

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD LOUIS UNDERHILL, PAUL DOUGLAS BEUTHER,
ROBERT IRVING GUSKY and KEVIN JOSEPH VOGT

Appeal No. 2006-1115
Application No. 10/397,748

ON BRIEF

Before GARRIS, WALTZ and FRANKLIN, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 13-21.

The subject matter on appeal relates to a tissue sheet having at least two distinct, regular, overall texture patterns (e.g., see figures 1 and 2 of the appellants' drawing) and an optical reference pattern (e.g., see element 5 in figure 3). This appealed subject matter is adequately represented by claim 13, the sole independent claim before us, which reads as follows:

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13. A tissue sheet having at least two distinct, regular, overall texture patterns and an optical interference pattern.

The references set forth below are relied upon by the examiner in the Section 102 and Section 103 rejections before us:

Burt	4,671,983	Jun. 9, 1987
Roussel	6,423,397	Jul. 23, 2002

Claims 13 and 14 are rejected under 35 U.S.C. § 102(e) as being anticipated by Roussel and under 35 U.S.C. § 102(b) as being anticipated by Burt. Claims 15-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Roussel or Burt.

With respect to each of the above noted rejections, no specific claim has been separately argued in accordance with 37 CFR § 41.37(c)(1)(vii) (September 13, 2004). Therefore, the claims in these respective rejections will stand or fall together.

We refer to the brief and to the answer respectively for a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning these rejections.

OPINION

For the reasons set forth in the answer and below, we will sustain each of the rejections before us:

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As correctly explained by the examiner, the tissue sheet of Roussel and Burt respectively has two or more texture patterns and an optical interference pattern of the type required by appealed independent claim 13. The appellants' contrary view is clearly erroneous. Moreover, this erroneous viewpoint is in no way supported by the two transparencies submitted in the evidence appendix of the appellants' brief. In particular, these transparencies display the same figures of Burt's drawing and thus overlaying one on the other cannot evince lack of an interference pattern as urged by appellants. This is because overlaying the sheets merely results in a comparison of the same texture patterns rather than a comparison of two different patterns within a given figure which interact to form an optical interference pattern in the manner detailed by the examiner.

Since the one and only argument advanced by the appellants for each of the rejections before us concerns the erroneous distinction discussed above, it would be appropriate, for this reason alone, to sustain each of these rejections. However, these rejections are additionally sustainable because the appellants' argument, aside from being erroneous, is simply irrelevant to the patentability issue before us.

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This is because the pattern feature of claim 13, to which the appellants' argument is directed, involves matters of appearance and visual impact only as revealed by the disclosure of the subject application (e.g., see page 1). Such matters have no relevance to the issue of whether the utility claims on appeal are patentable. It is here appropriate to emphasize that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish a claimed invention from the prior art. See In re Seid, 161 F.2d 229, 231, 73 USPQ 431, 433 (CCPA 1947). The pattern feature of claim 13 has no mechanical function. Moreover, this feature has no functional relationship with the tissue sheet substrate on which it appears. In this last mentioned respect, consideration of the appellants' pattern feature might be regarded as analogous to consideration of printed matter on an article defined by utility claims. See In re Ngai, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004); In re Gulack, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Miller, 418 F.2d 1392, 1396, 164 USPQ 64, 68-69 (CCPA 1969). That is, in the absence of a functional relationship to its substrate, the claim 13 pattern feature (as with printed matter) will not distinguish a utility invention from the prior art in terms of patentability.

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Id. In conclusion, the reference evidence adduced by the examiner establishes a prima facie case of unpatentability for the reasons detailed in the answer, and the appellants have failed to successfully overcome this prima facie case with argument or evidence for the reasons set forth above. At best, the argument is erroneous and the evidence is nonprobative. At worst, this argument and evidence are simply not relevant to the patentability issue presented by the utility claims on appeal. We hereby sustain, therefore, each of the Section 102 and Section 103 rejections advanced by the examiner on this appeal.

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The decision of the examiner is affirmed.

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

AFFIRMED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
THOMAS A. WALTZ)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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BEVERLY A. FRANKLIN)	
Administrative Patent Judge)	

BRG/hh

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KIMBERLY-CLARK WORLDWIDE, INC.
401 NORTH LAKE STREET
NEENHAH, WI 54956