

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. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MASAMITSU YAMAMOTO, TAKAMITSU IGAUE,  
YOSHIHISA FUJIOKA and HIROTOMO MUKAI

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Appeal No. 2000-0301  
Application No. 08/690,402

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ON BRIEF

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Before COHEN, ABRAMS, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 7, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a disposable diaper (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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

Lawson 1987	4,695,278	Sep. 22,
Enloe 1987	4,704,116	Nov. 3,
Foreman 1988	4,738,677	Apr. 19,
Igaue et al. 1990 (Igaue)	4,904,251	Feb. 27,
Robertson 25, 1991	5,026,364	June
Kido Apr. 20, 1994	GB 2,271,501	

Claims 1 to 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kido in view of Enloe, Lawson, Foreman, Igaue and Robertson.

Claims 1 and 4 to 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Enloe in view of Lawson, Foreman, Igaue and Robertson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 30, mailed April 14, 1999) for the examiner's complete reasoning in support of the rejections, and to the substitute appeal brief (Paper No. 29, filed January 4, 1999) and reply brief (Paper No. 31, filed June 14, 1999) 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 1 to 7 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<sup>1</sup> that would

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<sup>1</sup> 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., Inc. 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). 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 (continued...)

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).

The appellants argue that the applied prior art does not suggest the claimed subject matter. Specifically, the appellants assert (brief, pp. 4-13) that the "pair of elasticized cuffs" as set forth in the independent claims on appeal (i.e., claims 1 and 6) are not suggested by the applied prior art absent the use of impermissible hindsight.<sup>2</sup> More specifically, the appellants argue that the applied prior art does not teach or suggest the claimed pair of elasticized cuffs including "a substantially crescent-shape portion" or "a

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<sup>1</sup>(...continued)  
In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

<sup>2</sup> The use of hindsight knowledge derived from the appellants' own disclosure to support an obviousness rejection under 35 U.S.C. § 103 is 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).

crescent-shape portion" as recited in the claims under appeal.

All the claims under appeal require the claimed pair of elasticized cuffs to include either "a substantially crescent-shape portion" as recited in claim 1 or "a crescent-shape portion" as recited in claim 6. However, it is our opinion that these limitations are not taught or suggested by the combined teaching of the applied prior art.

To supply this omission in the teachings of the applied prior art, the examiner made determinations (answer, pp. 4-10) that this difference does not provide any new result or solve any recognized problem in the art and that the cuffs of Kido are "substantially crescent-shaped."

In proceedings before the United States Patent and Trademark Office (USPTO), the USPTO applies to the verbiage of the claims before it the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever

enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the appellants' specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See also In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). When this is done, we conclude that the term "crescent-shape" as used in the claims under appeal means a shape having concave and convex edges terminating in points.<sup>3</sup>

Clearly, the cuffs of Kido are not "substantially crescent-shaped" or "crescent-shaped" since they are shown to be "segment-shaped."<sup>4</sup> Moreover, none of the cuffs of Enloe, Lawson, Foreman, Igaue or Robertson are "substantially crescent-shaped" or "crescent-shaped." Thus, the applied prior art does not teach or suggest the claimed "substantially crescent-shaped" cuffs or "crescent-shaped" cuffs.

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<sup>3</sup> In reaching this conclusion we have utilized the definition of "crescent" provided on page 5 of the brief as well as the appellants use of that term in describing cuffs 10 and 10A (see Figure 1 and pages 7-9 of the specification).

<sup>4</sup> A segment is the area bounded by a chord and the arc of a curve subtended by the chord.

As set forth above, 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. The mere fact that a difference (between the teachings of the prior art and the claimed subject matter) does not provide any new result or solve any recognized problem does not, *ipso facto*, make that difference obvious under 35 U.S.C. § 103. Thus, we view the examiner's reliance (answer, p. 7) on In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) to be misplaced in this instance.

In our view, the only possible suggestion for modifying the applied prior art in the manner proposed by the examiner to meet the "cuff" limitations of the claims under appeal 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. It follows that we cannot sustain the examiner's rejections of claims 1 to 7.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 7 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
NEAL E. ABRAMS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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