

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARY E. FREELAND, JERRY L. DRAGOO
and PATRICK J. ALLEN

Appeal No. 95-5027
Application 07/993,198¹

HEARD: DECEMBER 9, 1998

Before McCANDLISH, *Senior Administrative Patent Judge*,
MEISTER, *Administrative Patent Judge* and ABRAMS,
Administrative Patent Judge.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1 through 20, which constitute all of

¹ Application for patent filed December 18, 1992.

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the claims of record in the application.

The appellants' invention is directed to a disposable absorbent article. The claims before us on appeal have been reproduced in an appendix to the Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Lindquist et al. (Lindquist) 1971	3,572,342	Mar. 23,
Eckert et al. (Eckert)	3,774,610	Nov. 27, 1973
Endres	3,848,595	Nov. 19, 1974
Lawson	4,695,278	Sept. 22, 1987
Enloe	4,895,568	Jan. 23, 1990
Kao (Japanese Patent) ²	3,202,057	Sept. 3, 1991

THE REJECTIONS³

Claims 2-6, 8, 9, 11 and 12 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to

² Our understanding of this foreign language reference was obtained from a PTO translation thereof, a copy of which is enclosed.

³ Rejections of claims 15-18 and 20 under 35 U.S.C. § 112, second paragraph, and claims 1-4, 7, 8, 10, 11 and 13 as being unpatentable over Enloe, were withdrawn in the Examiner's Answer.

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particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims 14-18 and 20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.⁴

Claims 5, 6, 9 and 12 stand rejected under 35 U.S.C. § 112, fourth paragraph, as being in improper dependent form for failing to further limit the subject matter of the previous claim.⁵

Claims 14 and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kao.

Claims 14-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Eckert or Endres.

⁴ This is a new rejection, made for the first time in the Examiner's Answer.

⁵ This is a new rejection, made for the first time in the Examiner's Answer.

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Claims 17 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Eckert or Endres, each taken further in view of Enloe.

Claims 1-13 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Enloe in view of Lindquist, Lawson and Kao.

The rejections are explained in the Examiner's Answer.

The appellants' arguments in rebuttal to the positions taken by the examiner are set forth in the Briefs.

OPINION

In reaching our decision on the issues raised in this appeal, we have carefully assessed the claims, the prior art applied against the claims, and the respective views of the examiner and the appellants as set forth in the Answer and the Briefs. Our conclusions follow.

The Rejections Under 35 U.S.C. § 112

The first of these rejections is that claims 2, 3-6, 8, 9, 11 and 12 fail to comply with the second paragraph of Section 112. The examiner has decided that claim 2 is

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indefinite because the limitation that the transverse partition be "elastically extensible" is inconsistent with the requirement in parent claim 1 that this element be "nonresilient." We first note here that not only has no definition been provided by the appellants for the term "nonresilient," but the term is not even present in the original disclosure. We therefore shall look to the common definition, where we find that "resilient" means that a body has

the capability to recover its size and shape after deformation, so it follows that an object that is "nonresilient" would not be capable of recovering its size and shape when the deforming force is removed, or would not be deformable in the first place. The common definition of "elastic" is, interestingly, the same as that of resilient, with each term being listed in the dictionary as a synonym of the other. See, for example, Merriam Webster's Collegiate Dictionary, Tenth Edition, 1996, pages 996 and 370. Based upon these common definitions, we conclude that an object that

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is "nonresilient" is not also capable of being "elastically extensible," and the examiner's position regarding the indefiniteness of claim 2 is well taken.

The second assertion in this rejection is that claim 5 also runs afoul of the second paragraph of Section 112. According to the examiner, claim 5 is indefinite in that it is "redundant" with line 11 of claim 1 (Answer, page 5) since it specifies that the "nonresilient" transverse partition recited in claim 1, from which claim 5 depends, be "substantially inelastic." While we agree with the examiner that this amounts to a second inclusion of the same limitation as was present in the parent claim, such does not cause the claim to be indefinite.

We therefore will sustain the rejection of claim 2 and claims 3, 4, 8 and 11, which depend therefrom, under the second paragraph of Section 112. However, we do not sustain the rejection of claim 5 or dependent claims 6, 9 and 12 under this same section of the statute.

Claims 14-18 and 20 also stand rejected under the second

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paragraph of 35 U.S.C. § 112 because there is no antecedent basis in claim 14 for "the plane" of the topsheet. The fact is that there is no antecedent basis for this term. However, while this is a technical violation, it is our view that it does not cause the claim to be indefinite, considering the explanation of the invention provided in the specification and the skill that should be accorded to the artisan. It is clear from Figure 2 of the drawings that the topsheet (24) has a planar configuration, and that the barrier leg cuffs (32) are upstanding therefrom. Thus, it is our view that the meaning of the disputed term is clear, and we will not sustain this rejection.

Claims 5, 6, 9 and 12 stand rejected under the fourth paragraph of Section 112. The sole limitation added to claim 1 by claim 5 is that the transverse partition is "substantially inelastic." It is the examiner's position that this does not further restrict the structure of claim 1, in which the transverse partition already has been described as being "nonresilient." For the reasons discussed above under the second paragraph rejections, we find these two recitations to be but different ways of stating the same requirement. We

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therefore agree with the examiner that claim 5 does not further limit the structure recited in claim 1, and we will sustain the rejection of claim 5 and claims 6, 9 and 12, which depend therefrom, on this ground.

The Rejection Under 35 U.S.C. § 102(b)

Claims 14 and 20 stand rejected as being anticipated by Kao. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of the claimed invention. See *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert. dismissed sub nom., *Hazeltine Corp. v. RCA Corp.*, 468 U.S. 1228 (1984). A reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession

of the invention. *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d

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1697, 1701 (Fed. Cir. 1995), cert. denied, 116 S.Ct. 1362
(1996), quoting from *In re LeGrice*, 301 F.2d 929, 936, 133
USPQ 365, 372 (CCPA 1962).

Among other limitations, claim 14 requires that there be
"a transverse partition formed by directly affixing said
barrier leg
cuffs together without an intermediate member therebetween"
(emphasis added). Even assuming, *arguendo*, that one of the
edges of "hole sheet 5" shown in Figure 2 constitutes the
required transverse partition, the limitation quoted above
clearly is not met. In the Kao item, the barrier leg cuffs
(4) simply are not "directly affixed" to one another, and
therefore the reference fails to anticipate the subject matter
recited in claim 14. The rejection under Section 102
therefore must fail. Since claim 20 depends from claim 14, it
follows that the rejection of it under this ground also cannot
be sustained.

The Rejections Under 35 U.S.C. § 103

The examiner bears the initial burden of presenting a
prima facie case of obviousness (see *In re Rijckaert*, 9 F.3d

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1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)), which is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art (see *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)).

Claims 14-18 stand rejected as being unpatentable over Eckert or Endres. Claim 14 requires that there be a transverse partition formed by "affixing together" the barrier leg cuffs "without an intermediate member therebetween," such that the article is divided into a front portion and a rear portion and whereby fecal material deposited in the rear portion "is obstructed from migrating to said front portion." Contrary to the examiner, our analysis of the folded article shown in Figure 4 of Eckert is that the oppositely oriented folded portions that define the barrier leg cuffs are not attached directly together to form a transverse partition, as required by the claim, in that an opening is shown to exist between edges 10a and 10b. This being the case, two requirements of the claim are not disclosed by Eckert. The examiner has not

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elucidated, nor can we determine, how or why one of ordinary skill in the art would have modified the Eckert article to eliminate these deficiencies. Such being the case, the teachings of Eckert fail to establish a *prima facie* case of obviousness with regard to the subject matter recited in claim 14, and we will not sustain this Section 103 rejection of claim 14 or, it follows, of dependent claims 15-18.

Endres discloses a diaper in which barrier leg cuffs are created by suitable folds and attachment at glue lines 20a (Figures 1a and 3). Even considering, *arguendo*, that lines 16 delineate the inner edges of the barrier leg cuffs and that these cuffs establish a transverse partition of some sort when the diaper is in its finally folded stage, they do not form that partition by being "directly" affixed together, as required by the claim. Nor is it clear that they obstruct fecal material from migrating from the rear to the front portion of the diaper, also as required by the claim, in that the reference does not clearly establish that any partition so formed has no gap in the center, where fold lines 16 meet. Thus, the teachings of Endres also fail to establish a *prima*

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facie case of obviousness with regard to the subject matter of claims 14-20, and we will not sustain this rejection.

There is a further rejection of claims 17 and 18, in which either Eckert or Endres is combined with Enloe. The deficiencies of the two primary references have been discussed above. Enloe has been applied by the examiner for teaching the partition height recited in these two claims. Be that as it may, Enloe

does not alleviate the shortcomings in either Eckert or Endres, and therefore this rejection cannot be sustained.

The last rejection offered by the examiner is that claims 1-13 and 19 are unpatentable over Enloe in view of Lindquist, Lawson and Kao. The examiner concludes that Enloe teaches all of the structure recited in claim 1 except that the Enloe transverse

partition is resilient rather than the required nonresilient (Answer, page 9). From that point on, we are unable to follow the examiner's meandering path of reasoning, or to appreciate the

following conclusion set out by the examiner on pages 9 and 10

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of the Answer:

[S]upported by Lindquist et al, Lawson and Kao, [the Examiner] takes Official Notice of the fact that a non-resilient partition with an elastically extensible member thereon is known in the absorbent arts to be equivalent to resilient material for use in resilient barrier sections. To substitute a non-resilient partition with an elastically extensible member thereon in Enloe for the disclosed resilient material partition would have been obvious functional equivalent. In so doing, the modified Enloe device would include a non-resilient partition as part of resilient barrier section.

First of all, "Official Notice" may be taken "only of facts outside the record which are capable of instant and unquestionable demonstration as being 'well-known' in the art" (MPEP Section 2144.03, citing *In re Ahlert*, 424 F.2d 1088, 165 USPQ 418, 420 (CCPA 1970), emphasis added). We hardly believe that to be the case in this instance.

Looking past the examiner's reasoning, we focus on the fact that the appellants' claim 1 requires that the partition be nonresilient, whereas the partition disclosed in Enloe is resilient. From the explanation provided in column 5, such resiliency would appear to be necessary in order for the Enloe invention to function in the desired manner, which would constitute a disincentive to replace it with a nonresilient

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partition. Against this backdrop, the examiner has not provided, nor do we perceive, any teaching, suggestion, or incentive which would have led one of ordinary skill in the art to modify Enloe by making the partition nonresilient. The mere fact that secondary references may establish that both types of partitions exist in the prior art is not, in and of itself, sufficient to provide one of ordinary skill in the art with the necessary suggestion to combine, for 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).

It thus is our view that the combined teachings of the four applied references fail to establish a *prima facie* case of obviousness with regard to the subject matter recited in independent claim 1, and therefore the Section 103 rejection of claim 1 and of claims 2-13 and 19, which depend therefrom, cannot be sustained.

New Rejection

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Pursuant to our authority under 37 C.F.R. § 1.196(b), this panel of the Board enters the following new rejection:

Claims 1-13 and 19 are rejected under 35 U.S.C. § 112, first paragraph, as the specification does not contain a written description of the claimed invention, in that the disclosure does not reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention at the time the application was filed.

Claim 1 recites, *inter alia*, "a compliant, nonresilient transverse partition" (emphasis added). The term "nonresilient" is not used in the original disclosure to describe the transverse barrier, but was added to the claims in the first amendment (Paper No. 6), in response to a rejection of claim 1 in the first office action (Paper No. 3). From our perspective, it

constitutes new matter. We are aware of the fact that the appellants have annotated to page 10, lines 26-28 of the specification for support for "nonresilient" in the summary of the invention section on page 2 of the Appeal Brief. However, it is our view that the descriptive words used there to

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describe the materials (water impervious and nonwoven), do not establish that the transverse barrier is nonresilient, nor do those used in lines 29 and 30 (foams, formed films and styrofoam beads in a water impervious casing).

SUMMARY

The rejection of claims 2, 3, 4, 8 and 11 under 35 U.S.C. § 112, second paragraph, is sustained.

The rejection of claims 5, 6, 9 and 12 under 35 U.S.C. § 112, second paragraph, is not sustained.

The rejection of claims 14-18 and 20 under 35 U.S.C. § 112, second paragraph, is not sustained.

The rejection of claims 5, 6, 9 and 12 under 35 U.S.C. § 112, fourth paragraph, is sustained.

The rejection of claims 14 and 20 under 35 U.S.C. § 102(b) as being anticipated by Kao is not sustained.

The rejection of claims 14-18 under 35 U.S.C. § 103 as being unpatentable over Eckert or Endres is not sustained.

The rejection of claims 17 and 18 under 35 U.S.C. § 103 as being unpatentable over Eckert or Endres, each taken further in view of Enloe, is not sustained.

The rejection of claims 1-13 and 19 under 35 U.S.C. § 103

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as being unpatentable over Enloe in view of Lindquist, Lawson and Kao is not sustained.

A new rejection of claims 1-13 and 19 under 35 U.S.C. § 112, first paragraph, has been entered.

The decision of the examiner is affirmed-in-part.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellants may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise

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one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request

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for reconsideration thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART, 37 CFR § 1.196(b)

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
)	
)	
)	
JAMES M. MEISTER)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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