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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte AHMET ERCELEBI, MARTIN T. GARTHAFFNER, and DWIGHT D. WILLIAMS

Appeal 2019-000952
Application 14/218,208
Technology Center 1700

Before MONTÉ T. SQUIRE, MICHAEL G. McMANUS, and MERRELL C. CASHION, Jr., *Administrative Patent Judges*.

SQUIRE, *Administrative Patent Judge.*

DECISION ON APPEAL[1]

Appellant[2] appeals under 35 U.S.C. § 134(a) from the Examiner's decision finally rejecting claims 3–5, 7, 8, and 10–19, which are all of the

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[1] In this Decision, we refer to the Specification filed Mar. 18, 2014 ("Spec."); Final Office Action dated Nov. 28, 2017 ("Final Act."); Advisory Action dated Mar. 22, 2018 ("Adv. Act."); Appeal Brief filed May 24, 2018 ("Appeal Br."); Examiner's Answer dated Sept. 13, 2018 ("Ans."); and Reply Brief filed Nov. 13, 2018 ("Reply Brief").

[2] We use the word "Appellant" to refer to "Applicant" as defined in 37 C.F.R. § 1.42(a). Appellant identifies Philip Morris USA Inc. as the real party in interest. Appeal Br. 3.

claims pending in this application.[3] We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

The Claimed Subject Matter

Appellant's disclosure relates to cigarettes and filter subassemblies for use with cigarettes, including a cigarette filter subassembly manufactured from a filter member having absorbent material encased within an outer cover, and to methods of manufacturing cigarettes and cigarette filters. Spec. ¶ 2; Abstract.

Independent claim 3 is illustrative of the claimed subject matter on appeal and is reproduced below from the Claims Appendix to the Appeal Brief:

> 3. An individual cigarette filter subassembly comprising:
>
> an absorbent material encased within an outer cover of plug wrap, the absorbent material radially outwardly displaced against the outer cover so as to form ***an annular liner of compressed absorbent material along an inner surface of the outer cover***, the annular liner surrounding a hollow axial opening having at least one capsule therein, and an impermeable material on an inner surface of the annular liner of compressed absorbent material forming an impermeable coating on the inner surface of the annular liner of compressed absorbent material, and wherein the coating is impermeable to an additive material released from the at least one capsule such that when the at least one capsule is broken, the additive material is isolated from the annular liner of compressed absorbent material and the outer cover; and

[3] Claims 1, 2, 6, and 9 are cancelled. Appeal Br. 3.

at least one first absorbent member of the absorbent material and at least one second absorbent member of the absorbent material arranged within the annular liner of compressed absorbent material, and wherein the at least one capsule is disposed within the hollow axial opening between the at least one first absorbent member and the at least one second absorbent member, the individual cigarette filter subassembly formed by a method comprising the steps of:

A. providing the filter member comprised of the absorbent material surrounded by the cover, the filter member defining a longitudinal center axis;

B. passing a plunger axially through the absorbent material such that a generally pointed leading end of the plunger displaces the absorbent material radially outwardly, wherein the displaced absorbent material forms the liner along the inside surface of the cover and defines the hollow axial opening within the absorbent material;

C. axially inserting a series of absorbent members into the hollow space, with the at least one capsule disposed between successive absorbent members, the at least one capsule containing the additive material for modifying characteristics of tobacco smoke during smoking to form an elongate filter structure which is cut to suitable length, each length containing at least one absorbent member and at least one capsule;

D. cutting every other absorbent member in said series of absorbent members at its axial midpoint to provide two dual-filter structures, each of said dual-filter structures comprising, in series, one half of a first absorbent member of twice the length of the first absorbent member, a first capsule, a second absorbent member, a second capsule, and one half of a third absorbent member, all disposed within said outer cover;

E. providing a series of additional absorbent members, with one of said dual-filter structures being provided between adjacent additional absorbent

members; and/or providing a quantity of activated carbon between each of said additional absorbent members and said adjacent dual-filter structure;

F. cutting every other one of said series of additional absorbent members substantially midway between adjacent dual-filter structures, said step of cutting producing quad subassemblies, each of said quad subassemblies comprising one half of a first additional absorbent member, a first quantity of activated carbon, a first dual-filter structure, a second quantity of activated carbon, a second additional absorbent member, a third quantity of activated carbon, a second dual-filter structure, a fourth quantity of activated carbon, and one half of a third additional absorbent member;

G. cutting each of said dual-filter structures midway between adjacent capsules; and

H. cutting each of said second additional absorbent members midway between adjacent dual-filter structures, whereby an individual cigarette filter assembly is provided.

Claims Appendix 1–2 (key disputed claim language italicized and bolded).

The References

The Examiner relies on the following prior art references as evidence in rejecting the claims on appeal:

Dube et al. (“Dube”)	US 2004/0261807 A1	Dec. 30, 2004
Karles et al. (“Karles”)	US 2007/0012327 A1	Jan. 18, 2007

The Rejection

On appeal, the Examiner maintains (Ans. 3) the following rejection: claims 3–5, 7, 8, and 10–19 rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Karles in view of Dube. Final Act. 4.[4]

OPINION

Having considered the respective positions advanced by the Examiner and Appellant in light of this appeal record, we affirm the Examiner's rejections based on the fact-finding and reasoning set forth in the Answer, Advisory Action, and Final Office Action, which we adopt as our own. We add the following primarily for emphasis.

Claims 3–5, 7, 8, and 10–19

Appellant argues independent claims 3, 4, 7, and 8 as a group, but does not present separate arguments for the patentability of dependent claims 5 and 10–19. Appeal Br. 14–15, 31; Reply Br. 2–10. We select claim 3 as representative and the remaining claims subject to the Examiner's rejection stand or fall with claim 3. 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner determines that the combination of Karles and Dube suggests a cigarette filter subassembly satisfying all of the limitations of claim 3 and concludes the combination would have rendered the claim obvious. Final Act. 4–7. On the record before us, we find a preponderance of the evidence and sound technical reasoning support the Examiner's

[4] At page 3 of the Answer, the Examiner has withdrawn both of the § 112 rejections, which were previously made and set forth at pages 2–3 of Final Office Action.

analysis and determination that the combination of Karles and Dube suggests a cigarette filter subassembly satisfying all of the limitations of claim 3, and conclusion that the combination would have rendered the claim obvious. Karles, Abstract, Figs. 2, 5–7, ¶¶ 42, 52, 59, 61, 71, 72–77; Dube, Abstract, ¶¶ 58–60.

Appellant argues the Examiner's rejection of claim 3 should be reversed because the cited art does not teach or suggest "an annular liner of compressed absorbent material," as recited in the claim. Appeal Br. 14–18; Reply Br. 1–4. In particular, Appellant contends Karles does not disclose a coating on the inner surface of the annular liner and the Examiner "errs in contending that Karles's member **42** is 'compressed' material." Appeal Br. 17. Appellant further contends the Examiner's rejection lacks a factual basis because the Examiner provides "no support" for finding that annular layer **42** of Karles is compressed, and neither Karles nor Dube mention or suggest compressing the cellulose acetate formed around the outer cover of Karles' filter assembly. *Id.* at 18.

We do not find Appellant's arguments persuasive of reversible error in the Examiner's rejection based on the fact-finding and reasoning provided by the Examiner at pages 4–5 of the Answer and pages 4–7 of the Final Office Action. Contrary to what Appellant argues (Appeal Br. 14–18; Reply Br. 1–4), we find that a preponderance of the record evidence supports the Examiner's finding that the cited art teaches or suggests "an annular liner of compressed absorbent material," as recited in the claim. As the Examiner finds (Ans. 4–5; Final Act. 4–7), Karles teaches forming a filter subassembly comprising an absorbent material **42** (cellulose acetate) encased within an outer cover **52**, and forming an annular liner of a compressed absorbent

material **42** ("annular layer **42** of cellulose acetate") along an inner surface of the outer cover. Karles, Figs. 2, 5, ¶¶ 61, 71.

As the Examiner further finds (Ans. 4), Karles refers to and incorporates by reference the process used to form annular layer **42** described in U.S. Patent No. 4,064,791,[5] (Karles ¶ 71), which is essentially the same process described in U.S. Patent No. 3,637,447,[6] wherein the inner member is formed from a filtering material such as cellulose acetate and continuously passed into and through a conventional stuffer jet or air nozzle (*compare* '791 patent, 5:24–37 *with*, '447 patent, 3:58–65). In particular, as the Examiner finds (Ans. 4–5), according to the process described in the prior art, in order to produce the tubular rod-like tow of filtering material, the cellulose acetate material is fed into a stuffer jet or air nozzle, which is generally shaped as a truncated cone having a greater cross section at the entrance end than at the exit end. *See, e.g.*, '447 patent, 3:58–65.

Thus, as the Examiner explains (Ans. 4–5), because during the process used to form the annular layer, the cellulose acetate material is passed through a stuffer jet or air nozzle shaped as a truncated cone, it follows that Karles' cellulose acetate material **42** is or would have been reasonably expected by one of ordinary skill in the art to be "compressed" along an inner surface of outer cover **52**, as recited in the claim.

Appellant's arguments do not reveal any reversible error in the Examiner's factual findings or analysis in this regard.

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[5] Berger, U.S. Patent No. 4,064,791 (issued Dec. 27, 1977).

[6] Berger et al., U.S. Patent No. 3,637,447 (issued Jan. 25, 1972).

Appellant argues one of ordinary skill in the art would not have had reason to combine Karles and Dube to arrive at the claimed invention "due to the differences in how the filters are designed and operate." Appeal Br. 20. In particular, Appellant contends that

> [c]ontrary to the objective of Dube of retaining the capsule against a conical wall of the cavity by a coating of triacetin . . . Karles seeks to provide a capsule in a cavity through which air can flow around the capsule.

Id. at 20. Appellant also contends there would be no reason to add a coating of triacetin to the inner surface of member **42** because capsule **36** of Karles is already retained by absorbent members **32** and **34**. *Id.* at 20; *see also* Reply Br. 9–10 (same).

Appellant's arguments are not persuasive of reversible error because the Examiner provides a reasonable basis, which is supported by a preponderance of the evidence in the record, to evince why one of ordinary skill would have combined the teachings of Karles and Dube to arrive at the claimed invention. Final Act. 7 (explaining it would have been obvious for one of ordinary skill in the art at the time of the invention to have coated Karles' cellulose acetate liner with triacetin in order to improve adhesion with the capsule, as taught by Dube); Dube ¶ 60 (disclosing the use of "a coating of triacetin plasticizers capable of causing some adhesion with the capsule"). *See also KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 420 (2007) (explaining that any need or problem known in the art can provide a reason for combining the elements in the manner claimed).

Appellant fails to direct us to persuasive evidence or provide an adequate technical explanation to establish why the Examiner's articulated reasoning lacks a rational underpinning or is otherwise based on some other

reversible error. Appellant's mere disagreement as to the Examiner's factual findings and reasoning for combining the references, without more, is insufficient to establish reversible error. *Cf. SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1320 (Fed. Cir. 2006) ("[M]ere statements of disagreement . . . as to the existence of factual disputes do not amount to a developed argument.").

Appellant's contention regarding the objective of Dube being contrary to Karles' filter subassembly (Appeal Br. 20) is not persuasive because it is conclusory and Appellant does not provide an adequate technical explanation or direct us to persuasive evidence in the record to support it. Attorney argument is not evidence. *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984).

Appellant argues the Examiner's rejection of claim 3 should be reversed because the Examiner errs in failing to give the product by process limitations patentable weight. Appeal Br. 18; Reply Br. 2, 5–8. Appellant argues that although claim 3 recites product by process steps A–H, the structure implied by the claimed process steps is not disclosed or suggested by Karles. Appeal Br. 19. In particular, Appellant contends the "claimed steps provide the claimed liner of compressed absorbent material, a structure which is not the same or obvious from the annular liner of Karles." *Id.* at 19.

We do not find Appellant's arguments in this regard persuasive of reversible error based on the Examiner's factual findings and reasoning provided at pages 5–6 of the Answer and pages 5–6 of the Final Office Action. In particular, as the Examiner finds (Ans. 5–6; Final Act. 5–6) and Appellant agrees (Appeal Br. 19), claim 3 is written in a product-by-process format. The patentability of this type of claim does not depend on the

process steps, i.e., process steps A–H of claim 3, except to the extent that the process steps are shown to result in properties not possessed by prior art products. "If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 697 (Fed. Cir. 1985); *see also In re Pilkington*, 411 F.2d 1345, 1348 (CCPA 1969) ("[The] patentability of a claim to a product does not rest merely on a difference in the method by which that product is made. Rather, it is the product itself which must be new and unobvious.").

Because, as the Examiner finds and previously discussed above, the combination of Karles and Dube suggests all of the limitations of the claimed filter subassembly product, the burden shifts to Appellant to show an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802 (Fed. Cir. 1993).

Appellant, however, has not shown, either by persuasive technical reasoning or evidence, an unobvious difference between the claimed product and the prior art product. Appellant's assertion that the "claimed steps provide the claimed liner of compressed absorbent material, a structure which is not the same or obvious from the annular liner of Karles" (Appeal Br. 19) is conclusory and, without more, insufficient to establish that the claimed structure implied by the recited process steps is different than the prior art structure, as the Examiner determines is suggested by the combination and Karles and Dube. *De Blauwe*, 736 F.2d at 705.

Accordingly, we affirm the Examiner's rejection of claim 3.

Claims 4, 7, and 8

Although Appellant argues claims 4, 7, and 8 each under separate headings in the Appeal Brief (*see* Appeal Br. 20, 24, 28), Appellant repeats and relies on principally the same arguments previously presented above in response to the Examiner's rejection of claim 3. *Compare* Appeal Br. 17–20 (presenting arguments for the patentability of claim 3) *with*, Appeal Br. 21–24, 25–27, 28–31 (repeating essentially the same arguments for the patentability of claims 4, 7, and 8, respectively).

Thus, based on the findings and technical reasoning provided by the Examiner, and for principally the same reasons discussed above for affirming the Examiner's rejection of claim 3, we affirm the Examiner's rejection of claims 4, 7, and 8.

Accordingly, we affirm the Examiner's rejection of claims 3–5, 7, 8, and 10–19 under 35 U.S.C. § 103(a) as obvious over the combination of Karles and Dube.

CONCLUSION

In summary:

Claim(s) Rejected	Basis	Affirmed	Reversed
3–5, 7, 8, 10–19	§ 103(a) Karles, Dube	3–5, 7, 8, 10–19	
Overall Outcome		3–5, 7, 8, 10–19	

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