

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DUANE KENNETH ZACHARIAS, YUNG HSIANG HUANG,
and
FRANK GERALD DRUECKE

Appeal No. 2002-0741
Application No. 08/935,348

HEARD: NOVEMBER 6, 2002

Before COHEN, STAAB, and BAHR, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1-20, all the claims currently pending in the application.

According to appellants, the present application is a continuation-in-part of 08/659,858 filed by appellants on June 7, 1996, now U.S. Patent 6,213,993 B1. In a decision rendered January 31, 2000 in Appeal No. 1998-2834 in the parent '858 application, this merits panel affirmed-in-part rejections of the

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claims under appeal therein under 35 U.S.C. § 103. The subject matter of the appealed claims in the present application is similar to the subject matter of the appealed claims in the prior appeal.

As stated on page 1 of the specification, "[t]he present invention relates to a disposable absorbent article having a body-facing adhesive to be positioned against a wearer's skin. In one aspect, the invention relates to a catamenial device having a supportive adhesive residing on the body-side surface of the device."

The references cited in the final rejection are:

Lichstein	5,658,270	Aug. 19, 1997
Paul	5,559,165	Sep. 24, 1996
Vukos (published Great Britain Patent Application)	GB 2 284 767 A	Jun. 12, 1995
Zacharias et al. (published World Intell. Prop. Org. Application) (hereinafter referred to as Zacharias PCT '238)	WO 96/13238	May 9, 1996

The following rejections are before us for review:¹

(a) claims 1-20, rejected under 35 U.S.C. § 112, first paragraph, "as based on a disclosure which is not enabling"

¹In the final rejection, claims 1-20 were also rejected under 35 U.S.C. § 112, second paragraph. In that this rejection was not included in the examiner's answer, it is presumed to have been withdrawn. *Ex parte Emm*, 118 USPQ 180, 181 (Bd. App. 1957).

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(answer, page 3);

(b) claims 13-19, under 35 U.S.C. § 102(b), as being anticipated by Zacharias PCT '238;

(c) claim 20, under 35 U.S.C. § 103(a), as being unpatentable over Zacharias PCT '238 in view of Lichstein and Vukos;

(d) claims 1, 4-6 and 8-12, under 35 U.S.C. § 102(b), as being anticipated by Zacharias PCT '238;

(e) claims 1, 2, 4-6 and 8-12, under 35 U.S.C. § 103(a), as being unpatentable over Zacharias PCT '238 in view of Paul; and

(f) claims 3 and 7, under 35 U.S.C. § 103(a), "as being unpatentable over Zacharias et al[.], alone, in view of Lichstein or Vukos, or in the alternative, Zacharias et al[.] and Paul, in view of Lichstein and Vukos" (answer, page 6).

Attention is directed to appellants' main² and reply briefs (Paper Nos. 15 and 17) and to the examiner's answer (Paper No. 16) for the respective positions of appellants and the examiner

²Our reference to "main brief" throughout this decision is with respect to the supplemental main brief filed January 12, 2000 (Paper No. 15).

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regarding the merits of these rejections. Appellants' position relies in part on the declaration under 37 CFR § 1.131 and attached exhibits filed November 1, 1999 (Paper No. 7).

DISCUSSION

Rejection (a): the rejection of claims 1-20 under 35 U.S.C. § 112, first paragraph

In rejecting claims 1-20 as being based on a disclosure that is not enabling, the examiner considers (answer, pages 3-4) that

. . . [a]t the most, dimensions, weights, concentrations, symmetrical patterns, a hot melt adhesive as set forth at [various places in the specification] . . . [are] critical or essential to the practice of the invention, but not included in the claim(s) . . . [, therefore the claims are] not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). At the very least . . . the description of the invention . . . [in the specification] is unclear and inconsistent with regard to what structure at a minimum is required.

We comprehend this rejection to be based on the examiner's view that certain features that are disclosed by appellants in the specification as being critical to the invention are not included in the claims. As we understand it, the examiner considers that the claims are based on a nonenabling disclosure because appellants have not taught how to achieve the desired effect of the invention (i.e., a disposable absorbent article that may be securely adhered to a user's skin, yet releasable

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cleanly with minimum discomfort when desired) in the absence of such allegedly critical features. In support of this rationale, the examiner cites *In re Mayhew*, 527 F.2d 1229, 1233, 188 USPQ 356, 358 (CCPA 1976) for the proposition that a claim that fails to recite a feature which is taught as critical in the specification should be rejected under the enablement requirement of that paragraph of the statute.

As noted above, appellants' invention is directed to a catamenial device having a supportive adhesive residing on the body-side surface of the device. Our review of appellants' disclosure reveals that the specification expressly states at page 3, lines 9-18, that *very few* adhesive compositions are completely satisfactory for application to human skin and that the requirements for such adhesives are *stringent*. Appellants' specification also expressly states at page 3, line 19, through page 4, line 7, that adhesives of the type used in appellants' invention that are applied to certain sensitive areas of the human body require *further special characteristics* because, among other things, hair covered regions are especially difficult to adhere to without causing pain upon removal of the adhered article. Throughout the specification, various "aspects" of the invention, including the rheological, chemical, and physical

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properties of the adhesive used to adhere the device to a user's skin are described. Concerning said rheological properties, appellants' specification expressly states that

[i]t is *critical* to the article of the present invention that the adhesive have a rheology property, tan delta (referenced at 20° Centigrade), ranging from about 0.01 to about 0.6 and preferably from about 0.06 to about 0.48 and most preferably from about 0.06 to about 0.40 at a frequency of about 0.1 radians per second and a tan delta ranging from about 0.1 to about 1.7, preferably from about 0.20 to about 1.5 and most preferably from about 0.6 to about 1.5 at a frequency of about 1000 radians per second. [Page 24, lines 16-24; emphasis added.]

Based on the above noted *express* disclosures in the appellants' specification that the requirements of the adhesive used in the invention are *stringent* and *specialized* because of the adhesive's use in adhering the absorbent device to sensitive areas of the body, and the clear and unequivocal statement in appellants' specification at page 24, lines 16-24, that the specific rheological property set forth therein is *critical*, we conclude that the rheological property in question is indeed essential to appellants' invention. Neither independent claim 1, nor claims 2-12 that depend therefrom, include this subject matter which we have determined to be essential to appellants' invention. In view of this lack of essential subject matter in claims 1-12, we conclude, as did the examiner, that a rejection

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of these claims as being based on a nonenabling disclosure is justified. See *In re Mayhew*, 527 F.2d 1229, 1233, 188 USPQ 356, 358 (CCPA 1976) (“[C]laims which fail to recite the use of a cooling zone, specially located [said feature being taught as critical in the disclosure], are not supported by an enabling disclosure. Rejection[] . . . [under 35 U.S.C. § 112, paragraph one], . . . will therefore be sustained”). Akin to the situation in *Mayhew*, claims 1-12 are not supported by an enabling disclosure because appellants’ disclosure does not teach how to achieve the desired effect of the invention (i.e., a disposable absorbent article securely adhered to a user’s skin, yet releasable with minimum discomfort) in the absence of the rheological property expressly stated to be “critical to the article of the present invention” (page 24, line 16; emphasis added).

In reaching our conclusion in this matter, we have given careful consideration to the case of *In re Goffe*, 542 F.2d 564, 191 USPQ 429 (CCPA 1976) cited in Section 2164.08(c) of the *Manual of Patent Examining Procedure*. In *Goffe*, the court stated at 542 F.2d 567, 191 USPQ 432, that in determining whether an unclaimed feature is critical, (1) the entire disclosure must be considered, (2) broad language in the disclosure omitting the

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allegedly critical feature tends to rebut the argument of criticality, and (3) features that are merely preferred are not critical. While we appreciate that there are portions of appellants' disclosure (e.g., page 13, line 12, through page 14, line 7) that generally track the language of claims 1-12 with respect to the properties of the adhesive recited in these claims, it is not apparent, and appellants have not argued, that adhesives having the characteristics of claims 1-12 necessarily possess the rheological property expressly stated in appellants' specification as being *critical* to the present invention. Based on our reading of the specification in its entirety, and in particular those portions noted above that very few adhesive compositions are completely satisfactory for appellants' purpose, that the requirements for such adhesives are *stringent*, that adhesives of the type used in appellants' invention that are applied to sensitive areas of the human body require *further special characteristics*, and that the rheology property, tan delta, described on page 24, lines 16-24, is *critical* to the present invention, we conclude that the examiner was justified in rejecting claims 1-12 under 35 U.S.C. § 112, first paragraph, as not being supported by an enabling disclosure.

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Appellants' argument on pages 14-15 of the main brief and page 3 of the reply brief implies that the rheological property taught as critical in the specification and not recited in claims 1-12 is optional. This line of reasoning is no more persuasive here than it was in *Mayhew*. In short, appellants' specification does not support the argument that the rheological property disclosed at page 24, lines 16-24, is optional. In view of the above, the rejection of claims 1-12 under 35 U.S.C. § 112, first paragraph, is sustained.

We reach an opposite conclusion with respect to claims 13-20. Unlike claims 1-12, claims 13-20 include the essential rheological property stated to be essential to the invention. Accordingly, our rationale for sustaining the examiner's rejection of claims 1-12 does not apply to these claims. As to the examiner's position that other disclosed features of the invention, such as the weight per unit area of adhesive applied to the body-facing surface of the article, are not recited in claims 13-20, we do not consider such disclosed but unclaimed features to be essential to the invention. Hence, the standing 35 U.S.C. § 112, first paragraph, rejection of these claims will not be sustained.

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Rejection (b): the rejection of claims 13-19 under 35 U.S.C. § 102(b)

Claims 13-19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Zacharias PCT '238.

Appellants do not dispute the examiner's determination that Zacharias PCT '238 anticipates claims 13-19 in the event it qualifies as prior art under 35 U.S.C. § 102(b). Instead, appellants argue on page 17 of the main brief that (1) the present application is a continuation-in-part of application 08/659,858 filed June 7, 1996, which is a continuation of earlier application 08/331,072 filed October 28, 1994, (2) the present application is entitled under 35 U.S.C. § 120 to the benefit of the earlier filing date of October 28, 1994 of the '072 application, and (3) the critical reference date of Zacharias PCT '238 under 35 U.S.C. § 102(b) is May 9, 1996, the international publication date thereof. Thus, appellants maintain that Zacharias PCT '238 is not available as prior art against claims 13-19 under 35 U.S.C. § 102(b).

We agree with appellants that the critical reference date of Zacharias PCT '238 under 35 U.S.C. § 102(b) is May 9, 1996. Based on this date, and the relevant dates of the related 08/331,072 and 08/659,858 applications, it is both necessary and

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sufficient that claims 13-19 be accorded the filing date of the '858 application in order to disqualify Zacharias PCT '238 as prior art under 35 U.S.C. § 102(b).³ Thus, the dispositive issue with respect to this rejection is whether claims 13-19 should be accorded the filing date of continuation-in-part application 08/659,858 filed by appellants on June 7, 1996.

When a continuation-in-part application contains claims that are not supported by the parent application, the effective filing date of the claims in the child continuation-in-part application is the filing date of the child application. Any prior art disclosing the invention having a critical reference date more than one year prior to the filing date of the child will bar the issuance of a patent under 35 U.S.C. § 102(b). *Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys.*, 804 F.2d 659, 665, 231 USPQ 649, 652-53 (Fed. Cir. 1986), *cert. denied*, 480

³It is *necessary* that claims 13-19 be accorded the filing date of the '858 application because earlier application 08/331,072 and the present application were never copending. Thus, if claims 13-19 cannot be accorded the filing date of the '858 application, the chain of copendency is broken and claims 13-19 cannot be accorded the filing date of the earlier '072 application. It is *sufficient* that claims 13-19 be accorded the filing date of June 7, 1996 of the '858 application because if they are accorded this date, the critical reference date of Zacharias PCT '238 would not be more than one year prior to the effective date of the subject matter of claims 13-19, as required by 35 U.S.C. § 102(b).

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U.S. 933 (1987). See also *In re Chu*, 66 F.3d 292, 297, 36 USPQ2d 1089, 1093 (Fed. Cir. 1995) and *In re Van Langenhoven*, 458 F.2d 132, 136, 173 USPQ 426, 429 (CCPA 1972).

In the present case, descriptive support within the meaning of 35 U.S.C. § 112, first paragraph, for the subject matter of claims 13 and 14 is found at column 1, lines 53-76, and column 5, lines 6-22 of U.S. Patent 6,213,993 B1, which issued from parent application 08/659,858. In addition, descriptive support for claim 15 is found at column 4, lines 19-23, descriptive support for claim 16 is found at column 4, lines 10-15, descriptive support for claim 17 is found in patent claim 5, and descriptive support for claims 18 and 19 is found at column 5, lines 43-55. Hence, claims 13-19 are entitled to the filing date of the '858 application and Zacharias PCT '238 is not a reference under 35 U.S.C. § 102(b) with respect to these claims.

The examiner's contention on pages 6 and 7 of the answer that appellants' claims 13-19 are not entitled to the benefit of an earlier filing date because the specification does not include a proper CIP declaration is noted. To the extent appellants have not complied with any of the formal requirements of 35 U.S.C. § 120, any such informality should be remedied upon return of the present case to the Technology Center.

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In light of the foregoing, the rejection of claims 13-19 under 35 U.S.C. § 102(b) will not be sustained.

Rejection (c): the rejection of claim 20 under 35 U.S.C. § 103(a)

Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Zacharias PCT '238 in view of Lichstein and Vukos.

Independent claim 20 is directed to a sanitary napkin having a body-side adhesive. In addition to the rheology property for the adhesive found in paragraph (c), claim 20 sets forth that (1) the body-facing surface of the cover has "a longitudinal dimension less than 9 inches and a transverse dimension less than 3.5 inches," and (2) the adhesive has "an adhesive weight less than 1500 mg per square inch." We have searched the disclosure of appellants' application 08/659,858 in vain for any descriptive support for the above noted claim elements (1) and (2).⁴ Finding none, we conclude that claim 20 is not entitled to an earlier

⁴Concerning claim element (2), we find that the disclosure of the '858 application which corresponds to column 7, lines 15-18 of U.S. Patent 6,213,993 B1 that "[t]otal adhesive add on to the spunbond was approximately 263 grams per square meter" (i.e., approximately 170 mg per square inch) does not provide descriptive support for the claim limitation that the adhesive has an adhesive weight in the range "less than 1500 mg per square inch."

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filing date, and that, as a consequence, Zacharias PCT '238 is available as prior art against claims 13-19 under 35 U.S.C. § 102(b).

In rejecting claim 20 under 35 U.S.C. § 103(a), the examiner relies on Vukos (see page 25, lines 16-24) and Lichstein (see paragraph bridging columns 6 and 7) for their disclosures of appropriate lengths and widths for absorbent sanitary protection products, and Lichstein (see column 7, line 45, through column 8, line 39) for its teaching of appropriate coating weight of adhesives for attaching an absorbent sanitary protection product directly to hair and/or skin. The examiner concludes that it would have been obvious to one of ordinary skill in the art to provide the sanitary protection article of Zacharias PCT '238 with longitudinal and transverse dimensions within the claimed range, and with the adhesive weight within the claimed range, in view of the teachings of Vukos and Lichstein noted above.

The examiner's position is reasonable on its face and has not been disputed with any reasonable degree of specificity by appellants. In this regard, appellants' general argument on pages 18-19 of the main brief to the effect that neither Vukos nor Lichstein disclose *all* of the limitations found in the paragraph (c) of claim 20 is not persuasive of error on the

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examiner's part because it fails to take into account that most of these limitations are found in Zacharias PCT '238, which we have found to be available as prior art against claim 20 under 35 U.S.C. § 102(b). Accordingly, as argued, the rejection of claim 20 under 35 U.S.C. § 103(a) will be sustained.

Rejection (d): the rejection of claims 1, 4-6 and 8-12 under 35 U.S.C. § 102(b)

Claims 1, 4-6 and 8-12, stand rejected under 35 U.S.C. § 102(b) as being anticipated by Zacharias PCT '238.

Independent claim 1 is directed to a sanitary napkin comprising an absorbent core, and a hot melt, pressure sensitive adhesive secured to the body-side surface of the core. As set forth in paragraph (b) of claim 1, the adhesive comprises

at least one block copolymer and a liquid diluent, the adhesive being characterized by a midblock Tg of less than -10° C., a G' (storage modulus) less than 15×10^4 dynes/cm² at 10 rad/s. (25° C.), a G'' (loss modulus) of 1 to 6×10^4 dynes/cm², a tensile strength greater than 10 psi, and which adhesive requires no subsequent curing operation after cooling.

Appellants have not pointed out, and it is not apparent to us, where there is descriptive support in application 08/659,858, now U.S. Patent 6,213,993 B1, for this subject matter. Finding no such descriptive support, we conclude, as did the examiner, that claim 1, as well as claims 4-6 and 8-12 that depend

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therefrom, are not entitled to the filing date of the earlier filed '858 application. *Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys.*, 804 F.2d at 665, 231 USPQ at 652-53. As a consequence, Zacharias PCT '238 is available as prior art against claims 1, 4-6, and 8-12 under 35 U.S.C. § 102(b).

In rejecting these claims as being anticipated by Zacharias PCT '238, the examiner implicitly acknowledged that Zacharias PCT '238 does not expressly set forth that the adhesive thereof possesses the properties called for in paragraph (c) of claim 1. The examiner determined, however, that these properties "are inherent in the adhesives set forth in Zacharias, since the structure as claimed is taught thereby, see MPEP [§] 2112.01" (answer, page 5).

Where an examiner has reason to believe that a property asserted as establishing novelty may, in fact, be an inherent characteristic of the prior art, the examiner possesses the authority to require an appellant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. *See, for example, In re Swinehart*, 439 F.2d 210, 213, 169 USPQ 226, 229 (CCPA 1971). However, before an appellant can be put to that task, the examiner must provide some evidence or convincing scientific reasoning to establish the

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reasonableness of the examiner's belief that the property in question is indeed an inherent characteristic of the prior art. In the present case, no such evidence or convincing reasoning has been set forth by the examiner. Absent such evidence or reasoning on the part of the examiner as to why the properties set forth in paragraph (c) of claim 1 flow as a natural result from the adhesive disclosed by Zacharias PCT '238, we are constrained to conclude that the examiner has not made out a *prima facie* case of anticipation. See *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323 326 (CCPA 1981) (the mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency).

In light of the above, the standing rejection of claims 1 and 4-6 and 8-12 as being anticipated by Zacharias PCT '238 will not be sustained.

Rejection (e): the rejection of claims 1, 2, 4-6 and 8-12 under 35 U.S.C. § 103(a)

Claims 1, 2, 4-6 and 8-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zacharias PCT '238 in view of Paul.

For the reasons discussed above in our treatment of the examiner's anticipation rejection of claims 1, 4-6 and 8-12,

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claims 1, 2, 4-6 and 8-12 are not entitled to the filing date of the earlier filed '858 application. Hence, Zacharias PCT '238 is available as prior art under 35 U.S.C. § 102(b) against these claims.

Zacharias PCT '238 discloses a sanitary napkin article provided with a hot melt, pressure sensitive adhesive on the body-facing surface for securement of the article to the wearer (page 4, lines 6-11). The adhesive has a rheological property that allows for secure adherence to the wearer's skin, yet releases cleanly with minimum discomfort. Zacharias PCT '238 does not expressly set forth that the adhesive thereof meets the claim limitations of paragraph (c) of claim 1, or of claim 2.

Paul pertains to hot melt, pressure sensitive adhesives "which adhere well to the human skin and hair, and are therefore useful for a variety of medical and other products" (column 1, lines 8-10). The adhesives of Paul are characterized by the properties called for in appealed claim 1 (paragraph (c)) and appealed claim 2. See, for example, column 1, line 54, through column 2, line 6, of Paul. As explained by Paul in the

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background section of the specification, the requirements for adhesives for application to the skin are stringent. The adhesives must

adhere well to human skin during perspiration, when the weather is hot, or in an environment of draining wounds, yet be removable without leaving adhesive residue on the skin's surface. Moreover, adhesion should take effect immediately on application to skin, even in a hot or moist environment, and should release cleanly and with minimal discomfort when voluntarily removed in this environment. [Column 1, lines 13-20.]

Paul also observes that "[a]dhesives applied to sensitive areas of the human body require further special characteristics. Hair covered regions are especially difficult to adhere well to without causing pain upon removal of the adhered article" (column 1, lines 21-24). Paul indicates that the adhesives disclosed therein meet these objectives. Thus, Paul's adhesives "[are] especially suited for adhesive skin application" (columns 54-55).

The above noted teachings of Zacharias PCT '238 and Paul would have provided ample motivation to one of ordinary skill in the art to have utilized the hot melt, pressure sensitive adhesives of Paul in the sanitary napkin article of Zacharias PCT '238. Appellants do not argue that the combination proposed by the examiner would not have been obvious or that the resulting modified Zacharias PCT '238 article would not correspond to the

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subject matter of appealed claims 1, 2, 4-6 and 8-12. Instead, appellants contend that Paul does not qualify as prior art under 35 U.S.C. § 102(e) because the filing date of Paul (August 8, 1995) is after the date appellants completed their invention. In support of this position, appellants have submitted a declaration under 37 CFR § 1.131 for the purpose of swearing behind the filing date of Paul.

A threshold issue with respect to this rejection is whether 37 CFR § 1.131 is available to appellants to swear behind the filing date of the Paul reference. In this regard, 37 CFR § 1.131, in pertinent part, states that

Prior invention may not be established under this section if . . . :

(1) The rejection is based upon a U.S. patent or U.S. patent application publication of a pending or patented application to another or others which claims the *same patentable invention as defined in § 1.601(n)*. . . . [Emphasis added.]

37 CFR § 1.601(n) states that

(n) Invention "A" is the *same patentable invention* as an invention "B" when invention "A" is the same as (35 U.S.C. § 102) or is obvious (35 U.S.C. [§] 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A". Invention "A" is a *separate patentable invention* with respect to invention "B" when invention "A" is new (35 U.S.C. [§] 102) and non-obvious (35 U.S.C. [§] 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A".

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In applying the test set forth in 37 CFR § 1.601(n), we will assume that the test for same patentable invention involves a two-way patentability analysis. See *Winter v. Fujita*, 53 USPQ2d 1234, 1243 (Bd. Pat. App. & Int. 2000).

Assuming that Paul's claims 1 and 2 are prior art with respect to appealed claims 1 and 2, it would have been obvious to one of ordinary skill in the art to have utilized the claimed pressure sensitive hot melt adhesive of Paul as a body-side adhesive for securing a sanitary napkin article to a wearer in view of the teachings of Zacharias PCT '238. The additional limitations set forth in appealed claims 4-6 and 8-12 also do not patentably distinguish over the combination of Paul's claims 1 and 2 and Zacharias PCT '238. More particularly, the limitations of appealed claims 4-6 are taught by and would have been obvious in view of the disclosures found in Zacharias PCT '238 at page 8, lines 23-26; page 6, lines 16-19; and page 6, lines 10-12, respectively, and the limitations of appealed claims 8-12 are taught by and would have been obvious in view of the disclosures found in Zacharias PCT '238 at claims 8-12 thereof.

Assuming that appealed claims 1, 2, 4-6 and 8-12 are prior art with respect to claims 1 and 2 of Paul, claim 1 of Paul lacks novelty over appealed claim 1 because the hot melt pressure

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sensitive adhesive of appealed claim 1 has all the properties for the adhesive set forth in claim 1 of Paul. As to claim 2 of Paul, the hot melt pressure sensitive adhesive of appealed claim 2 includes all the components of the adhesive recited in claim 2 of Paul in the concentrations called for therein. Appealed claim 2 does not expressly state that (1) the "high molecular weight" components thereof (i.e., the rubber triblock or radial block copolymer, the diblock rubber, and the other compatible weight polymer) each have a viscosity within the range called for in claim 2 of Paul⁵, or that (2) the rubber copolymer is an A-B-A block copolymer where block A is a non-elastomeric polymer and blocks B are isoprene or butadiene.

As to (1), we initially note that in proceedings before it, the PTO applies to verbiage of claims 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

⁵Paul's claim 2 states that each of these components to have a viscosity at 25° C. of above 1,000 cP in toluene at a concentration of 20% by weight.

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USPQ2d 1023, 1027 (Fed. Cir. 1997). With this principle in mind, we consider that an artisan would understand the "high molecular weight" components of appealed claim 2 to have a viscosity within the range called for in Paul's claim 2 for these components based on the definition of "high molecular weight rubber" expressly set forth in appellants' specification at page 14, lines 8-10.⁶

Concerning (2), it would have been obvious to one of ordinary skill in the art to have utilized a rubber copolymer corresponding to that called for in Paul's claim 2 in the adhesive of appealed claim 2 based on the teaching of Zacharias PCT '238 at page 9, lines 21-28, that the preferred rubber based adhesive thereof comprises block copolymers of styrene-butadiene-styrene, styrene-isoprene-styrene, styrene-ethylenepropylene-styrene, or styrene-ethylenebutylene-styrene.

It follows from the above that the subject matter of claims 1 and 2 of Paul and the subject matter of appealed claims 1, 2, 4-6 and 8-12 are the *same patentable invention* within the meaning of 37 CFR § 1.601(n). Accordingly 37 CFR § 1.131 is *not*

⁶Page 14, lines 8-10, read as follows:

As used herein, the term "high molecular weight rubbers" are those with a viscosity at 25° C. of above 1,000 centipoise in toluene at a concentration of 20% by weight.

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available to appellants to swear behind the filing date of the Paul reference. In that appellants have not otherwise challenged the positions taken by the examiner in concluding that claims 1, 2, 4-6 and 8-12 are unpatentable over Zacharias PCT '238 in view of Paul, the rejection of claims 1, 2, 4-6 and 8-12 under 35 U.S.C. § 103 will be sustained.

Rejection (f): the rejection of claims 3 and 7 under 35 U.S.C. § 103(a)

Claims 3 and 7 stand rejected under 35 U.S.C. § 103(a) "as being unpatentable over Zacharias et al, alone, in view of Lichstein or Vukos, or in the alternative, Zacharias et al and Paul, in view of Lichstein and Vukos." We understand this rejection to be based on the combined teachings of Zacharias PCT '238, Paul, Lichstein and Vukos.

Appellants argue that Zacharias PCT '238 is not available as prior art against claims 3 and 7 under 35 U.S.C. § 102(b). Claims 3 and 7 depend either directly or indirectly from claim 1 and therefore include all the limitation of that base claim. For the reasons discussed above in our treatment of the anticipation rejection of claims 1, 4-6 and 8-12 (i.e., rejection (d)), this argument is not well taken.

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Appellants also argue that Paul does not qualify as prior art under 35 U.S.C. § 102(e) because the filing date of Paul (August 8, 1995) is after the date appellants completed their invention. Claim 3 adds to claim 1 that the major surface of the sanitary napkin (i.e., the surface to be positioned against a wearer's skin) "has a longitudinal dimension less than 9 inches and a transverse dimension less than 3.5 inches." Claim 7 depends from claim 1 through claim 5 and adds that the adhesive is applied "to provide an adhesive weight less than about 1500 mg/in²." Claims 3 and 7 are directed to the *same patentable invention* as Paul's claims 1 and 2 because the limitation added by claim 3 is taught by and would have been obvious in view of the disclosures of Vukos (see page 25, lines 16-24) and Lichstein (see paragraph bridging columns 6 and 7), and because the limitation added by claim 7 is taught by and would have been obvious in view of the disclosure of Lichstein (see column 7, line 45, through column 8, line 39). Accordingly, 37 CFR § 1.131 once against is *not* available to appellants to swear behind the filing date of the Paul reference.

The only other arguments made by appellants specifically directed to the Section 103(a) rejection of claims 3 and 7 is found on page 24 of the main brief, wherein appellants argue that

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neither Lichstein nor Vukos teach or suggest a hot melt pressure sensitive adhesive having the properties set forth in paragraph (c) of appealed claim 1. This argument fails at the outset, however, because it does not take into account that the rejection is based on the *combined* teachings of Zacharias PCT '238, Paul, Lichstein and Vukos.

In light of the foregoing, the rejection of claims 3 and 7 under 35 U.S.C. § 103(a) will be sustained.

REMAND

This case is remanded to the examiner for consideration of the following matters.

This application appears to be a *voluntarily filed* continuation-in-part application of 08/659,858, now U.S. Patent 6,213,993. The examiner should determine whether the subject matter claimed in the present application is patentably distinct from the claimed subject matter in the '993 patent, either alone or in combination with other prior art of which the examiner may be aware. In the event it is determined that any claim of the present application is not patentably distinct from the claimed subject matter of the '993 patent, an appropriate rejection under the judicially created doctrine of obviousness-type double patenting should be made.

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As noted at the outset, during prosecution of the parent '858 application, this merits panel affirmed-in-part rejections of claims under appeal therein under 35 U.S.C. § 103(a). The prior art relied upon in the affirmed rejections, most notably Japanese Laid Open application 6-9622 (Kao KK) and Kenny et al. "Medical-Grade Acrylic Adhesive for Skin Contact" *Journal of Applied Polymer Science*, vol. 45, pp. 355-61 (1922), remain prior art with respect to the claimed subject matter in the present application. The examiner should determine whether any claim of the present application is unpatentable over the combined teachings of Kao KK and Kenny, either alone or in combination with other prior art of which the examiner may be aware. In the event it is determined that any claim of the present application is unpatentable over such prior art, an appropriate rejection under 35 U.S.C. § 103(a) should be made.

SUMMARY

The rejection of claims 1-20 under 35 U.S.C. § 112, first paragraph, is affirmed as to claims 1-12, but is reversed as to claims 13-20.

The rejection of claims 13-19 under 35 U.S.C. § 102(b) is reversed.

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The rejection of claim 20 under 35 U.S.C. § 103(a) is affirmed.

The rejection of claims 1, 4-6 and 8-12 under 35 U.S.C. § 102(b) is reversed.

The rejection of claims 1, 2, 4-6 and 8-12 under 35 U.S.C. § 103(a) is affirmed.

The rejection of claims 3 and 7 under 35 U.S.C. § 103(a) is affirmed.

Further, this case is remanded to the examiner for consideration of the matters noted above.

The decision of the examiner is affirmed-in-part.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a remand. 37 CFR § 1.196(e) provides that

whenever a decision of the Board of Patent Appeals and Interferences includes or allows a remand, that decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

Regarding any affirmed rejection, 37 CFR § 1.196(b) provides:

Appellant may file a single request for rehearing within two months from the date of the original decision. . . .

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The effective date of the affirmance in this case is deferred until conclusion of the proceedings before the examiner unless, as a mere incident to the limited proceedings, the affirmed rejection is overcome. If the proceedings before the examiner 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.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01.

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

AFFIRMED-IN-PART; REMANDED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

LJS:hh

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