THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH P. CRUZ

Appeal No. 1999-1505
Application No. 08/638,454[1]

ON BRIEF

Before MEISTER, STAAB, 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 12 through 19, which are all of the claims pending in this application.

We AFFIRM, REMAND and enter a new rejection pursuant to 37 CFR § 1.196(b).

[1] Application for patent filed April 26, 1996.

BACKGROUND

The appellant's invention relates to a hands-free paper towel dispenser. An understanding of the invention can be derived from a reading of exemplary claims 12 and 16, which appear in the appendix to the appellant's brief.

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

Anderson	4,771,966	Sep. 20, 1988
Tinker et al. (Tinker)	4,979,688	Dec. 25, 1990

In addition, the examiner also relied upon the admitted prior art discussed on pages 1-3 of the original disclosure (admitted prior art).

References made of record by this panel of the Board are:

Chakravorty	4,790,490	Dec. 13, 1988
Hawkins	4,796,825	Jan. 10, 1989
Bauer et al. (Bauer)	4,960,248	Oct. 2, 1990

Byrd et al. 5,772,291 June 30, 1998
(Byrd) (filed Feb. 16, 1996)

Claims 12 through 19 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 12 through 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over the admitted prior art in view of Tinker and Anderson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 9, mailed December 4, 1997) and the examiner's answer (Paper No. 18, mailed September 29, 1998) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 17, filed July 3, 1998) and reply brief (Paper No. 19, filed November 30, 1998) 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. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

We sustain the rejection of claims 12 through 19 under 35 U.S.C. § 112, second paragraph.

In the final rejection (pp. 2-3) and the answer (p. 3), the examiner set forth his rationale as to why claims 12 through 19 were indefinite.

The appellant has not specifically contested this rejection in the brief or reply brief. Accordingly, we summarily sustain the rejection of claims 12 through 19 under 35 U.S.C. § 112, second paragraph.

The obviousness rejection

We will not sustain the rejection of claims 12 through 19 under 35 U.S.C. § 103.

When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the appellant. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the appellant's structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the appellant's combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir.

1992); Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

In this case, we agree with the arguments set forth in the appellant's brief and reply brief that the applied prior art does not suggest the claimed subject matter. Specifically, it is our opinion that the applied prior art does not provide any motivation to have changed the admitted prior art's hands-on dispensing to be hands-free dispensing. In our view, the only suggestion for modifying the admitted prior art by the teachings of Tinker in the manner proposed by the examiner stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claims 12 through 19.

NEW GROUND OF REJECTION

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claims 12 through 19 stand rejected under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The written description requirement serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later

claimed by him; how the specification accomplishes this is not material." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976).

Claim 12 recites a housing having "an opening through said bottom surface, said opening being sufficiently narrow to permit the unused portion of said product within said housing to be protected from outside forces and remain in a usable condition." Claim 12 further recites "said opening being positioned through said front portion." Claim 16 recites making "an opening through the bottom front surface of said housing."

We have reviewed the originally filed disclosure and find no express disclosure for the above-noted limitations of claims 12 and 16. In addition to an express disclosure, the written description requirement can be satisfied by showing that the disclosed subject matter, when given its "necessary and only

reasonable construction," inherently (i.e., necessarily) satisfies the limitation in question. See Kennecott Corp. v. Kyocera Int'l, Inc., 835 F.2d 1419, 1423, 5 USPQ2d 1194, 1198 (Fed. Cir. 1987), cert. denied, 486 U.S. 1008 (1988). While there is an inherent disclosure that the housing has an opening permitting the product (i.e., paper towel) to be dispensed, there is nothing in the application to suggest that the opening be in the bottom front portion of the housing as set forth in the above-noted limitations from claims 12 and 16. In that regard, we note that a disclosure that merely renders the later-claimed invention obvious is not sufficient to meet the written description requirement; the disclosure must describe the claimed invention with all its limitations. See Tronzo v. Biomet Inc., 156 F.3d 1154, 1158-60, 47 USPQ2d 1829, 1832-34 (Fed. Cir. 1998); Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1571-72, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997); Vas-Cath Inc., 935 F.2d at 1563-1564, 19 USPQ2d at

1117; In re Winkhaus, 527 F.2d 637, 640, 188 USPQ 129, 131 (CCPA 1975); In re DiLeone, 436 F.2d 1404, 1405, 168 USPQ 592, 593 (CCPA 1971); In re Wohnsiedler, 315 F.2d 934, 937, 137 USPQ 336, 339 (CCPA 1963).

For the reasons set forth above, the disclosure in the application does not provide written description support for the above-noted limitations of the claims under appeal.[2]

REMAND

This application is remanded to the examiner for consideration of prior art and further search of the claimed subject matter as set forth below.

Since the claimed subject matter is directed to hands-free dispensing, the examiner should consider whether the claims are patentable under 35 U.S.C. § 103 over Chakravorty,

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[2] Likewise, it would appear that the proposed drawing corrections to Figures 1 and 4 (filed June 6, 1997) and the amendment to Page 6, line 5, (presented in Paper No. 4, filed June 6, 1997) contain new matter. The examiner should take appropriate steps to ensure that any new matter is removed from the specification and the drawings.

Hawkins, Bauer and Byrd when considered together with the other prior art.

The examiner's field of search as indicated on the filewrapper was limited to Class 242, WINDING, TENSIONING, OR GUIDING. The examiner's search did not include Class 225, SEVERING BY TEARING OR BREAKING,[3] or Class 312, SUPPORTS.[4] These classes appear to contain relevant subject and therefore a search therein would seem to be appropriate.

CONCLUSION

To summarize, the decision of the examiner to reject claims 12 through 19 under 35 U.S.C. § 112, second paragraph is affirmed; the decision of the examiner to reject claims 12 through 19 under 35 U.S.C. § 103 is reversed; a new rejection of claims 12 through 19 under 35 U.S.C. § 112, first paragraph, has been added pursuant to provisions of 37 CFR § 1.196(b); and the application has been remanded to the examiner for consideration of prior art and further search.

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[3] This class was searched in Chakravorty.

[4] This class was searched in Chakravorty, Bauer and Byrd.

Since at least one rejection of each of the appealed claims has been affirmed, the decision of the examiner is affirmed.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) and a remand pursuant to 37 CFR
§ 1.196(e).

37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(e) provides that

> Whenever a decision of the Board of Patent Appeals and Interferences includes or allows a remand, that decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

> (b) Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

37 CFR § 1.196(b) also provides that the appellant, <u>WITHIN TWO MONTHS FROM THE DATE OF THE DECISION</u>, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter

> reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

The effective date of the affirmance is deferred until conclusion of the proceedings before the examiner unless, as a mere incident to the limited proceedings, the affirmed rejection is overcome. If the proceedings before the examiner does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejections, including any timely request for rehearing thereof.

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

AFFIRMED; REMANDED; 37 CFR § 1.196(b)

JAMES M. MEISTER Administrative Patent Judge	)	
LAWRENCE J. STAAB Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)	

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APPEAL NO. 1999-1505 - JUDGE NASE
APPLICATION NO. 08/638,454

APJ NASE

APJ MEISTER

APJ STAAB

DECISION: **AFFIRMED, REMANDED & 37 CFR § 1.196(b)**

Prepared By: Gloria Henderson

DRAFT TYPED: 02 Jul 99

FINAL TYPED: