

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS GERARD SHANNON

Appeal 2007-2862
Application 10/955,533
Technology Center 1700

Decided: October 4, 2007

Before and EDWARD C. KIMLIN, BRADLEY R. GARRIS, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-14, 17-21, and 23. Claims 15, 16, and 22 are also pending, but have been withdrawn from consideration. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

The invention relates to a wiping product such as facial tissue, bath tissue and paper towels. (Br. 2; claim 21). Claim 1 is illustrative of the invention and is reproduced below:

1. A wiping product comprising a non-woven fibrous sheet containing a deliquescent material and a friction reduction compound.

The Examiner relies on the following prior art references to show unpatentability:

Kennedy	US 4,390,438	Jun. 28, 1983
Viazmensky	US 5,009,747	Apr. 23, 1991
Nielsen	US 5,167,764	Dec. 1, 1992
Kato	US 5,814,568	Sep. 29, 1998

The Examiner made the following rejections:

1. Claims 1-14 and 17-21 under 35 U.S.C. § 103 as unpatentable over Kato in view of Nielsen and Kennedy.
2. Claim 23 under 35 U.S.C. § 103 as unpatentable over Kato in view of Nielsen and Kennedy and further in view of Viazmensky.

BACKGROUND

The Examiner finds that Kato discloses the invention as claimed with the exception of a polyethylene oxide friction reduction compound. (Answer 3-4). The Examiner further finds that Nielson discloses the addition of high molecular weight polyethylene oxide in the manufacture of nonwoven/paper sheets to provide excellent slip characteristics and aid in deterring the formation of clumps, tangles and bundles. (Answer 4). The Examiner contends that it would have been obvious to one of ordinary skill in the art at the time of the invention to add high molecular weight

polyethylene oxide to Kato's product in order to achieve the advantages disclosed in Nielson. (Answer 4).

Appellant concedes that the prior art discloses the addition of high molecular weight polyethylene oxide as a process aid to improve formation of wet laid paper webs. (Br. 4). However, Appellant argues that "while it may be obvious to use" friction reduction compounds to make the wet laid sheets of Kato, "it would not be obvious to add" these compounds to the sheets of Kato. (Br. 4). More specifically, Appellant maintains that "[t]hose familiar with papermaking will appreciate that the high molecular weight polyethylene oxides have no mechanism by which they are retained by the cellulose fibers during web formation. Consequently, these process aids pass through the sheet during formation and exit the system with the process water." (Br. 4). Thus, Appellant contends that the Examiner's proposed combination would not result in a product containing a friction reduction compound as claimed. (Br. 4).

ISSUE

Based on the contentions of the Examiner and the Appellant, the issue before us is: Has the Examiner established, by a preponderance of the evidence, that the combined teachings of the references disclose or suggest a wiping product which inherently possesses the claimed friction reduction compound?

For the reasons discussed below, we answer this question in the affirmative.

RELEVANT FINDINGS OF FACT

- 1) Kato discloses a water absorbent paper or nonwoven fabric “composed of short or long fibers of cotton, rayon, acetate, nylon, polyester or the like.” (Col. 2, ll. 16-18).
- 2) The fabric is impregnated with 5-hydroxy-2-hydroxymethyl- γ -pyrone as well as an additional organic acid such as adipic acid and/or water-retaining agent such as magnesium chloride. (Col. 2, ll. 30-39).
- 3) Nielsen discloses a composite wet-formed matt comprising a blend of cellulose acetate fibers, bicomponent fibers, and an aqueous based organic solvent which solubilizes the surface of the cellulose acetate fibers to permit bonding thereof. (Col. 3, ll. 27-34).
- 4) Nielsen teaches that the acetate fibers, bicomponent fibers and solvents are dispersed in a system of water, thickener and dispersant. (Col. 6, ll. 3-5).
- 5) According to Nielsen, suitable dispersing agents are synthetic, long-chain, linear molecules such as polyethylene oxide, which are deposited on and coat the fiber surface and make it slippery. (Col. 6, ll. 49-50, 60-63, 65-66). Nielsen states that the slip characteristic “aids in deterring the formation of clumps, tangles and bundles.” (Col. 6, 63-65).

ANALYSIS AND CONCLUSIONS

Appellant does not dispute the Examiner’s conclusion that it would have been obvious to add polyethylene oxide in the process used to form Kato’s nonwoven/paper product. Rather, Appellant argues that the polyethylene oxide would only serve to reduce coefficient of friction between fibers during processing and would not be retained in Kato’s final product. (Br. 4).

In our view, however, the Examiner set forth a reasonable basis to conclude that at least some of the polyethylene oxide would be retained by the fibers in Kato's final product. (Answer 7-8). *See In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977) (Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established.); *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) ("When the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not."). Thus, the burden was properly shifted to Appellant to establish that a non-woven sheet produced by addition of polyethylene oxide as a dispersing agent would not result in "a non-woven fibrous sheet containing . . . a friction reduction compound" as claimed. *See In re Best*, 562 F.2d at 1255, 195 USPQ at 433 (The prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product.). *See also, Titanium Metals Corp. of Am. v. Banner*, 778 F.2d 775, 783, 227 USPQ 773, 779 (Fed. Cir. 1985). Appellant has not provided the requisite evidentiary showing to meet this burden. *Cf. In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997) (argument by counsel cannot take the place of evidence).

Claims 18, 19, and 20 set forth specific amounts of friction reduction compound in the claimed product. (Br. 4). According to Appellant, these amounts are necessary for the product to be effective, but are not taught or suggested by the prior art. (Br. 4). Appellant has not, however, directed us

to any evidence which establishes that a product manufactured in accordance with the relied upon prior art would not necessarily or inherently contain polyethylene oxide (i.e., friction reduction compound) in the amounts claimed.

Appellant also contends that claim 21 is separately patentable because Kato's product is not a facial tissue, bath tissue, or paper towel. (Br. 4-5). Appellant argues, more specifically, that "[t]he term 'bath tissue' is a limitation in the claim and inherently carries with it a normal meaning, including structural characteristics." (Br. 5). This argument, even if correct, is unpersuasive since claim 21 is not limited to bath tissue. Appellant has not explained, for example, how the claim term "paper towel" patentably distinguishes over Kato's paper.

Because Appellant has not presented persuasive arguments or evidence to overcome the Examiner's prima facie showing of obviousness, we affirm the rejection of claims 1-14 and 17-21 under 35 U.S.C. § 103 as unpatentable over Kato in view of Nielsen and Kennedy.

Appellant does not present any additional substantive arguments with respect to the rejection of claim 23. Accordingly, we also affirm the rejection of claim 23 under 35 U.S.C. § 103 as unpatentable over Kato in view of Nielsen and Kennedy and further in view of Viazmensky.

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ORDER

The rejection of claims 1-14 and 17-21 under 35 U.S.C. § 103 as unpatentable over Kato in view of Nielsen and Kennedy is affirmed.

The rejection of claim 23 under 35 U.S.C. § 103 as unpatentable over Kato in view of Nielsen and Kennedy and further in view of Viazmensky is affirmed.

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

AFFIRMED

tf/ljs

KIMBERLY-CLARK WORLDWIDE, INC.
CATHERINE E. WOLF
401 NORTH LAKE STREET
NEENAH, WI 54956