

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 32

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte PETER B. RUSSO

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Appeal No. 2002-1643  
Application No. 09/140,700

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ON BRIEF

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Before ABRAMS, McQUADE, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 5, 7, 11, 13, 15, 16, 24 and 29. Claims 10, 17 to 19, 21 to 23 and 27 have been allowed. Claims 3, 4, 6, 8, 9, 12, 14, 20, 25, 26 and 28 have been canceled.

We REVERSE.

BACKGROUND

The appellant's invention relates to dispensers and containers for cleaning materials, particularly for wipers for use in cleaning surfaces, and to methods of using such wipers (specification, p. 2). A substantially correct copy of the claims under appeal is set forth in the appendix to the appellant's brief.<sup>1</sup>

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

Julius	4,185,754	Jan. 29, 1980
Murphy	4,570,820	Feb. 18, 1986
Jacobson	4,783,129	Nov. 8, 1988
Landis, II et al. (Landis)	5,467,893	Nov. 21, 1995
Palumbo et al. (Palumbo)	5,938,013	Aug. 17, 1999

Claims 1, 2, 5, 7, 13, 15 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Julius in view of Palumbo.

Claim 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Julius in view of Palumbo as applied to claim 7, and further in view of Landis.

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<sup>1</sup> In claims 1, 7 and 13, the phrase "naphtha and aromatic hydrocarbons" should read --naphtha, aromatic hydrocarbons--.

Claims 24 and 29 stand rejected under 35 U.S.C. § 103 as being unpatentable over Murphy in view of Jacobson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 29, mailed January 22, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 28, filed December 14, 2001) for the appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1, 2, 5, 7, 11, 13, 15, 16, 24 and 29 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

#### **Claims 1, 2, 5, 7, 11, 13, 15 and 16**

Independent claims 1, 7 and 13 read as follows:

1. An industrial cleaning device comprising  
a sheet material dispenser bag having at least one flexible sidewall,  
said side-wall comprising at least two layers, one made of metal and the  
other made of a flexible plastic material, said flexible plastic material forming the  
outside of said side wall,  
a strip of industrial cleaning sheets delineated from one another by lines  
of weakness, said strip being contained within said bag, and an industrial  
cleaning liquid absorbed into said sheets,  
said bag having an outlet fixture forming a restricted outlet opening  
through which said sheet material can be pulled with substantial resistance so as  
to allow a sheet extending through said outlet opening to be withdrawn and torn  
free from said strip when pulled out through said outlet opening,  
in which said strip is formed into a roll and said roll is flattened and has a  
hollow core hole from which said sheet material can be withdrawn longitudinally,  
said hole being aligned so as to exit towards said outlet opening,  
said industrial cleaning liquid containing a solvent selected from the group  
consisting of acetone, isopropyl alcohol, methyl propyl ketone and methyl ethyl  
ketone, naphtha, aromatic hydrocarbons and a mixture of two or more of the  
foregoing.

7. An industrial cleaning sheet dispenser comprising  
a bag with at least one flexible side-wall,  
said side-wall comprising at least three layers, one made of metal and the other two made of a flexible plastic material, said flexible plastic material forming the outside and inside layers of said side-wall,  
a roll of elongated industrial cleaning sheet material with sheets delineated from one another by lines of weakness, said roll being sealed within said bag,  
a reclosable restricted dispensing opening in said sidewall, and a removable cap on said dispensing opening  
in which said sheet material has a quantity of industrial cleaning liquid absorbed in it, the material of which said bag is made being substantially impervious to said cleaning liquid,  
said industrial cleaning liquid containing a solvent selected from the group consisting of acetone, isopropyl alcohol, methyl propyl keytone and methyl ethyl keytone, naphtha, aromatic hydrocarbons and a mixture of two or more of the foregoing.
  
13. A method of cleaning a surface, said method comprising the steps of  
(a) providing a bag with at least one flexible side-wall, said side-wall comprising at least two layers, one made of metal and the other made of a flexible plastic material, said flexible plastic material forming the outside of said side wall, said bag containing a flattened roll of industrial wiper sheets delineated from one another by means of lines of weakness, said bag having a reclosable outlet opening;  
(b) pulling one end of said strip out of said bag and tearing off one of said sheets from said strip and using' it for wiping said surface, said strip being pre-wetted with an industrial cleaning solvent, said cleaning solvent being selected from the group consisting of acetone, isopropyl alcohol, methyl propyl keytone and methyl ethyl keytone, naphtha, aromatic hydrocarbons and a mixture of two or more of the foregoing.

In the rejection of independent claims 1, 7 and 13 (answer, p. 3), the examiner (1) determined that the cleaning device and method thereof disclosed by Julius includes a sheet material dispenser bag 125 having at least one flexible side-wall comprising

three layers 180, 182, 184 made of plastic and metal material; the plastic material, forming an outside of the wall 182 and an inner wall 184; cleaning sheets 16 impregnated with any number of solvent based liquids (column 3, lines 55-63); an outlet opening 35 forming a restricted outlet and a reclosable snap-on cover 39 for the outlet opening; and the dispenser being small enough and capable of being secured to a user by being placed in a pocket of the user;

(2) ascertained that Julius does not disclose the wet sheets are in a flattened roll having a hollow core;

(3) determined that Palumbo discloses the broad teaching of providing a dispenser having flexible side walls with a flattened roll of impregnated sheets having a hollow core wherein sheets 13 are pulled through a restricted outlet opening 8; and

(4) concluded that it would have been obvious to one of ordinary skill in the art to provide the dispenser of Julius include a flattened roll of impregnated sheets to facilitate a less bulky dispensing package as taught by Palumbo.

The appellant argues (brief, pp. 6-14) that he "solvent limitation" set forth in independent claims 1, 7 and 13 (i.e., the industrial cleaning liquid containing a solvent selected from the group consisting of acetone, isopropyl alcohol, methyl propyl keytone and methyl ethyl keytone, naphtha, aromatic hydrocarbons and a mixture of two or

more of the foregoing) is not taught or suggested by the applied prior art (i.e., Julius and Palumbo).

The examiner's response (answer, pp. 5-6) to this argument by the appellant was that

a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

. . .  
In addition while the references do not recite the specific solvent additives as claimed it is notoriously well known that one or more of these additives are present in many cleaning solutions, soaps, and the like.

Independent claims 1, 7 and 13 clearly recite the "solvent limitation" as part of the claimed invention and not as the intended use of the claimed invention. As such, the examiner has not correctly ascertained the differences between the prior art and the claims at issue.<sup>2</sup> In that regard, based on our analysis and review of Julius and claims, 1, 7 and 13, it is our opinion that one difference is the above-noted "solvent limitation." Since the examiner has not set forth any rationale in the rejection of independent claims

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<sup>2</sup> After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

1, 7 and 13 before us in this appeal as to why it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have utilized an industrial cleaning liquid containing a solvent selected from the group consisting of acetone, isopropyl alcohol, methyl propyl keytone and methyl ethyl keytone, naphtha, aromatic hydrocarbons and a mixture of two or more of the foregoing to impregnate the towelettes in Julius' packet, a prima facie case of obviousness has not been established.<sup>3</sup>

Additionally, we do not agree with the position set forth by the examiner that the cases of In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and In re Otto, 312 F.2d 937, 136 USPQ 458 (CCPA 1963) support the proposition that in a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.

For the reasons set forth above, the decision of the examiner to reject independent claims 1, 7 and 13, and claims 2, 5, 11, 15 and 16 dependent thereon, under 35 U.S.C. § 103 is reversed.

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<sup>3</sup> While it may be well known in the art that one or more of the claimed solvents are present in many cleaning solutions, soaps, and the like, there is no basis in the applied prior art to impregnate the towelettes in Julius' packet with any of the claimed solvents. In addition, the appellant appears to admit (specification, p. 3; brief, pp. 4-5) that wipers impregnated with the claimed solvents are known in the art but not with a bag as set forth in the claims under appeal.

### Claims 24 and 29

Independent claim 24 reads as follows:

A cleaning device comprising  
a plastic bag having at least one side-wall,  
said side-wall comprising at least three layers, one made of metal and the  
other two made of a flexible plastic materials, said flexible plastic material  
forming the outside and inside of said side wall,  
a plurality of industrial cleaning wipers contained in said bag, said wipers  
being absorbent and having a cleaning liquid absorbed in them,  
said bag having an elongated opening and a slide fastener for closing said  
opening, said slide fastener being made of plastic strips sealed to the bag  
material at the edges of said opening, and a slider,  
the amount of said liquid being from an amount sufficient to moisten all of  
said wipers to an amount exceeding that needed to saturate all of said wipers,  
in which said liquid is selected from the group consisting of isopropyl  
alcohol, MPK, MEK, acetone, naphtha, aromatic hydrocarbons, said plastic  
materials being resistant to deterioration due to contact with said solvents.

In the rejection of independent claim 24 (answer, pp. 4-5), the examiner  
(1) determined that Murphy includes a plastic bag containing at least one and having a  
plurality of cleaning applicators (figure 4) which are absorbent and are saturated with  
cleaning liquid (column 1, lines 47-51); an elongated opening (13) in the bag; walls  
consisting of a laminate aluminum film having thermoplastic coating and the broad  
teaching of providing a polyethylene on the interior wall of the dispenser (column 3,  
lines 3-13); and a slide fastener made of continuous plastic strips (7,8);  
(2) ascertained that the dispenser disclosed by Murphy includes all the claimed features  
except the slide fastener does not include a slider;

(3) determined that Jacobson discloses a slider (82) for a slide fastener;

(4) concluded that it would have been obvious to one of ordinary skill in the art to provide a slider for the slide fastener in Murphy to provide a tighter seal of the continuous strips than that provided by applying side pressure manually as taught by Jacobson; and

(5) stated that with regard to the recitation of a number of solvents that the sheets may be impregnated with Murphy does not disclose the particular solvents, but does disclose the same wall structure of the dispensing pouch for which the appellant claims is suitable for housing sheets containing such solvents. The examiner further stated that if the appellant's claimed wall construction is capable of holding the claimed solvents, it naturally follows that the same wall construction disclosed by Murphy is capable of holding the solvents as well and since the structure disclosed by Murphy is fully capable of performing the appellant's intended use, it meets the claim.

The appellant argues (brief, pp. 17-19) that the "solvent limitation" set forth in independent claim 24 (i.e., the cleaning liquid absorbed in the wipers is selected from the group consisting of isopropyl alcohol, MPK, MEK, acetone, naphtha and aromatic hydrocarbons) is not taught or suggested by the applied prior art (i.e., Murphy and Jacobson).

The examiner's response (answer, p. 8) to this argument by the appellant was the same as set forth above with respect to claims 1, 7 and 13 (i.e., a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.).

Independent claim 24, just like independent claims 1, 7 and 13, clearly recites the "solvent limitation" as part of the claimed invention and not as the intended use of the claimed invention. As such, the examiner has not correctly ascertained the differences between the prior art and claim 24. In that regard, based on our analysis and review of Murphy and claim 24, it is our opinion that one difference is the above-noted "solvent limitation." Since the examiner has not set forth any rationale in the rejection of independent claim 24 before us in this appeal as to why it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have utilized a cleaning liquid selected from the group consisting of isopropyl alcohol, MPK, MEK, acetone, naphtha and aromatic hydrocarbons to impregnate the towels in Murphy's envelope, a prima facie case of obviousness has not been established.

For the reasons set forth above, the decision of the examiner to reject independent claims 24, and claim 29 dependent thereon, under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 5, 7, 11, 13, 15, 16, 24 and 29 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
JOHN P. McQUADE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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