

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EBRAHIM SIMHAEE

Appeal No. 1999-2102
Application No. 08/715,990

ON BRIEF

Before ABRAMS, McQUADE, and CRAWFORD, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 11-14, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a dispenser for plastic bags. An understanding of the invention can be derived from a reading of exemplary claim 11, which appears in the appendix to the appellant's Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Wheeler	438,567	Oct. 14, 1890
Gage	3,154,232	Oct. 27, 1964
Richardson	4,714,191	Dec. 22, 1987

Claims 11 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wheeler in view of Richardson.

Claims 12 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wheeler in view of Richardson and Gage.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 16) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No.15) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, the applied prior art references, the respective

positions articulated by the appellant and the examiner, and the guidance provided by our reviewing court. As a consequence of our review, we make the determinations which follow.

The appellant's invention is directed to "[a] dispenser for dispensing and separating a plastic bag from a roll of plastic bags which includes separation lines between adjacent bags and an elongated slot in the separation line" (claim 11, lines 1-3). According to the appellant, the objective of the invention is to solve problems that exist in the prior art devices, which include dispensing and separating the bags with one-handed operation, retaining the next bag in an easily accessible position, and preventing free-wheeling of the continuous web during the dispensing operation (Brief, pages 3 and 4). As manifested in the body of claim 11, the invention comprises a pair of spaced apart, shaped tracks for receiving the opposite ends of an axle upon which a roll of bags is carried, with the tracks being positioned so that the axle can fall within the tracks under the influence of gravity, a back wall having a surface that contacts the outer surface of the roll of bags and provides a braking force to the roll when the bags are to be separated, a tongue for engaging the slot in the separation line between bags to enable a bag to be separated, and wherein the tracks are shaped so that a frictional component of force exerted by the roll against the back wall surface due to the weight of the roll relative to a component transverse thereto is

greater when the roll is at least partially depleted and supported in the lower portion of the tracks than when in the upper portion.

It is the examiner's view that all of the claimed structure is disclosed by Wheeler, except for the tongue, which is shown by Richardson. The examiner goes on to conclude that it would have been obvious for one of ordinary skill in the art to have modified Wheeler by providing a ripping tongue "in order to facilitate the dispensing of the rolled material" (Answer, page 3). The appellant has advanced a number of arguments in opposition to the examiner's rationale and conclusion, including the allegation that there is no suggestion to combine the references in the manner proposed by the examiner. It is this argument that we find to be dispositive of the issue in the appellant's favor.

Wheeler discloses a toilet tissue dispenser comprising a pair of spaced apart, shaped tracks for receiving the opposite ends of an axle upon which the roll of toilet tissue is mounted. The tracks are positioned so that the axle can fall within the tracks under the influence of gravity, in the same fashion as in the appellant's device, and the roll contacts a back surface due to its weight. The appellant has conceded that the Wheeler device operates in the same fashion as the claimed device with regard to the force components and relationships recited in claim 11 (Brief, page 5). Wheeler states that the toilet paper on the roll is "either perforated or incised so as to give sheets of any predetermined length" (page 1, lines 59-61). The reference does not, however, disclose or teach any mechanism

on the dispenser for facilitating separation of the sheets, much less that there be a tongue for engaging slots located at the separation lines in the paper.

Richardson is directed to a carton for dispensing plastic bags from a roll that is contained therein. The bags are pulled over an edge of the carton that is provided with a protruding tab (25) upon which the perforation lines between bags are “impaled”¹ (column 3, line 54) in such a fashion that it “restrains withdrawal of the succeeding bag to allow separation of the bags” (column 4, lines 14-16). There is no teaching of utilizing a roll of bags which have elongated slots at the separation lines between bags.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure.

¹The applicable common definition of “impaled” is “pierced.” See, for example, Merriam Webster's Collegiate Dictionary, Tenth Edition, 1999, page 581.

See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In the present case, we fail to perceive any teaching, suggestion or incentive in either reference which would have led one of ordinary skill in the art to outfit the Wheeler toilet paper dispenser with a tongue for engaging the separation lines between the individual sheets to enable the sheets to be separated for, from our perspective, the record is devoid of evidence establishing reason for doing so. In this regard, the examiner's statement that this was "well known" because of the showing of Richardson (Answer, page 3) is not persuasive because Richardson is not dispensing toilet paper, which is easily torn, but bags made of plastic, a material that commonly is considered much more difficult to tear. The examiner's later comment that the modification is justified because "tearing initiators" such as teeth are present on toilet paper dispensers in the PTO's Crystal Plaza buildings (Answer, page 5) not only is merely opinion, but by its very name ("tearing initiator") would appear not to operate on perforations between sheets, but would itself be the means by which the sheets are caused to be separated.

We therefore conclude that the combined teachings of Wheeler and Richardson fail to establish a prima facie case of obviousness with regard to the subject matter recited in independent claim 11. The rejection of claim 11 and of claim 14, which depends therefrom, is not sustained.

Nor will we sustain the rejection of dependent claims 12 and 13. Further consideration of Gage, which was applied against these two claims for its teaching of providing an open-topped slot for a dispenser roller, does not overcome the shortcoming of the other two references.

CONCLUSION

Neither rejection is sustained.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

MURRIEL E. CRAWFORD
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)

Appeal No. 1999-2102
Application No. 08/715,990

Page 9

DARBY AND DARBY
805 THIRD AVENUE
NEW YORK , NY 10022

APPEAL NO. 99-2102 - JUDGE ABRAMS
APPLICATION NO. 08/715,990

APJ ABRAMS

APJ McQUADE

APJ CRAWFORD

DECISION: REVERSED

Prepared By:

DRAFT TYPED: 28 Jun 01

FINAL TYPED: