

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID H. HOLLENBERG, PATRICIA M. EXARHOS,
BRIGITTE K. WEIGERT and LORRIE L. KRYNOCK

Appeal No. 1996-2960
Application 08/192,027

ON BRIEF

Before DOWNEY, OWENS, and ROBINSON, Administrative Patent Judges.

ROBINSON, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 - 19, which are all of the claims pending in this application.

Claims 1 and 14 are illustrative of the subject matter on appeal and are reproduced below:

1. A tissue comprising two or more plies and thereby having two or more internal ply surfaces, two of said plies being outer plies, wherein one or more of said internal surfaces contains a colored or patterned indicia which is visible through at least one of said outer plies.

14. A three-ply facial tissue comprising two outer tissue plies and an inner tissue ply crimped together at the edges of the plies, said inner ply containing a virucide and a colored or patterned indicia which is visible through both outer plies.

The references¹ relied upon by the examiner are:

Brown	2,143,682	Jan. 10, 1939
Holbein et al. (Holbein)	4,504,357	Mar. 12, 1985
Amano et al. (Amano) (Japanese Patent)	63-270896	Nov. 8, 1988

Ground of Rejections

Claims 1-19 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Holbein, Brown, Amano, and the admitted state of the prior art from the specification.

We reverse.

¹ The examiner has additionally listed British Patent 1,268,262 to Barfred in the Examiner's Answer at page 2. We find no other mention of Barfred or any indication that the examiner intends to rely on this document in this appeal. Therefore, we have not considered this reference in this appeal.

BACKGROUND

At pages 1-2 of the specification, the applicants describe the invention as relating to a tissue comprising two or more plies wherein one or more of the internal ply surfaces contains a colored or patterned indicia which is visible through at least one of said outer plies. Applicants indicate that the plies can be attached to each other by crimping the edges, gluing, or other suitable means. The indicia are stated to be intended to provide a distinctive visual indication that the tissue contains unique ingredients or properties relative to conventional tissue.

Discussion:

The rejection under 35 U.S.C. § 103

Claims 1-19 stand rejected under 35 U.S.C. § 103 as being unpatentable over the admitted prior art taken in view of Holbein, Brown or Amano.

In describing the admitted prior art, the examiner relies on pages 1 and 3 of the specification as disclosing that (Answer, page 3):

it is known in general to both print indicia or decorative pattern and to color multiply tissue product. Additionally, the acknowledged prior art, . . . shows that a multiply tissue paper with a center ply containing a virucidal composition and which plies are crimped together to form the multiply tissue product is well known in the art.

The examiner relies on the secondary references as disclosing (id.):

the incorporation of decorative print or indicia within the body of multiply paper wherein the indicia or decorative pattern is visible through the covering layer of pulp. The advantage of having the decorative pattern or indicia in the inner layer is to provide tamper proof identification of the paper product which also have the inherent property of having the indicia or decorative pattern protected by an overlying layer of pulp.

The examiner concludes that (Answer, paragraph bridging pages 3-4):

it would have been obvious to provide indicia or decorative pattern on the inner layer or ply of the multiply tissue paper of the admitted prior art for [the] above stated advantage.

It is the initial burden of the patent examiner to establish that claims presented in an application for patent are unpatentable. In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). We have carefully considered the evidence and discussion in support of the rejection presented by the examiner. However, a fair evaluation of the references, applicants' specification and consideration of the claimed subject matter as a whole, dictates a conclusion that the construction of the claimed subject matter from the prior art teachings is not suggested by the record before us. To establish a prima facie case of obviousness, there must be more than the demonstrated existence of all of the components of the claimed subject matter. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the substitutions required. That knowledge

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can not come from the applicants' invention itself. Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678-79, 7 USPQ2d 1315, 1318 (Fed. Cir. 1988); In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). The extent to which such suggestion must be explicit in or may be fairly inferred from the references is decided on the facts of each case, in light of the prior art and its relationship to the invention. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed inventions using applicants' disclosure as a template and selecting elements from references to fill the gaps. In re Gorman, 933 F.2d 983, 986-987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). On the record before us, we find no reasonable suggestion for combining the admitted state of the art which describes the printing of indicia or decorative patterns or the use of color on the outside of the tissue (Specification, page 1) with the teaching of Holbein, which relates to a laminated security paper, Brown, which discloses carton board having indicia within the inner layers as a deterrent to counterfeiting, or Amano, which relates to laminated decorative wall paper and packing paper having a printed film laminated between the paper layers, in a manner to arrive at the claimed tissue wherein one or more of the internal surfaces of the multiply tissue contains a colored or patterned indicia, visible through at least one of said outer plies. Here the examiner fails to provide any evidence which would have reasonably suggested, to those of ordinary skill in this art at the time of the invention, the incorporation of the indicia or printed patterns used

on the multilayered products of the secondary references into the internal surfaces of multiply tissue. Where the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). We, therefore, reverse the rejection of the claims under 35 U.S.C. § 103.

Other Issues

On the record before us, it reasonably appears that both applicants and the examiner have interpreted the claims as limited to the use of printing, dyes or other form of coloring to yield patterns on the interior surfaces of the layers of tissue. It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Claim language also should be interpreted as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 218 USPQ 385 (Fed. Cir. 1983). Should further prosecution occur in this application we would urge the examiner to considered whether the claims reasonably encompasses multiply tissue where the pattern present on the internal surfaces are other than printed, dyed or colored to give a pattern on an internal surface of one or more of the plies. For example, if the tissue layers were embossed, the pattern would be present on the internal surfaces of the multiply tissue and yet remain visible on the outside surfaces. Should the examiner determine

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that the claims reasonably encompass this type of indicia or pattern, the examiner should make the appropriate review of the prior art to determine if this aspect of the claimed subject matter distinguishes over the prior art.

Summary

We reverse the rejection of claims 1-19 under 35 U.S.C. § 103.

REVERSED

MARY F. DOWNEY)	
Administrative Patent Judge)	
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TERRY J. OWENS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
DOUGLAS W. ROBINSON)	
Administrative Patent Judge)	

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Kimberly-Clark Corporation
401 North Lake Street
Neenah, WI 54956