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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* JARED STEVEN FELIX and PAUL JAMES RUTHVEN

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Appeal 2019-004404  
Application 14/595,694  
Technology Center 3600

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Before CHARLES N. GREENHUT, WILLIAM A. CAPP, and  
MICHAEL L. WOODS, *Administrative Patent Judges*.

CAPP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant<sup>1</sup> seeks our review under 35 U.S.C. § 134(a) of the final rejection of claims 1, 5, 23, and 37–39 as unpatentable under 35 U.S.C. § 103 over Yamaura (JP 2000043960 A, pub. Feb. 15, 2000) and Hotchkiss (US 4,411,374, iss. Oct. 25, 1983) and claims 2–4 over Yamaura, Hotchkiss, and Hallam (US 2012/0223093 A1, pub. Sept. 6, 2012). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM and enter a NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).

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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(a). Appellant identifies GPCP IP Holdings LLC as the Applicant and real party in interest. Appeal Br. 2.

## THE INVENTION

Appellant's invention relates to dispensing systems for paper towels and the like. Spec. ¶¶ 102–03. Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A sheet product dispensing system, comprising:

a housing having one or more vertically stacked cartridges therein, each cartridge containing a plurality of individual sheet products for dispensing through a dispensing opening of the cartridge,

wherein the housing defines a load opening in a side panel or top end of the housing, the load opening being configured to receive the one or more cartridges therethrough,

wherein the housing defines a dispensing slot in a side panel or bottom end of the housing, the dispensing slot being configured to at least partially align with the dispensing opening of a bottommost cartridge of the one or more vertically stacked cartridges, such that the individual sheet products are accessible therethrough, and

wherein the cartridges are each formed of a flexible panel material, such that the cartridge does not maintain its shape when empty of sheet products so that an exhausted cartridge is removable from the housing via the dispensing slot.

## OPINION

### *Unpatentability of Claims 1, 5, 23, and 37–39 over Yamaura and Hotchkiss*

#### *Claim 1*

The Examiner finds that Yamaura discloses the invention substantially as claimed except for flexible cartridge materials, for which the Examiner relies on Hotchkiss. Final Action 5–6. The Examiner concludes that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use cartridges made of flexible materials in Yamaura. *Id.* at 6. According to the Examiner, a person of ordinary skill in

the art would have done this to reduce the cost of a replacement cartridge.  
*Id.*

Appellant argues that an advantage of the invention is that replacement cartridges may be loaded without any delay for removal of unused cartridges that may be vertically stacked above the exhausted cartridge. Appeal Br. 7. However, claim 1 may be satisfied by a dispensing system that only accommodates a single cartridge. Claims App. claim 1 (“a housing having one or more vertically stacked cartridges therein”). The “*or more*” language indicates an optional feature that does not limit the claim. *In re Johnston*, 435 F.3d 1381, 1384 (Fed. Cir. 2006) (“As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted”). Thus, Appellant’s argument is not commensurate with the scope of the claim.

Appellant next argues that Yamaura fails to provide any guidance as to how one would modify its dispenser to provide for dispensing from flexible cartridges. *Id.* at 8. This argument is not persuasive. Yamaura discloses a dispensing system for tissue paper boxes. Yamaura, Abstract; Figs. 1–8. A person of ordinary skill in the art would understand that tissue boxes are loaded into the top of Yamaura’s dispenser, after which tissues are eventually dispensed through slot 6. *Id.* Gravity would operate on a soft-sided cartridge to lower it into the dispensing position in much the same way that a typical tissue box would be lowered into the dispensing position. The path traveled by the cartridges is, more-or-less, a straight line and the distance traveled by the cartridges is only about 2 cartridge widths. *Id.* Fig. 6. We are not apprised of any technological challenges that would be encountered if Yamaura’s dispenser is loaded with soft-sided cartridges

instead of more rigid, for example, paperboard cartridges. Essentially, all an operator needs to do is place a cartridge above the opening on the top of the dispenser and then let go of it so that it can fall, by gravity, into position. Appellant provides neither evidence nor persuasive technical reasoning as to why a person of ordinary skill in the art would need additional guidance to make and use a Yamaura dispenser with a soft-sided cartridge.

Next, Appellant argues that Hotchkiss teaches that its cartridge is removed through a side opening. Appeal Br. 10. In response, the Examiner points out that Hotchkiss' cartridge is capable of being removed through the dispenser opening. Ans. 8.

We note that the claim at issue is an apparatus claim, not a method claim. Claims App. It is well settled that where all the structural elements of a claim exist in a prior art product, and that prior art product is capable of satisfying all functional or intended use limitations, the claimed invention is nothing more than an unpatentable new use for an old product. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). The claim limitation at issue here is “removable” or, in other words, that the cartridge is capable of being removed from the housing via the dispensing slot. Claims App. Thus, our focus here is not on whether Hotchkiss teaches the use of a side opening but rather whether Hotchkiss's cartridge is capable of being removed from the dispenser of Yamaura via the dispensing slot.

Appellant next argues that Hotchkiss teaches cartridges that are too rigid to be removed through a dispenser opening. Appeal Br. 11. Appellant argues that the cartridges are necessarily rigid to prevent collapse. *Id.* According to Appellant: “Hotchkiss's reinforcing plastic strut prevents removal of an exhausted cartridge through its dispensing slot.” *Id.* In

response, the Examiner points out that the strut of Hotchkiss only prevents collapse until the last tissue is removed. Ans. 9.

In Hotchkiss, a stack of tissues is dispensed through perforated opening 14 in film overwrap 16. Hotchkiss, Fig. 2, col. 4, ll. 28–38. The tissue is further threaded through dispensing slot 18 in a face plate of dispenser cabinet 20. *Id.* The front face of the overwrap is maintained at the front side of the cabinet by tensile forces attributable to the interaction between curled edges of the tissues and plastic overwrap protruding through dispensing slot 18. *Id.* col. 6, l. 5 – col. 7, l. 8. According to Hotchkiss:

Backface 16b of package 16 includes I-shaped, plastic strut 30 formed by sealed seam 23 best seen in FIG. 3e extending the length of the package and two side seals 24--24 extending the width of the package. Strut 30 provides structural strength to the backface of the package which prevents the backface of package 16 from collapsing. Strut 30 cooperatively interacts with the compressive forces originating from the truncated hip roof shape front face to provide a structure which extends away from slot 18 of the dispensing cabinet and which maintains the clip upright and steady until the last tissue is removed.

*Id.* col. 5, ll. 15–27.

As the clip becomes depleted the sealed seam 23 and the sealed ends 24--24 forming the I-shape, plastic strut 30 in the walls of the back face 16b of the overwrap package provides structural strength to the back half of the package which prevents the plastic from collapsing, and causing the plastic walls to sag, hindering the dispensing of the interleaved tissues. It is believed the I-shape strut 30 also has the unusual effect of aiding in keeping the nearly depleted clip from collapsing since the clip remains upright and steady until the last tissue is removed from package 16.

*Id.* col. 7, ll. 9–20; *see also* Figs. 3a–f, 4a–d. The foregoing passages and referenced Figures of Hotchkiss support, by a preponderance of the

evidence, the Examiner's findings of fact that Hotchkiss's cartridge, once it is exhausted, is sufficiently collapsed, or at least collapsible, that it can be removed through dispensing slot 18 of cabinet 20.

In reaching our determination, it bears mention that Appellant provides little or no teaching disclosure regarding the composition and structure of the material panels that comprise the claimed cartridge. Appellant merely makes passing mention of the fact that cartridges are formed of a "flexible panel material" so that an empty cartridge may be removed in the same manner in which the sheet products are dispensed. Spec. ¶¶ 146, 170, 194. Appellant also mentions that flexible panel materials may be composed of a polymer film such as low density polyethylene. *Id.* ¶ 146. There is no additional detailed teaching disclosure about how to make the panel material sufficiently rigid so that the cartridge maintains its shape until it is empty and then becomes sufficiently flexible so that the cartridge may be removed through the dispenser opening. The most reasonable conclusion to draw from such a lack of teaching disclosure is that Appellant, in drafting the Specification, understood that such was a matter that was already well within the ambit of ordinary skill, as specifically found by the Examiner. Final Action 7; *see also Streck, Inc. v. Research & Diagnostic Sys., Inc.*, 665 F.3d 1269, 1288 (Fed. Cir. 2012) (explaining that a patent need not teach, and preferably omits, what is well known in the art).

We sustain the Examiner's unpatentability rejection of claim 1.

*Claims 5, 23, and 39*

Appellant does not argue for the separate patentability of claims 5, 23, and 39 apart from arguments presented with respect to claim 1, which we have previously considered. We sustain the Examiner's rejection of

claims 5, 23, and 39. *See* 37 C.F.R. § 41.37(c)(1)(iv) (failure to separately argue claims constitutes a waiver of arguments for separate patentability).

*Claim 37*

Claim 37 depends from claim 1 and adds the limitation: “wherein the housing is closed other than the load opening and the dispensing slot.”

Claims App. The Examiner finds that Yamaura’s Figure 7 discloses the closed housing. Final Action 8.

Appellant disagrees, and argues that Yamaura, in addition to having a load opening and a dispensing slot, also has an opening for advancing a spent cartridge and another opening provides an exit path for the spent cartridge. Appeal Br. 16. We have reviewed Figures 1, 4, 5, 7, and 8 of Yamaura and agree with Appellant that Yamaura’s housing is not closed on all six sides except for two openings. Yamaura, Figs. 1, 4, 5, 7, and 8.

Nevertheless, it would have been obvious to modify Yamaura’s housing to arrive at the claimed housing. The additional two openings identified by Appellant are utilized for removing an empty, exhausted cartridge from Yamaura’s housing. *Id.* The Examiner’s proposed modification of Yamaura provides for an empty, flexible cartridge to be removed through the dispenser opening, thereby obviating any need for the additional openings. Final Action 5–7.

It is well settled that merely omitting an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 311 F.2d 581, 584 (CCPA 1963). Thus, the fact that Appellant’s claim dispenses with the two additional, but otherwise unnecessary, openings does not impart patentability to Appellant’s invention.

Consequently, we sustain the Examiner's unpatentability rejection of claim 37. However, inasmuch as our reasoning departs somewhat from that of the Examiner, we designate our affirmance as a NEW GROUND OF REJECTION so as to provide Appellant with an opportunity to react to the thrust of the rejection. *See In re Biedermann*, 733 F.3d 329, 337 (Fed. Cir. 2013) (explaining that an applicant is entitled to a fair opportunity to react to the thrust of a rejection).

*Claim 38*

Claim 38 depends from claim 1 and adds the limitations:

wherein

each cartridge comprises a pair of opposed rectangular side panels that lie in planes perpendicular to a plane in which the panel in which the dispensing opening of the cartridge is disposed, and

each of the opposed rectangular side panels comprises a flat panel surface.

Claims App.

Appellant argues that Hotchkiss features protruding seals 24 on each side of its cartridge and, therefore, the cartridge does not have "flat" panel surfaces as claimed. Appeal Br. 18.

Appellant's argument is not persuasive. During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Under the broadest reasonable interpretation standard, claim terms are given their ordinary and customary meaning as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249,

1257 (Fed. Cir. 2007). In the instant case, we are dealing with the packaging art. Appellant’s Specification teaches that:

In one embodiment, at least two of the material panels are formed from a unitary material sheet that is folded to form distinct panels about the surfaces of the stack of sheet products. In certain embodiments, as shown in FIG. 8, each of the plurality of material panels 810, 820, 830, 840, 850, 860 is formed from a unitary material sheet that is foldable to form the cartridge 800. In other embodiments, the plurality of material panels includes at least two distinct material panels that are associated or connected to form the cartridge.

Spec. ¶ 142, Fig. 8. Thus, a person of ordinary skill in the art would have understood that packages are routinely made by starting with a flat piece of material (sometimes referred to as a blank) and then folding, bending, or wrapping that flat piece of material to form an enclosure. *Id.* Completion of the packaging enclosure frequently entails overlapping material at or near their edges to form a joint, seam, or seal which edges are joined such as by adhesive, heat sealing, etc. A person of ordinary skill in the art would understand that *de minimis* departures from a perfectly flat surface in order to accommodate joints, seams, and seals would nevertheless fall within the scope of “flat panel surface” as it is used in claim 38.

We sustain the Examiner’s unpatentability rejection of claim 38.

*Unpatentability of Claims 2–4  
over Yamaura, Hotchkiss, and Hallam*

Claim 2 depends from claim 1 and adds the limitation: “wherein the dispensing slot is sized such that a detachable area of the cartridge is removable therethrough, to form the dispensing opening of the cartridge,” for which the Examiner relies on Hallam. Claims App.; Final Action 10–11. Appellant’s brief fails to comply with our rules regarding arguing claims

under separate subheadings. *See* 37 C.F.R. § 41.37(c)(1)(iv) (“any claim(s) argued separately . . . shall be argued under a separate subheading that identifies the claim(s) by number”). As near as we are able to determine, Appellant appears to devote pages 13–16 of the Appeal Brief to arguments for claim 2.

Appellant traverses the rejection by arguing that Hallam discloses a cartridge, not a housing of a dispenser as claimed. Appeal Br. 14. In response, the Examiner finds that Hallam discloses a cartridge (20) that is inserted into a dispenser (50). Ans. 10. The Examiner further notes that upon removal of surfboard (54) from dispenser housing (5), a dispensing slot is created. *Id.* The Examiner further finds that detachable area (34) is removed through the dispensing slot in housing (50). *Id.*

With reference to Figures 6 and 7 thereof, Hallam teaches the following:

The operation of the carton 10 will now be discussed with reference to FIGS. 6 and 7. In one embodiment the carton 10 is opened by removing the surfboard 54 which is defined by a line of weakness 56, such as a line of perforations or the like. Preferably the surfboard 54 has a finger tab 57 to facilitate removal. Removal of the surfboard 54 forms a carton opening 51 and exposes the overwrapped package 20 of compressed tissues, which may contain, in a preferred embodiment, from about 50 to about 200 tissues. The user opens the overwrapped package 20 by grasping the finger tab 34 and removing the tear strip 30, which separates along the lines of weakness 32 to form a dispensing opening in the overwrap through which tissues may be dispensed.

Hallam ¶ 33. Appellant’s effort to characterize element 10 of Hallam as something other than a dispenser is off the mark. Appeal Br. 14. It is well settled that a reference need not satisfy an *ipsissimis verbis* test. *In re*

*Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009). For purposes of the instant rejection, particularly in light of what Yamaura and Hotchkiss already teach, overwrapped package of compressed tissues 20 of Hallam may be considered reasonably to correspond to Appellant's cartridge and Hallam's carton 10 may be considered reasonably to correspond to Appellant's housing. Hallam, Fig. 6. The Examiner's finding that Hallam's detachable area is removable through a dispensing slot that is sized to accommodate such removal is supported by the record before us. *Id.* ¶ 33, Fig 6.

Appellant argues that person of ordinary skill in the art would not have been motivated to modify Yamaura and Hotchkiss by the teachings of Hallam. Appeal Br. 15–16.

Hallam's teachings regarding fully enclosed, rigid cartridges having a detachable surfboard do not provide any teaching relevant to the housing of Yamaura and the cartridges of Hotchkiss. A person of ordinary skill in the art would not have had any reason to modify the references in the way proposed by the Examiner, absent improper hindsight reconstruction based on Appellant's claims and application.

*Id.*

In the final rejection, the Examiner states that a person of ordinary skill in the art would have modified the prior art as proposed because the detachable panel could be removed while the cartridge resides in the dispenser. Final Action 10–11. As we understand the Examiner's reasoning, a plurality of tissue cartridges, each with a removable surfboard as taught by Hallam, could be stored in Yamaura's dispenser, but the surfboard need not be removed until previously used, exhausted cartridges are removed, and the replacement cartridge stacked vertically in the dispenser (Yamaura, top two element 10's in Figure 6) drops into alignment

with dispenser opening 6. *See* Yamaura, Fig. 6. A common sense, obvious advantage to this would be to maintain the tissues in a more sanitary condition until they are needed. The Examiner’s reasoning is sufficient to support the rejection. *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (requiring an obviousness conclusion to be based on explicit articulated reasoning with rational underpinning) cited with approval in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

We sustain the Examiner’s unpatentability rejection of claim 2.

*Claims 3 and 4*

These claims are not separately argued and fall with claim 2. 37 C.F.R. § 41.37(c)(1)(iv).

CONCLUSION

In summary:

<b>Claims Rejected</b>	<b>§</b>	<b>Reference(s)</b>	<b>Aff’d</b>	<b>Rev’d</b>	<b>New Ground</b>
1, 5, 23, 37-39	103	Yamaura, Hotchkiss	1, 5, 23, 37-39		37
2-4	103	Yamaura, Hotchkiss, Hallam	2-4		
<b>Overall Outcome</b>			1-5, 23, 37-39		37

TIME PERIOD FOR RESPONSE

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

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37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. . . .

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

AFFIRMED; 37 C.F.R. 41.50(b)