UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,820	08/27/2007	7,166,561	15717.3.1.2	8489

22913 7590 08/19/2010

Workman Nydegger
1000 Eagle Gate Tower
60 East South Temple
Salt Lake City, UT 84111

EXAMINER	
JOHNSON, JERRY D	
ART UNIT	**PAPER NUMBER**
3991	
MAIL DATE	**DELIVERY MODE**
08/19/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BUTTERCUP LEGACY, LLC,
Patent Owner and Appellant

Appeal 2009-010111
Reexamination Control 90/008,820
Patent 7,166,561 B2[1]
Technology Center 3900

Before SALLY G. LANE, ROMULO H. DELMENDO, and
JEFFREY B. ROBERTSON, *Administrative Patent Judges*.

ROBERTSON, *Administrative Patent Judge*.

DECISION ON APPEAL[2]

---

[1] The patent under reexamination (hereinafter the "'561 Patent") issued to Mark S. Allen on January 23, 2007 from Application 10/925,470 filed on August 25, 2004 which claims priority to Provisional Application 60/514,154, filed on October 23, 2003.

[2] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" shown on the PTOL-90A cover letter attached to this decision.

Buttercup Legacy, LLC, the owner of the '561 Patent under reexamination, appeals under 35 U.S.C. §§ 134(b) and 306 from a final rejection of claims 1,2, 4-6, 25, and 26 (Amended Appeal Brief filed November 10, 2008, hereinafter "App. Br.," at 3; Final Office Action mailed July 2, 2008).[3] We have jurisdiction under 35 U.S.C. §§ 134(b) and 306.

We AFFIRM.

STATEMENT OF THE CASE

This reexamination proceeding arose from a third-party request for *ex parte* reexamination filed by Roy A. Kim of Sedgwick, Detert, Moran & Arnold, LLP (Request for *Ex Parte* Reexamination filed August 27, 2007). We also understand that the '561 Patent is the subject of litigation that has been stayed pending the outcome of this reexamination, which is identified at page 2 of the Appeal Brief.[4]

The '561 Patent states that the invention involves a lubrication sheet for the maintenance of paper shredders. (Col. 1, ll. 40-55.)

Claim 1 on appeal reads as follows:

> 1. A lubrication sheet for lubricating a paper shredder, comprising:

[3] *See* Patent Assignment Abstract of Title, Reel 018839, Frame 0313, which was entered into the record of this proceeding as "Title Report" on August 30, 2007.

[4] *Buttercup Legacy, LLC v. Michilin Prosperity Company, Ltd, et al.*, Civil No. 2:07-CV-00769-DN in the United States District Court, District of Utah, Central Division. (Order signed by Chief Judge Tena Campbell, dated February 14, 2008, App. Br., Related Proceedings Appendix.)

> a lubrication substrate that is configured to be passed through a shredding mechanism of the paper shredder; a lubricant carried by the lubrication substrate; and
>
> one or more shell layers adjacent to the lubrication substrate,
>
> wherein the one or more shell layers provide mechanical stiffness and rigidity to the lubrication sheet.

(App. Br. 30, Claims App'x)

The Examiner relied upon the following as evidence of unpatentability (Examiner's Answer mailed April 2, 2009, hereinafter "Ans.," 4):

Mitchell	US 2,350,366	June 6, 1944
Zettler	DE 8702207.9	July 30, 1987[5]

Appellant relied on certain parts of the Declaration of Mark S. Allen[6] dated June 19, 2008 (App. Br. 13-16).

The Examiner rejected claims 1, 2, 4-6, 25, and 26 as follows:

I. Claims 1, 2, and 4 under 35 U.S.C. § 102(b) as being anticipated by Zettler (Ans. 11);

II. Claims 5, 6, and 25 under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of Zettler and Mitchell (Ans. 12); and

III. Claim 26 under 35 U.S.C. § 103(a) as unpatentable over Zettler (Ans. 12-13.)

[5] All citations to Zettler are by way of the English translation of record.
[6] Hereinafter "the Allen Declaration."

ISSUES[7]

Appellant argues that Zettler fails to present a substantial new question of patentability over the prior art previously cited during examination of the application maturing into the '561 patent. (App. Br. 16-23.) Specifically, Appellant argues that Zettler's disclosure of a "thin sheet casing" is cumulative to German Patent No. DE 34 26 979 (hereinafter "DE '979", all citations to English Translation of record) disclosure of "two pieces of oil-impervious film" cited during prosecution of the'561 Patent. (App. Br. 19-23.)

The Examiner maintains that whether Zettler raises a substantial new question of patentability is a petitionable issue, not an appealable issue. (Ans. 3.) The Examiner determined that Zettler discloses additional information beyond DE '979 by using the term "sheet" rather than "film." (Final Rejection mailed July 2, 2009, at 6-7.)

The Examiner interpreted "mechanical stiffness and rigidity" as recited in claims 1, 25, and 26 to mean "sufficient stiffness and rigidity to allow the lubrication sheet to be passed through a paper shredder." (Ans. 4.) The Examiner stated: "the claims [do not] require that the shell layer(s) provide a stiffness and rigidity above that provided by the lubrication substrate alone." (Ans. 6.)

In rejecting claims 1, 2, and 4 as being anticipated by Zettler, the Examiner found that "[b]ecause all solids have at least some degree of

[7] Appellant initially challenged the Finality of the Final Office Action (App. Br. 24-25), but acknowledged in the Reply Brief that such an issue is properly handled by petition and not on appeal to the Board. (Rep. Br. 6.)

mechanical stiffness and rigidity," Zettler discloses shell layers that provide mechanical stiffness and rigidity to the lubrication sheet. (Ans. 13-14.)

Regarding claims 5, 6, and 25, the Examiner found that Zettler does not disclose one or more shell layers formed from cellophane or a polymeric material. (Ans. 12.) The Examiner found that Mitchell discloses a moisture-resistant sheet cellophane wrapping material having improved moisture-proofing, moisture resistant and heat sealable coatings. (Ans. 12.) The Examiner concluded that it would have been obvious to form the lubrication sheet taught by Zettler where the casing is a moisture-resistant wrapping as taught by Mitchell to provide improved moisture-proofing, moisture resistance, and heat sealability. (*Id*.)

Regarding claim 26, the Examiner determined that it would have been obvious to form the lubrication sheet of Zettler with a dry lubricant applied to a single side of the lubrication sheet and a single shell layer to enclose the lubricant. (Ans. 12-13.)

Appellant contends that the Examiner's claim interpretation is incorrect because it essentially reads the phrase "wherein the one or more shell layers provide mechanical stiffness and rigidity to the lubrication sheet" out of the claims. (App. Br. 7.) Appellant argues that the Examiner's interpretation ignores the plain and customary meaning of this phrase in light of the specification and prosecution history of the '561 patent. (*Id*.) Appellant contends that the correct interpretation of "wherein the one or more shell layers provide mechanical stiffness and rigidity to the lubrication sheet" is that the mechanical stiffness and rigidity aids in "facilitating the act of passing the lubrication sheet through the shredding mechanism." (App.

Br. 7-8.) Appellant also argues that the Examiner's finding that all shell layers may individually have mechanical and stiffness is insufficient to meet the recited claim requirements, because the Examiner fails to account for how the one or more shell layer(s) interact with the lubrication substrate and lubricant. (App. Br. 9-10.)

Appellant contends that Zettler is silent as to the mechanical stiffness and rigidity of the thin sheet casings. (App. Br. 10-13.) Appellant additionally relies on the comparative testing performed in the Allen Declaration to show that not all shell layers "provide mechanical stiffness and rigidity to the lubrication sheet." (App. Br. 13-16.)

Regarding claims 5, 6, and 25, Appellant contends that due to the large number of thin sheets that could be used, one of ordinary skill in the art would not have selected the cellophane materials of Mitchell for use with the Zettler lubrication sheet absent hindsight. (App. Br. 25-26.)

Regarding claim 26, Appellant argues that it is highly probable that the lubrication sheet substrate carrying the solid lubricant would provide all or substantially all of the mechanical stiffness and rigidity of the lubrication sheet and that the Final action does not attempt to show that the hypothetical lubrication sheet would provide mechanical stiffness and rigidity. (App. Br. 27.) Appellants also argue secondary considerations, specifically the commercial success of products within the scope of claim 1.

Thus, the principal issues in this appeal are:

Is Zettler's disclosure of "thin sheet casing" cumulative to the "two pieces of oil-impervious film disclosed by DE '979 such that the Examiner

erred in determining that Zettler raises a substantial new question of patentability?

Did the Examiner err in finding that Zettler discloses that "one or more shell layers provide mechanical stiffness and rigidity to the lubrication sheet"?

Did the Examiner err in concluding that it would have been obvious to employ the cellophane materials in Mitchell as the thin sheet casings of Zettler?

Did the Examiner err in concluding that it would have been obvious to employ the single shell layer structure in claim 26 in view of Zettler?

FINDINGS OF FACT ("FF")

1. The '561 patent states: "[i]n general, the shell layers can provide mechanical stiffness and rigidity to the lubrication sheets, which can be useful in facilitating the act of passing the lubrication sheet through the shredding mechanism." (Col. 3, ll. 12-15.)
2. The Allen Declaration measures the sag of a lubrication sheet with and without shell layers that is spanned between the top end surfaces of two books, and then compares the two measurements. (Decl. paras. 15, 16, 22-24.)
3. The Allen Declaration provides results for shell layers made of thin sandwich bags, glassine envelope, and polyethylene envelope. (Decl. para. 21, 27, 49.)

4. Zettler describes a lubricant carrier medium for the lubrication of cutting gear in document shredders including a thin sheet casing (2, 3) that surrounds sheet (5) containing lubricant (6). (Zettler, p. 4, ll. 15-25, Figs. 1 and 2.)
5. Zettler discloses thin sheet materials include "paper, foil, magnetic tape, etc." (Zettler, p. 2, ll. 4-5.)
6. Mitchell discloses a moisture-resistant heat-sealable sheet wrapping material, e.g., cellophane. (Page 1, ll. 1-6, 36-39.)
7. DE '979 describes a pillow-type vessel for oiling cutters of a paper shredder including "two pieces of oil-impervious film (3,4)", but does not describe the materials that make up the film. (DE '979, at 3.)

PRINCIPLES OF LAW

Unlike a district court in patent litigation,[8] "the PTO must give claims their broadest reasonable construction consistent with the specification . . . . Therefore, we look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation." *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007). "[A]s applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee." *ICON Health,* 496 F.3d at 1379.

[8] *See, e.g., In re Swanson.*, 540 F.3d 1368, 1377-78 (Fed. Cir. 2008) (explaining that, relative to district court litigation, reexamination is conducted under different standards including standard of proof, absence of a presumption of validity, and claim construction).

"[W]hen 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." *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990) (citing *In re King*, 801 F.2d 1324, 1327 (Fed. Cir. 1986); *In re Ludtke,* 441 F.2d 660, 664 (CCPA 1971). "'[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. . . . Whether the rejection is based on 'inherency' under 35 U.S.C. 102, on 'prima facie obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same . . . [footnote omitted].'" *In re Fitzgerald*, 619 F.2d 67, 70 (CCPA 1980) (quoting *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977)).

ANALYSIS

Substantial New Question of Patentability

The U.S.P.T.O. has recently clarified the procedure for seeking review of issues pertaining to substantial new question of patentability. *See* Clarification on the Procedure for Seeking Review of a Finding of a Substantial New Question of Patentability in *Ex Parte* Reexamination Proceedings, 75 Fed. Reg. 36357-58 (June 25, 2010) (hereinafter "Notice") (delegating the authority to review issues related to the Examiner's determination that a reference raises a substantial new question of patentability to the Chief Administrative Patent Judge, who may further delegate this authority to a panel of Administrative Patent Judges deciding the appeal in the *ex parte* reexamination proceeding).

In the present appeal, the reexamination of the '561 patent was ordered prior to the date of the Notice. *See* Order Granting Request for Reexamination, October 3, 2007. However, the Notice states:

> for *ex parte* reexamination proceedings ordered prior to June 25, 2010, if the patent owner presents the SNQ issue in its appeal brief, the BPAI panel will review the procedural SNQ issue along with its review of any rejections in an appeal and will enter a final agency decision accordingly.

75 Fed. Reg. 36357.

We agree with the Examiner that, based on this record, Zettler's disclosure of a "thin sheet" is not cumulative to the "oil impervious film" disclosed in DE '979. Specifically, while Zettler discloses that "thin sheet materials" include paper, foil, and magnetic tape, DE '979 is silent as to the materials that are representative of "films." (FF 5, 7.) In this regard, the Manual of Patent Examining Procedure (MPEP) provides the following guidance on determining whether references disclose cumulative information:

> For purposes of reexamination, a cumulative reference that is repetitive is one that substantially reiterates verbatim the teachings of a reference that was either previously relied upon or discussed in a prior Office proceeding even though the title or the citation of the reference may be different. However, it is expected that a repetitive reference which cannot be considered by the Office during reexamination will be a rare occurrence since most references teach additional information or present information in a different way than other references, even though the references might address the same general subject matter.
>
> (MPEP § 2258.01.)

Thus, Zettler's "thin sheet materials" are not coextensive with the "film" disclosed in DE '979 because Zettler discloses additional information with respect to the "thin sheet materials" beyond the disclosure of "films" in DE '979.[9] Accordingly, the Examiner did not err in determining that Zettler raises a substantial new question of patentability.

Claim Interpretation

In addressing Appellant's arguments regarding the prior art rejections, we begin by interpreting "wherein the one or more shell layers provide mechanical stiffness and rigidity to the lubrication sheet" as recited in representative claim 1. As pointed out by the Examiner, Appellant has offered different explanations throughout examination and re-examination of the '561 patent as to the meaning of this claim limitation. (*See* Ans. 8-10.) These explanations include: assisting in the removal of debris by pushing out the debris from the cutting teeth of the shredder; and facilitating the act of passing the lubrication sheet through the shredding mechanism by helping the user maintain the lubrication sheet in a more coplanar orientation relative to the feeder slot of the shredder against the opposing force of gravity. (*Id*.) Neither of these explanations provides any guidance as to what degree of assistance in the removal of debris or help in maintaining the lubrication sheet in a more coplanar orientation is required by the claims.

[9] Appellant urges the Board to take judicial notice of the non-entered dictionary definitions presented on July 23, 2008 and August 13, 2008. (App. Br. 22-23.) We decline to do so because the definitions, while defining a film as a thin sheet are not probative as to whether all thin sheets are films.

While we agree with the Examiner that "mechanical stiffness and rigidity" would allow the lubrication sheet to pass through a paper shredder, we also agree with Appellant that the claim language requires that the shell layers *provide* mechanical stiffness and rigidity to the lubrication substrate, i.e., the shell layers must increase the mechanical stiffness and rigidity of the lubrication substrate. We emphasize that because the claims do not specify to what extent the mechanical stiffness and rigidity must be provided, *any* increase, no matter how small, would meet the claim limitation.

Rejection under 35 U.S.C. § 102(b)

In light of our claim interpretation above, we cannot say that the Examiner's statement that "all solids have at least some degree of mechanical stiffness and rigidity" is insufficient to support the Examiner's finding that Zettler's thin sheet casings "provide mechanical stiffness and rigidity to the lubrication sheet" as required in the claims. Again, the claims do not recite what degree of mechanical stiffness and rigidity must be provided to the lubrication substrate. Therefore, we are unpersuaded by Appellant's argument that the Examiner's interpretation essentially reads that limitation out of the claims. The Examiner additionally states "[i]n the *vertical feeding* of paper into the shredder, the shell layer(s) would facilitate feeding of the lubrication sheet into the shredder mechanism if for no other reason, the increased mass provided by the shell layer(s) for gravity to act on." (Ans. 7) (Emphasis added.) Thus, the Examiner's position merely underscores the breadth of the claims. Therefore, the Examiner properly

shifted the burden to Appellant to prove that the sheet casings of Zettler fail to "provide mechanical stiffness and rigidity to the lubrication sheet."

Appellant argues that the comparative testing in the Allen Declaration provides evidence that not all materials falling within the definition of a thin sheet casing as disclosed in Zettler would provide mechanical stiffness and rigidity to the lubrication sheet. (App. Br. 13.) We are unpersuaded by Appellant's arguments. The Allen Declaration provides no results testing the materials specifically described by Zettler as thin sheet materials, namely, paper, foil, and magnetic tape. (FF 3 and 5; Ans. 14-15.) In addition, the comparative testing in the Allen Declarations measures the sag in lubrication sheets supported between two books. (*See* FF 2.) Thus, the sag test results only measure the effect of gravity on *horizontal* paper. Moreover, according to Appellant, providing mechanical stiffness and rigidity includes the feature of assisting in the removal of debris by pushing out the debris from the cutting teeth of the shredder. The testing in the Allen declaration does not address whether all materials, and in particular those disclosed in Zettler, would provide this feature. Thus, the sag test results presented in the Allen Declaration are not sufficient to prove that the thin sheet casing materials disclosed in Zettler fail to provide mechanical stiffness and rigidity to the lubrication substrate. Accordingly, we affirm the Examiner's rejection of claims 1, 3, and 4 under 35 U.SC. § 102(b).

Rejection of claims 5, 6, and 25 under 35 U.S.C. § 103(a)

We are not persuaded by Appellant's argument that due to the large number of thin casing sheets that are suggested by Zettler, one of ordinary

skill in the art would have had no reason to employ Mitchell's sheets in the lubrication sheets of Zettler absent hindsight. Appellant fails to address the reasoning provided by the Examiner, that because Mitchell provides improved moisture-resistant and heat sealable sheets, and Zettler's casing materials are sealable and substantially impermeable to liquid, one of ordinary skill in the art would have expected predicable results in employing the materials of Mitchell as the thin sheet casings of Zettler. (Ans. 12 and 16.) Therefore, we affirm the rejection of claims 5, 6, and 25 under 35 U.S.C. § 103(a) as being unpatentable over Zettler in view of Mitchell.

Rejection of claim 26 under 35 U.S.C. § 103(a)

As noted by the Examiner, Appellant's arguments with respect to claim 26 are similar to the arguments addressed above for the rejection under 35 U.S.C. § 102(b). (Ans. 16.) Thus, we affirm the Examiner's rejection for the same reasons as discussed above.

Evidence of Secondary Considerations

Appellant's arguments regarding commercial success are not persuasive. Initially, we note that Appellant only asserts that products within the scope of claim 1 have been sold. (App. Br. 28.) However, claim 1 was not rejected under 35 U.S.C. § 103(a). Arguments directed to secondary consideration are not relevant to a rejection under 35 U.S.C. § 102. *See Cohesive Technologies Inc. v. Waters Corp.*, 543 F.3d 1351, 1364 (Fed. Cir. 2008). Moreover, to the extent that Appellant's arguments apply to claims 5, 6, 25, and 26, we agree with the Examiner that Appellant's

evidence of commercial success is insufficient to overcome the Examiner's evidence of obviousness for essentially the same reasons as identified in the Examiner's Answer. (Ans. 16-18.)

CONCLUSION

On this record, Appellant has failed to demonstrate any error in the Examiner's factual findings and conclusions that:

Zettler raises a substantial new question of patentability;

Zettler discloses "one or more shell layers [that] provide mechanical stiffness and rigidity to the lubrication sheet";

it would have been obvious to employ the cellophane materials in Mitchell as the thin sheet casings of Zettler; and

it would have been obvious to employ the single shell layer structure in claim 26 in view of Zettler.

DECISION

The Examiner's decision to reject claims 1, 2, and 4 under 35 U.S.C. §102(b) and the Examiner's decision to reject claims 5, 6, 25, and 26 under 35 U.S.C. § 103(a) are affirmed.

Requests for extensions of time in this *ex parte* reexamination proceeding are governed by 37 C.F.R. § 1.550(c). *See* 37 C.F.R. § 41.50(f).

AFFIRMED

rvb

For Patent Owner

Workman Nydegger
100 Eagle Gate Tower
60 East South Temple
Salt Lake City, UT 84111

For Third Party Requester

Roy A. Kim
Venable LLP
2049 Century Park East, Suite 2100
Los Angeles, CA 90067

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte Buttercup Legacy, LLC

Appeal 2009-010111
Reexamination Control 90/008,820
Patent 7,166,561 B2

DELEGATION OF AUTHORITY IN EX PARTE REEXAMINATION PROCEEDING APPEAL

Pursuant to the Notice published June 25, 2010, at Volume 75 of the Federal Register, pages 36357-58, the Chief Judge of the Board of Patent Appeals and Interferences hereby delegates authority to the panel to review issues related to the examiner's determination that a reference raises a substantial new question of patentability in this ex parte reexamination proceeding.

Michael R. Fleming
Chief Administrative Patent Judge

Patent Owner:

Workman Nydegger
100 Eagle Gate Tower
60 East South Temple
Salt Lake City, UT 84111

Third Party Requester:

Roy A. Kim
Venable LLP
2049 Century Park East, Suite 2100
Los Angeles, CA 90067