

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NICHOLAS A. DELFINO

Appeal No. 2004-1159
Application 10/108,315

ON BRIEF

Before COHEN, FRANKFORT, and NASE, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 11 through 13 and 21. Claims 1 through 10 and 14 through 20, all of the other claims pending in the application stand allowed.

As noted on page 1 of the specification, appellant's invention is directed to a narrow paper towel roll, having a width approximately one-half that of a conventional 11-inch wide

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paper towel roll, and to a method for supplying such a narrow paper towel roll together with a suitable holder, wherein the paper towel roll and holder are provided in a package for retail sale. Independent claims 11 and 21 are representative of the subject matter on appeal and a copy of those claims can be found in the Appendix to appellant's brief.

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

Monahan	3,160,361	Dec. 8, 1964
French et al. (French)	5,909,832	Jun. 8, 1999

Claim 11 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Monahan.

Claim 11 also stands rejected under 35 U.S.C. § 102(b) as being anticipated by French.

Claims 12, 13 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Monahan.

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Rather than attempt to reiterate the examiner's full commentary with respect to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding the rejections, we make reference to the examiner's answer (Paper No. 14, mailed October 9, 2003) for the reasoning in support of the rejections, and to appellant's brief (Paper No. 11, filed June 20, 2003), Supplemental Remarks contained in Paper No. 12 (filed June 26, 2003) and reply brief (Paper No. 15, filed November 25, 2003) for the comments and arguments thereagainst.

OPINION

Having carefully reviewed the anticipation and obviousness issues raised in this appeal in light of the record before us, we have come to the conclusion that the examiner's rejection of claim 11 under 35 U.S.C. § 102(b) based on French will be sustained, while that based on Monahan will not be sustained. The examiner's rejection of claims 12, 13 and 21 under 35 U.S.C.

§ 103(a) as being unpatentable over Monahan, will also not be sustained. Our reasoning in support of these determinations follows.

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In responding to the examiner's rejection of independent claim 11 under 35 U.S.C. § 102(b) based on Monahan, appellant contends that Monahan discloses only a holder or rack (R) for a conventional paper towel roll (T), and fails to provide any disclosure or teaching of a "package for retail sale" as set forth in claim 11 on appeal. The examiner expresses the view (answer, page 6) that the language "for retail sale" is merely intended use and that Monahan clearly teaches a "package" since the rack and paper towel roll have been combined into a single unit, which the examiner apparently views as being accepted or rejected as a single unit. We do not agree. Like appellant, it is our opinion that one of ordinary skill in the art would not reasonably view the rack and roll of paper toweling associated therewith as shown in Figure 1 of Monahan as being a "package for retail sale." In that regard, we generally share appellant's views as expressed in the brief (pages 3-4) and reply brief (pages 1-3).

Before the USPTO, when evaluating claim language during examination of a patent application, the examiner is required to give the terminology of the claims its broadest reasonable interpretation consistent with the specification, and to remember

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that the claim language cannot be read in a vacuum, but instead must be read in light of the specification as it would be interpreted by one of ordinary skill in the pertinent art. See In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); In re Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) and In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). Looking to the package for retail sale seen in Figure 4 of the present application and to the disclosure associated therewith (specification, page 7), it is clear to us that the examiner in formulating the present rejection has dissected the claim language, read the claim language "package for retail sale" in a vacuum, and clearly not read such language in light of the specification as it would be understood and interpreted by one of ordinary skill in the pertinent art.

In light of the foregoing, we will not sustain the examiner's rejection of claim 11 under 35 U.S.C. § 102(b) as being anticipated by Monahan.

As for the examiner's rejection of claim 11 under 35 U.S.C. § 102(b) as being anticipated by French, we share the examiner's view that the vehicle cleaning kit (10) containing the items seen

in Figures 1-3 of that patent would have been reasonably viewed by one of ordinary skill in the art as being a "package for retail sale." In that regard, we consider that the housing (12) and securable housing lid (26) of French provide a container or package for the paper towel holder (30) and roll of paper towels (39), as well as for the other accessory items contained in the cleaning kit and carried in the closed and secured housing (note, col. 4, lines 20-28). We see no need for the container/package of French to be further boxed or wrapped in order to permit retail sale thereof. Moreover, contrary to appellant's assertion in the paragraph bridging pages 4 and 5 of the brief, we find that the arm portions (32, 34) of French's paper towel holder (30) are clearly "movable into positions extending along opposite ends of said paper towel roll," as set forth in claim 11, and are resiliently and releasably engageable with the ends of paper towel roll (39) via roll support plugs (unnumbered) shown in Figure 1.

For the above reasons, we will sustain the examiner's rejection of independent claim 11 under 35 U.S.C. § 102(b) as being anticipated by French.

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In rejecting claims 12, 13 and 21 under 35 U.S.C. § 103(a) based on Monahan, the examiner has expressed the following views on page 5 of the answer:

With respect to Claims 13 and 21, Monahan is advanced above. Monahan, column 3, lines 30-32, mention the length of the holder which above that being claimed. However, it would have been obvious, as determined through routine experimentation and optimization, to dimension the roll holder of Monahan because one of ordinary skill would have been expected to have routinely experimented to determine the optimum dimensions for a particular use. For example, one would select a narrower roll for the purpose of saving space and/or saving paper.

With respect to Claim 12, Monahan does not mention a plurality of rolls. However, it would have been obvious to one of ordinary skill in the art to provide a plurality because it has been held that mere duplication of the essential parts of a device involve only routine skill in the art. Such plurality would allow for the ease of refilling or replacing the roll.

We will not sustain this rejection. Claims 12 and 13 depend from independent claim 11, and are thus also directed to a "package for retail sale." Since we have determined above that Monahan provides no disclosure or teaching of a package for retail sale, and since it is apparent that the examiner's reasons for rejecting claims 12 and 13 do not otherwise account for this limitation, it follows that the rejection of dependent claims 12 and 13 will also not be sustained.

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As for independent claim 21, which is directed to a roll of paper towels having, *inter alia*, "a width of 12.7 to 15.24 centimeters (5 to 6 inches)," suffice it to say that the examiner's above-noted position represents a clear case of hindsight reconstruction, since the applied patent to Monahan provides no teaching or suggestion whatsoever of modifying the paper towel rack therein to be of any size other than that necessary to accommodate a conventional roll of paper towels (see, col. 3, lines 28-37 of Monahan). In that regard, we observe that the mere fact that the prior art could be modified in the manner urged by the examiner would not have made such modification obvious unless the prior art suggested the desirability of the modification. See In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) and In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992).

In this case, it is our opinion that the examiner has impermissibly drawn from appellant's own teaching in concluding, without any factual basis in the applied prior art, that it would have been obvious to one of ordinary skill in the art to have

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routinely experimented to determine optimum dimensions of the paper towel roll and holder of Monahan for some particular use.

Since we have determined that the teachings and suggestions that would have been fairly derived from Monahan would not have made the subject matter as a whole of claim 21 on appeal obvious to one of ordinary skill in the art at the time of appellant's invention, we must refuse to sustain the examiner's rejection of that claim under 35 U.S.C. § 103(a).

To summarize, we have refused to sustain the examiner's rejection of claim 11 under 35 U.S.C. § 102(b) based on Monahan and the rejection of claims 12, 13 and 21 under 35 U.S.C. § 103(a) based on Monahan. However, we have sustained the examiner's rejection of claim 11 under 35 U.S.C. § 102(b) based on French. Thus, the examiner's decision is affirmed-in-part.

In addition to the foregoing, we REMAND this application to the examiner under 37 CFR § 41.50(a) for 1) a more complete search of the prior art and 2) consideration of a rejection of claim 21 under 35 U.S.C. § 103(a) based on U.S. Patent No.

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4,097,002 to John H. Krueger, which patent was cited by appellant in an Information Disclosure Statement filed March 28, 2002 (Paper No. 3).

In regard to a further search, we note that during examination of an application for patent, the examiner is charged with the responsibility of conducting a thorough search of the prior art, which search should cover the invention as described and claimed, including the inventive concepts toward which the claims are directed. For the present application, the inventive concept involved in independent claim 11 deals with promotional packaging where a product and a refillable holder/dispenser for that product are included together in a "package for retail sale." This type of tying arrangement between a replaceable product and a holder/dispenser is not new in the art of commercial retailing. One example that come to mind from many years ago is where Dixie® cups and a plastic holder/dispenser for the cups were packaged together for retail sale. Another example is where PEZ® candy and a refillable holder/dispenser for such candy are marketed together in a package for retail sale. The examiner should make an appropriate search of arts addressing

such promotional packaging and consider applying any teachings derived therefrom to appellant's paper towel roll and holder package set forth in claim 11 on appeal. As for the inventive concept involved in independent claim 21, this claim essentially addresses a roll of paper towels that is approximately one-half the width of a conventional roll of paper towels. We suggest that the examiner may wish to search prior art concerning children's play kitchens, where all aspects of the play kitchen have been downsized to accommodate the play of small children, perhaps even to the extent of having a small sized roll of paper towels used in such a play kitchen.

With regard to claim 21, we also direct the examiner's attention to U.S. Patent No. 4,097,002 to John H. Krueger. More specifically, we note Figure 2 of that patent and the disclosure associated therewith (e.g., col. 1, lines 10-20 and lines 34-39, col. 2, lines 62-68 and patent claim 3) concerning a roll of paper towels (64) that is constructed so as to be separated into smaller sections widthwise by having at least one continuous longitudinal score line provided in the toweling and core (68), whereby a separated discrete section of the roll of paper towels

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can then be used in the patentee's adjustable length holder/dispenser (10). If the roll of paper towels in the Krueger patent were of a conventional size (i.e., approximately 11 inches in width), then a single score line down the middle of the roll of toweling would appear to result in two rolls of paper towels, each approximately 5.5 inches in width. This size roll of paper towels clearly falls within appellant's claimed size range of 5 to 6 inches set forth in claim 21 on appeal.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a remand. 37 CFR § 41.50(e) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) provides that

[w]henver a decision of the Board includes a remand, that decision shall not be considered final for judicial review. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board may enter an order otherwise making its decision final for judicial review.

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Regarding any affirmed rejection, 37 CFR § 41.52(a)(1) provides "[a]ppellant may file a single request for rehearing within two months from the date of the original decision of the Board."

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 do 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.

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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 and REMANDED

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Administrative Patent Judge)	
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)	BOARD OF PATENT
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