have supplied page numbers).

BACKGROUND

The '813 Application describes tobacco derived materials that can be useful as a filtration media in cigarettes. *See* Spec. 1:1–3.

Claims 7 and 12 are representative of the '813 Application's claims and are reproduced below from the claims listing in the Claims Appendix to the Appeal Brief:

7. A method for formation of a filter element of a smoking article, the method comprising:

i) chemically pulping a tobacco input comprising stalks, roots, or a combination thereof of a plant of the *Nicotiana* species to form a cellulosic pulp;

ii) forming a web of sheet-like material comprising the cellulosic pulp; and

iii) pleating the web of sheet-like material to form a rod-like element suitable for use in a filter element.

12. A method for formation of a filter element of a smoking article, the method comprising:

i) chemically pulping a tobacco input comprising stalks, roots, or a combination thereof of a plant of the *Nicotiana* species to form a cellulosic pulp;

ii) esterifying the cellulosic pulp to produce cellulose acetate;

iii) dissolving the cellulose acetate in a solvent to form a cellulose acetate dope;

iv) spinning the cellulose acetate dope into a plurality of filaments; and

v) collecting, drying and crimping the plurality of filaments to form a tow material suitable for use in a filter element, the tow material comprising at least 10 dry weight percent of cellulose acetate filaments made from the cellulosic pulp.

Br. (Claims App.) 11–12.

REJECTIONS

On appeal, the Examiner maintains the following rejections:

1. Claims 7–11 are rejected under 35 U.S.C. § 103 as unpatentable over the combination of Pan² and Byrd.³ Final Act. 2.
2. Claims 12–14 are rejected under 35 U.S.C. § 103 as unpatentable over the combination of Yamashita⁴ and Byrd. Final Act. 4.

DISCUSSION

Appellant argues for the reversal of the rejections of claims 7–11 and 12–14 on the basis of limitations recited in independent claims 7 and 12, respectively. Br. 3–9. We select claims 7 and 12 as representative. Accordingly, we limit our discussion to claims 7 and 12.

Rejection 1. The Examiner rejected claims 7–11 as obvious over the combination of Pan and Byrd. Final Act. 2.

In rejecting claim 7, the Examiner found that Pan describes or suggests every step of the method for forming a smoking article's filter element with the exception of chemically pulping a tobacco input to form a cellulosic pulp. *Id.*

The Examiner found Byrd discloses, *inter alia*, that tobacco input, which may come from tobacco plant stalk and/or reconstituted tobacco, and other tobacco components, may be chemically pulped to form a tobacco

² US 2015/0001148 A1, published Jan. 1, 2015.

³ US 2013/0276801 A1, published Oct. 24, 2013.

⁴ US 6,571,802 B1, issued June 3, 2003.

pulp. Final Act. 3 (citing Byrd Abstract). The Examiner further found Byrd teaches that chemical pulping involves applying chemicals and heat to break down the tobacco input's lignin, thereby leaving cellulose fibers intact. Final Act. 3. The Examiner determined that it would have been obvious to the ordinarily skilled artisan at the time of the invention to chemically pulp a tobacco input because Byrd teaches bleaching a tobacco pulp to remove the pulp's non-cellulosic material. *Id.* (citing Byrd ¶ 58).

Appellant argues that the rejection of claim 7 should be reversed because one of ordinary skill in the art would not have combined Pan and Byrd as proposed. Br. 4. In particular, Appellant asserts that: (1) Pan neither teaches nor suggests pulping a tobacco input comprising stalks, roots, or both from a *Nicotiana* species plant to form a cellulosic pulp, *id.* at 5; (2) Byrd is likewise silent regarding any process for making a cellulosic pulp, forming the pulp into a web of sheet-like material, then pleating the material form a rod-like filter element, *id.*; (3) the ordinarily skilled artisan would not have expected that Byrd's chemically pulped tobacco-derived cellulosic pulp would have functioned *predictably* as a suitable material for forming Pan's filter element, *id.* at 7 (emphasis added); and (4) such an artisan would not "have a reasonable expectation of success in using a cellulosic pulp formed from chemically pulping a tobacco material to form a pleated web of sheet-like material[,] which is then pleated to form a rod-like element suitable for use in a filter element." *Id.*

Appellant's arguments are not persuasive.

First, Appellant's arguments (1) and (2) fail to address the Examiner's specific findings. For example, the Examiner relies on Pan for disclosing the use of a cellulose source, i.e., pulp fibers, which are obtained from tobacco

stems and stalks. Answer 7 (citing Pan ¶¶ 11–13, 42). The Examiner found that Pan, not Byrd, teaches that these fibers are deposited on a forming surface to form a paper web, which is dried, crimped, and gathered to form a rod-shaped filter element. Final Act. 3 (citing Pan ¶¶ 70–71). The Examiner, furthermore, relies on Byrd, not Pan, for teaching “chemically pulping a tobacco input to form a tobacco pulp.” Answer 7.

Appellant has not identified any particular claim limitation that is neither described nor suggested in the cited references. Appellant’s arguments are thus directed to attacking the individual references rather than the combined teaching of these references. Appellant’s criticisms of Pan and Byrd, therefore, do not establish nonobviousness. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981); *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971) (“[T]he test for combining references is not what the individual references themselves suggest but rather what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art.”).

Second, Appellant’s arguments (3) and (4) regarding an alleged unreasonable expectation of success for the Examiner’s proposed combination are not persuasive because “arguments of counsel cannot take the place of evidence lacking in the record.” *Estee Lauder Inc. v. L’Oreal, S.A.*, 129 F.3d 588, 595 (Fed. Cir. 1997); *In re Huang*, 100 F.3d 135, 139–40 (Fed. Cir. 1996); *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984).

As explained by the Examiner, both Pan and Byrd discuss chemically pulping a tobacco input to form a tobacco pulp. Answer 7. For example, Pan discloses a reconstituted tobacco paper formed from a tobacco furnish, which contains tobacco stems and/or other tobacco by-products. *Id.* (citing Pan ¶ 73). Pan teaches mixing this tobacco furnish with a solvent at elevated

temperatures, extracting an insoluble residue fraction, and subsequently mechanically refining the fraction to produce a fibrous pulp. Pan ¶¶ 73–77. We, therefore, agree with the Examiner’s determination that one of ordinary skill in the art would have had a reasonable expectation of success in using a chemical pulping method because Pan, like Byrd, discloses chemical pulping. *See Answer 7.*

On this record, Appellant has not provided sufficient evidence demonstrating that it was erroneous for the Examiner to find that claim 7 is drawn to a combination of known steps, according to a known method, that yields predictable results. *See id.*; Final Act. 2–3. Thus, when we consider all of the evidence, we determine that the preponderance of the evidence supports the Examiner’s conclusion of obviousness with respect to the claimed method for forming a smoking article’s filter element.

We, therefore, affirm **Rejection 1** of claim 7. Thus, we also affirm **Rejection 1** of claims 8–11, which ultimately depend from claim 7. 37 C.F.R. § 41.37(c)(1)(iv).

Rejection 2. The Examiner rejected claims 12–14 as obvious over the combination of Yamashita and Byrd. Final Act. 4.

In rejecting claim 12, the Examiner found that Yamashita describes or suggests every step of the method for forming a smoking article’s filter element except for chemically pulping a tobacco input to form a cellulosic pulp. *Id.*

As in **Rejection 1**, the Examiner relied upon Byrd’s teachings that a tobacco input may be chemically pulped to form a tobacco pulp. *Id.* at 4–5. The Examiner determined that chemically pulping a tobacco input would have been obvious to the ordinarily skilled artisan at the time of the

invention because Byrd teaches bleaching a tobacco pulp to remove the pulp's non-cellulosic material. *Id.* at 5 (citing Byrd ¶ 58).

Appellant argues that the rejection of claim 12 should be reversed because one of ordinary skill in the art would not have combined Yamashita and Byrd as proposed. Br. 7. Specifically, Appellant asserts that: (1) Yamashita fails to disclose or suggest pulping a tobacco input comprising stalks, roots, or both from a *Nicotiana* species plant to form a cellulosic pulp, *id.* at 8; (2) Byrd is similarly silent regarding making a cellulosic pulp, forming this pulp into cellulose acetate, then esterifying, dissolving, spinning, collecting, drying, and crimping this cellulose acetate to form a tow material suitable for use in a filter element, *id.*; and (3) the ordinarily skilled artisan would not “have a reasonable expectation of success in using a cellulosic pulp formed from chemically pulping a tobacco material[,] which can be used in an esterification process to produce cellulose acetate, which can then [be used] to form a tow material[,], which is suitable for use in a filter element.” *Id.* at 9.

Appellant's arguments are not persuasive.

First, Appellant's arguments (1) and (2) fail to address the Examiner's specific findings. The Examiner relied upon Byrd, not Yamashita, for disclosing the use of a tobacco input as a cellulose source. Answer 8 (citing Byrd ¶¶ 7, 52; Abstract). The Examiner found Yamashita, not Byrd, teaches “producing cellulose acetate from a cellulose source, dissolving the cellulose acetate in acetone, spinning the cellulose acetate solution into cellulose acetate fibers, and drying, bundling, and crimping the fibers into a cellulose acetate tow.” Answer 8 (citing Yamashita 1:11–23; 5:1–18; 6:44–7:40; 8:27–42; 9:16–25).

On these facts, Appellant has not identified any particular claim limitation that is neither described nor suggested in the cited references. Appellant's criticisms of Yamashita and Byrd, therefore, do not establish nonobviousness. *See Keller*, 642 F.2d at 426; *McLaughlin*, 443 F.2d at 1395.

Second, Appellant's argument (3) regarding an alleged unreasonable expectation of success for the Examiner's proposed combination are not persuasive because "arguments of counsel cannot take the place of evidence lacking in the record." *Estee Lauder Inc.*, 129 F.3d at 595. As explained by the Examiner, one of ordinary skill in the art would have had a reasonable expectation of success in using Byrd's tobacco input as a cellulose source in Yamashita's method of forming a tow material, which is suitable for use in a filter element, because Yamashita does not require any particular cellulose source in the preparation of cellulose acetate. Answer 8–9.

On this record, Appellant has not provided sufficient evidence demonstrating that it was erroneous for the Examiner to find that claim 12 is drawn to a combination of known steps, according to a known method, that yields predictable results. *See id.*; Final Act. 4–5. Thus, when we consider all of the evidence, we determine that the preponderance of the evidence supports the Examiner's conclusion of obviousness with respect to the claimed method for forming a smoking article's filter element.

We, therefore, affirm **Rejection 2** of claim 12. Thus, we also affirm **Rejection 2** of claims 13 and 14, which ultimately depend from claim 12. 37 C.F.R. § 41.37(c)(1)(iv).

CONCLUSION

In summary:

Claims Rejected	Basis	Affirmed	Reversed
7-11	§ 103 Pan Byrd	7-11	
12-14	§ 103 Yamashita Byrd	12-14	
Overall Outcome		7-11 and 12-14	

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED