

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN JAMES GINGRAS et al.

Appeal No. 2006-0111
Application 09/900,746

ON APPEAL

Before PAK, OWENS and WALTZ, *Administrative Patent Judges*.
WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 1 through 7 and 9 through 48. Claims 49 through 62, the remaining claims pending in this application, stand withdrawn from further consideration as directed to a non-elected invention (Brief, page 3). We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellants, the invention is directed to a method for making wet rolls which includes applying a wetting solution to a web of material, breaking the wet web, and winding the wet web into

a roll (Brief, pages 4-8). Representative independent claim 1 is reproduced below:

1. (Previously Presented) A method of making wet rolls, comprising:
providing a web of material, wherein the web travels at a speed of at least 60 meters per minute;
applying a wetting solution to the web to produce a wet web; breaking the wet web; and winding the web into a roll.

The examiner has relied on the following references as evidence of obviousness:

Deacon et al. (Deacon)	4,601,938	Jul. 22, 1986
Win et al. (Win)	5,667,635	Sep. 16, 1997
Perini (published International Application)	WO 01/40090 A2	Nov. 28, 2000

Claims 1-7, 9-12, 14, 16-19 and 21-48 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Perini (Answer, page 3).¹ Claims 13 and 15 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Perini in view of Deacon (Answer, page 6). Claims 1-7, 9-19, and 21-30 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Deacon (Answer, page 7). Claim 20 stands rejected

¹As correctly noted by the examiner (Answer, pages 4-5, footnote 1) and appellants (Brief, pages 2-4, footnote 2), this rejection in the final Office action dated Dec. 28, 2004, inadvertently did not include claims 41-48. However, as the examiner and appellants agree, these claims will be considered as included in this rejection.

under 35 U.S.C. § 103(a) as unpatentable over Perini or Deacon in view of Win (Answer, page 9).

We *affirm* the rejections of (1) claims 13 and 15 over Deacon alone; (2) claims 1-7, 9-19 and 21-30 over Deacon; and (3) claim 20 over Deacon in view of Win. We *reverse* the rejections of (1) claims 1-7, 9-12, 14, 16-19 and 21-48 over Perini and (2) the rejection of claim 20 over Perini in view of Win. Accordingly, the decision of the examiner is *affirmed-in-part*. We refer to the examiner's Answer and appellants' Brief and Reply Brief for a complete exposition of the opposing arguments. Our reasoning follows.

OPINION

A. The Rejections over Perini and Perini in view of Win

The examiner finds that Perini discloses a method of making wet rolls comprising the steps of providing a web of material, applying a wetting solution to the web to produce a wet web, and winding the wet web into rolls (Answer, page 3). The examiner acknowledges that Perini teaches that the web material should be "substantially dry" at the changeover zone where the web is broken because the presence of moisture or liquid impregnating the web material would make the changeover difficult (Answer, paragraph bridging pages 3-4).

However, the examiner concludes that this teaching of Perini would have still rendered obvious the breaking of the web while wet with

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the expectation of achieving worse, but still successful, results (Answer, page 4).

Appellants do not dispute the examiner's findings (Brief, page 10) but argue that Perini "teaches away" from breaking the web when it is wet (Brief, pages 10-11; Reply Brief, page 2). We agree.

"Under the proper legal standard, a reference will teach away when it suggests that the developments flowing from its disclosures are unlikely to produce the objective of the applicant's invention. *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)." *Syntex v. Apotex*, ___ F.3d ___, ___, 74 USPQ2d 1823, 1830 (Fed. Cir. 2005). "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1145-46 (Fed. Cir. 2004), quoting *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). General skepticism of those in the art is relevant and persuasive evidence of non-obviousness. See *Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720, 726, 16 USPQ2d 1923, 1929 (Fed. Cir. 1990).

Perini discloses that the "changeover zone" is where the web material is torn and begins to wind to form the initial core of a

new roll (page 8, ll. 25-31). Perini teaches that this "changeover" is a "critical operation" and takes place with web material that is "substantially dry" (sentence bridging pages 8-9). Perini further teaches that the presence of moisture or liquid impregnating the web material "would make the changeover difficult or would in some cases even render it impossible," with the consequence that the winding process could not be performed continuously (page 9, ll. 1-4). We determine that these teachings of Perini alone would have suggested that breaking of wet web material in the changeover zone would have been unlikely to produce the objective of appellants' invention, i.e., winding of the wet web into a roll, and the artisan would have been led in a path divergent from appellants' invention. Appellants were proceeding against the conventional wisdom as taught by Perini, who taught that the web material risks breakage through weakness caused by moistening (page 8, ll. 6-7). Additionally, we determine that the *entire tenor* of the Perini reference teaches away from appellants' invention. Perini repeatedly teaches that the moistening solution should be applied to the web material after the tearing or cutting of the web material (i.e., the "interruption zone"; see page 2, ll. 5-12; page 3, ll. 1-30; page 4, ll. 3-5; page 7, ll. 16-21; page 9, ll. 28-31; and page 10, ll. 8-11). Perini further teaches that the nozzles should be located "[i]n order to

ensure that the changeover zone remains dry" (page 9, l. 11).
Therefore, upon consideration of Perini as a whole, we determine that this reference teaches away from the claimed subject matter.

For the foregoing reasons and those set forth in the Brief and Reply Brief, we determine that the examiner has not established a prima facie case of obviousness in view of Perini. Therefore we cannot sustain the rejection of claims 1-7, 9-12, 14, 16-19, and 21-48 under section 103(a) over Perini.

With regard to the rejection of claim 20 under section 103(a) over Perini in view of Win (Answer, page 9), we note that Win was applied by the examiner to show a web substrate for a pre-moistened wet wipe comprising multiple plies for strength (*id.*). Accordingly, Win does not remedy the deficiencies of Perini as discussed above. Therefore we also cannot sustain the rejection of claim 20 under section 103(a) over Perini in view of Win.

B. The Rejections over Deacon and Deacon in view of Win

With regard to the rejection of claims 1-7, 9-19 and 21-30 under section 103(a) over Deacon (Answer, page 7), the examiner finds that Deacon teaches a method of impregnating a dry web substrate with a liquid cleaning composition, passing the wet web through a perforator and a slitter, and winding the wet web in the form of a coreless roll (*id.*). The examiner construes the claimed

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term "breaking" to include the perforating and slitting taught by Deacon (*id.*). The examiner also finds that Deacon fails to disclose the speed at which the web travels but determines that this speed is a "cause-effective variable" well within the ordinary skill in the art (Answer, paragraph bridging pages 7-8; see also page 11).

Appellants argue that the term "breaking" as used in the specification should not be read so broadly as to include the act of separating a web of material in the machine direction (MD), i.e., slitting (Reply Brief, page 3; Brief, page 13). Appellants argue that one should look to the "patentee's use of the term in the specification of the patent" where appellants define "breaking" as the action creating a leading edge connected to the trapped portion of the web by pulling the web back or breaking the perforation (*id.*).

Appellants' arguments are not persuasive. First we must note that we are not concerned with "the specification of a patent" but the claim construction of terms during *ex parte* prosecution (Reply Brief, page 3). In *ex parte* prosecution, the words of a claim must be given their broadest reasonable meaning in their ordinary usage as they would have been understood by one of ordinary skill in the art, taking into account any enlightenment from the specification. See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329

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(Fed. Cir. 2005); *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). “[T]he specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.” *Phillips v. AWH Corp.*, 415 F.3d at 1315, 75 USPQ2d at 1327 (internal quotations omitted). Of course, limitations from the specification should not be imported into the claims, even if the preferred embodiment is the only embodiment described, absent clear disclaimer in the specification. See *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004); and *Comark Commc’ns, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186-87, 48 USPQ2d 1001, 1005 (Fed. Cir. 1998). As correctly argued by the examiner (Answer, paragraph bridging pages 11-12), appellants’ “definition” of breaking is merely the description of one action where pulling back the web “breaks” the web (see the specification, page 24, ll. 14-30). Appellants disclose “breaking the wet web” which may comprise perforating the web and then making the break along the line of perforation (specification, page 3, ll. 20-27). Appellants further teach that the “perforations are preferably in the cross direction (CD) of the web; that is in the plane of the web perpendicular to the direction of movement, or the machine direction (MD)” (specification, page 10, ll. 18-20,

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underlining added). Thus appellants' specification impliedly teaches to one of ordinary skill in the art that perforations, and the accompanying breaking of the web, may be in the CD or MD but preferably in the CD, and clearly does not limit or exclude any direction of breaking. See *Phillips v. AWH Corp.*, *supra*. Accordingly, we determine that the claimed term "breaking" includes breaking or tearing of the web material in any direction.

Additionally, the examiner notes that it was a "well known and normal operation" in this art to produce multiple smaller rolls from a single larger master roll (Answer, page 12). The examiner further finds that such well known step of breaking the larger roll to form smaller rolls would read on the "breaking the wet web" as required by claim 1 on appeal (*id.*).

Appellants argue there is no reference to support the examiner's statement regarding this "well known" feature (Reply Brief, page 3). Furthermore, appellants argue that it may have been known to create smaller rolls of web from larger rolls by breaking the web while it was dry but it would not have been obvious to do so while the web is wet, especially in view of the teachings of Perini (*id.*).

Appellants' arguments are again not persuasive. As admitted by appellants (specification, page 1, ll. 10-23), wet wipes have been

traditionally made in processes in which the larger web of wipes are initially made and then these larger webs are converted into smaller rolls or sheets that can be placed in a dispenser.² Appellants' admitted prior art includes the formation of smaller rolls from a larger roll when the wipes or web material is wet, since the specification discloses that these smaller rolls are ready for a dispenser.

Appellants argue that claims 1 and 18 recite providing a web of material where the web travels at a speed of at least 60 meters per minute and Deacon fails to teach or suggest this web speed (Brief, page 12). Appellants further argue that the examiner has failed to address the fact that Deacon does not teach how the speed of the web might be maximized, and the prior art gives no indication of which parameters are critical or any direction as to which of the possible choices are likely to be successful (*id.*).

Appellants' arguments are not persuasive. Deacon teaches a continuous process for production of a wet wipe where the substrate

²It is axiomatic that admitted prior art in an applicant's specification may be used in determining the patentability of a claimed invention (*In re Nomiya*, 509 F.2d 566, 570-71, 184 USPQ 607, 611-12 (CCPA 1975)); and that consideration of the prior art cited by the examiner may include consideration of the admitted prior art found in an applicant's specification (*In re Davis*, 305 F.2d 501, 503, 134 USPQ 256, 258 (CCPA 1962); *cf.*, *In re Hedges*, 783 F.2d 1038, 1039-40, 228 USPQ 685, 686 (Fed. Cir. 1986)).

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9 travels at a specific speed but this speed is not disclosed (Certificate of Correction, pages 11-12; see Figure 7). As correctly argued by the examiner, the optimum speed of the web material would be based on several factors and would have been well within the ordinary skill in this art (Answer, page 11). See *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990) (the law is replete with cases where the difference between the claimed invention and the prior art is some variable within the claims; consistently held that applicant must show the criticality for such a variable). Appellants have not argued that the claimed web speed is critical, much less submitted any evidence of criticality for the claimed web speed.

For the foregoing reasons, we determine that the examiner has established a prima facie case of obviousness in view of the reference evidence. Based on the totality of the record, including due consideration of appellants' arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of section 103(a). Therefore we affirm the examiner's rejection of claims 1-7, 9-19 and 21-30 under section 103(a) over Deacon.

With regard to the rejection of claim 20 under section 103(a) over Deacon in view of Win (Answer, page 9), the examiner applies

Deacon as discussed above, additionally relying on Win for the teaching of a web substrate for a pre-moistened wet wipe that comprises multiple plies for strength (*id.*). Appellants' arguments concerning this rejection are merely a restatement of their previous arguments (Brief, page 14; Reply Brief, page 4). Accordingly, for reasons stated above and adopting the findings and conclusion of law on page 9 of the Answer, we determine that the examiner has established a prima facie case of obviousness based on the reference evidence. Based on the totality of the record, including the due consideration of appellants' arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of section 103(a). Therefore we affirm the examiner's rejection of claim 20 under section 103(a) over Deacon in view of Win.

C. The Rejection over Perini in view of Deacon

With regard to the rejection of claims 13 and 15 under section 103(a) over Perini in view of Deacon (Answer, page 6), we have determined that Perini teaches away from the breaking of a wet web as discussed above. However, we have also determined above that Deacon alone renders the subject matter of claim 1 on appeal prima facie obvious. Since the examiner has relied on Deacon for all of the findings regarding the limitations of claims 13 and 15,

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specifically the nonwoven fabric required by claim 13 on appeal (see col. 3, ll. 34-38) and the water-dispersible binder (col. 3, ll. 57-58) (Answer, page 7), we determine that Deacon alone establishes a prima facie case of obviousness for the claimed subject matter. We also adopt our discussion of Deacon from above regarding the prima facie obviousness of claim 1 on appeal, from which claims 13 and 15 depend. Since all of appellants' arguments concerning this rejection are directed to Perini (Brief, pages 13-14; Reply Brief, pages 3-4), these arguments are not persuasive.

For the foregoing reasons as well as the findings from the Answer, we determine that claims 13 and 15 are prima facie obvious in view of the reference evidence. Based on the totality of the record, including due consideration of appellants' arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of section 103(a). Therefore we affirm the rejection of claims 13 and 15 under section 103(a) over Deacon alone.

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D. Summary

The rejection of claims 1-7, 9-12, 14, 16-19 and 21-48 under 35 U.S.C. § 103(a) over Perini is reversed. The rejection of claim 20 under 35 U.S.C. § 103(a) over Perini in view of Win is reversed.

The rejection of claims 13 and 15 under 35 U.S.C. § 103(a) over Deacon is affirmed. The rejection of claims 1-7, 9-19 and 21-30 under 35 U.S.C. § 103(a) over Deacon is affirmed. The rejection of claim 20 under 35 U.S.C. § 103(a) over Deacon in view of Win is affirmed.

The decision of the examiner is affirmed-in-part.

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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) (1) (iv) (2004).

AFFIRMED-IN-PART

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