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NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			CHOI, PETER Y	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte FRANCOIS TOUBEAU and GILLES VETTER

Appeal 2020-000389
Application 14/773,778
Technology Center 1700

Before BEVERLY A. FRANKLIN, N. WHITNEY WILSON, and
SHELDON M. McGEE, *Administrative Patent Judges*.

FRANKLIN, *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 1–6 and 16–28. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as Ahlstrom-Munksjö Oyj. Appeal Br. 3.

CLAIMED SUBJECT MATTER

Claim 1 is illustrative of Appellant's subject matter on appeal and is set forth below:

1. A fibrous substrate comprising, by dry weight compared to the weight of the substrate,
 - a) between 39.9 and 87.9% natural fibers refined to between 50 and 95 °SR;
 - b) between 12 and 60% nanofibrillar polysaccharide having a diameter or thickness between 5 and 100 nanometers, and a length less than 1 micrometer;
 - c) between 0.1 and 4 % of at least one retention agent;and
 - d) less than 10% ash content; wherein a ratio between a thickness of the substrate, expressed in micrometers, and a weight per unit of surface area of the substrate, expressed in grams per square meter, is less than $1.4 \mu\text{m}/(\text{g}/\text{m}^2)$.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Kress	US 1,633,787	June 28, 1927
Marx	US 5,203,491	Apr. 20, 1993
Mora	US 5,387,319	Feb. 7, 1995
Laleg	US 2012/0080156 A1	Apr. 5, 2012
Laine	WO 2010/125247 A2	Nov. 4, 2010

REJECTIONS

1. Claim 27 is rejected under 35 U.S.C. § 112(a) as failing to comply with the enablement requirement.

2. Claims 1–6, 16, and 18–28 are rejected under 35 U.S.C. § 103 as being unpatentable over Laleg in view Laine and Mora.

3. Claims 16 and 20–24 are rejected under 35 U.S.C. § 103 as being unpatentable over Laleg in view of Laine and Mora, and further in view of Kress.

4. Claims 17 and 21–24 are rejected under 35 U.S.C. § 103 as being unpatentable over Laleg in view of Laine and Mora, and further in view of Marx.

OPINION

Upon consideration of the evidence and each of the respective positions set forth by each party, we find that the preponderance of evidence supports Appellant’s position in the record. We thus reverse the Examiner’s decision to reject the appealed claims for the reasons provided by Appellant in the Appeal Brief and Reply Brief, and add the following for emphasis.

Rejection 1

Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement is whether the experimentation needed to practice the invention is undue or unreasonable. *See In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the

enablement requirement and whether any necessary experimentation is “undue.” These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

Id.

Appellant argues that the enablement rejection does not apply the Wands factors. Appeal Br. 6. Reply Br. 3. The Examiner does discuss certain examples in the Specification (Final Act. 2–3), but this is not sufficient to reach a conclusion of non-enablement. It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The Examiner’s analysis must consider all the evidence related to each of these factors, and any conclusion of non-enablement must be based on the evidence as a

whole. *See Wands*, 858 F.2d at 740 (“Considering *all* of the factors, we conclude that it would not require undue experimentation to obtain antibodies needed to practice the claimed invention.” (emphasis added)). We thus reverse Rejection 1 on this basis.

Rejections 2–4

We agree with Appellant that the Examiner misapprehends the teachings of Laleg for the reasons stated on page 14 of the Appeal Brief and on pages 8–11 of the Reply Brief. Therein, Appellant states, *inter alia*, that Laleg specifically instructs persons having ordinary skill in the art that the super-filled sheet papers (of the kind of his disclosure) have low density, with specific densities ranging between 0.5–0.7g/cm³ (which converts to bulk values of from 1.43–2.0, and this conversion is not disputed by the Examiner in the record). Laleg, ¶ 8. Based upon this teaching, Appellant states that Laleg does not teach or suggest bulk values of < 1.4 as required by Appellant’s claims. Appellant states that, rather, a person having ordinary skill in the art would understand that Laleg teaches the opposite, bulk values > 1.43, *e.g.*, as noted in the general description found in ¶ 8 of Laleg, and as confirmed in Tables 2c and 2d.² Reply Br. 9.

On the other hand, the Examiner believes the aforementioned teaching in ¶ 8 of Laleg is merely establishing the state of the art, for the reasons

² Tables 2c and 2d of Laleg include “bulk” values. There is no dispute in the record that these bulk values are synonymous with the bulk values according to Appellant’s Specification in terms of what “bulk” means. Spec. ¶ [0027]. On page 7 of the Reply Brief, Appellant notes that the recited thickness/basis weight ratio is called “bulk”.

stated in the paragraph bridging pages 19–20 of the Answer. The Examiner refers to Laleg ¶ 55 (Ans. 21) which discusses “basis weight” ranges for the sheets—a separate parameter than “bulk”. *See* Laleg ¶ 7.

However, as stated by Appellant, Appellant’s understanding of Laleg’s teachings in ¶ 8 is confirmed by Tables 2c and 2d of Laleg. Appeal Br. 14. In response, the Examiner believes that the data in these tables are not the full scope of Laleg for the reasons stated on pages 18–19 of the Answer. However, the Examiner does not adequately explain why one would have been motivated to have modified Laleg to arrive at a bulk value of less than 1.4 when Laleg specifically teaches bulk values greater than 1.43.³ We add that the Examiner does not direct us to evidence in the record (*see* Answer *generally*) that the differences in the values between that taught in Laleg versus that claimed are not meaningful or that one skilled in the art would know to discard the limits set by Laleg, especially in light of Appellants’ position to the contrary. *In re Patel*, 566 Fed. Appx. 1005, 1010 (Fed. Cir. 2014) (nonprecedential) (“When differences clearly exist and there is no evidence that they are either not meaningful or one of skill in the art would know to discard the limits set by the prior art, proximity alone is not enough to establish a prima facie case of obviousness.”).

³ On pages 9–10 of the Answer, the Examiner alternatively states that it would have been obvious to have adjusted this ratio to within the claimed ratio to achieve a desired tensile strength. However, as mentioned *supra*, Laleg expressly teaches bulk values of greater than 1.43. The Examiner’s alternative theory fails because “the prior art does not teach that a broader range [of density] would be appropriate.” *In re Patel*, 566 Fed Appx. 1005, 1009 (Fed. Cir. 2014) (nonprecedential).

In view of the above, we reverse Rejections 2–4 (the additional references applied in Rejections 3 and 4 do not cure the deficiencies of the applied art of Rejection 2, discussed, *supra*).

CONCLUSION

We reverse the Examiner’s decision.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Reversed	Affirmed
27	112(a)	Enablement	27	
1–6, 16, 18–28	103	Laleg, Laine, Mora	1–6, 16, 18–28	
16, 20–24	103	Laleg, Laine, Mora, Kress	16, 20–24	
17, 21–24	103	Laleg, Laine, Mora, Marx	17, 21–24	
Overall Outcome			1–6, 16–28	

REVERSED