

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 48

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN K. NEWBY and RANDY G. OGG

Appeal No. 96-2657
Application 08/212,379¹

ON BRIEF

Before COHEN, KRASS and FLEMING, **Administrative Patent Judges**.

FLEMING, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of

¹Application for patent filed March 14, 1994. According to appellants, this application is a continuation of application 08/135,751, filed October 12, 1993, abandoned, which is a continuation of application 07/758,926, filed September 11, 1991, abandoned.

claims 8 through 13, all of the claims present in the application. Claims 1 through 7 have been canceled.

The invention relates to core-wound paper products. Appellants' invention is directed to reducing the costs associated with the contribution of the package volume by compressing the product, reducing the void space of the hollow core. On page 3 of the specification, Appellants disclose that the object of their invention is to improve the ability of the consumer to reround, with fewer occurrences of core inversion, the core of the compressed core-wound paper product to a generally cylindrically shaped paper product.

The independent claim 8 is reproduced as follows:

8. A method of making a compressed core-wound paper product, said method comprising the steps of:
 - providing a generally tubular core having a circular cross section;
 - providing a cellulosic paper product;
 - winding said paper product about said tubular core in a spiral pattern;
 - flattening said core until two diametrically opposed vertices defining a major axis and a minor axis orthogonal thereto are formed and opposing halves of said core are in contact, said major and minor axes lying within said cross section of said core;

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providing a constraining means for maintaining said core-wound paper product in a compressed state;

packaging said core-wound paper product in said constraining means while said core-wound paper product is in a compressed state;

providing a means in said compressed core-wound paper product for opening said core to a dimension of said minor axis of about 0.16 centimeters to about 1.27 centimeters, after said core has been flattened until

opposing halves of said core are in contact with one another; and

opening said core to said dimension of said minor axis while said core-wound paper product is packaged in said constraining means.

The Examiner relies on the following reference:

Watanabe et al. (Watanabe)	4,762,061	Aug. 09,
1988		
Watanabe	4,909,388	Mar.
20, 1990		
Mathieson	1,096,821	Mar.
03, 1981		
(Canadian patent)		

Claims 8 through 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Watanabe 061 in view of Watanabe 388 or Mathieson.

Rather than reiterate the arguments of Appellants and the

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Examiner, reference is made to the briefs² and answers³ for the respective details thereof.

OPINION

We will not sustain the rejection of claims 8 through 13 under 35 U.S.C. § 103.

The Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or

²Appellants filed an appeal brief on October 27, 1995. We will refer to this appeal brief as simply the brief. Appellants filed a reply appeal brief on April 1, 1996. We will refer to this reply appeal brief as the reply brief. The Examiner responded with mailing a second Examiner's answer on May 1, 1996. The Appellants responded to the second Examiner's answer by filing a second reply appeal brief on May 14, 1996 by resubmitting the reply brief. The Examiner responded to the reply brief with a letter, mailed May 28, 1996, stating that the reply brief has been entered and considered but no further response by the Examiner is deemed necessary.

³The Examiner responded to the brief with an Examiner's answer, dated January 29, 1996. The Examiner responded to the reply brief filed April 1, 1996 with a substitute Examiner's answer, mailed May 1, 1996. We will refer to the substitute Examiner's answer as simply the answer.

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suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." ***Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.***, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), ***cert. denied***, 117 S.Ct. 80 (1996) ***citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.***, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), ***cert. denied***, 469 U.S. 851 (1984).

Appellants argue on page 5 of the brief that neither the combination of Watanabe 061 and Watanabe 388 nor Watanabe and Mathieson teaches or suggests the claimed limitation that the core will self-reopen and stay open to the minor axis dimension

while the core is within a constraining means required by the rejected claims. Appellants further emphasize these arguments in the reply brief.

We note that Appellants' claim 8 recites in part the following:

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A method of making a compressed core-wound paper product, said method comprising the steps of: ...

flattening said core until two diametrically opposed vertices defining a major and a minor axis orthogonal thereto are formed and opposing halves of said core are in contact ...

providing a constraining means for maintaining said core-wound paper product in a compressed state;

packaging said core-wound paper product in said constraining means while said core-wound paper product is in a compressed state;

providing a means in said compressed core-wound paper product for opening said core to a dimension of said minor axis of about 0.16 to about 1.27 centimeters, after said core has been flattened until opposing halves of said core are in contact with one another; and

opening said core to said dimension of said minor axis while said core-wound paper product is packaged in said constraining means.

We note that Appellants' other independent claim, claim 10, recites similar limitations.

On page 4 of the answer, the Examiner states that Watanabe 061 discloses "the claimed method except for maintaining the minor axis of the core within the constraining means." The

Examiner goes on to argue that Watanabe 388 in column 2, lines

23-27 and lines 49-58, discloses "constraining a compressed roll of paper to define a shape having a major and minor axis with elasticity of the core allowing inherent reopening of the core." On pages 6 and 7 of the answer, the Examiner makes a similar rejection stating that Mathieson in Figure 5 "discloses constraining a compressed roll of paper to define a shape having a major and minor axis (elliptical)."

However, the Examiner has failed to show that the prior art teaches or suggests the method steps recited in Appellants' claim that we have emphasized above. We agree that the prior art teaches a paper wound core product that is shaped into an elliptical shape, but we fail to find that the prior art method teaches or suggests the method steps as recited in Appellants' claims to arrive at a core with a dimension of said minor axis of about 0.16 centimeters to about 1.27 centimeters. Both Watanabe 388 and Mathieson are silent as to the method steps that are required to arrive at the elliptical shape.

We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference or shown to be common knowledge of

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unquestionable demonstration. Our reviewing court requires this

evidence in order to establish a *prima facie* case. *In re Knapp-Monarch Co.*, 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); *In re Cofer*, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

We have not sustained the rejection of claims 8 through 13 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ERROL A. KRASS)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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MICHAEL R. FLEMING)	
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