

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL Y. CHAN and PAUL F. TRAMONTINA

Appeal No. 2000-0606
Application No. 08/755,435

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, STAAB and
BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-19, which are all of the claims pending in this application.

BACKGROUND

The appellants' invention relates to a system for dispensing interfolded paper napkins. Claim 1 is illustrative of the invention and reads as follows:

1. An interfolded paper napkin dispensing system comprising:

an outer housing defining an interior space;

stacking means mounted within the outer housing for holding a stack of interfolded paper napkins within the interior space; and

a dispensing face defined in the outer housing proximate to an end of the stacking means, the dispensing face having a central portion projecting out from the dispenser and a dispensing throat located in the central portion, the dispensing throat comprising a slot portion having a length sufficient to permit an interfolded paper napkin to be pulled through by a user, but a relatively narrow width that prevents more than a few interfolded napkins from being pulled through the throat at one time, the dispensing throat further comprising a finger access portion to help a user grip and pull an interfolded napkin through the dispensing slot despite the relatively narrow width of the dispensing slot.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Winter et al. (Winter)	2,143,614	Jan. 10, 1939
Downham	3,203,586	Aug. 31, 1965

The following rejections are before us for review.

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- (1) Claims 1, 2, 10, 11 and 19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Downham.
- (2) Claims 5-9 and 14-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Downham.
- (3) Claims 3, 4, 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Downham in view of Winter.

Reference is made to the brief (Paper No. 11) and the final rejection and answer (Paper Nos. 7 and 12) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

We note, at the outset, that appellants' brief (page 6) groups the claims on appeal as follows: Group I (claim 1); Group II (claims 2, 3, 11 and 12); Group III (claims 4 and

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13); Group IV (claims 5-9 and 14-18) and Group V (claims 10 and 19). However, appellants have not argued the patentability of claims 2, 10, 11 and 19 separately from claim 1, claims 6-9 and 14-18 separately from claim 5 or claims 4, 12 and 13 apart from claim 3. Accordingly, we shall decide the appeal of rejection (1) on the basis of claim 1, with claims 2, 10, 11 and 19 standing or falling with representative claim 1, the appeal of rejection (2) on the basis of claim 5, with claims 6-9 and 14-18 standing or falling with representative claim 5 and the appeal of rejection (3) on the basis of claim 3, with claims 4, 12 and 13 standing or falling with representative claim 3. See In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978).

The anticipation rejection

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there

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must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

We understand the examiner's position to be that claim 1 reads on the Downham dispenser as follows. The Downham dispenser comprises an outer housing (cabinet formed of bottom 10, side walls 11 and dispensing front 12) defining an interior space; stacking means (adaptors 29 and 32) mounted within the outer housing for holding a stack of paper napkins within the interior space; and a dispensing face (front 12) defined in the outer housing proximate the stacking means, the dispensing face having a central portion and a dispensing throat (cut out 21) located in the central portion, the

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dispensing throat having a slot portion bounded by short side margins 26 and upper margin 23 and a finger access portion bounded by U-shaped lower margin 25.

As pointed out by appellants on page 8 of the brief, Downham discloses use of the dispensing device for dispensing non-interfolded napkins. Appellants argue, in essence, that Downham cannot anticipate the subject matter recited in claim 1 because (1) Downham lacks a slot portion of the dispensing throat having a relatively narrow width that prevents more than a few interfolded napkins from being pulled through the throat at one time; (2) neither the front cut out 21 nor the thumb recess 24 is a "finger access portion" as recited in the claim and (3) it is unclear to appellants how the Downham dispenser could successfully and reliably dispense interfolded napkins (i.e, the Downham dispenser cannot reasonably be considered an "interfolded paper napkin dispensing system" as claimed). See pages 7-10 of the brief.

The prior art reference need not expressly disclose each claimed element in order to anticipate the claimed invention. See Tyler Refrigeration v. Kysor Indus. Corp., 777 F.2d 687, 689, 227 USPQ 845, 846-847 (Fed. Cir. 1985). Rather, if a

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claimed element (or elements) is inherent in a prior art reference, then that element (or elements) is disclosed for purposes of finding anticipation. See Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631-33, 2 USPQ2d 1051, 1052-54 (Fed. Cir. 1987). Under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). For the reasons which follow, we are satisfied that there is reasonable basis to support the examiner's determination that the characteristics alleged by appellants to be absent from Downham are inherently possessed by the Downham dispenser so as to establish a prima facie case of anticipation.

As for the capability of the Downham dispenser to dispense interfolded napkins, we observe that appellants' specification does not expressly define the term "interfolded." On page 9 of the brief, appellants state that "a stack of interfolded napkins or sheets has alternating

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folded ends and free ends." The examiner does not explicitly contest this statement but points out on page 4 of the answer that "interfolded sheets or napkins can come in a variety of types of interfolds." In the absence of an express definition in appellants' specification, we interpret "interfolded" in accordance with its conventional usage¹ as folded together or inside one another.² We also note that appellants' claims are not limited to any particular type of interfolding or any particular napkin material, thickness, dimensions or surface characteristics. Furthermore, the claims do not specify any relationship between the dimensions of the napkins and the dimensions of the dispenser housing, slot or finger access portion.

¹ In proceedings before it, the PTO applies to the verbiage of claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). Moreover, absent an express definition in their specification, the fact that appellants can point to definitions or usages that conform to their interpretation does not make the PTO's definition unreasonable when the PTO can point to other sources that support its interpretation. Id., 127 F.3d at 1056, 44 USPQ2d at 1029.

² Webster's New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988).

From our perspective, even assuming the napkins stacked in Downham's device were interfolded as described on page 9 of appellants' brief with alternating top and bottom fold arrangements and the leading flap of each napkin being interfolded ahead of the trailing flap of the preceding napkin, the central region of the forwardmost of such napkins in the stack would still be caused to bulge into the space 36 by the support arrangement of the upper and lower adaptors 29, 32, as illustrated in Figure 3, thereby being accessible to the user's fingers/thumb for removal.³ Moreover, while the alternating fold pattern would not present a flap having an upper free end for each napkin in the stack as does the non-interfolded stack disclosed by Downham, the Downham dispenser is capable of dispensing a stack of appropriately sized interfolded napkins having leading and trailing flaps of adjacent napkins sufficiently tightly or securely interfolded in much the same manner described on page 7 of appellants'

³ While such gripping of the bulged portions of napkins having folds on top may not be as easy as gripping of a downwardly and forwardly disposed flap extending from a bottom fold as taught by Downham, it is not apparent to us why such gripping is not possible, especially given the similarity of the dispensing face of Downham's dispenser to the dispensing face of appellants' disclosed dispenser.

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specification. Specifically, as the user grasps the forwardmost napkin and withdraws it through the cut out 21, the leading flap of the next napkin will be pulled toward or into the cut out 21 for subsequent grasping by the user. We see nothing in the tilt of the Downham dispenser opening or the non-uniform gripping pressure applied by the upper and lower adaptors (brief, page 10) which would prevent dispensing of napkins of an appropriate stack of interfolded napkins from Downham's dispenser, albeit perhaps not in accordance with the particular manner of operation contemplated by Downham.

As for the appellants' argument that the thumb recess 24 is not a finger access portion, the examiner does not contend that the thumb recess 24 responds to the "finger access portion" of the claim. The lower U-shaped margin 25 defines a portion of the cut out which has a larger width (the height dimension as illustrated in Figure 1) than the upper (slot) portion defined by short rounded side marginal portions 26 and upper margin 23. It is this lower portion of the cut out which the examiner asserts responds to the recited "finger access portion." We find no error in this determination.

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Turning next to the limitation that the slot portion have a relatively narrow width that prevents more than a few interfolded napkins from being pulled through the throat at one time, appellants' specification does not define what is meant by "a few."⁴ Further, appellants' claims do not specify any particular material properties, dimensions or thickness for the napkins. Given the breadth of this claim terminology, the slot portion of Downham's cut out 21 appears to us to be fully capable of preventing more than a few interfolded napkins from being pulled through the cut out at one time, especially if those napkins are relatively thick in relation to the slot portion width.

After the PTO establishes a prima facie case of anticipation based on inherency, the burden shifts to appellants to prove that the subject matter shown to be in the prior art does not possess the characteristics of the claimed invention. See In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986). In this instance, appellants

⁴ Webster's New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988) defines "few" as "not many; a small number."

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have not come forward with any evidence to satisfy that burden. Compare In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); In re Ludtke, 441 F.2d 660, 664, 169 USPQ 563, 566-67 (CCPA 1971). Appellants' mere argument on pages 7-10 of the brief is not evidence. See In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974)(attorney's arguments in a brief cannot take the place of evidence).

In light of the above, we shall sustain the examiner's rejection of representative claim 1, as well as claims 2, 10, 11 and 19 which fall therewith, as being anticipated by Downham.

The obviousness rejections

Claim 5 depends from claim 1 and further recites that the slot portion of the dispensing throat has a point of minimum width which is less than about 1.0 inches. Downham is silent with respect to the exact dimensions of the dispensing system or the dispensing cut out 21.

The following quotation from In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990), is applicable here:

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The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. [citations omitted] These cases have consistently held that in such a situation, the applicant must show that the particular range is *critical*, generally by showing that the claimed range achieves unexpected results relative to the prior art range.

See also Gardner v. TEC Sys., Inc., 725 F.2d 1338, 1349, 220 USPQ 777, 786 (Fed. Cir.), cert. denied, 469 U.S. 830 (1984) (obviousness determination affirmed because dimensional limitations in claims did not specify a device which performed and operated differently from the prior art; while the claimed device produced a different pressure profile, the complex array of variables which contribute to the pressure profile were not specified in the claim).

In this instance, appellants have not shown that the minimum width of the dispensing throat is critical. While it is apparent from appellants' specification (page 5), as well as from the language of the claim itself, that the width of the slot was selected with a view toward preventing more than a few interfolded napkins from being pulled through the throat at one time, it would appear to be the *relative* dimensions of the slot portion and the napkins (e.g., the ratio of the slot

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width to napkin thickness under compression), not the slot width per se, which is critical in limiting the number of napkins that can be pulled through the throat at one time. Claim 5 is directed to the dispensing system alone and not to the napkins in combination with the dispensing system and, further, does not specify the dimensions, thickness or compressibility of the napkins or the ratio of the slot portion width to napkin thickness. It is also worth repeating that appellants have not specified precisely what number of napkins constitutes "a few." In any event, appellants have provided no evidence showing that a dispensing throat slot portion minimum width of less than about 1.0 inches yields substantially different and unexpected results as compared with a minimum width of 1.0 inches or more. Accordingly, we conclude that appellants have not shown that the claimed range of minimum slot portion width is critical so as to patentably distinguish appellants' claimed invention from the Downham dispenser. Therefore, we shall sustain the examiner's rejection of representative claim 5, as well as claims 6-9 and 14-18 which fall therewith, as being unpatentable over Downham.

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Turning finally to rejection (3), representative claim 3 depends indirectly from claim 1 and further requires that the stacking means comprises a staging means proximate the dispensing throat and that the staging means comprises at least two curved bumpers and a number of ribs defined on the bumpers. The examiner's position, as expressed on page 4 of the final rejection, is that

[t]o have the curved bumpers 30 and 34 of Downham have a number of ribs on there [sic: their] surface to aid in arresting movement of the napkins as they approach the dispensing throat 21 would be obvious in view of the teaching of Winter et al. Note the ribs 19 and column 2 lines 35-52 of Winter et al.

Winter discloses a dispenser for interfolded paper towels having a bottom delivery opening. The ribs 19 alluded to by the examiner are reinforcement or friction means in the form of corrugations along the sides of the dispenser which act to support the stack of paper towels and take the weight of the stack off the lowermost sheet. We see nothing in the teachings of Winter which would have suggested to one of ordinary skill in the art at the time of appellants' invention provision of ribs on the upper adaptor 30 or the rounded lower portions 34 of shoulders 33 of the lower adaptor 32 of

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Downham. Accordingly, we cannot sustain the examiner's rejection of claim 3, or claims 4, 12 and 13 which also require two curved bumpers having ribs defined thereon.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-19 under 35 U.S.C. § 103 is affirmed as to claims 1, 2, 5-11 and 14-19 and reversed as to claims 3, 4, 12 and 13.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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Senior Administrative Patent Judge)	
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