

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte PATRICK J. ALLEN, TRACEY E. BECKMAN  
JOHN M. BLEVINS, LOUIS J. VILTRO and  
WILLIAM R. VINNAGE

---

Appeal No. 97-2597  
Application 08/176,056<sup>1</sup>

---

HEARD: July 16, 1999

---

Before FRANKFORT, STAAB and BAHR, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 29-32. Claims 14-28, the only other claims remaining in the application, have been withdrawn from further

---

<sup>1</sup> Application for patent filed January 3, 1994.

Appeal No. 97-2597  
Application 08/176,056

consideration under 37 CFR § 1.142(b) as not being readable in the elected invention. An amendment filed subsequent to the final rejection has not been entered. See the advisory letter mailed May 28, 1996 (Paper No. 18).

Appellants' invention pertains to an elasticized disposable training pant. An understanding of the invention can be derived from a reading of independent claim 29, a copy of which is found in an appendix to appellants' brief.

The references of record relied upon by the examiner in support of rejections under 35 U.S.C. § 103 are:

Wolf	2,522,421	Sep. 12, 1950
Miller	2,564,369	Aug. 14, 1951
Boland et al. (Boland)	4,747,846	May 31, 1988
Proxmire	4,936,840	Jun. 26, 1990

Claims 29-32 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claim 29 stands rejected under 35 U.S.C. § 103 as being unpatentable over Boland in view of Proxmire.

Claims 30-32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Boland in view of Proxmire as applied in the rejection of claim 29, and further in view of Wolf and Miller.

Appeal No. 97-2597  
Application 08/176,056

The rejections are explained in the final rejection (Paper No. 16) and the examiner's answer (Paper No. 23).

The opposing viewpoints of appellants are set forth in the brief (Paper No. 22) and the reply brief (Paper No. 25).

*The 35 U.S.C. § 112, Second Paragraph, Rejection*

In rejecting the appealed claims under the second paragraph of § 112, the examiner considers that the term "elastically extensible" found in line 2 of claim 29 is indefinite. The examiner recognizes that appellants' specification provides a definition of this term. The examiner considers, however, that the term in question is indefinite because its definition in the specification "sets forth a narrow range within a broader range and uncertainty exists since one cannot tell if the narrower limitation is a restriction on the broader limitation" (answer, sentence spanning pages 4 and 5).

During patent prosecution, claims are to be given their broadest reasonable interpretation consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969). Furthermore, when the specification

Appeal No. 97-2597  
Application 08/176,056

explains and defines a term used in the claims, without ambiguity or incompleteness, there is no need to search further for the meaning of the term. *Multiform Desiccants, Inc. V. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1433 (Fed. Cir. 1998).

Here, appellants' specification defines of the term "elastically extensible" as being

able to be stretched, without rupture, from the free length at least about 50 percent, preferably at least about 100 percent, more preferably at least about 350 percent, held about 15 seconds, and within about 5 minutes return to within about 10 percent of the free length upon release of the force which causes such elongation to occur. [Specification, page 6.]

Unlike the examiner, we do not find this definition to be ambiguous, especially when given its *broadest* reasonable interpretation consistent with the specification. When so interpreted, it is clear that the term "elastically extensible" as used herein means being able to be stretched "at least about 50 percent." Accordingly, we will not sustain this rejection.

*The 35 U.S.C. § 103 Rejections*

Boland, the primary reference, pertains to a stretchable disposable absorbent undergarment. With reference to Figures 6A and 7, the Boland undergarment comprises a outer cover 12 having a stretchability of from about 20% to about 200% in the cross-body direction 41 (column 8, lines 46-50). The outer cover is configured to have front 28 and rear 30 panels separated from one another by a crotch section 16. Superposed on the bodyside surface of the front and rear panels and the crotch section is an absorbent structure 32. The absorbent structure comprises a liquid-permeable bodyside liner 34, a liquid-impermeable barrier 36, and an absorbent core 30 disposed therebetween. Proxmire, the secondary reference, discloses a stretchable disposable absorbent undergarment that is similar to Boland's undergarment. For example, compare Figures 6A and 7 of Boland with Figures 10A and 11 of Proxmire.<sup>2</sup>

---

<sup>2</sup> With respect to the outer cover 12 of Proxmire's undergarment, we appreciate that Proxmire at column 22, line 42 through column 23, line 2, incorporates by reference the disclosure of US application Serial No. 919,901 to Kieffer (now U.S. Patent No. 5,299,695) and indicates that the outer cover may also be made of the resiliently stretchable material disclosed in the Kieffer patent.

According to the examiner, Boland includes all of the claimed structure "except for 1) the specific structure of the laminate and 2) a core between the elastomeric lamina and the first lamina" (final rejection, page 4). With respect to the first deficiency, the examiner contends that "to make the elastic laminate of Boland et al elastic laminate as claimed . . . would be [sic, have been] obvious to one of ordinary skill in the art in view of the interchangeability as taught by Proxmire" (final rejection, pages 4-5). As to the second deficiency, it is the examiner's position that

Applicant does not disclose the criticality of such structure over the other structures, i.e., no criticality of the claimed structure of Figure 3 over that in Figure 4.<sup>[3]</sup> Therefore, it would have been [an] obvious matter of design choice to employ the claimed structure on Boland et al since Applicant has not disclosed that such structure solves any stated problem or is for any particular purpose and it appears the article would work equally well with various structures. See also In re Japikse, 86 USPQ 70 (CCPA 1950) (shifting location of parts where operation not otherwise modified.) [Final rejection, page 5.]

The examiner further explains her position with respect

---

<sup>3</sup>The "structures" the examiner is referring to here are the undergarment constructions illustrated in Figure 3 and Figure 4 of the present application.

Appeal No. 97-2597  
Application 08/176,056

to the location of the absorbent core in Boland as follows:

Appellant's remarks [in the brief] . . . have been considered but are deemed nonpersuasive. Appellant appears to argue that a prior art reference must be provided to teach all the elements. However, there is a whole body of case law including *In re Kuhle*, 188 USPQ 7 (CCPA 1975) and *In re Japikse* which is inconsistent with such argument. See also claim 1 of Boland et al, i.e., the absorbent is superimposed on an elastic nonwoven web joined to at least one gatherable nonwoven web, but does not say innermost web of outer cover, and is thus not so limited. The lack of disclosure of the criticality of the claimed invention (Figure 3) over the prior art (similar to Figure 4), the prior art's non-limitation to only the structure of Figure 4 and the case law provide the prima facie case of obviousness. [Answer, pages 5-6.]

We will not sustain this rejection.

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). 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. *Id.*

Claim 29 expressly requires that the absorbent core is

Appeal No. 97-2597  
Application 08/176,056

*positioned between* the adhesive film layer and the first lamina layer of the elastomeric laminate. In both Boland and Proxmire, the absorbent core 32 is located *inboard* of the elastomeric laminate 12 on the bodyside surface of the laminate. Accordingly, there is no factual basis in the evidence relied upon by the examiner in rejecting claim 29 to support the examiner's position that the claimed subject matter as a whole would have been obvious. The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification (*see In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). Here, no such suggestion is found in the applied prior art.

Regarding the positions taken by the examiner in rejecting claim 29, the examiner's reliance on appellants' disclosure of alternative constructions, namely, those of Figures 3 and 4, in support of the rejection is inappropriate. *See In re Ruff*, 256 F.2d 590, 598, 118 USPQ 340, 347 (CCPA 1958) (it is improper to rely on an equivalence *known only to appellants* to establish obviousness because it assumes that

Appeal No. 97-2597  
Application 08/176,056

appellants' disclosure is part of the prior art). The examiner's contention that the claimed placement of the absorbent core would have been obvious because appellants do not disclose the criticality thereof also is not well taken. Criticality is not a requirement of patentability. See *W. L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1556, 220 USPQ 303, 315 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). As to the examiner's reliance on *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) and *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) in support of her position that the claimed placement of the absorbent core is merely a matter of design choice, appellants argue on page 6, lines 19-37 of the brief that the claimed placement of the absorbent core achieves a different result as compared to the placement of the absorbent core in the prior art. This argument may not be ignored, as the examiner appears to have done, simply because it does not appear in the specification. See *In re Chu*, 66 F.3d 292, 298, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995) (held, in case where examiner and Board alleged that difference between prior art and appealed claim was "design choice," that there

Appeal No. 97-2597  
Application 08/176,056

is no basis supporting position that a patent applicant's evidence and/or argument traversing rejection must be contained within specification in order to be considered). Concerning the examiner's reliance on the breadth of Boland's claim 1 in support of her conclusion of obviousness, the circumstance that a prior art claim may be broad enough to read on a claimed invention does not require a conclusion of obviousness since a patent's claims are not a technical description of the disclosed invention. See *In re Benno*, 768 F.2d 1340, 1345-46, 226 USPQ 683, 686 (Fed. Cir. 1985) and *In re Vamco Mach. & Tool, Inc.*, 752 F.2d 1564, 1577, n.5, 224 USPQ2d 617, 625, n.5 (Fed. Cir. 1985).

In light of the foregoing, we will not sustain the examiner's rejection of claim 29 as being unpatentable based on the combined teachings of Boland and Proxmire.

As to the examiner's rejection of claims 30-32, the tertiary references, i.e., Wolf and Miller, applied in this rejection have been carefully considered but do not render obvious what we have found to be lacking in Boland and/or Proxmire. It follows that the standing § 103 rejection of

Appeal No. 97-2597  
Application 08/176,056

claims 30-32 likewise will not be sustained.

*Summary*

The examiner's rejection of claims 29-32 under 35 U.S.C. § 112, second paragraph, is reversed.

The examiner's rejections of claims 29-32 under 35 U.S.C. § 103 are also reversed.

The decision of the examiner is reversed.

REVERSED

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

Appeal No. 97-2597  
Application 08/176,056

Steven W. Miller  
The Procter & Gamble Company  
6100 Center Hill Road  
Cincinnati, OH 45224