

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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM M. CHILD and WARREN TARR

Appeal No. 2000-1071
Application No. 08/851,381

HEARD: February 22, 2001

Before ABRAMS, STAAB, and BAHR, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 31 and 35-40, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a method of forming a tampon. An understanding of the invention can be derived from a reading of exemplary claim 31, which appears in the appendix to the appellants' Brief.

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

Ganz	2,620,799	Dec. 9, 1952
Bletzinger <u>et al.</u> (Bletzinger)	2,926,394	Mar. 1, 1960
Cloots <u>et al.</u> (Cloots)	3,131,435	May 5, 1964
Wolff <u>et al.</u> (Wolff)	3,422,496	Jan. 21, 1969
Corrigan	3,595,236	Jul. 27, 1971

Claims 31 and 35-40 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cloots in view of Corrigan.

Claims 31 and 35-40 also stand rejected under 35 U.S.C. § 103 as being unpatentable over Cloots in view of Corrigan, Bletzinger, Ganz and Wolff.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (Paper No. 18) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 17) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The rejections are under 35 U.S.C. § 103. 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. 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 appellants' claims are directed to a method of forming a tampon intended for digital insertion, as opposed to insertion by means of an applicator. As manifested in independent claim 31, the invention comprises the steps of rolling a length of compressible absorbent material into a rolled layered pledget, displacing radially central layers of the

absorbent material from the withdrawal end of the pledget towards the insertion end to produce an increase in fiber density in at least some locations along an axially-extending central region of the tampon as compared to that in regions radially outside the central region, radially compressing the pledget, and forming an indentation in the withdrawal end of the pledget shaped to permit the user to apply an axial force for inserting the tampon. There are two rejections. As we understand the examiner's position in the first rejection, it is that all of the subject matter recited is disclosed by Cloots, except for the indentation for digital insertion, which would have been an obvious addition in view of the teachings of Corrigan. In the second rejection, three references are added to the basic combination for the purpose of demonstrating that it was known in the art to make tampons from a number of different materials. As to both rejections, the appellants point out that Cloots does not utilize a rolled layered pledget. They argue that Cloots does not, as the examiner has implied, teach the step of radially displacing the central layers to increase the fiber density along the central region, and that Corrigan does not teach creating an indentation in the withdrawal end of the tampon unless an applicator stick is used. With regard to the second rejection, they urge that the deficiencies in the primary references are not cured by the three additional references.

The Rejection On The Basis Of Cloots And Corrigan

Cloots fails to disclose or teach several of the requirements of the method set forth in the appellants' claim 31. Initially, we point out that the Cloots tampon is not "a tampon intended for digital insertion," that is, for insertion without the use of an applicator, as is recited in the preamble of the claim 31. With regard to step (a) of the claim, the Cloots tampon is made of batts of absorbent material enclosed in a wrapper (column 4, lines 3-9), which then is radially and axially compressed into its final shape (see Figures 2A-2K and columns 4-6). The material is not rolled, and therefore, the reference fails to disclose or teach the step of "rolling a length of compressible material into a rolled layered pledget." Step (b) requires "displacing radially central layers of the absorbent material . . . to produce an increase in fiber density . . . along an axially-extending central region of the tampon" as opposed to that in the surrounding regions. Cloots provides no explicit teaching that such occurs, although the method disclosed therein includes two instances where forming tools are pushed into the compressed batt at the withdrawal end to form an elongated opening to receive an applicator stick. However, to conclude that the insertions of these two forming tools inherently result in the specified increase in fiber density in the central region, which appears to be what the examiner has done is, in our view, not supported by the disclosure and therefore must be considered to be mere speculation. In this regard, consistent with their function of forming a recess sized to allow an applicator stick to be inserted into the end of the tampon, both of the tools are illustrated as having

very small diameters and appear from the drawings to have pointed ends, features which in our view would cause them to apply little if any axial compressive force upon the tampon material (see Figures 32 and 33, and columns 17 and 18). Finally, even if one were to consider the recess made by the two forming tools to be an “indentation” in the withdrawal end of the tampon, it clearly is not “shaped to permit the user to apply an axial force thereto” for inserting the tampon, as is required by step (d). Nor, of course, is that indentation even available to the fingers of the user in the completed product at the time of insertion, for at that point the applicator stick is installed therein.

Even if one were to accept, arguendo, the examiner’s position that it would have been obvious to one of ordinary skill in the art to modify the Cloots system by replacing the wrapped batting with a rolled layered pledget,¹ the teachings of Corrigan do not overcome the deficiencies in Cloots pointed out above. Corrigan is directed to an improved coating material for application to the forward portion of a tampon as an aid to insertion. In the course of presenting the coating, Corrigan discloses a tampon that is provided with a socket (recess) to receive a stick applicator, but teaches that “[w]hen the tampon is of the digital insertion type, no stick is used and the socket may be dispensed with” (column 3, lines 46 and 47). Contrary to the examiner’s theory, it is our opinion that application of this

¹The appellants have admitted on page 1 of their specification that it was known at the time of their invention to utilize rolled pledgets in the making of digital tampons, however, the Cloots tampon is not a digital tampon.

teaching to Cloots would result in the removal of the Cloots insertion stick as well as the recess in which it is located, and therefore the requirement of the appellants' step (d) that there be an indentation shaped to permit the user to apply an axial force for inserting the tampon is not met. Also, as was the case with Cloots, there is no factual basis from which to conclude that forming the recess for the Corrigan stick, or inserting the stick, results in the displacement of the central layers of material called for in the appellants' step (c).

It therefore is our conclusion that the combined teachings of Cloots and Corrigan fail to establish a prima facie case of obviousness with regard to independent claim 31, and we will not sustain this rejection. Since independent claim 40 contains the same steps as claim 1, a prima facie case of obviousness is lacking there also, and we will not sustain this rejection of claim 40 or of claims 35-39, which depend therefrom.

The Rejection On The Basis
Of Cloots, Corrigan, Bletzinger, Ganz And Wolff

As an alternative to the examiner's position in the other rejection that it would have been obvious to one of ordinary skill in the art to utilize a rolled layered pledget in the Cloots method, the examiner has added Bletzinger, Ganz and Wolff to the basic references as evidence that rolled layered pledgets were known in the art at the time of the appellants' invention. Be that as it may, these references do not overcome the deficiencies in the combination of Cloots and Corrigan which we pointed out above. This

being the case, the five references here applied also fail to establish prima facie case of obviousness with regard to the subject matter of independent claims 31 and 40 and the claims depending therefrom, and we will not sustain this rejection.

SUMMARY

Neither rejection is sustained.

The decision of the examiner is REVERSED.

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

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APPEAL NO. 2000-1071 - JUDGE ABRAMS
APPLICATION NO. 08/851,381

APJ ABRAMS

APJ STAAB

APJ BAHR

DECISION: REVERSED

Prepared By:

DRAFT TYPED: 18 Oct 01

FINAL TYPED: