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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHEL MORAND

Appeal 2019-003799
Application 14/530,914
Technology Center 3600

Before MICHAEL J. FITZPATRICK, WILLIAM A. CAPP, and
JILL D. HILL, *Administrative Patent Judges*.

HILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–10 and 12–19². Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

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 International Refills Company Ltd. Appeal Br. 2.

² Claim 11 was withdrawn from consideration.

BACKGROUND

Sole independent claim 1, reproduced below, illustrates the claimed invention, with certain limitations italicized:

1. A film-supporting device for use with a waste disposal unit comprising:
 - an annular body removably insertable in the waste-disposal unit and including an inner annular wall delimiting a central opening of the annular body, an outer annular wall, a bottom horizontal wall at a bottom end of the annular body to form a cavity in the annular body, outlines of each of the central opening and the outer annular wall in a transverse plane of the device having variable diametrical dimensions with a first diameter being of greater dimension than a second diameter, *the outlines each having, in the transverse plane of the device, at least two of the first diameter of generally equal dimension and at least two of the second diameter of generally equal dimension, with the first diameter being the maximum diameter of the outline in the transverse plane, and with the second diameter being the minimum diameter of the outline in the transverse plane, a central perimeter of the cavity defined between the outlines in the transverse plane being greater than a central perimeter of a similarly-defined cavity of a circular film-supporting device, where a circular outer annular wall and a circular central opening of the circular film-supporting device each have a constant diameter respectively equal to said minimum diameter of each said outline in the transverse plane;* and
 - tubular film accumulated in the cavity between the inner annular wall and the outer annular wall, with a free annular end dispensed outwardly from the inner annular wall, the free annular end being adapted to be closed to form a bag with an opening of the bag being accessible through the central opening, wherein a quantity of said tubular film in the cavity is greater than a quantity of tubular film in the cavity of the circular film-supporting device.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Chomik	US 2003/0218022 A1	Nov. 27, 2003
Gagnebin	US 2004/0206760 A1	Oct. 21, 2004
Alvarez	US 2006/0082085 A1	Apr. 20, 2006
Morand	US 2009/0100806 A1	Apr. 23, 2009
Stravitz	US 7,712,285 B2	May 11, 2010

REJECTIONS

I. Claims 1–8, 12, 13, 18, and 19 stand rejected under 35 U.S.C. § 103 as unpatentable over Morand '029 and Gagnebin. Final Act. 2.

II. Claim 9 stands rejected under 35 U.S.C. § 103 as unpatentable over Morand, Gagnebin, and Stravitz. Final Act. 7.

III. Claims 10, 14, and 15 stand rejected under 35 U.S.C. § 103 as unpatentable over Morand '029, Gagnebin, and Morand '806. Final Act. 8.

IV. Claim 16 stands rejected under 35 U.S.C. § 103 as unpatentable over Morand '029, Gagnebin, and Alvarez. Final Act. 9.

V. Claim 17 stands rejected under 35 U.S.C. § 103 as unpatentable over Morand '029, Gagnebin, and Chomik. Final Act. 9.

OPINION

The Examiner notes that the italicized language of claim 1, reproduced above, is understood to refer to cassette shapes having $A1 > A2$, which could include “super-ellipses, squircles, octagons, hexagons, and decagons since the minimum diameter would connect opposing sides of the polygons and the maximum diameter would connect opposing vertexes of the polygons.” Reply Br. 3; *see also* Spec. ¶39 (identifying super-ellipses, squircles, octagons, hexagons, and decagons). The Examiner finds that

Appellant's Specification discloses that the ability of the claimed invention "to support more film within the cassette is a function of the shape." *Id.* (citing ¶ 40).

Rejection I: Claims 1–8, 12, 13, 18, and 19

Regarding claim 1, the Examiner finds that Morand '029 discloses a waste disposal unit including the structure set forth in the recitations of claim 1, wherein "the cassette shape and shape of the opening is an oval (Col. 4, Lines 4-8) but other shapes of cassette are foreseen, such as circular cassettes (Col. 4, Lines 8-10) but does not disclose the outlines each having, in the transverse plane of the device" the claimed first and second diameters, the non-circular shape specifically defined in the claims, or the resulting greater tubular film quantity in the cavity. Final Act. 2–5.

The Examiner finds, however, that Gagnebin discloses a trash receptacle with a container 2 and an insert 21 that "can be shaped as cylindrical members or other cross-sectional configurations including various polygons, such as square, hexagon, pentagon," and contends that Gagnebin's hexagonal shape would meet "the specific limitations concerning the diameters as claimed." *Id.* at 6. According to the Examiner, "the hexagon would have at least two maximum diameters and at least two minimum diameters in the same manner as [Appellant's] hexagonal shape illustrated in Fig. 6c," and modifying Morand '029 to have Gagnebin's hexagonal shape "would produce a cassette having a greater quantity of tubular film support[ed] in the cavity than a similar circular film supporting device." *Id.* The Examiner concludes that this cassette shape modification would have been obvious because Morand '029 itself suggests considering alternate shapes, and Gagnebin discloses that "hexagonal and other

polygonal shapes are recognized alternative shapes for mating refuse bins and inserts.” *Id.* (citing Morand ’029, 4:8–10; Gagnebin ¶ 15).

The Examiner reasons that Appellant’s Specification discloses that it is the $A1 > A2$ outline, as recited in claim 1, that causes Appellant’s cassette to have “a greater amount of tubular film than cassettes without such outlines, for a same minimum axial dimension.” Ans. 11 (citing Spec. ¶ 40). Thus, per the Examiner, the modified device of Morand ’029, having a hexagonal shape as disclosed by Gagnebin, would have a $A1 > A2$ outline, and would therefore necessarily also “produce a cassette having a greater quantity of tubular film supporting in the cavity than a similar circular film supporting device.” *Id.*

Appellant argues claims 1–8, 12, 13, 18, and 19 as a group. Appeal Br. 8–11. We select independent claim 1 as representative. Claims 2–8, 12, 13, 18, and 19 stand or fall with claim 1.

Appellant does not challenge the Examiner’s findings regarding the disclosures of the prior art, instead arguing that the Examiner’s conclusion of obviousness contains error because “[t]here is no evidence or explanation in the record that would lead to the solution identified by the Office,” such that “[t]here are no rational underpinnings for the reason to combine the teaching of Morand [’029] and Gagnebin.” Appeal Br. 8.

According to Appellant, the mere existence of rounded cassettes and hexagonal garbage bins in the prior art does not make their combination obvious. *Id.* at 9. Appellant contends that Morand ’029 does not suggest the Examiner’s proposed combination because, while Morand ’029 states that “other shapes of cassette are foreseen,” the only other shape actually disclosed is a circle, which suggests that “the only shapes contemplated in

Morand are ‘rounded’ shapes (e.g. circular and oval), which do not satisfy the claimed outlines.” *Id.* In addition, Appellant argues, “some of the ‘alternate shapes’ disclosed in Gagnebin may not satisfy the claimed outlines.” *Id.* Thus, Appellant argues, Morand ’029 and Gagnebin are “not as suggestive to the person of ordinary skill in the art as the Office Action implies” and provide no evidence that would have led a person of ordinary skill to modify Morand’s cassette to have a hexagonal shape “over Gagnebin’s other shapes which may not satisfy the claimed outlines.” *Id.*

The Examiner responds that Gagnebin discloses each of the various shapes listed therein, “some which meet the claimed outlines (square, hexagon)” and “provides guidance to one of ordinary skill to choose any of the listed shapes and therefore since a hexagon is one of the listed shape[s],” Gagnebin guides a skilled artisan to select a hexagonal shape for container and liner walls. Ans. 10.

Appellant replies that the Examiner’s selection or “singl[ing] out” of a hexagonal shape from Gagnebin was guided by Appellant’s disclosure and therefore “results entirely from the impermissible use of hindsight. *See* Reply Br. 2–3.

Regarding hindsight, the Examiner responds that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning; but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Appellant’s disclosure, such a reconstruction is proper. Ans. 10 (citing *In re McLaughlin*, 443 F.2d 1392 (CCPA 1971)). The Examiner asserts that the rejection of claim 1 relies solely upon the disclosures of Morand ’029 and

Gagnebin, rather than Appellant's disclosure. Ans. 10, 12. For this reason, the impermissible hindsight was not used in rejecting claim 1.

The issue in the case is whether a claim reciting a combination of elements, each of which is disclosed in the prior art, is obvious. In such a case, "[i]f a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007). In *KSR*, the Supreme Court identified a number of exemplary rationales to support a conclusion of obviousness including, e.g., (1) the simple substitution of one known element for another to obtain predictable results. *See KSR*, 550 U.S. at 401, 417.

Here, the known elements are an oval or circular shape for a waste cassette as disclosed in Morand '029, and a hexagonal shape for a container/liner of a waste container as disclosed in Gagnebin. Substituting a hexagonal shape for an ovoid shape is properly considered a simple substitution that could be understood and performed by a skilled artisan. Further, Appellant has not apprised or persuaded us of any unpredictable results of such a simple substitution of shapes.

Regarding the result of substituting a hexagonal shape for a circular shape, Appellant argues that "[i]ncreasing or optimizing the film used in a cassette, . . . is not an issue contemplated in either Morand ['029] or Gagnebin." Appeal Br. 10. Appellant does not, however, argue that such optimization of film use is other than a predictable result of the Examiner's proposed shape substitution. There is no requirement that the prior art appreciate the benefit(s) set forth by Appellant to render the claim unpatentable. That the prior art suggested such shape substitutability is

enough to establish a rational basis for the Examiner's reasoning, lacking evidence of unexpected results of the substitution.

Appellant further argues that the Examiner "makes no attempt to explain why the person of ordinary skill would choose some of Gagnebin's polygonal shape[s] over Gagnebin's other shapes that may not satisfy the claimed outlines," and "[k]nowledge of different shapes alone is not a good enough reason to combine the teachings of the prior art." *Id.* at 11. This argument is not persuasive. That Gagnebin discloses a hexagonal shape is enough — neither Gagnebin nor the Examiner must identify specific advantages of selecting one of the many shapes disclosed by Gagnebin, or explain why such a shape is particularly suited for use in the device of Morand '029. That another combination of prior art features might be more advantageous/obvious is not evidence that the proposed combination is nonobvious. *See In re Mouttet*, 686 F.3d 1322, 1334 (Fed. Cir. 2012) ("just because better alternatives exist in the prior art does not mean that an inferior combination is inapt for obviousness purposes").

For the reasons explained above, we sustain the rejection of claim 1. Claims 2–8, 12, 13, 18, 19 fall with claim 1.

Rejections II–V: Claims 9, 10, and 14–17

Appellant makes no argument that claims 9, 10, and 14–17 would be patentable over the applied references if claim 1 is not patentable over Morand '029 and Gagnebin. For the reasons explained above in our analysis of Rejection I, we sustain Rejections II–V.

CONCLUSION

The Examiner's rejections are affirmed as to claims 1–10 and 12–19.

More specifically:

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1-8, 12, 13, 18, 19	103	Morand '029, Gagnebin	1-8, 12, 13, 18, 19	
9	103	Morand '029, Gagnebin, Stravitz	9	
10, 14, 15	103	Morand '029, Gagnebin, Morand '806	10, 14, 15	
16	103	Morand '029, Gagnebin, Alvarez	16	
17	103	Morand '029, Gagnebin, Chomik	17	
Overall Outcome			1-10, 12-19	

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