

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 DANIEL FRASER MASTING

Appeal 2007-3934
Application 10/324,860
Technology Center 1600

Decided: October 2, 2007

Before DONALD E. ADAMS, ERIC B. GRIMES, and LORA M. GREEN,
Administrative Patent Judges.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134 involves claims 1-19, the only claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

INTRODUCTION

Claim 1 is illustrative:

1. A product comprising:
 - a first substrate wound into a roll, the roll having a cylindrical interior space and a rotation axis;
 - a second substrate located within at least a portion of the roll's cylindrical interior space;
 - the roll's rotation axis orientated substantially vertical; and
 - wherein the first substrate is dispensed from the roll's periphery and the second substrate is dispensed from the cylindrical interior space.

The Examiner relies on the following evidence to show unpatentability:

McClymonds 6,189,730 B1 Feb. 20, 2001

The rejection as presented by the Examiner is as follows:

Claims 1-19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by McClymonds.

We reverse.

DISCUSSION

Claim Grouping:

Claim 1 is drawn to a product. The claimed product comprises a first and second substrate. Claim 1 requires that the first substrate is wound into a roll, the roll having a cylindrical interior space and a substantially vertical rotation axis. Claim 1 also requires that the second substrate is located

within at least a portion of the roll's cylindrical interior space.¹ Claims 2-10 depend from claim 1. The only other independent claim, claim 11, is substantially similar to claim 1 but requires that the second substrate is at least partially enclosed by a container, wherein at least a portion of the container is located in the roll's cylindrical interior space and the second substrate is dispensed from the container. Claims 12-19 depend from claim 11. Appellant's Fig. 3 provides a fair representation of one embodiment of the invention set forth in Appellant's claim 1.

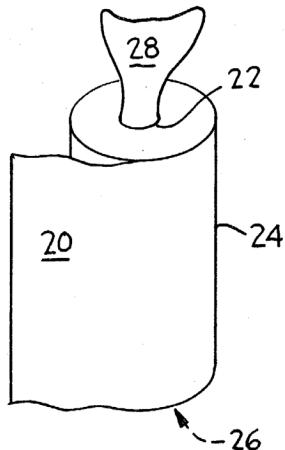


FIG. 3

Fig. 3 is said to illustrate a co-packaged first and second substrate (Specification 2: 10). Element 20 depicts a first substrate that is wound around a core 22 into a roll 24 (Specification 3: 11-12). Interior space 26 is generally cylindrical and is located within roll 24 (Specification 3: 12-13).

¹ Claim 1 further requires that the first substrate is dispensed from the roll's periphery and the second substrate is dispensed from the cylindrical interior space. The Examiner finds that the claims recitation of the manner in which the substrates are dispensed is a statement of the intended use of the product (Final Rej. 3; Answer 3). We agree. *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974) ("[T]erms [that] merely set forth the intended use for . . . an otherwise old composition . . . do not differentiate the claimed composition from those known in the prior art.").

The interior space 26 contains a second substrate 28 located within the core 22 (Specification 3: 16-17).

The Examiner finds that McClymonds teaches a dispenser for paper towels and pre-moistened wipes (Answer 3). While this is true, McClymonds' apparatus has two separate compartments - one for holding dry paper towels and a second for holding sealed containers of pre-moistened paper towelette wipes (McClymonds Abstract). While the shape of McClymonds' apparatus can vary depending on the type of substrate it contains (e.g., rolled towels or folded towels). We find that Fig. 5 provides a fair representation of McClymonds apparatus.

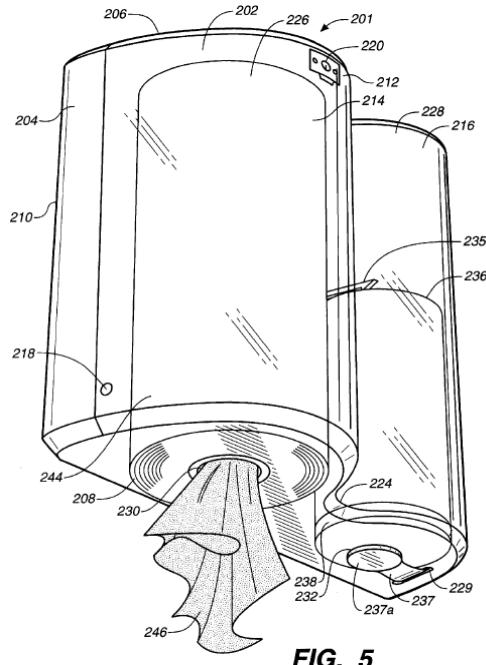


FIG. 5

According to McClymonds, "FIG. 5 is a front perspective view of a third preferred dispenser of this invention" (McClymonds, col. 4, ll. 66-67). As illustrated in Fig. 5, and explained by McClymonds, "[t]he generally cylindrically concave divider indentation 224, though not extending all the way to the back 210, effectively comprises means physically dividing the

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hollow interior of the shell **202** into two compartments: a first or dry towel compartment **226** and a second or pre-moistened towelette compartment **228”** (McClymonds, col. 8, ll. 40-46).

Therefore, rather than teaching a conformation wherein the second substrate is located within at least a portion of the rolled first substrate’s cylindrical interior space, McClymonds’ two substrates are contained within an apparatus that ensures their physical separation. The Examiner has not identified, and we do not find, a teaching in McClymonds wherein the second substrate is located within at least a portion of the rolled first substrate’s cylindrical interior space. Thus, McClymonds fails to teach all of the limitations of independent claims 1 and 11.

Anticipation requires that every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001). For the foregoing reasons we find that McClymonds fails to anticipate Appellant’s claimed invention. Accordingly, we reverse the rejection of claims 1-19 under 35 U.S.C. § 102(b) as being anticipated by McClymonds.

CONCLUSION

In summary, we reverse the rejection of claims 1-19 under 35 U.S.C. § 102(b) as being anticipated by McClymonds.

REVERSED

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LP

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