

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* GERALD KEITH SOSALLA  
JOHN DAVID AMUNDSON and ANDREW KUO

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Appeal No. 2006-0130  
Application 10/161,166

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ON BRIEF

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Before WARREN, KRATZ and TIMM, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

*Decision on Appeal and Opinion*

We have carefully considered the record in this appeal under 35 U.S.C. § 134, and based on our review, find that we cannot sustain the grounds of rejection advanced on appeal: claims 10, 13, 14, 16 through 18, 21, 22 and 24 through 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Clancy in view of Craig et al. (Craig) (final action mailed June 15, 2004 (final action), pages 2-4); and claims 11 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Clancy in view of Craig, further in view of Mertens (final action, page 5).<sup>1,2</sup>

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<sup>1</sup> Claims 10, 11, 13, 14, 16 through 19, 21, 22 and 24 through 26 are all of the claims in the application. See the appendix to the brief.

<sup>2</sup> The examiner states that the grounds of rejection are as set forth in the final action (answer, page 3).

We refer to the answer and to the brief and reply brief for a complete exposition of the positions advanced by the examiner and appellants.

The principal issue in this appeal as framed by appellants is whether the combined teachings of the references as applied would have led one of ordinary skill in this art to the second step of “weakening the elongated web of material along a plurality of lines formed in the length direction of the web of material to form a plurality of panels joined to adjacent panels along the plurality of lines,” and the subsequent fourth step of “cutting the plurality of panels to form at least two clips, each clip having a plurality of sheets wherein every sheet within the clip is joined to any adjacent sheet within the clip by a weakened line” specified for the claimed process encompassed by independent claim 10; and to the same second step and the subsequent third step of “folding the plurality of panels together to form a . . . ribbon of panels,” and the latter part of the fifth step “wherein each panel within each ribbon of panels is joined to any adjacent panel within the ribbon of panels by a weakened line” specified for the claimed process encompassed by independent claim 18.

Appellants submit that Clancy would not have taught “weakening the towelette . . . but simply folds the material into an accordion fold and cuts it to length,” and that Craig “slits the individual sheets,” pointing out that Clancy “is concerned with packaging an individual wipe in an envelope” (brief, pages 3-4, original emphasis deleted; *see also* page 5). Appellants further submit that there is no motivation to combine Mertens with Clancy and Craig, pointing out that Mertens would have taught perforations for separating sheets while Clancy would have taught “an individual towelette” and the “sheets of Craig are already slit” (*id.*, pages 5-6; original emphasis deleted). The examiner responds that appellants refer “to ‘weakened line’ as being a perforated lines, a zone of frangibility, score lines or crush cutting,” and that “[i]t is deemed that a longitudinal folded web ‘becomes weak’ along several longitudinal fold lines,” pointing to Clancy **FIGs. 1 and 4** wherein “the web 10 is gradually folded into longitudinal panels having weaker fold lines,” thus meeting the subject limitations of claims 10 and 18 (answer, pages 3-5). Appellants reply that they “define a weakened line at page 5, line 35” (reply brief, page 2) as found by the examiner, and submit that “[f]olding of the elongated web is not defined as a process producing weakened lines,” contending that “folding a web material does not inherently produce a weakened line or make the web material weaker along the fold line than the remaining

web” and “there is no information in Clancy to suggest that the folding process used would produce a different result . . . even though the fold is creased between feed roller 16 and idler roller 18” (*id.*, pages 2-3)

It is well settled that in order to establish a *prima facie* case of obviousness under § 103(a), the examiner must show that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in this art would have led that person to the claimed invention as a whole, including each and every limitation of the claims arranged as required by the claims, without recourse to the teachings in appellants’ disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

We determine that the broadest reasonable interpretation of the claim terms “weakening” and “weakened lines” in the context of the specification, including the drawings, as interpreted by one of ordinary skill in this art, is that the “weakening” requires a modification of the web material which in fact weakens it to any extent while permitting the panels and sheets to remain attached “by a weakened line.” *See, e.g., In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004); *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Thus, the burden is with the examiner to establish by scientific explanation and/or evidence that Clancy would have reasonably disclosed to one of ordinary in this art that the creasing of the towelette web **10** through longitudinal folding funnel **11** would inherently result in a single towelette **27,42** as shown in Clancy **FIGs, 1, and 3-5** (e.g., col. 1, l. 41, to col. 3, l. 16) that is weakened along the creased, longitudinal fold lines.<sup>3</sup> The examiner’s

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<sup>3</sup> It is well settled that a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom, *see In re Fritch*, 972 F.2d 1260, 1264-65, 23 USPQ2d 1780, 1782-83 (Fed. Cir.

bare contention that a “weakening” may occur is not sufficient to establish inherency. Indeed, it is well settled that in order to establish that a claim element is inherent in a prior art reference, it must be established that such limitation is necessarily present in the description in the reference and that it would be recognized as such by one of ordinary skill in the art, as “[t]he mere fact that a certain thing may result from a given set of circumstances is not sufficient. [Citations omitted.]” *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); *see also Transclean Corp. v. Bridgewood Serv., Inc.*, 290 F.3d 1364, 1372-73, 62 USPQ2d 1865, 1870-71 (Fed. Cir. 2002); *MEHL/Biophile Int’l Corp. v. Milgram*, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305-06 (Fed. Cir. 1999); *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995); *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268-69, 20 USPQ2d 1746, 1749-50 (Fed. Cir. 1991); *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986); *cf. Ex parte Levy*, 17 USPQ2d 1461, 1462-64 (Bd. Pat. App. & Int. 1990), and cases cited therein; *Ex parte Skinner*, 2 USPQ2d 1788, 1788-89 (Bd. Pat. App. & Int. 1986).

We agree with appellants that it is not apparent that the machine of Clancy operated by the process that one of ordinary skill in the art would have found therein would necessarily inherently cause a weakening in the longitudinal fold lines between the panels of the individually produced and enveloped towelettes. Indeed, there is no disclosure in Clancy that the individual, separated towelettes are to be used in any other fashion than as a whole. Thus, there is also no suggestion or motivation to one of ordinary skill in the art in Clancy to modify the teachings thereof in these respects, either expressly or by inference. *See B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996) (“When obviousness is based on a particular prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. [Citation omitted.] This suggestion or motivation need not be expressly stated. [Citation omitted.]”).

On this record, we further agree with appellants that this particular difference between the

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1992); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968), presuming skill on the part of this person. *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

claimed processes encompassed by claims 1 and 18 and the process of Clancy is also not shown or suggested by Craig and/or by Mertens. In this respect, we find that Craig would have disclosed that clips of interfolded individual, separated sheets can be bonded together to form a stack that can be packaged in a container (e.g., cols. 1, l. 11, to col. 4, l. 25; **FIGs. 1, 2 and 4**), without teaching or suggestion of joining the sheets by weakened lines. We further find that Mertens would have disclosed that perforations can be used as weakened lines to separate sheets from fan folded material, but this disclosure alone would not have provides the necessary teachings or motivation to modify Clancy alone or as combined with Craig. This is because both Clancy and Craig would have taught individual, separated sheets.

Accordingly, on this record, we determine that the examiner has failed to establish a *prima facie* case of obviousness over the combined teachings of Clancy and Craig and over the combined teachings of Clancy, Craig and Mertens.

The examiner's decision is reversed.

*Reversed*

CHARLES F. WARREN	)	
Administrative Patent Judge	)	
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	)	
	)	
PETER F. KRATZ	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
CATHERINE TIMM	)	
Administrative Patent Judge	)	

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