

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRED H. STEIGER

Appeal No. 1996-2735
Application 08/322,741

ON BRIEF

Before WILLIAM F. SMITH, ELLIS and SPIEGEL, Administrative Patent Judges.

ELLIS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 9, 14 through 16, 20, 25 through 27, 29 through 31, 42, 43, 46 through 50 and 53 through 55, all the claims remaining in the application. Claims 1 through 8, 10 through 13, 17 through 19, 21 through 24, 28, 32 through 41, 44, 45, 51, 52, 56 and 57 have been canceled.

Claims 9, 26 and 30 are illustrative of the subject matter on appeal and read as follows:

9. A method for inhibiting the development of odor in menstrual fluid in a catamenial product having a body facing surface adapted to receive said menstrual fluid and a garment facing surface, said method comprising contacting said menstrual fluid with a salt, said salt having at least one anion which is capable of forming a precipitate with odor-causing magnesium or calcium cations in said menstrual fluid and which is selected from the group consisting of fluoride, phosphate, oxalate, and carbonate, said salt being present in an amount effective to prevent the formation of said odor by precipitating a substantial portion of said cations and wherein said salt is proximate to the body facing surface of said catamenial product.

26. A catamenial device having a body-facing surface and a garment facing surface comprising a member adapted to receive menstrual fluid in combination with an amount of salt having a least one anion which is capable of forming a precipitate with odor-causing calcium or magnesium cations in said menstrual fluid and which is selected from the group consisting of fluoride, phosphate, oxalate, and carbonate, said amount of said salt being sufficient to precipitate substantially all of said cation and wherein said salt is proximate to the body-facing surface of said catamenial device.

30. The device of claim 26 which is a tampon.

The references relied upon by the examiner are:

Jones, Sr. (Jones)	3,794,034	Feb. 26, 1974
Heitfeld et al. (Heitfeld)	4,957,063	Sep. 18, 1990
Tanzer et al. (Tanzer)	5,037,412	Aug. 6, 1991 (filed Oct. 27, 1989)
Fukumoto et al. (Fukumoto)	5,231,063	Jul. 27, 1993 (filed Apr. 10, 1991)

The claims stand rejected as follows:

I. Claims 9, 14 through 16, 20, 25 through 29, 31 and 46 stand rejected under 35 U.S.C. § 102 (e) as being anticipated by Tanzer.¹

II. Claim 30 stands rejected under 35 U.S.C. § 103 as being unpatentable over Tanzer.

III. Claims 9, 14 through 16, 20, 25 through 27, 29 through 31, 42, 43, 46² through 50 and 53 through 55 stand rejected under 35 U.S.C. § 103 as being unpatentable over Jones, Fukumoto and Heitfeld.

We have carefully considered the respective positions of the appellant and the examiner and find ourselves in substantial agreement with that of the appellant.

Accordingly, we reverse all the rejections. We refer to the appellant's Brief (Paper No. 33) and the examiner's Answer (Paper No. 34) for a complete exposition of the opposing viewpoints and we add only brief comment.

¹The examiner has indicated on p. 2 of the Answer that claims 22 through 24 are also encompassed by the rejection. However, since these claims were canceled by amendment filed June 1, 1995, in Paper No. 28, we presume that their inclusion in the rejection was an oversight on the part of the examiner. Accordingly, for purposes of this appeal, we have considered the rejection as applying to the claims as denominated above.

² We point out that claim 46 appears to contain an inadvertent typographical error. A comma is missing between the words "fluoride" and "phosphate" on line 2.

I.

With respect to the examiner's rejection under 35 U.S.C. § 102 (e), we point out that it is well established that anticipation requires that each and every element set forth in the claim be present, either expressly or inherently, in a single prior art reference. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999); Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051,1053 (Fed. Cir. 1987); Lindemann Maschinenfabrik GMGH v. American Hoist and Derrick Co., 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). Thus, the examiner has the initial burden of specifically pointing out where and/or how Tanzer discloses, either explicitly or implicitly, each of the claimed elements. This the examiner has not done. Contrary to the examiner's finding, we agree with the appellant that Tanzer discloses that it is preferable that the odor controlling particles

"not be immediately contacted by body fluids discharged by the user. The non-buffered mixture is most effective when dry." Tanzer, col. 5, lines 60-66. Thus, we find that the teachings of Tanzer are diametrically opposed to the present invention.

We note that Tanzer discloses that the deodorizing mixture (i) will work when wet (col. 5, line 66), and (ii) should be positioned in manner which minimizes contact with the bodily fluid (col. 6, lines 8-12). Thus, we find that Tanzer acknowledges that there may be times when menstrual fluid and the deodorizing material come in contact. However, even though such inadvertent contact might result in the precipitation of some of the cations

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present in menstrual fluid, as described in the claims before us, we do not find this teaching sufficient to establish a prima facie case of anticipation because the use of the device disclosed by Tanzer does not manifestly result in the contacting of menstrual fluid with the deodorizing material. Thus, we do not find that in following the teachings of Tanzer, one would inherently perform the claimed method and that the claimed precipitation event would occur. Inherency must be established by more than mere probability or possibility. In re Robertson, 169 F.3d at 745, 49 USPQ2d at 1951; Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

We also point out that all the claims state that the “salt is proximate to the body facing surface” of the catamenial device. In amending the claims to include this phrase the appellant stipulated that “When the salts of the invention are proximate [to] the body facing surface of the catamenial device, they will immediately contact any menstrual fluid which is absorbed by the catamenial device and thus react with the magnesium and/or calcium in the menstrual fluid to form a precipitate thereby preventing the formation of odors.” [Emphases added]. Paper No. 28, sentence bridging pp. 3-4. In contrasting the present device from the devices described by Tanzer, the appellant stated that “the salts of the present invention are placed in the catamenial device, proximate to the body-facing surface, so that they can contact the menstrual fluid, and chemically interact with the odor-causing magnesium and calcium cations contained therein.” Id., p. 4, second complete

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para. Thus, we find this

spatial limitation of the salt in the claim sufficient to distinguish the present devices from the prior art devices, including the device which is set forth in Figure 12 of Tanzer.

Accordingly, in view of the foregoing, the rejection is reversed.

II.

As to the examiner's conclusion that Tanzer would have suggested the use of the claimed salts in a tampon to one of ordinary skill in the art at the time the invention was made, we direct attention to our discussion above that the patent discloses that contact of the deodorizing salts with bodily fluids should be minimized because they are most effective when dry. Tanzer, col. 5, lines 61-66; col. 6, lines 5-12. We do not find that such teachings would have suggested to those of ordinary skill in the art the internal use of the claimed salts in a tampon. Accordingly, we reverse.

III.

Finally, the examiner argues that the claimed methods and devices would have been obvious to one of ordinary skill in the art in view of the combined teachings of Jones, Fukumoto and Heitfeld.

Jones discloses deodorant feminine pads comprising a buffered acid composition which include, inter alia, nontoxic, solid, weak acids of citric, tartaric, gluconic, glutaric,

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levulinic, glycolic, succinic, malic, fumaric, and acid phosphate salts.³ Jones, col. 3, lines 45-49. The buffered acid compositions reduce odor by (i) inhibiting bacterial growth, and (ii) neutralizing the ammonia and amines that form, or which are initially excreted, in the waste fluids by forming nonvolatile salts. Id., lines 3-10.

Fukumoto discloses a “composite absorbent which comprises at least one acid salt selected from the group consisting of acid salts of m-aromatic amino acid and p-aromatic amino acid, at least one acid, and at least one transition metal compound.” Fukumoto, col. 3, lines 29-34. Examples of the third component include, inter alia, carbonate, phosphate and fluoride. Id., lines 34-40. Fukumoto further discloses that the composite absorbents are useful for removing odors present in the living environment such as automobiles, kitchens, living rooms, and offices. Id., col. 2, lines 29-31.

Heitfeld discloses an odor control for animal litter which comprises an agent selected from the group consisting of guanidine hydrochloride, alkali metal fluorides, sodium bisulfite, and mixtures thereof. Heitfeld, col. 1, lines 53-58. Heitfeld further discloses that alkali metal fluorides include sodium fluoride, as an effective urease inhibitor. Id., col. 2, lines 32-33.

According to the examiner it would have been obvious to one of ordinary skill in the

³ Since the examiner has stated that Jones does not teach the claimed salts as deodorizing material (Answer, p. 3), and the appellant appears to agree (Brief, p. 7), we have accepted as fact that the “acid phosphate salts” disclosed by Jones are not within the scope of the presently claimed invention.

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art “to utilize transition metal salts and sodium fluoride in particular in a deodorizing feminine article such as disclosed by Jones. The motivation lies in the substitution of equivalent deodorizing material on the substrate taught by Jones” Answer, p. 4. We disagree.

In addition, to the many excellent points made by the appellant on pp. 6-9 of the Brief, we point out that the examiner has also failed to establish that the transition metal salts and sodium fluoride taught by Fukumoto and Heitfeld, respectively, are equivalent to, or function in the same manner as, the buffered acid compositions taught by Jones. Although, the examiner asserts that the deodorizing materials of the applied prior art are all equivalent, she has not provided any evidence to support her position. We remind the examiner that a conclusion of obviousness must be based on fact, and not unsupported generalities. In re Freed, 425 F.2d 785, 788, 165 USPQ 570, 572 (CCPA 1970); In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Accordingly, the rejection is reversed.

IV.

New Ground of Rejection under 37 CFR § 1.196(b)

Pursuant to 37 CFR § 1.196(b) we set forth the following new ground of rejection.

Claims 25 and 30 are rejected under 35 U.S.C. § 112, fourth paragraph, for failing to further limit the subject matter of independent claims 9 and 27, respectively. A tampon does not possess a body-facing surface and a garment facing surface.

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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 that, “A new ground of rejection shall not be considered final for purposes of judicial review.”

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 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. . . .

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

REVERSED: 37 CFR § 1.196(b)

WILLIAM F. SMITH)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JOAN ELLIS)	
Administrative Patent Judge)	APPEALS AND
)	
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