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CANTOR COLBURN LLP 20 Church Street 22nd Floor Hartford, CT 06103			WITTENSCHLAEGER, THOMAS M	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ARNOLD LESLIE HERHOLDT and
GERHARD MALAN LE ROUX

Appeal 2019-003699
Application 13/393,209
Technology Center 3700

Before JENNIFER D. BAHR, EDWARD A. BROWN, and
PAUL J. KORNICZKY, *Administrative Patent Judges*.

KORNICZKY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE¹

Pursuant to 35 U.S.C. § 134(a), Appellant² appeals from the Examiner's decision to reject claims 1–13, 15–17, and 22–24. *See* Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

CLAIMED SUBJECT MATTER

Independent claims 1, 11, and 15 are directed to a machine for making filter rods for use in the manufacture of smoking articles, a garniture of a machine for making filter rods for use in the manufacture of smoking articles, and a method of making filter rods for use in the manufacture of smoking articles, respectively. Claim 1, reproduced below, is illustrative of the claimed subject matter (emphasis added):

1. A machine for making filter rods for use in the manufacture of smoking articles, comprising:

a garniture that receives filter plug material and filter wrapping material and forms a wrapped elongate filter rod, the garniture comprising a garniture tape and a tapering garniture inlet channel through which filter wrapping material is dragged on the garniture tape, the garniture further comprising a tongue, the tongue being tapered to compress filter plug material and convey filter plug material onto the filter wrapping material being dragged through the tapering garniture inlet channel on the garniture tape as it passes through the tongue;

¹ In this Decision, we refer to (1) the Examiner's Final Office Action dated April 3, 2018 ("Final Act."), Advisory Action dated June 29, 2018 ("Adv. Act"), and Answer dated February 8, 2019 ("Ans."), and (2) Appellant's Appeal Brief dated December 4, 2018 ("Appeal Br.") and Reply Brief dated April 8, 2019 ("Reply Br.").

² We use the term "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Tobacco Research and Development Institute (Proprietary) Limited. Appeal Br. 1.

a rotatable object-transport member that delivers objects directly into *filter plug material* passing through the tongue and *which has been conveyed onto filter wrapping material* being dragged through the garniture inlet channel on the garniture tape; and

a cutter configured to cut the elongate filter rod, thereby forming filter rod segments, each segment having one or more objects therein.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Green	US 4,862,905	Sept. 5, 1989
Deal	US 2005/0070409 A1	Mar. 31, 2005
Esposti	EP 1 917 871 A1	May 7, 2008

REJECTION

1. Claims 1–13, 15–17, and 22–24 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Esposti, Deal, and Green. Ans. 3–9.

OPINION

*Claims 1–13, 15–17, and 22–24
as Unpatentable over Esposti, Deal, and Green*

Independent Claims 1, 11, and 15

The Examiner finds that claims 1–13, 15–17, and 22–24 are unpatentable over Esposti, Deal, and Green. Final Act. 11–19; Adv. Act. 2; Ans. 18–19. More specifically, the Examiner finds that Esposti discloses all of the limitations of independent claims 1, 11, and 15 except for the limitation reciting “a rotatable object-transport member.” Final Act. 12 (claim 1), 16–17 (claim 11), 18–19 (claim 15) (emphases omitted). For this missing limitation, the Examiner finds that Deal “teaches a rotatable object-

transport member (74 – Fig. 12) that delivers objects (300 – Fig. 12) directly into filter plug material (16 – Fig. 1) passing through a tongue (the assembly of 30 and 32 – Fig. 1) in order to incorporate distinctive flavors into a cigarette and improve the desirability of a cigarette.” Final Act. 12 (claim 1), 16 (claim 11), 18 (claim 15) (emphases omitted). The Examiner reasons that it would have been obvious to one of ordinary skill in the art “to have modified the machine of Esposti to include a rotatable object-transport member as taught by Deal in order to incorporate distinctive flavors into a cigarette and improve the desirability of a cigarette.” *Id.*

In its Appeal Brief, Appellant initially argues that the Examiner’s argument is erroneous because “Deal does not teach or disclose a rotatable object-transport member that corresponds with Applicant’s claimed rotatable object-transport member.” Appeal Br. 22. According to Appellant,

[Deal’s] filter material passes through the tongue 30, such that at the point of insertion of the objects into the filter material, the filter material has NOT been conveyed onto filter wrapping material. As indicated in paragraph [0051] of Deal, “as the insertion wheel 74 rotates, the capsules held within the pocket 75 are brought into contact with the filter material 16 within the block 30 where the capsule is then ejected from the pocket into the gathering filter material.” Instead, the Deal insertion wheel 74 delivers objects into the filter material at a position *prior to* the filter material being on the filter wrapping material, which is being conveyed by the garniture tape, as the filter material is only delivered onto the wrapping material, which is being conveyed by the garniture tape, once it reaches the wrapping mechanism 34, well downstream of the point at which the rotatable object transport member 34 delivers objects into the filter material. See also, Figure 1.

Id. at 21–22. Appellant argues that Deal does not disclose the claimed rotatable object-transport member because Deal’s rotatable member delivers

objects into the filter material before the filter material is positioned on the filter wrapping material. *Id.* According to Appellant, at the point of insertion of the objects into the filter material, the filter material has not been conveyed onto filter wrapping material. *Id.*

Appellant's arguments are not persuasive because Appellant is attacking the teachings of Deal individually. Nonobviousness, however, cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Here, the Examiner's rejections of claims 1, 11, and 15 are based on the combination of Esposti, Deal, and Green. The Examiner relies on Esposti, not Deal, for its disclosure of a garniture comprising tongue 21, filter plug material 9, filter wrapping material 12, and garniture tape 19. Final Act. 12 (claim 1), 15–16 (claim 11), 17–18 (claim 15). Referring to Figure 2 of Esposti, the Examiner finds that Esposti, not Deal, discloses that garniture tape 19 drags filter wrapping material 12 through the inlet of the tongue (e.g., tapering inlet channel 30a of tongue 21 in Fig. 4) and filter plug material 9 is conveyed onto filter wrapping material 12 at inlet channel 30a of tongue 21. *Id.* The Examiner relies on Deal for its teaching of rotatable object-transport member 74. *Id.* (citing Deal, Fig. 12). In the Examiner's proposed combination of Esposti and Deal, the rotatable object-transport member delivers objects to a filter plug material at a position after the filter plug material has been conveyed onto filter wrapping material being dragged through the garniture inlet channel on the garniture tape. *Id.* Appellant does not address the rejection as articulated by the Examiner, and, thus, does not identify error by the Examiner.

In its Reply Brief, Appellant presents new arguments that (1) Esposti's tongue (connecting element 21) is "neither identified as a 'tongue', nor even a part of the 'garniture'" (Reply Br. 4), and (2) Deal's rotatable object-transport member could not be bodily incorporated into Esposti's connecting element 21 and one of ordinary skill in the art would have "no motivation to modify Esposti so as to provide it with the rotatable object transport member of Deal so that objects are delivered into the connecting element (21) because a skilled person would have to make substantial further modifications to Esposti in order to achieve this" (*id.* at 5–7). Because these arguments could have been presented in the Appeal Brief to rebut the rejections as set forth in the Final Office Action, thus affording the Examiner an opportunity to consider and respond to the arguments, Appellant's arguments are untimely. *See* 37 C.F.R. § 41.37(c)(vii)(second sentence); *In re Hyatt*, 211 F.3d 1367, 1373 (Fed. Cir. 2000) (noting that an argument not first raised in the brief to the Board is waived on appeal); *Ex parte Borden*, 93 USPQ2d 1473, 1477 (BPAI 2010) (informative) (The Board is not required "to take up a belated argument that has not been addressed by the Examiner, absent a showing of good cause.").

For the reasons above, the rejection of independent claims 1, 11, and 15 is sustained.

Dependent Claims 2–10, 12, 13, 16, 17, and 22–24

Appellant makes no separate arguments as to the rejections of claims 2–10, 12, 13, 16, 17, and 22–24 which depend from independent claims 1, 11, or 15. Appellant asserts that these dependent claims "being dependent on allowable claims 1, 11, and 15, respectively, are also allowable over

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Esposti in view of Deal/Green” and “these dependent claims recite additional features further distinguishing them over both Deal and Green.”
Appeal Br. 24.

For the reasons discussed above, the rejection of claims 1, 11, and 15 is sustained. Although Appellant references “additional features further distinguishing them over Deal and Green” (*id.*), because Appellant does not specifically identify any patentable features of these claims over the independent claims, we sustain the rejection of claims 2–10, 12, 13, 16, 17, and 22–24. *See also In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (37 C.F.R. § 41.37 requires “more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”).

CONCLUSION

The Examiner’s rejection of claims 1–13, 15–17, and 22–24 as being unpatentable over Esposti, Deal, and Green is AFFIRMED.

DECISION SUMMARY

In summary:

Claim(s) Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1-13, 15-17, 22-24	103(a)	Eposti, Deal, Green	1-13, 15-17, 22-24	
Overall Outcome			1-13, 15-17, 22-24	

TIME PERIOD FOR RESPONSE

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