

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte EDWARD L. PUTMAN

Appeal No. 2002-0938
Application No. 08/958,182

ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 3-8, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to peri-anal hygiene and especially to a method of wiping the anal area clean following a bowel movement (specification, page 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The examiner relied upon the following prior art references in rejecting the appealed claims:

Gold	3,865,271	Feb. 11, 1975
Peters	5,753,246	May 19, 1998 (filed Dec. 2, 1996)

Claims 3-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gold.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gold in view of Peters.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the non-final action mailed June 6, 2000, the final rejection and the answer¹ (Paper Nos. 18, 20 and 27) for the examiner's complete reasoning in support of the rejections and to the brief (Paper No. 26) 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, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. For the reasons which follow, we cannot sustain the examiner's rejections.

¹ The answer (page 3) incorporates the final rejection, which in turn incorporates the prior action mailed June 6, 2000. Such a procedure is not in compliance with the Manual of Patent Examining Procedure (MPEP) § 1208, which expressly provides that incorporation by reference may be made only to a **single** other action.

Each of appellant's independent claims 3, 4 and 7 requires the application or dispensing onto a sheet of toilet paper of a gel of sufficient viscosity to prevent noticeable disintegration of the toilet paper when the gel is applied thereto. Gold, in contrast, discloses dispensing either a liquid or a powder onto a special toilet paper 16 having a moisture resistant backing which prevents the applied liquid from penetrating through the entire paper and causing it to shred or disintegrate upon use (column 3, lines 27-33). Gold teaches that the liquid can be a fluid spray, mist or foam that is either medicated or non-medicated (column 1, lines 58-59). The examiner concedes that Gold does not disclose dispensing gel onto a sheet of toilet paper, as called for in appellant's claims, but contends that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention "to incorporate gel into Gold, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice" (non-final action mailed June 6, 2000, page 2).

The examiner is correct that it has been held that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. See In re Leshin, 227 F.2d 197, 199, 125 USPQ 416, 418 (CCPA 1960). However, rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to

speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). In this case, the examiner has not adduced any evidence that gels were recognized by those of ordinary skill in the art at the time of appellant's invention as suitable for use in peri-anal hygiene. While the examiner "contends that it has been well established to dispense sanitizers in the form of gels to sanitize portions of a user's body" and "that such gels generally comprise aloe vera to help combat the dryness associated with alcohol based gels" (answer, page 4), the examiner has not supported this contention with evidence. Moreover, even accepting this contention as true, the known use of gel sanitizers for other portions of the body does not necessarily provide any suggestion to use such gel sanitizers in the peri-anal area.

For the foregoing reasons, it appears to us that the examiner's rejection of claims 3, 4 and 7 as being unpatentable over Gold stems from impermissible hindsight rather than from any suggestion in the applied prior art to modify Gold to arrive at the claimed invention. We thus conclude that the teachings of Gold are insufficient to establish a prima facie case of obviousness of the subject matter of independent claims 3, 4 and 7, or of claims 5 and 6 which depend from claim 4.²

² Having determined that a prima facie case of obviousness has not been established, it is unnecessary for us to consider the declaration under 37 CFR § 1.132 (Paper No. 21) filed by appellant.

In rejecting claim 8, which depends from claim 7 and further calls for the gel to contain aloe vera, the examiner relies upon the additional teachings of Peters and concludes that it would have been obvious “to provide Gold with the aloe vera gel as taught by Peters, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice” (non-final action mailed June 6, 2000, page 3). The flaw in the examiner’s analysis is that Peters teaches a pre-packaged anti-septic towelette treated with an alcohol solution containing aloe vera gel and cocoa butter for use as a moisturizing disinfectant hand-wipe (column 1, lines 15-18), not for use in perianal hygiene. While Peters does teach distribution of the towelettes in locations such as bathrooms, restrooms and washrooms of restaurants and hotels (column 4, lines 20-24), Peters provides absolutely no teaching or suggestion to use these towelettes on any other area of the body except the hands. As for the examiner’s reference to “Purell Instant Hand Sanitizer with Aloe” in the footnote on page 4 of the answer, we note, at the outset, that the examiner has neither incorporated this reference in the statement of the rejection³ nor provided any supporting documentation describing the product and its use. Accordingly, we have not considered it as evidence of obviousness in our decision. In any event, the examiner’s footnote appears to indicate that the product

³ Where a reference is relied on to support a rejection, whether or not in a “minor capacity,” there would appear to be no excuse for not positively including the reference in the statement of rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970).

alluded to therein is a hand sanitizer, and not a product recognized for use in the perianal area. As such, this product appears to suffer from the same deficiency as Peters as a teaching reference for suggesting the provision of aloe vera gel in the product dispensed onto the toilet paper in Gold.

Accordingly, we conclude that the examiner has failed to present sufficient evidence to establish a prima facie case of obviousness of the subject matter of claim 8.⁴ The examiner's rejection of claim 8 as being unpatentable over Gold in view of Peters is not sustained.

⁴ Thus, as noted above, it is unnecessary for us to consider appellant's declaration under 37 CFR § 1.132 (Paper No. 21).

CONCLUSION

To summarize, the decision of the examiner to reject claims 3-8 under 35 U.S.C. § 103(a) is reversed.

REVERSED

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. MCQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

Appeal No. 2002-0938
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Page 8

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