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 DEAN VAN PHAN,
PAUL DENNIS TROKHAN and
PETER GRAVES AYERS

Appeal 2006-1483
Application 10/159,395
Technology Center 1700

Decided: September 29, 2006

Before KIMLIN, PAK, and LINCK, *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the Examiner's final rejection of claims 22 and 24, which are all of the claims pending in the above-identified application. We have jurisdiction pursuant to 35 U.S.C. § 134.

I. APPEALED SUBJECT MATTER

The subject matter on appeal is directed to a tissue paper comprising a second plurality of regions extending outwardly from a plane, which has a lower density than a first plurality of regions lying in the plane. See Specification at 17, together with claim 22. The second plurality of regions is also said to have "at least one foreshortening ridge…" See claim 22. With respect to the foreshortened ridge, the Specification at page 17 states that:

> The cellulosic web 20 may also be foreshortened, as is known in the art. Foreshortening can be accomplished by creping the web 20 from a rigid surface, and preferably from a cylinder. A Yankee drying drum 70 is commonly used for this purpose. Creping is accomplished with a doctor blade as is well known in the art. Creping may be accomplished according to commonly assigned U.S. Patent 4,919,756, issued April 24, 1992 to Sawdai, the disclosure of which is incorporated herein by reference. Alternatively or additionally, foreshortening may be accomplished via wet microcontraction as taught in commonly assigned U.S. Patent 4,440,597, issued April 3, 1984 to Wells et al., the disclosure of which is incorporated herein by reference.

Details of the appealed subject matter are recited in claim 22[1], which is reproduced below:

22. A tissue paper defining an X-Y plane and having a Z direction orthogonal thereto, the tissue paper comprising a first plurality of regions, the first plurality of regions lying in a plane; and a second plurality of regions extending outwardly from the plane, the second plurality of regions

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[1] The Appellants' arguments are limited to claim 22. See Br. 3-5 and Reply Br. 2-4. The Appellants also state that "[c]laims 22 and 24 stand or fall together with respect to the 35 U.S.C. § 102(a) rejection." See Br. 2. Therefore, for purposes of this appeal, we limit our discussion to claim 22 consistent with 37 C.F.R. § 41.37(c)(1)(vii)(2004).

has a lower density than the first plurality of regions, the second plurality of regions has at least one foreshortening ridge therein, the at least one foreshortening ridge being spaced apart from the plane in the Z direction.

II. PRIOR ART

As evidence of unpatentability of the claimed subject matter, the Examiner relies upon the following sole reference:

Morgan, Jr.	US 3,994,771	Nov. 30, 1976

III. REJECTION

Claims 22 and 24 stand rejected under 35 U.S.C. § 102(a) as anticipated by the disclosure of Morgan.

IV. FACTUAL FINDINGS AND CONCULSIONS

Upon careful consideration of the claims, Specification and prior art reference, including the arguments advanced by both the Appellants and the Examiner in support of their respective positions, we determine that the Examiner's §102 (a) rejection is well-founded. Accordingly, we affirm the Examiner's decision rejecting claims 22 and 24 on appeal under §102(a) for the reasons set forth in the Answer and below.

As evidence of anticipation of the subject matter defined by claims 22 and 24 under 35 U.S.C. § 102(a), the examiner relies on the disclosure of Morgan. See Answer at 3. Morgan teaches soft and bulky tissue papers having "discrete patterned arrays of fibers extending outwardly therefrom," along with "improvements in softness and tactile impression." See col. 1, ll. 9-37 and Figures 4-16. These tissue papers are made as follows:

> FIG. 4 is a photographic plan view enlarged about 20 times actual size of the fabric side of a prior art, non–layered, creped paper sheet **60** processed generally in accordance with the teachings of U.S. Pat. No. 3,301,746, said sheet being formed from a single, homogeneously mixed slurry containing approximately 50 percent softwood and 50 percent hardwood fibers. The sheet as subjected to fluid pressure and thermally pre-dried on a 26 x22 semi-twill drying/imprinting fabric prepared as described in the aforementioned patent of Peter G. Ayers, compacted by the fabric knuckles upon transfer to a Yankee dryer drum, finally dried, and creped upon removal from the drum by means of a doctor blade. **The finished sheet contains approximately 16 percent crepe. As shown in FIG. 5, the sheet has the appearance of a lazy corrugation with only a minor portion of the fibers on the fabric side 60a of the sheet extending outwardly away from the surface of the sheet when viewed in the cross-machine direction.**
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> FIG. 6 is a plan view enlarged about the same extent as FIG. 4 of the fabric side **70*a*** of a layered, creped paper sheet 70 of the present invention produced generally in accordance with the process illustrated in FIG. 1, said sheet being formed from two identical slurries of essentially the same fiber content, each slurry containing approximately 50 percent softwood and 50 percent hardwood fibers in a homogeneous mixture. **The basis weights, processing conditions, drying/imprinting fabric, and degree of crepe were essentially the same as those of non-layered prior art sheet shown in FIGS. 4 and 5. As should be apparent from a comparison of FIGS. 5 and 7, the fabric side 70*a* of the layered sheet has a greater proportion of its fibers deflected outwardly in a direction generally away from the plane of the sheet**. [(Morgan, col. 11, ll. 32-66) (Emphasis ours).]

Thus, from our perspective, the claimed tissue papers and the tissue papers produced by Morgan not only appear to be identical or substantially identical, but also appear to be produced by substantially the same method. Compare the above teachings in Morgan with Specification at 6, 12-14, and

17. As held by the predecessor to our reviewing court in *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977):

> Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product…Whether the rejection is based on "inherency" under 35 USC 102, on "prima facie obviousness" under 35 USC 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products. (Footnotes and citations omitted).

However, the Appellants have not supplied sufficient factual evidence to distinguish the claimed tissue papers from Morgan's tissue papers. Rather, the Appellants argue that:

> The claimed feature is at least one foreshortening ridge spaced apart in the z direction from a plurality of lower density regions that extend in the z direction from a plane defined by a plurality of higher density regions. The foreshortening ridge extends in the x-y plane. Each of the cited figures provides a single z-x planar view of a paper sample. Nothing more than a single point of the x-y or z-y planes is discernable from the figures. The figures do not provide sufficient data to support the contention that the claimed feature is inherent in the cited papers.
>
> …
>
> Appellant submits that the figures of the reference were selected to illustrate the paper features described in the reference. That is the figures are representative of the layered nature of the illustrated papers. Since the reference does not teach or suggest a foreshortening ridge extending from a lower density region and spaced apart from the plane of the paper in the z direction there is no basis to assume that the data provided by the figures represents any type of trend or average that may

> be extrapolated to define the claimed foreshortening ridge as an inherent feature of the illustrated papers. [Reply Br. 2-3.]

This argument is not well taken. First, as undisputed by the Appellants, the figures showing a single point of the x-y and z-y planes, together with Morgan's written description discussed supra, appear to indicate that Morgan's tissue papers are identical or substantially identical to the claimed tissue papers. Moreover, as indicated supra, Morgan's tissue papers appear to be made by substantially the same method as the Appellants,' including a creping step, which according to page 17 of the Appellants' Specification, will produce "foreshortening," as required by claim 22.

In view of the foregoing, we concur with the Examiner that the preponderance of evidence weighs most heavily in favor of anticipation within the meaning of 35 U.S.C. §102(a).

V. CONCLUSION

The decision of the Examiner is affirmed.

VI. TIME PERIOD

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

AFFIRMED

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