

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 13

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte JOSEPH M. ARMBRUSTER and  
SUE B. ARMBRUSTER

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Appeal No. 2001-1037  
Application No. 08/550,002

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ON BRIEF

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Before WINTERS, WILLIAM F. SMITH, and SCHEINER, Administrative Patent Judges.  
WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 1, 3, 4, and 15. Claims 5 through 14, which are the only other claims remaining in the application, stand objected to as depending from a rejected claim.

Representative Claim

Claim 1, which is illustrative of the subject matter on appeal, reads as follows:

1. A shaving system including a method of shaving without requiring the presence of a source of water to wash, wet or soak the skin surface area to be shaved consisting of the steps of applying a shaving product in the form of a thin transparent film of lubricant gel cream to a dry, unwetted skin surface area to be shaved without prior application of water to the skin surface area, said transparent film of gel cream

leaving the hair shaft in unwetted erect substantially rigid condition and in generally perpendicular relation to the skin surface area to be shaved and enable observation of skin blemishes, pimples, and moles by a person when moving a razor and blade assembly along the skin surface area to eliminate cutting, nicking and scraping of the skin blemishes, pimples, and moles, moving a razor and blade assembly along the skin area in a manner to cut the erect hair with a straight transverse cut in substantially perpendicular relation to the hair shaft in close proximity to the skin surface area and entrain cut hair in the gel cream, removing the razor and blade assembly and gel cream from contact with the skin surface area after cutting the hair therefrom and manually rubbing residual shaving product into the shaved skin surface area and other skin areas without applying water to the shaved skin surface area for washing off the shaving product with the residual shaving product providing skin enhancement and protection.

#### The Prior Art Reference

The prior art reference relied on by the examiner is:

Moore

5,387,412

Feb. 7, 1995

#### The Issue

The issue presented for review is whether the examiner erred in rejecting claims 1, 3, 4, and 15 under 35 U.S.C. § 102(e) as anticipated by Moore.

#### Deliberations

Our deliberations in this matter have included evaluation and review of the following materials: (1) the instant specification, including all of the claims on appeal; (2) applicants' Appeal Brief received November 3, 1998 (Paper No. 11); (3) the

Examiner's Answer (Paper No. 12) and the Office action mailed by the examiner March 13, 1997 (Paper No. 4); and (4) the above-cited prior art reference.

On consideration of the record, including the above-listed materials, we reverse the examiner's rejection under 35 U.S.C. § 102(e).

#### Discussion

Initially, we note that applicants' claims are couched in terms of a shaving system; but the "system" is but a method of shaving consisting of four manipulative steps. This anomalous manner of claim drafting has given us pause - and some measure of difficulty - in evaluating the merits of the appeal. As best we can judge, the claims cover a method of shaving consisting of four steps and, on that basis, we have reviewed the examiner's rejection. We note that applicants themselves characterize their claims as drawn to a method of shaving (Appeal Brief, Paper No. 11, section V SUMMARY OF INVENTION; and paragraph bridging pages 6 and 7).

On return of this application to the Examining Corps, we recommend that applicants and the examiner consider whether it would be more appropriate or more accurate to amend the claims so that they are not couched in terms of a shaving system; but instead are drawn, in a straightforward manner, to a method of shaving.

For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 677, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988). Here, the examiner has not established that Moore describes the gel cream limitation recited in claim 1. Accordingly, the examiner has not established a prima

facie case of anticipation under 35 U.S.C. § 102.

As best we can understand, the examiner believes that Moore's aqueous solution fully meets the gel cream limitation of independent claim 1. On its face, however, an aqueous solution is not a gel cream. The examiner argues that Moore's aqueous solution "would change [its] consistency to that of what would be considered a gel cream" when applied to the skin in the manner disclosed in the reference.

(Examiner's Answer, page 4). That argument, however, is speculative and not supported by adequate evidence in the record. If the examiner's position is based on inherency, we remind the examiner that:

Inherency, however, 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 Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999), quoting In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981).]

Simply stated, the examiner has not furnished evidence of record making clear that the missing descriptive matter, viz., a thin transparent film of lubricant gel cream, is necessarily present in the method disclosed by Moore.

Furthermore, we agree with applicants (Appeal Brief, page 5) that Moore does not describe, expressly or inherently, the step of "manually rubbing residual shaving product into the shaved skin surface area and other skin areas without applying water to the shaved skin surface area for washing off the shaving product with the residual shaving product providing skin enhancement and protection" as recited in independent claim 1. For this reason too, the examiner has not established a prima facie case of anticipation of the appealed claims under 35 U.S.C. § 102(e) based on teachings found in Moore.

The examiner's decision is reversed.

REVERSED

Sherman D. Winters  
Administrative Patent Judge

William F. Smith  
Administrative Patent Judge

Toni R. Scheiner  
Administrative Patent Judge

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