

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte THOMAS W. OSBORN III

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Appeal No. 1998-2794  
Application No. 08/506,137

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HEARD: JANUARY 27, 2000

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Before ABRAMS, 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 1-3 and 5-12, which are all of the claims pending in this application. We reverse.

BACKGROUND

The appellant's invention relates to an absorbent article having, *inter alia*, a liquid pervious topsheet, a liquid impervious back sheet joined to the topsheet, an absorbent core between the topsheet and back sheet and a barrier adjacent a longitudinal side edge of the

absorbent article having an inner edge, an outer edge and a pair of ends. The outer edge and the ends of the barrier are joined to the topsheet and at least a portion of the inner edge of the barrier is unattached to the topsheet between the ends. It is important to appellant that the topsheet is extensible and that the barrier is less extensible than the topsheet so that the barrier tends to move to a more upright disposition to form a lip upon extension of the topsheet.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Foreman	4,938,755	Jul. 3, 1990
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The following rejections are before us for review.

1. Claims 1-3 and 5-12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Foreman.
2. Claims 1-3 and 5-12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Foreman.

Reference is made to the brief (Paper No. 20) and the final rejection (Paper No. 16) and answer (Paper No. 21) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification<sup>1</sup> and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Turning first to the 35 U.S.C. § 102(b) rejection of the claims, it is not in dispute that Foreman discloses an absorbent article (a diaper) comprising a liquid pervious topsheet (38 or 40), a liquid impervious back sheet (42), an absorbent core (44) and at least one barrier cuff (62) as required by claim 1. Further, the barrier cuff is provided with a spacing means (76), which is "any member which gathers, contracts, stiffens, shortens or otherwise acts on the barrier cuffs so as to cause the barrier cuff to stand up" to provide a channel (96) that acts as a constraint against the leakage of exudates (column 14, lines 42-48). The sole issue in determining whether Foreman anticipates the claims is whether the barrier cuffs (62) of Foreman's diaper are less extensible than the topsheet.<sup>2</sup>

At the outset, we note that the term "extensible" as used in the claims "refers to articles that can increase in at least one of their dimensions in the x-y plane" (specification, page 7, last

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<sup>1</sup> We note that the amendment to the first page of the specification filed August 11, 1997 (Paper No. 17) has been approved for entry by the examiner but has not, in fact, been entered.

<sup>2</sup> Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

line, to page 8, line 2). Further, the x-y plane is a plane generally parallel to the faces of the absorbent article.

We note that there is no disclosure in Foreman regarding the degree of extensibility of the topsheet in its x-y plane (parallel to the top and bottom surfaces thereof). In the illustrated embodiment, the barrier cuff (62) is extensible in a (x-y) plane parallel to its inboard and outboard surfaces in that it is gathered or contracted (column 14, lines 58-60) by a spacing means in the form of an elastic member (77) and can be extended to an ungathered or uncontracted position by the application of force. Quite simply, we find no teaching in Foreman which indicates that the barrier cuff is less extensible than the topsheet.

The examiner's position (final rejection, page 4), which appears to rely on other alternative forms of spacing means discussed in column 16, lines 3-29, is that:

[i]f the barrier and top sheet are made of the same material, all material being "extensible" or having "give" in all directions to some extent, and the barrier is made stiffer or shortened from its original length which can also be the same as that of the topsheet, the barrier will have less give or extensibility due to its being shortened or stiffer than the topsheet.

Even accepting the examiner's initial assumption that the barrier cuff and topsheet are made of the same material, an assertion for which we find no basis in Foreman<sup>3</sup>, it does not necessarily follow that stiffening or shortening the barrier cuff as taught by Foreman will make

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<sup>3</sup> In fact, Foreman's disclosure that the topsheet must be liquid pervious (column 3, line 36) and the barrier preferably liquid impermeable (column 13, lines 16-17) suggests to us that the materials of the barrier cuff and topsheet, even if made from the same fiber, film or foam, must be processed differently so as to possess different properties, which may or may not affect the extensibility of the product.

it less extensible. By stiffening, we understand Foreman to mean reduction of the flexibility or bendability of the barrier cuff in a direction toward and away from the topsheet, or generally perpendicular to its inboard and outboard faces, so that it will retain an orientation in which it is angled upwardly away from the topsheet. While we understand that it may be possible to apply a stiffening means such that it also restrains the extensibility of the barrier cuff in its x-y plane, Foreman does not require this.<sup>4</sup> As for shortening, it is not apparent to us how a shortening of the barrier cuff will have any impact on its extensibility from that shortened length.

For the foregoing reasons, we are constrained to reverse the examiner's rejection of claims 1-3 and 5-12 under 35 U.S.C. § 102(b).

Turning next to the examiner's rejection of claims 1-3 and 5-12 under 35 U.S.C. § 103, as discussed above, we are of the opinion that Foreman does not disclose, expressly or under principles of inherency, that the barrier cuffs are less extensible than the topsheet. While we appreciate that it is possible, consistent with the teachings of Foreman, to have constructed the absorbent article of Foreman so as to possess this feature, the mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the

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<sup>4</sup> Under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981).

desirability of the modification. See In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

In establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, e.g., Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). In this case, it appears that the only motivation for constructing the absorbent article of Foreman such that the barrier cuff is less extensible than the topsheet to meet the limitations of appellant's claims stems from hindsight knowledge derived from the appellant's own disclosure. It follows that we also cannot sustain the examiner's rejection of claims 1-3 and 5-12 under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-3 and 5-12 under 35 U.S.C. § 102 or, in the alternative, under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS	)	
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	)	

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