

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

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HENRI BRISBOISE and MICHAEL J. MENARD

Appeal No. 1997-2956
Application No. 08/511,288

ON BRIEF

Before COHEN, NASE, and JENNIFER D. BAHR, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 13-35, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to the art of manufacturing disposable absorbent products having a laminated construction (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief. Claim 13 is reproduced in the opinion section below.

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

Worden et al. 1984 (Worden)	4,443,511	Apr. 17,
Suzuki et al. 1986 (Suzuki)	4,626,305	Dec. 2,
De Jonckheere et al. 1988 (De Jonckheere)	4,760,764	Aug. 2,

Claims 13-35 stand rejected under 35 U.S.C. § 103 as being unpatentable over De Jonckheere in view of Suzuki and Worden.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted

rejection, we make reference to the answer (Paper No. 32, mailed March 4, 1997) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 31, filed November 29, 1996) 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. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 13-35 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims 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 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d

1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Independent claim 13 (the only independent claim on appeal) reads as follows:

A method for manufacturing laminated, disposable absorbent product, each absorbent product comprising a fluid-permeable cover layer and a fluid-impervious backing layer in a parallel and in a spaced apart relationship, and an absorbent core between said layers, one of said layers having two opposite edges with inflected contours, said absorbent core being in a predetermined positional relationship with respect to said opposite edges, said method comprising the steps of:

- providing a continuous web having a laminated structure, including a laminae of fluid-permeable material and a laminae of fluid-impervious material;
- longitudinally cutting said continuous web according to a cyclic pattern comprising a combination of line segments corresponding to a selected section of said opposite edges, thereby dividing said web in two strips, each strip having a patterned longitudinal edge whose outline corresponds to said cyclic pattern;
- reassembling said strips in a parallel and in a selected phase relationship, with the longitudinal edges thereof which are opposite said patterned edges being placed in adjacency to produce a compound web having longitudinal edges formed by said patterned edges which are longitudinally matched to produce repeatedly said selected section, said compound web having laminated side edge portions;
- applying absorbent cores in a spaced apart relationship to said compound web at positions selected in accordance with said predetermined positional relationship;

- applying an additional web to free sides of said absorbent cores, one of said compound and additional webs comprising fluid-pervious material and the other of said compound and additional webs comprising fluid-impervious material;

- uniting said webs to retain said absorbent cores captive therebetween; and

- transversely cutting said compound and additional webs between adjacent absorbent cores to produce discrete disposable absorbent products.

The appellants argue (brief, pp. 6-9) that the applied prior art does not suggest the claimed subject matter. We agree. In that regard, we agree with the appellants that the teachings of Worden would not have made it obvious at the time the invention was made to a person having ordinary skill in the art to use a laminate material as the backing sheet in the nappy-pants of De Jonckheere. Moreover, the examiner's determination (answer, p. 4) that it would have been obvious to an artisan to slit and reassemble any of the layers (i.e., the backing layer or the cover layer) used to make the nappy-pants of De Jonckheere has not been supported by any evidence.¹

¹ Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998), cert. denied, 119 S. Ct. 1804 (1999).

(continued...)

In our view, the only suggestion for modifying De Jonckheere in the manner proposed by the examiner to arrive at the claimed invention stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejection of claims 13-35.

¹(...continued)

A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977). See also In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

CONCLUSION

To summarize, the decision of the examiner to reject claims 13-35 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

Appeal No. 1997-2956
Application No. 08/511,288

Page 10

AUDLEY A. CIAMPORCERO JR.
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

Appeal No. 1997-2956
Application No. 08/511,288

Page 11

JVN/dl