

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARGARET A. KATO and FRANK S. GLAUG

Appeal No. 1998-2817
Application No. 08/455,366

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge and
ABRAMS and GONZALES, Administrative Patent Judges.

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 1, 3 through 7, 9 through 13, 15 through 19, 21 through 26 and 28 through 36. These claims constitute all of the claims pending in this application.

We AFFIRM and enter new rejections pursuant to 37 CFR

§ 1.196(b).

The specification describes a waist elastic system 60 for children's disposal absorbent training pants wherein the waist elastic system may be formed separate (Figure 2) or unitary (Figure 3) with the training pants. See specification, pp. 12 and 46. Two embodiments of the separate system shown in Figure 2 are described in detail, both of which include a sleeve member 62, defining an elongate passage 64, and an elastic member 66. We are informed by the specification (pp. 12-13) that the first embodiment (hereinafter referred to as "Embodiment 1") is constructed by providing two lengths of elastic members having respective relaxed lengths of about 14.29 cm (5-5/8 inches)¹ and two lengths of nonwoven web having respective relaxed lengths of about 36.83 cm (14.5 inches).² Both elastic members are extended about 36.83 cm

¹ The specification states (p. 13, l. 2) that this is "one-half of the relaxed circumferential length." Presumably, the appellants mean one-half of the relaxed circumferential length of the elastic member 66. Compare p. 12, ll. 24-26.

² Each elastic member is described as being made of natural rubber having a thickness of 7 mils and a width of .79 cm. Each nonwoven web is described as being made of bicomponent fibers in a side-by-side orientation, in which the fibers are present in the amount of about 50 percent

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and placed on a respective nonwoven web length, with the ends of the elastic members being joined to the ends of their respective nonwoven web length.³ Each nonwoven web length is then C-folded over its respective elastic member. The two resulting composites, comprising an elastic member and a nonwoven web length, are joined at their ends to form a closed-loop elastic waistband with the elastic member being freely movable within the sleeve between their ends.

The second embodiment (hereinafter referred to as "Embodiment 2") is described (specification, p. 31) as

. . . similar to Embodiment 1, except that in Embodiment 2 the elastic member is selectively intermittently joined to the elongate sleeve member. The intermittent pattern of joining is a pattern of 1.27 centimeter (0.5 inch) wide adhesive zones separated by 1.27 centimeter wide zones with no adhesive.

The claims on appeal are directed to a disposal absorbent pant including a closed loop waist elastic system (claims 19,

polypropylene fibers to about 50 percent polyethylene fibers and having a basis weight of about 17 gm². Specification, p. 12.

³ The description of the relaxed circumferential length of the closed-loop elastic waistband as being "about 73.66 centimeters (29 inches)" (p. 13, ll. 16-17) is believed to be a mistake, since it is inconsistent with the elastic members being extended about 36.83 cm when placed on the nonwoven webs. See, also, footnote 1, supra.

21 through 26 and 28 through 36) and to a closed loop waist elastic system per se (claims 1, 3 through 7, 9 through 13, 15 through 18). An understanding of the claimed invention can be derived from a reading of exemplary claim 1, which reads as follows:

1. A closed loop waist elastic system for a disposable absorbent pant comprising a chassis including a front panel, a back panel, a crotch panel and an absorbent structure on said crotch panel, said front panel and said back panel being selectively joined to form a waist opening and a pair of leg openings, said closed loop waist elastic system comprising:
 an elongate sleeve member defining an elongate passage therein, and being generally peripherally disposed about said waist opening, and
 an elongate elastic member disposed within said elongate passage,
 said closed loop waist elastic system having a maximum magnitude of decay of less than about 76.98 grams in an extension range of about 300 millimeters over the first three cycles.^{4,5}

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

⁴ "Decay" is defined in the specification (p. 6) as "a loss of tension at a specific extension over a selected number of cycles."

⁵ A "cycle" is defined in the specification (p. 6) as "an extension of an elastic member or elastic structure, and a retraction of the elastic member or elastic structure following the removal of the force causing the extension." Technically, the language "the first three cycles" in each independent claim lacks proper antecedent basis.

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Ales et al. (Ales)	4,639,949	1987	Feb. 03,
Weil et al. (Weil)	5,242,436		Sep. 07, 1993

The following rejections are before us for review:

claims 1, 3 through 7, 9 through 13, 15 through 19, 21 through 26 and 28 through 36 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which fails to provide an enabling disclosure;

claims 1, 3 through 7, 9 through 13, 15 through 19, 21 through 26 and 28 through 36 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;

claims 1, 3 through 7, 9 through 13, 15 through 19, 21 through 26 and 28 through 36 stand rejected under 35 U.S.C. § 103 as being unpatentable over Weil; and

claims 1, 3 through 7, 9 through 13, 15 through 19, 21 through 26 and 28 through 36 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ales in view of Weil.

The full text of the examiner's rejections and response

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to the arguments presented by the appellants appears in the final rejection (Paper No. 8) and the answer (Paper No. 14), while the complete statement of the appellants' arguments can be found in the brief (Paper No. 13).

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. As a consequence of our review, we have made the determinations which follow.

35 U.S.C. § 112, Second Paragraph

We will not sustain the rejection of claims 1, 3 through 7, 9 through 13, 15 through 19, 21 through 26 and 28 through 36 under 35 U.S.C. § 112, second paragraph.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re

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Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977).

In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable

language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second

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paragraph, is appropriate.

With this as background, we analyze the specific rejection under 35 U.S.C. § 112, second paragraph, made by the examiner of the claims on appeal. Specifically, the examiner stated (answer, p. 4):

All claims are rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. MPEP § 706.03(f). There is no mention as to the length (or circumference) of the elongate elastic member. No recitation of the length makes the claims ambiguous. For example, a 1,000,000 mm elastic member extended 300 mm over three cycles would produce little or no stress in the elastic member, therefore, little decay would probably occur. However, a 10 mm elastic member extended 300 mm would be greatly overstressed and most likely would tear in half. In addition to the length, the width, thickness, and type of elastic would all produce an affect on the results.

Claim 33 is ambiguous as to structure.

We agree with the appellants' argument (brief, p. 7) that the claims under appeal do fully apprise those of ordinary skill

in the art of the scope of the invention claimed, and thus satisfy the requirement of 35 U.S.C. § 112, second paragraph, to particularly point out and distinctly claim the subject

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matter which the appellants regard as the invention. In this regard, we note, as did the appellants, that breadth of a claim is not to be equated with indefiniteness. See In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971). Additionally, we see no basis for the examiner to conclude that the claims are incomplete for omitting essential structural cooperative relationships of elements. MPEP § 706.03(f) cited by the examiner to support his position no longer exists. However, the second paragraph of MPEP § 2172.01 does state that

. . . a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See In re Venezia, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); In re Collier, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968).

Nevertheless, the examiner has failed to cite any passage of the specification or in other statements of record that would establish that any essential element or interrelationship between essential elements has been omitted from the claims under appeal. While the claims are certainly broader without a recitation of

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the relaxed circumferential length of the closed loop waist elastic system than they would be if a relaxed circumferential length were recited, that does not make the claims indefinite.

35 U.S.C. § 112, First Paragraph

We will also not sustain the examiner's rejection of claims 1, 3 through 7, 9 through 13, 15 through 19, 21 through 26 and 28 through 36 under 35 U.S.C. § 112, first paragraph.

An analysis of whether the claims under appeal are supported by an enabling disclosure requires a determination of whether that disclosure contained sufficient information regarding the subject matter of the appealed claims as to enable one skilled in the pertinent art to make and use the claimed invention. The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

In order to make a rejection, the examiner has the

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initial burden to establish a reasonable basis to question the enablement

provided for a claimed invention. See In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of

35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that a sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. See In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). As stated by the court, "it is incumbent upon the Patent Office, whenever a rejection on this basis is

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made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the

contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure." In re Marzocchi, 439 F.2d at 224, 169 USPQ at 370.

With this as background, we turn to the specific rejection under 35 U.S.C. § 112, first paragraph, made by the examiner of the claims on appeal. The examiner's statement of this rejection (answer, pp. 3, 4) is as follows:

The testing procedures fail to account for length (circumference) of the waist elastic system. As described by appellant, the test involves removing the waist elastic system from the absorbent pant. The waist system is then stretched between a top peg and bottom peg. For example, a large waist system having a circumference equal to 100,000 mm (possibly for adults) is stretched 300 mm over three cycles. This equates to stretching the system 0.6% its length; this would produce little or no stress in the elastic member. Therefore, little decay would probably occur. However, a small system having a 10,000 mm elastic member (possible for children)

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extended 300 mm or 6% of its length (length = 1/2 the circumference) would produce greater stress and greater decay in the waist system while using the same test procedures. No recitation of the length makes the test indefinite. (emphasis in original)

The examiner's statement that the lack of any recitation of length makes the test indefinite, indicates to us that the examiner has confused the requirement of 35 U.S.C. § 112, second

paragraph, that the claims particularly point out and distinctly claim the invention, with the requirement of 35 U.S.C. § 112, first paragraph, that the specification describe how to make and use the invention. While we recognize that the claims do not require the closed loop waist elastic system to be any particular length, we fail to understand why the specification is not enabling as a result. A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, first paragraph, as not enabling. Mayhew, id. Such essential matter may include missing

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elements, steps or necessary structural cooperative relationships of elements described by the applicant as necessary to practice the invention. However, in this case, the appellants have not omitted any matter from the claims under appeal disclosed to be essential to the invention as described in the specification or in other statements of record. As set forth previously, the examiner has failed to cite any passage of the specification or in other statements of record that would establish that any essential element has been omitted from the claims under appeal.

35 U.S.C. § 103 Rejection Based On Weil

We will not sustain the rejection of claims 1, 3 through 7, 9 through 13, 15 through 19, 21 through 26 and 28 through 36 under 35 U.S.C. § 103 based on Weil.

Each of the independent claims on appeal calls for a closed-loop waist elastic system. In the final rejection (p. 7), the examiner interpreted the language "said front and said back panel being selectively joined to form a waist opening

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and a pair of leg openings" in the preamble of claim 1 "as utilizing fastening tabs. Therefore, Weil is interpreted as having a 'closed-loop waist elastic system.'"

The appellants argue that

Weil simply does not disclose the same structure as the present invention, in that Weil refers to a diaper that utilizes refastenable tape tabs, while the present invention relates to a training pant having a closed-loop waist opening and leg openings. The specification of the present invention clearly is directed toward pant-like garments that have a full, i.e., 360 degree, waistband and not to flat, diaper-like garments that utilize refastenable tape tabs for adjusting the fit.

Brief, p. 10.

We note the following description at page 9 of the appellants' specification

With reference to FIG. 1, a disposable absorbent training pant 20 comprises a chassis 22 including a front panel 24, a back panel 26, a crotch panel 28, a waist opening 30, and a pair of leg openings 32. Openings 30, 32 are formed by selectively joining portions of front panel 24 and back panel 26 at side seams 34, which extend between waist opening 30 and a respective leg opening 32. Each side seam 34 can be formed in any suitable manner, such as by ultrasonic bonding, thermal bonding, adhesive bonding, or the like. A waist border 36 peripherally surrounds waist opening 30, and is formed upon joining front panel 24 and back panel 26 at seams

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34.

When read in light of the underlying specification, we cannot agree that "selectively joined" in claim 1 embraces the use of fastening tabs to join front panel 24 and back panel 26 at side seams 34. At any rate, the language referred to by the examiner concerns the joining of the front and back panels of the training pant chassis 22, not the separate waist elastic system 60. Thus, we agree with the appellants that Weil does not teach or suggest a closed-loop elastic waist system. Since all of the claim limitations are not taught or suggested by Weil, the examiner has not established the prima facie obviousness of the claimed invention. In re Royka, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

35 U.S.C. § 103 Rejection Based On Ales and Weil

We will sustain the rejection of claims 1, 3 through 7, 9 through 13, 15 through 19, 21 through 26 and 28 through 36 under 35 U.S.C. § 103 based on Ales and Weil.

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The appellants have grouped claims 1, 3 through 7, 9 through 13, 15 through 19, 21 through 26 and 28 through 36 as standing or falling together. See brief, p. 3. In accordance with 37 CFR § 1.192(c)(7), we have selected claim 1 as the representative claim and will decide this ground of rejection on the basis of that claim.

The examiner describes Ales as disclosing the invention substantially as claimed, including a closed-loop elastic waist system for a disposable panty for infants and adults. See answer, p. 5. The examiner also describes Ales as teaching, at col. 13, ll. 51-57, the same materials as the appellants for the elastic member, including natural rubber. Id. The examiner acknowledges that Ales is silent as to the maximum magnitude of decay over the first three cycles.

The examiner describes (answer, pp. 6 and 7) Weil as teaching that

. . . elastic materials in an elastic waist system undergoing sustained stress/strain (extension/contraction) have diminishing forces with time (i.e. elastic

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creep). Therefore, it is desired to make sure this reduction in wearing forces over time doesn't fall below a minimum for wearing stability. **The elastic creep (decay) should be kept to a minimum.** See column 34, lines 51 et seq. (Weil et al further teaches the waist elastic system should not have insufficient contractive forces that result in the diaper slipping down after being worn and loaded. In contrast, excessive contractive forces may reduce the comfort for the wearer producing pressure markings on the wearer's skin See column 34, lines 20 et al. [sic: et seq.]) (emphasis in original)

The examiner then concluded (answer, p. 7) that

[i]t would have been obvious to one having ordinary skill in the art to have utilized the concept of keeping the elastic decay to a minimum as taught by Weil et al with the closed-loop waist elastic system of Ales et al to maintain the functional integrity of the waist system over repeated cycling.

In regards to the specific claimed decay values, it would have been obvious to one having ordinary skill in the art to have kept this value to a minimum. Also, lacking any criticality in the specification, the use of the claimed "decay" values in lieu of those used in the references solves no stated problem and would have been an obvious matter of design choice within the skill of the art.

The appellants' argue that neither Ales nor Weil provides any description or suggestion regarding the decay of the elastic waistband over a number of cycles and that it is improper for the examiner to combine the concept of Weil with the teaching of Ales. We are not persuaded by this argument because Weil does,

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in fact, recognize that for wearing stability the decay of the elastic waistband over a number of cycles, which the reference refers to as elastic creep, should be kept to a minimum. See Weil, col. 3, ll. 51-59.

Also, the appellants describe Ales and Weil as lacking any teaching with respect to the problem addressed by the appellants' invention and argue that the failure of the art to address the problem of elastic decay should be taken into account when deciding whether the references can be combined under 35 U.S.C. § 103.

This argument is not persuasive since the "[m]ere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention" (In re Baxter Travenol Labs, 952 F.2d 388, 392, 21 USPQ2d 1282, 1285 (Fed. Cir. 1991)) and "[t]he fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise have been obvious" (Ex parte Obiaya, 227 USPQ 58 (Bd. Pat. App. & Int.

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1985)), aff'd.mem., 795 F.2d 1017 (Fed. Cir. 1986)).

Moreover, "[a]s long as some motivation

or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor" (In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992)) and all the benefits of the claimed invention need not be explicitly disclosed to render the claim unpatentable under § 103 (see In re Dillon, 919 F.2d 688, 692, 696, 16 USPQ2d 1897, 1901, 1904 (Fed. Cir. 1990) (in banc), cert. denied, 500 U.S. 904 (1991)). As to the appellants' reliance on Wright,⁶ we must point out that, to the extent that this decision was inconsistent with Dillon, it was expressly overruled (see Dillon at 919 F.2d 692, 16 USPQ2d 1901).

In the present case, Weil clearly teaches that hysteresis loss of the elastic materials used in the elastic waistband of

⁶ In re Wright, 6 USPQ2d 1959 (Fed. Cir. 1988), cited at page 11 of the brief.

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a diaper should not be so great that the contractive force is low enough to allow sagging/slipping of the diaper on the wearer (see col. 34, ll. 48-50) and that for wearing stability elastic creep should be kept to a minimum (see col. 34, ll. 51-59). Based on

these teachings in Weil, it is our opinion that it would have been obvious to a person of ordinary skill in the art prior to the appellants' invention to minimize the hysteresis loss and the elastic creep of the elastic material used to produce the closed-loop waistband disclosed in Ales.

Further, it is beyond question that the closed-loop waist elastic system suggested by the combined teachings of Ales and Weil would have had some measurable magnitude of decay over three cycles, just as samples 1 to 7 described in the appellants' specification had a measurable magnitude of decay over three cycles. The only difference between the prior teachings and claim 1 is that claim 1 call for a maximum magnitude of decay over three cycles of less than 76.98 grams. However, where the general conditions of a claim are

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disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). As the court stated in In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990)

[n]or can patentability be found in the difference in ... ranges recited in the claims. The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims....These cases have consistently held that in such a situation, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range...(obviousness determination affirmed because dimensional limitations in claims did not specify a device which performed and operated differently from the prior art).... [Emphasis in original; citations omitted.]

Here, however, the appellants have made no persuasive showing that the provision of "a maximum magnitude of decay of less than about 76.98 grams in an extension range of about 300 millimeters over the first three cycles" is in any way critical or is anything which would be unexpected.

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The rejection of claim 1 under U.S.C. § 103 will therefore be sustained, as will the rejection of claims 3 through 7, 9 through 13, 15 through 19, 21 through 26 and 28 through 36, grouped therewith.

NEW GROUNDS OF REJECTION

In accordance with our authority under 37 CFR § 1.196(b), this panel of the board introduces the following new grounds of rejection.

Claims 1, 3 through 7, 9 through 13, 15 through 19, 21 through 26 and 28 through 36 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The scope of enablement must bear a "reasonable correlation" to the scope of the claims (see, e.g., In re Fisher, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970)) and "the specification must teach those skilled in the art how to make and use the full scope of the claimed invention without

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'undue experimentation'" (In re Wright, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)).

All of the claims call for a maximum magnitude of decay over three cycles which is "less than about" a specified number of grams at a specified extension. Thus, the range in each claim includes zero grams at the specified extension. However, the appellants' specification only provides two working examples, i.e., Embodiment 1 in which the elastic member is joined to the sleeve member at the seams 34 and Embodiment 2, similar to Embodiment 1, except that the elastic member is intermittently joined to the elongate sleeve member by a pattern of 1.27 centimeter (0.5 inch) wide adhesive zones separated by 1.27 centimeter wide zones with no adhesive. Referring to Tables 1 and 13 in the appellants' specification, closed-loop waist elastic systems constructed according to the teachings of Embodiment 1, had a maximum magnitude of decay of less than about 59.18 grams in an extension range of about 300 millimeters over the first three cycles while closed-loop waist elastic systems constructed according to the teachings

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of Embodiment 2 had an average maximum magnitude of decay of less than about 76.98 grams in an extension range of about 300 millimeters over the first three cycles. There are no examples in the appellants' specification illustrating how one would make a closed-loop waist elastic system having a maximum magnitude of decay in an extension range of about 300 millimeters over the first three cycles of zero (0) grams or 25 grams or of any number of grams less than 59.18 grams. In some cases involving predictable factors, a single embodiment provides broad enablement in the sense that, once imagined, other embodiments can be made without difficulty and their performance characteristics predicted by resort to known scientific laws. The scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved. In this case, involving unpredictable factors, such as the effect on decay of (1) the material used to make the elastic elements, (2) the spacing of the bond areas between the sleeve and the elastic elements, (3) the total area of all bond areas between the sleeve and the elastic elements, (4) the cross sectional dimensions of

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the elastic member, and (5) the material used to make the sleeve, we must conclude that the scope of enablement of the specification does not bear a "reasonable correlation" to the scope of the claims.

Claims 1, 3 through 7, 9 through 13, 15 through 19, 21 through 26 and 28 through 36 are rejected under 35 U.S.C. § 103(a) as unpatentable over the prior art described in the appellants' specification in view of Weil.

According to the appellants, samples 1 through 7, described at pages 15-16 of the specification, "were commercially purchased in late 1994 or early 1995" (see specification, p. 16). Thus, samples 1 through 7 constitute prior art under at least 35 U.S.C. § 102(a).

The differences between the prior art, i.e., samples 1 through 7, and the claims at issue is the decay of the elastic waistband over a number of cycles. For example, claim 1 requires the closed loop waist elastic system to have a maximum magnitude of decay of less than about 76.98 grams in an extension range of about 300 millimeters over the first three cycles while the maximum magnitude of decay for the same

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range of sample 1-7 varies from about 151-840 grams. See specification, p. 30. Claim 19 requires the closed loop waist elastic system to have a maximum magnitude of decay of less than about 65.41 grams in an extension range of about 225 millimeters over the first three cycles while the maximum magnitude of decay for the same range of sample 1-7 varies from about 82-556 grams.

The pertinent teachings of Weil are described above. Based on those teachings, it is our opinion that it would have been obvious to a person of ordinary skill in the art prior to the appellants' invention to minimize the hysteresis loss and the elastic creep of the elastic material used to produce the closed-loop waistband disclosed in sample 1-7. As such, it would not have been inventive prior to the appellants' invention to discover the optimum or workable ranges by routine experimentation. In re Aller, supra; In re Woodruff, supra.

CONCLUSION

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The decision of the examiner to reject claims 1, 3 through 7, 9 through 13, 15 through 19, 21 through 26 and 28 through 36 under 35 U.S.C. § 112, first and second paragraphs, is reversed. The decision of the examiner to reject claims 1, 3 through 7, 9 through 13, 15 through 19, 21 through 26 and 28 through 36 under 35 U.S.C. § 103 over Weil is reversed.

The decision of the examiner to reject claims 1, 3 through 7, 9 through 13, 15 through 19, 21 through 26 and 28 through 36 under 35 U.S.C. § 103 over Ales in view of Weil is affirmed.

Additionally, this panel of the board has introduced new grounds of rejection pursuant to 37 CFR § 1.196(b).

Since at least one rejection of each of the appealed claims has been affirmed, the decision of the examiner is affirmed.

In addition to affirming the examiner's rejection of one or more claims, this decision contains new grounds 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,

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1997)). 37 CFR § 1.196(b) provides that "[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) Appellant 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 appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds 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

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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 for rehearing
thereof.

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

AFFIRMED
37 CFR 1.196(b)

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	HARRISON E. McCANDLISH)	
	Senior Administrative Patent Judge)	
)	
)	
)	BOARD OF
PATENT			
	NEAL E. ABRAMS)	APPEALS AND
	Administrative Patent Judge)	
INTERFERENCES)	
)	
)	
	JOHN F. GONZALES)	
	Administrative Patent Judge)	

jfg/vsh

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