

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte URBAN WIDLUND

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Appeal No. 2003-1406  
Application No. 09/335,723

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ON BRIEF

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Before WARREN, WALTZ and KRATZ, Administrative Patent Judges.  
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 18-23, which are all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to a shaped element for use in an absorbent product. An understanding of the invention can be derived from a reading of exemplary claim 18, which is reproduced below.

Appeal No. 2003-1406  
Application No. 09/335,723

Page 2

18. A shaped element for use in an absorbent product selected from the group consisting of a sanitary towel, an incontinence pad, and a panty liner; said shaped element having an essentially elongate shape with a longitudinal direction and a transverse direction, and comprising a first short side and a second short side, two long sides, a central portion, a first end portion extending from said first short side and a second end portion extending from said second short side; said first end portion being wider than the central portion and having a width which increases towards said first short side of the shaped element, and said second end portion being a bifurcated end portion comprising a first segment having a first edge extending in said longitudinal direction from said second short side towards said first short side, and a second segment having a second edge extending in said longitudinal direction from said second short side towards said first side, and said first edge being bonded to said second edge.

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

Buell	5,171,302	Dec. 15, 1992
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Claims 18-23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Buell.

We refer to the briefs and to the answer for a complete exposition of the opposing viewpoints expressed by appellant and the examiner concerning the issues before us in this appeal.

OPINION

Having carefully considered each of appellant's arguments set forth in the brief and reply brief, appellant has not persuaded us of reversible error on the part of the examiner. Accordingly, we will affirm the examiner's rejection for substantially the reasons set forth by the examiner in the answer. We add the following for emphasis.

Appellant states that the appealed claims are "not grouped separately for the purposes of the present appeal" (brief, page 5, item No. 7). Consequently, we select claim 18 as the representative claim in deciding this appeal. See 37 CFR § 1.192(c)(7)(2000).

The element recited in representative claim 18 is defined at least in part in terms of the process by which it is made. In this regard, the element is formed by bonding a first edge of a first segment to a second edge of a second segment as recited in the representative claim. The bonding results in a finished element that may have a shape as shown in appellant's drawing figure 3 as opposed to an unbonded blank with bifurcated segments as shown in drawing figure 1. We note that representative claim 18 does not require that the shaped element have a triangular wedged-shaped cutout as argued as a patentable distinction at page 7 of the brief. When the claim does not recite allegedly

distinguishable features, "appellant[s] cannot rely on them to establish patentability." See In re Self, 671 F.2d 1344, 1350-1351, 213 USPQ 1, 7 (CCPA 1982).

Furthermore, appellant contends that the examiner's reliance on the thermomolded central hinge (23a) as shown in drawing figure 24 of Buell to establish the obviousness of the here claimed bonded edges is misplaced. In this regard, appellant contends in the reply brief that the examiner is using the same feature (23A, figure 24) of Buell to read on appellant's separate edges of the first and second bifurcated segments. The difficulty we have with appellant's position stems from the fact that representative claim 18 calls for the edges of the separate segments to be bonded to each other. In other words, the claimed final product does not require bifurcated segments each having edges to be subsequently bonded but rather requires that the edges of those once separate segments have been bonded to each other. Such bonding results in a final product element having a broadly defined shape that reasonably embraces the shape of the product depicted in figure 24 of Buell as has been determined by the examiner.

While we agree with appellant that the product of figure 24 of Buell may have been made by a somewhat different process than

that called for in appellant's product-by-process claim 18, we note that the patentability of such claims is determined based on the product itself. See In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) ("If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process.").

Whether a rejection is under 35 U.S.C. § 102 or § 103, where, as here, appellant's product and that of the prior art appear to be identical or substantially identical, the burden shifts to appellant to provide evidence that the prior art product does not necessarily or inherently possess the relied upon characteristics of appellant's claimed product. See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1658 (Fed. Cir. 1990); In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980); In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-434 (CCPA 1977); In re Fessmann, 489 F.2d 742, 745, 180 USPQ 324, 326 (CCPA 1974). The reason is that the Patent and Trademark Office is not able to manufacture and compare products. See In re Best, supra; In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). This, appellant has not done.

Consequently, on this record, we shall sustain the rejection advanced by the examiner.

CONCLUSION

The decision of the examiner to reject claims 18-23 under 35 U.S.C. § 103 as being unpatentable over Buell is affirmed.

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

AFFIRMED

CHARLES F. WARREN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
THOMAS A. WALTZ	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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PETER F. KRATZ	)	
Administrative Patent Judge	)	

Appeal No. 2003-1406  
Application No. 09/335,723

Page 8

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