

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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFF PINK

Appeal No. 2004-1246
Application No. 09/960,948

HEARD: July 15, 2004

Before COHEN, STAAB, and NASE, 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 1-19, all the claims pending in the application. Upon further consideration, the examiner has withdrawn the rejection as to dependent claims 4, 7, 9, 11, 15 and 18, and indicated that these claims would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claim (answer, page 2). Accordingly, the

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appeal as to these claims is dismissed, leaving for our consideration only the examiner's final rejection of claims 1-3, 5, 6, 8, 10, 12-14, 16, 17 and 19.

Appellant's invention pertains to the combination of a container and applicator. A further understanding of the invention can be derived from a reading of independent claim 1, which appears in the appendix to appellant's main brief.

The references applied in the final rejection are:¹

Funcke	1,062,961	May 27, 1913
Kemmerer	5,595,198	Jan. 21, 1997
Beals et al. (Beals)	6,298,516	Oct. 9, 2001

Claims 1-3, 5, 6, 8, 10, 12-14, 16, 17 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Funcke in view of Beals.

¹On page 9 of the answer, the examiner has mentioned U.S. No. Patent 5,826,741 to Dumler that purportedly shows a brush having a shaft with bristles extending substantially in the same direction as the longitudinal axis of the shaft, but this patent has been given no consideration since it has not been listed among the references relied upon, and since it has not been included in the statement of either of the rejections. *Ex parte Raske*, 28 USPQ2d 1304, 1304-05 (Bd. Pat. App. & Int. 1993). *Compare In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970), cited in Section 706.02(j), Manual of Patent Examining Procedure ("Where a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of the rejection.").

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Claims 1-3, 5, 6, 8, 10, 12-14, 16, 17 and 19 stand further rejected under 35 U.S.C. § 103(a) as being unpatentable over Kemmerer in view of Beals.

Reference is made to appellant's main and reply briefs (Paper Nos. 12 and 17) and to the examiner's answer (Paper No. 13) for the respective positions of appellant and the examiner regarding the merits of these rejections.

Discussion

Independent claim 1 is directed to a combination container and applicator comprising (a) a reservoir having an opening for access to the interior thereof, and (b) a cap for sealing the opening. The cap comprises a rigid base member, an applicator brush fixed to the base member, and an overshell of compressible material provided on the base member to provide a gripping surface for the cap. In addition, claim 1 calls for the applicator brush to be aligned in substantially the same direction as the longitudinal axis of the base member. Claim 12, the only other independent claim on appeal, is similar to claim 1 except that instead of calling for an overshell constructed of compressible material, claim 12 sets forth an overshell constructed of non-rigid material.

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Funcke is directed to a combination toothbrush and container. The Funcke device comprises a container having an opening 4 for access to the interior thereof, and a cap in the form of a toothbrush 6 having a bristle portion 7 and a handle 9. The handle is configured to close off the opening of the container to prevent leakage therefrom. Funcke states (page 1, lines 62-68) that the container may be filled with a liquid or dry prophylactic or concentrated dentifrice to keep the brush sterilized and to kill germs.

Kemmerer pertains to a mascara applicator comprising a container 26 and a cap for closing off the container. The cap includes a handle 32 having a threaded portion 34 for engaging complimentary threads 36 on the container and an applicator brush 16 having bristles 18, 20.

Beals is directed to a toothbrush having a handle comprising a base of rigid material and an outer portion of softer resilient material to provide enhanced comfort and a more secure grip (column 3, lines 16-17; column 3, lines 45-54).

In rejecting claims 1 and 12 as being unpatentable over Funcke or Kemmerer in view of Beals, the examiner has taken the position that each of Funcke and Kemmerer discloses a combination container and applicator generally as claimed, including an applicator brush

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that is aligned in substantially the same direction as the longitudinal axis of the base member of the brush. The examiner concedes that each of the primary references lacks the claimed feature of an overshell of non-rigid compressible material for the applicator brush. The examiner takes the position, however, that it would have been obvious to one of ordinary skill in the art to provide the applicator brush of Funcke or Kemmerer with an overshell of non-rigid compressible material in view of the teachings of Beals in order to provide a better grip, and thus arrive at the claimed subject matter.

Appellant argues, first, that Funcke, Kemmerer and Beals constitute nonanalogous art. The question of nonanalogous art is a threshold issue in determining whether the examiner has established a *prima facie* case of obviousness. In resolving this issue, we note that the law presumes full knowledge by the hypothetical worker having ordinary skill in the art of all the prior art in the inventor's field of endeavor. With regard to prior art outside the inventor's field of endeavor, knowledge is presumed only as to those arts reasonably pertinent to the particular problem with which the inventor was involved. See *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992), and *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). Thus, the

determination that a reference is from a nonanalogous art is twofold. First, it must be decided if the reference is from within the inventor's field of endeavor. If it is not, then it must be determined whether the reference is reasonably pertinent to the particular problem with which the inventor was concerned.²

In the present case, appellant argues that the field of endeavor is nail polish applicators or cosmetic applicators, however, the relatively broad scope of the appealed claims, which make no mention of the applicator being used for applying either a cosmetic or nail polish, justifies a relatively broad interpretation of the stated field of endeavor. Under these circumstances, we are of the view that Funcke is in the same broad field of endeavor as the *claimed* invention since the appealed claims are directed to a container and applicator combination of unspecified utility³, and since Funcke is directed to a combination container and toothbrush, which toothbrush is an "applicator" in

²On page 7 of the answer, the examiner implies that the test for analogous art is whether the applied references are analogous to each other. However, as correctly noted by appellant on page 2 of the reply brief, the *In re Wood* test for analogous art is an inquiry concerning the relationship of the applied prior art reference to appellant's invention.

³The preamble of each of the appealed claims simply states that the claim is directed to "A combination container and applicator"

that it may be used for applying a dentifrice⁴ (Funcke, page 1, lines 65 and 80). We also are of the view that Kemmerer is in the same broad field of endeavor as the *claimed* invention in that Kemmerer clearly pertains to a combination container and applicator.⁵ Thus, we consider that Funcke and Kemmerer satisfy the first prong of the above noted test. Appellant's arguments on pages 10 and 15 of the main brief and pages 6-7 of the reply brief urging that appellant's field of invention comprises *cosmetic* applicators and/or *nail polish* applicators are not persuasive in that they are not commensurate in scope with the actual claimed invention.

Concerning Beals, we note that the "Background of the Invention" section of appellant's specification indicates at page 3, last two paragraphs, that applicator caps constructed of hard material are uncomfortable to hold, and that hard applicator cap surfaces accelerate the feeling of discomfort and fatigue. We further note that the "Objects and Summary of the Invention"

⁴The word "dentifrice" may mean "A paste or powder for cleaning the teeth." *Webster's II New Riverside University Dictionary*, copyright © 1984 by Houghton Mifflin Company.

⁵Kemmerer is likewise in the same field of endeavor as appellant's *disclosed* invention, i.e., an applicator for applying cosmetics, in that Kemmerer relates to a combination container and applicator for applying mascara.

section of appellant's specification indicates at page 4, first paragraph, that a cap having an exterior of non-rigid material reduces fatigue. Since the soft non-rigid handle portion of Beals' toothbrush is stated to be for the purpose of enhancing user comfort and feel (column 3, lines 16-17; column 3, lines 45-52; column 7, lines 46-50), we consider that Beals is reasonably pertinent to the particular problem with which appellant was involved, and therefore satisfies the second prong of the above noted test. Appellant's view to the contrary in this matter is based on an overly restrictive view of the particular problem with which the inventor was involved. As a further point, we note that it is well settled that in cases involving relatively simple every-day mechanical concepts, like those involved in the present application, it is reasonable to permit inquiry into other areas where one of even limited technical skill would have been aware that similar problems exist. See *In re Heldt*, 433 F.2d 808, 812, 167 USPQ 676, 679 (CCPA 1970).⁶

⁶In *In re Heldt*, it was held that a reference pertaining to a corrugated, sheet metal culvert with a structurally reinforced end was analogous art with respect to a claim directed to a storage tube for a golf club having a reinforcing ring at the end thereof.

For these reasons, we conclude that Funcke, Kemmerer and Beals are analogous art with respect to appellant's claimed invention.

Looking first at the examiner's rejection of claims 1 and 12 as being unpatentable over Funcke in view of Beals, we are in agreement with the examiner that it would have been obvious to one of ordinary skill in the art to incorporate a soft compressible non-rigid overshell onto the rigid handle 9 of the toothbrush of Funcke for the purpose of enhancing the grip of the handle in view of the teachings of Beals at, for example, column 3, lines 16-17 ("The finger-gripping . . . regions . . . are cushioned, for a more comfortable and secure grip"); column 3, lines 45-52 ("The finger gripping region 12 is cushioned for more comfortable, secure gripping Again, the resilient elements generally provide a non-slippery gripping area, and give the handle a softer feel during brushing"); and column 7, lines 46-50 ("Preferred resilient materials . . . provide a secure feeling grip, while also being sufficiently soft to provide a comfortable degree of cushioning during use").

Appellant further argues (main brief, page 12; reply brief, pages 3-4) with respect to the standing rejection of claims 1 and 12 as being unpatentable over Funcke in view of Beals that even if Funcke is modified in the manner proposed by the examiner, the

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claimed subject matter would not ensue because (1) there is no disclosure in Funcke of an *applicator* brush, and (2) the brush of Funcke is not aligned in substantially the same direction as the longitudinal axis of the base member as claimed. Concerning (1), as we explained in our treatment of appellant's nonanalogous argument *supra*, we consider that the toothbrush of Funcke constitutes an "applicator brush" as broadly set forth in appellant's claims in that Funcke's toothbrush is for applying a "dentifrice" (i.e., a paste or powder for cleaning the teeth). As to (2), during patent examination claims are to be given their broadest reasonable interpretation, and limitations are not to be read into them from the specification, *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993). Here, as aptly noted by the examiner on pages 7-8 of the answer, the "[applicator] brush is aligned in substantially the same direction as the longitudinal axis of said base member." This language of independent claims 1 and 12 is broad enough to be readable on the brush construction of Funcke, where the bristles of the brush are arranged along the longitudinally axis of the brush's base member. Appellant's argument on page 12 of the main brief and pages 3-4 of the reply brief to the effect that the brush alignment limitation of the independent claims should be interpreted as requiring that

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the longitudinal axis of every bristle of the brush extends in the same direction as the longitudinal axis of the handle is not well taken since it is, in effect, an improper and unjustified attempt to read a limitation from the specification into the claims.

In light of the foregoing, we shall sustain the rejection of claims 1 and 12 as being unpatentable over Funcke in view of Beals. We also shall sustain the rejection of claims 2, 3, 5, 10, 13, 14, 16 and 19 as being unpatentable over Funcke in view of Beals since appellant states on page 8 of the main brief with respect to this rejection that claims 1-3, 5, and 10 stand or fall together and that claims 12-14, 16 and 19 stand or fall together. In addition, we shall sustain the standing rejection of claim 8 as being unpatentable over Funcke in view of Beals because appellant has not separately argued for the patentability of this dependent claim with any reasonable degree of specificity apart from claim 1 from which it depends.

Concerning claims 6 and 17, these claims depend from claims 1 and 12, respectively, and add that the base member is constructed from a material selected from the group consisting of polypropylene, ABS copolymers and nylon. We are accord with the examiner that it also would have been obvious to make the base portion of the handle of the modified Funcke handle of

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polypropylene in view of Beals' teaching at column 7, lines 58-63. Accordingly, we likewise shall sustain the rejection of claims 6 and 17 as being unpatentable over Funcke in view of Beals.

Turning to the examiner's rejection of claims 1 and 12 as being unpatentable over Kemmerer in view of Beals, we note at the outset that the majority of appellant's arguments in favor of patentable of claims 1 and 12 over this reference combination track those presented in connection with the rejection based on Funcke in view of Beals. For the reasons set forth above, these arguments are no more persuasive here than they were when raised in connection with the examiner's first rejection under 35 U.S.C. § 103(a).

Appellant further argues (main brief, pages 18-19; reply brief, pages 8-9) in connection with the rejection based on Kemmerer in view of Beals that the requisite motivation for the proposed modification of Kemmerer is lacking because there is nothing in Kemmerer that suggests a need to enhance the grip of the cosmetic applicator brush. We do not agree.

The test for obviousness is what the combined teachings of references would have suggested to one of ordinary skill in the art. *In re Young*, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881

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(CCPA 1981). Here, while Kemmerer is silent in regard to a need to enhance the grip of the brush, Beals expressly teaches that the composite handle thereof provides, among other things, increased comfort and a non-slippery gripping area. As we see it, the incentive on the part of one having ordinary skill in the art for modifying Kemmerer in the manner proposed by the examiner would have simply been to gain the advantages Beals' soft, compressible overshell construction provides, which advantages the ordinarily skilled artisan would have readily appreciated as being applicable to Kemmerer's mascara applicator brush as well. In this regard, it is skill in the art, rather than the converse, which we are to presume. *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

Accordingly, we shall sustain the rejection of claims 1 and 12 as being unpatentable over Kemmerer in view of Beals. We also shall sustain the rejection of claims 2, 3, 5, 6, 8, 13, 14, 16, 17 and 19 as being unpatentable over Kemmerer in view of Beals since appellant states on page 14 of the main brief with respect to this rejection that claims 1-3, 5, 6 and 8 stand or fall together and that claims 12-14, 16, 17 and 19 stand or fall together.

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Claim 10 depends from claim 1 and adds that the base member has a flange provided at one end thereof. While appellant argues (main brief, pages 17-18) that there is no flange in Kemmerer because the portion 34 identified by the examiner as being a flange is threaded and does not extend perpendicular to the longitudinal axis of the cap 32, we consider that the claim terminology appellant has chosen to use is broad enough to read on Kemmerer's threaded portion 34.⁷ Hence, we also shall sustain the rejection of claim 10 as being unpatentable over Kemmerer in view of Beals.

In summary, we have sustained each of the standing rejections of the appealed claims.

It follows that the decision of the examiner finally rejecting the appealed claims is affirmed.

⁷The word "flange" may mean "A protruding rim, edge, rib, or collar, as on a wheel or a pipe shaft, used to strengthen an object" *Webster's II New Riverside University Dictionary*, copyright © 1984 by Houghton Mifflin Company.

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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

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

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NASE, Administrative Patent Judge. Concurring-in-part and dissenting-in-part.

I concur with my colleagues in the affirmance of the rejection of claims 1-3, 5, 6, 8, 10, 12-14, 16, 17 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Funke in view of Beals.

I dissent from my colleagues affirmance of the rejection of claims 1-3, 5, 6, 8, 10, 12-14, 16, 17 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Kemmerer in view of Beals for the reasons which follow.

Kemmerer's invention relates to the application of cosmetics, and more particularly to applicator devices for applying cosmetics, such as mascara, to the eyelashes. As shown in Figure 1, applicator 10 comprises a central core 12 having bristles 18, 20 disposed at one end 14 defining a brush section 16, while the other end 30 comprises handle 32 to facilitate the application of the mascara and which also serves as a cap for a container 26 when not in use. Handle 32 has threaded portion 34 designed so as to be received by complementary threaded portion 36 of container 26 to seal cap 32 to container 26 so that mascara is stored in a relatively air-tight manner.

Beals' invention relates to toothbrushes. Beals teaches that it is well known that frequent and thorough toothbrushing is

important in order to keep the teeth and gums clean and healthy. Beals states that it is desirable that a toothbrush be as comfortable to use as possible and that due to differences in hand size and shape and brushing style, a toothbrush design that seems comfortable to one user may not seem comfortable to another user.

Figures 1-2 of Beals show a toothbrush 10 having a rigid handle 26 that defines a finger-gripping region 12 and a palm-gripping region 14. The toothbrush also includes a distal end 16, a neck 18, and a head 20 that includes a brush portion 22 including a plurality of bristles 24. The finger-gripping and palm-gripping regions 12, 14 are cushioned, for a more comfortable and secure grip. Thus, a finger-gripping resilient element 28 is provided in the finger-gripping region 12 of the handle and a palm-gripping resilient element 30 is provided in the palm-gripping region 14 of the handle. The palm-gripping resilient element 30 serves two purposes. First, it provides a comfortable surface for gripping between the palm and fingers that generally has a relatively non-slippery surface to give a secure-feeling grip. Second, a tapered distal tip 32 of resilient element 30 extends beyond the distal end 34 of the underlying handle 26 to cushion the palm or heel of the user's hand from uncomfortable contact with the hard end 34. This distal tip 32

provides comfort when the user is maneuvering the toothbrush around in the mouth or applying pressure to the brush head, actions that typically result in contact between the distal end of the toothbrush and the palm or heel of the user's hand. The distal tip 34 also flexes (arrow A and dotted line, Figure 2) to accommodate the curvature of the heel of the hand, and to allow the end of the toothbrush body to move about in the hand without causing user discomfort. The finger-gripping region 12 is cushioned for more comfortable, secure gripping between the thumb and index finger. This cushioning is provided by resilient element 28, together with the front portion 31 of resilient element 30 (the portion that is located on the opposite side of the handle 26 from resilient element 28). Again, the resilient elements generally provide a non-slippery gripping area, and give the handle a softer feel during brushing.

In my view, there is no motivation in the combined teachings of Kemmerer and Beals that would have made it obvious at the time the invention was made to a person of ordinary skill in the art to have provided Kemmerer's handle 32 with an overshell of either compressible material (claim 1) or non-rigid material (claim 12). While Beals does teach a toothbrush having a handle having an overshell of a compressible, non-rigid material, Beals does not

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teach or suggest, in my opinion, using that overshell on Kemmerer's handle 32.

It is my belief, that the only suggestion for modifying Kemmerer's handle 32 in the manner proposed by the examiner to arrive at the claimed invention stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that I would reverse the decision of the examiner to reject claims 1-3, 5, 6, 8, 10, 12-14, 16, 17 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Kemmerer in view of Beals.

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Concurring-in-part and dissenting-in-part

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