

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LOUISE C. E. COE, LAURA J. ANDERSON,
MARK L. KASPAR, MARY L. McDANIEL, JOHN C. FAISON,
ANDREW E. DIAMOND, MARY C. WANEK, DAVID K. OSTEEEN
and KENNETH Y. WANG

Appeal No. 95-4526
Application 08/200,251¹

ON BRIEF

Before McCANDLISH, *Senior Administrative Patent Judge*, STAAB
and McQUADE, *Administrative Patent Judges*.

STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application for patent filed February 23, 1994.
According to appellants, the application is a continuation of
Application 07/980,137, filed November 23, 1992, now
abandoned, which is a continuation of Application 07/731,589,
filed July 17, 1991, now abandoned.

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This is a decision on an appeal from the final rejection of claims 1-26, 28-30 and 37-63, all the claims pending in the application. Upon further consideration, the examiner has allowed claims 21-24, 40, 41, 50, 51, 58 and 59, and has indicated that claims 17, 19 and 20 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. See page 4 of the answer. Consequently, only claims 1-16, 18, 25, 26, 28-30, 37-39, 42-49, 52-57 and 60-63 remain before us for review.

Appellants' invention pertains to an absorbent article. With reference to drawing Figure 1, the absorbent article comprises an absorbent 12, a bicomponent cover 24 which includes a first material 26 having openings 28 formed therethrough and a second material 30 different from the first material, and a separation means 18 positioned between the first material 26 and the absorbent for dispersing fluid downward away from the first material and outwardly along the surface 14 of the absorbent. Independent claims 1 and 4, copies of which are appended to appellants' brief, are illustrative of the subject matter in issue.

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The references of record relied upon by the examiner in support of rejections under 35 U.S.C. § 103 are:²

Nishino 1987	4,676,786	Jun. 30,
Matthews et al. (Matthews) 1983	4,397,644	Aug. 9,
Sukiennik et al. (Sukiennik) 13, 1990	4,908,026	Mar.
Sneyd Jr. et al. 1987 (British Patent Document)	2,180,162	Mar. 25,
Nosaki ³ 1989 (Japanese Patent Document)	122,727	Aug. 21,

The following rejections under 35 U.S.C. § 103 are before us for review:

(a) claims 1-10, 25, 26, 28-30, 37, 38, 42-48, 52-56 and

² We have not included the Mattingly patent listed on page 5 of the answer since the claims against which this reference was cited in the final rejection have now been allowed by the examiner.

³ Our understanding of this Japanese language reference is derived from a translation, of record in the application. A copy of said translation is appended to this opinion.

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60-63, unpatentable over Sukiennik in view of Nosaki;

(b) claims 8 and 9, unpatentable over Sukiennik in view of Nosaki and further in view of Matthews;

(c) claims 11-16, 18, 39, 49 and 57, unpatentable over Sukiennik in view of Nosaki and further in view of Nishino;
and

(d) claims 30, 45 and 54, unpatentable over Sukiennik in view of Nosaki and further in view of Sneyd.

The examiner's rationale in rejecting the claims is set forth in the final rejection and the answer.

The opposing viewpoints of appellants are found in the brief and the reply brief. Appellants also rely on the affidavit of Mark L. Kaspar under 35 U.S.C. § 132 (Paper No. 7, submitted August 18, 1994) in support of their position.

*The Rejection based on Sukiennik and Nosaki
(rejection (a))*

(1) Claims 1-3, 25, 26, 28-30, 37, 42-48, 52-56 and 60-63.

Considering the examiner's foundation combination of Sukiennik and Nosaki, both of which are mentioned on page 2 of appellants' specification in the "Background of the Invention"

section, Sukiennik pertains to a flow distribution system for an absorbent pad. The pad of Sukiennik comprises an absorbent 30, a backing member 22, a fluid permeable cover 14 having a first perforated longitudinal area 16 (column 3, lines 5-7) and second unperforated areas flanking the first area (see, for example, Figure 1), and a flow control layer 28 for controlling dispersion of body fluid, said flow control layer being positioned in an area generally corresponding to the perforated area 16 (column 3, lines 19-24). Sukiennik teaches at column 3, lines 33-38, that "[t]he flow zone control layer 28 is selected such that it will preferentially transfer fluid along its length prior to transferring the fluid to the absorbent 30. However, the hairy fibers 54 on its lower side aids [sic, aid] in transfer of fluid to the absorbent 30."

Nosaki pertains to a sanitary napkin. With reference to Figures 4 and 5, the sanitary napkin includes an absorbent 8, a liquid permeable surface layer comprising an apertured central band region 2 flanked by apertured band regions 3, and an intermediate layer 11 (translation, page 3) between the

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surface layer and the absorbent. Nosaki describes the band regions 2 and 3 as follows: "said surface layer comprises a first band region [2] having a hydrophobic plastic film with a number of openings at least in the menstrual blood absorptive opening region, and a second band region [3] having hydrophobic nonwoven cloth with a number of openings" (translation, page 2). The examiner has implicitly found, and appellants do not dispute, that the material of the band region 2 is different from the material of the band regions 3.

Independent claim 1 calls for an absorbent article comprising, inter alia, a bicomponent cover including a first material having openings formed therethrough and a nonapertured second material, with the second material being different from the first material. Independent claims 25, 26, 29, 30, 37, 42-46, 48, 52-54 contain similar limitations. In explaining her rejection of these claims based on the teachings of Sukiennik and Nosaki, the examiner states that "the only modification being made is to make Sukiennik's cover from separate pieces [of different materials?] instead of one whole sheet, as shown

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in the Japanese '727 patent. The Examiner has never suggested that the bicomponent cover should be completely covered with apertures" (answer, pages 6-7).

While we appreciate that Nosaki's liquid permeable surface area is a "bicomponent" in the sense that the bands 2 and 3 are separate pieces made of different materials, we are unable to agree with the examiner's position that the ordinarily skilled artisan would have focused exclusively on this feature of Nosaki in modifying Sukiennik, as proposed by the examiner. Where prior art references require a selective combination to render obvious a claimed invention, there must be some reason for the combination other than hindsight gleaned from the invention disclosure, *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). Here, the examiner's motivation for the proposed modification of Sukiennik is "to simplify the manufacturing process" (final rejection, page 4).

We agree with appellants, however, that the proposed use of multiple pieces in the fabrication of Sukiennik's cover would more likely complicate the manufacturing process thereof. In

the fact situation before us, we are unable to agree with the examiner that one of ordinary skill in the art would have been motivated by the teachings of Sukiennik and Nosaki to provide a "bicomponent" cover in Sukiennik including a first material having openings formed therethrough and a nonapertured second material, with the second material being different from the first material.

In light of the foregoing, we shall not sustain the standing § 103 rejection of independent claims 1, 25, 26, 29, 30, 37, 42-46, 48, 52-54, or dependent claims 2, 3, 28, 55 and 60-63, based on the teachings Sukiennik and Nosaki.

Independent claim 47 requires that the first material in conjunction with the separation means has a rewet value⁴ of less than 0.1 grams. In rejecting this claim, the examiner concedes that the tests described in the Kaspar affidavit "show[] that Sukiennik's diaper has a rewet value which exceeds 0.1 grams" (final rejection, page 5). Nevertheless,

⁴ As explained on pages 12-13 of the specification of the present application: "Both the bicomponent cover 24 and the separation means 18 are designed to minimize fluid transfer in the upward or reverse direction. This feature, commonly referred to as 'a low rewet value,' is important to providing a dry feel to the cover 24."

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the examiner has taken the position that the claimed subject matter is not patentably distinguishable from the applied prior art insofar as the rewet values are concerned because "[a]pplicants have not been convincing in their attempt to demonstrate the criticality of the 0.1 gram rewet value" (final rejection, page 5). We cannot accept this position.

The examiner has advanced no convincing reasoning, and none is apparent to us, as to why it would have been obvious to one of ordinary skill in the art to modify the absorbent pads of Sukiennik or Nosaki to meet the "rewet value of less than 0.1 grams" requirement of claim 47. While Sukiennik indicates generally that "rewetting" is a continuing problem in the formation of absorbent articles for bodily excretions (column 1, lines 23-26), it is not clear to us why the ordinarily skilled artisan would make the selections of material type, density and thickness necessary to arrive at a rewet value that is low enough to fall within the claimed range other than through exercise of hindsight knowledge gleaned from first reading appellants' disclosure. As to the examiner's comments regarding appellants' alleged failure to

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establish criticality of the claimed range, criticality, whatever may be intended by that term, is not a requirement of patentability under the patent statute, but is merely one of the indicia suggestive of nonobviousness. *See, for example, In re Luvisi*, 342 F.2d 102, 108, 144 USPQ 646, 651 (CCPA 1965). In short, the examiner's position that the combined teachings of Sukiennik and Nosaki would have led the ordinarily skilled artisan to an absorbent article wherein the first material in conjunction with the separation means has a rewet value of less than 0.1 grams is, at best, speculative.

We therefore shall not sustain the standing § 103 rejection of claim 47 as being unpatentable over Sukiennik and Nosaki. Furthermore, in that independent claims 46, 48 and 52-54 also recite that the first material in conjunction with the separation means have a rewet value of less than 0.1 grams, the presence of this limitation constitutes an additional reason for not sustaining the § 103 rejection thereof based on Sukiennik and Nosaki.

Claim 56 depends from independent claim 4, discussed below, and adds that the first material in conjunction with

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the separation means "has a rewet value which is at least 10% lower than the rewet value of said second material without said

separation means." In rejecting this claim, the examiner has taken the position that

since Applicants' bicomponent cover is of the same nature as Sukiennik's, as modified by the Japanese patent, and Sukiennik's separation layer is made of the same materials as disclosed by Applicants' [sic, Applicants] (compare, for example, Sukiennik, column 5, lines 3-20 with page 6, lines 14-21 of the instant application), it is reasonable to assume that the rewet value of Sukiennik's first material in conjunction with the separation layer can be less than that of the second material in conjunction with the absorbent only [final rejection, page 4]

Given appellants' discussion on page 3 of the reply brief as to the various ways that the "bicomponent" cover teaching of Nosaki could be applied in Sukiennik, and the Kaspar affidavit test data which indicates that a flow control layer made in accordance with the teachings of Sukiennik tends of increase rather than decrease rewet value when used in conjunction with a cover layer, there is no reasonable basis for concluding that the modified Sukiennik's absorbent article

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would possess the characteristic called for in claim 56. As with the rejection of claim 47, the examiner's position is speculative.

We therefore shall not sustain the standing § 103 rejection of claim 56. Furthermore, in that dependent claims 60-63 also recite that the separation means has a rewet value which is at

least 10% lower than the rewet value of the second material without the separation means, the presence of this limitation constitutes an additional reason for not sustaining the § 103 rejection thereof based on Sukiennik and Nosaki.

(2) Claims 4-10 and 38.

Unlike the majority of the independent claims on appeal, independent claim 4 does not require the second material of the bicomponent cover to be nonapertured. In addition, claim 4 does not set forth any particulars with respect to rewet values. From our perspective, it would have been obvious to one of ordinary skill in the art to provide a fluid control

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layer of the type disclosed by Sukiennik at element 28 beneath the first band region 2 of Nosaki but not the second band regions 3 thereof, suggestion being found in Sukiennik's teaching that a flow control layer such as element 28 should be located only in the middle portion of the pad (column 2, lines 14-19) to (1) minimize side staining (column 1, lines 67-68), (2) give the wearer the perception that the absorbed material is held in the center of the pad (column 2, lines 62-65), and (3) provide uniform transfer of fluid into the absorbent so as not to overload the center or

target area during early use of the pad (column 3, lines 1-4). The resulting modified Nosaki pad would correspond to the pad of claim 4 in all respects, in our view. In particular, the modified Nosaki pad would include be a "bicomponent" cover as claimed (see our above discussion of Nosaki), and a separation means for controlling dispersion of fluid downwardly. In this latter regard, the flow control layer 28 of Sukiennik qualifies as a separation means for controlling dispersion of

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body fluid downwardly in the z-direction, as broadly claimed, in that it preferentially transfers fluid along its length prior to transferring the fluid to the absorbent, and in that hairy fibers on its lower side aid in transferring fluid to the absorbent (column 3, lines 33-38).

For these reasons and based on the arguments and evidence before us, the difference between the subject matter recited in independent claim 4 and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to one of ordinary skill in the art. We therefore shall sustain the standing rejection of independent claim 4 as being unpatentable over the combined teachings of Sukiennik and Nosaki.

We also shall sustain the rejection of claims 5-10, which depend from claim 4, as being unpatentable over the teachings of Sukiennik and Nosaki, since appellants have not separately argued the merits of these dependent claims with any reasonable degree of specificity. See 37 CFR 1.192(c)(7) as

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amended, effective April 21, 1995. See also *In re Young*, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and *In re Wood*, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978).

Independent claim 38 is similar to independent claim 4, but adds that the first material in conjunction with the separation layer "has a rewet value of less than 1.7 grams." In that the test described in the Kaspar affidavit in the paragraph spanning pages 4 and 5 establishes that sanitary napkins constructed in accordance with the flow control layer teachings of Sukiennik have a rewet value of about 1.36 grams, which is well within the claimed range, it is reasonable to conclude that providing a flow control layer in accordance with Sukiennik's teachings in Nosaki would result in an absorbent article that satisfies the rewet

requirement of claim 38.⁵

⁵In light of the test described in the Kaspar affidavit in the paragraph spanning pages 4 and 5, appellants' statement on page 16 of the brief that "[n]o single prior art references teach [sic, reference teaches] rewet values below 1.7 grams . . ." is not well taken.

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In light of the above, we also shall sustain the rejection of claim 38 as being unpatentable over the teachings of Sukiennik and Nosaki.

Inasmuch as the basic thrust of our affirmance of the § 103 rejection of claims 4-10 and 38 based on Sukiennik and Nosaki differs from the rationale advanced by the examiner, we hereby designate our affirmance to be a new ground of rejection pursuant to 37 CFR § 1.196(b) to allow appellants a fair opportunity to react thereto (*see In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976)).

*The Rejections based on Sukiennik and Nosaki
and Other Prior Art
(rejections (b), (c) and (d))*

Claims 8 and 9 depend from claim 6 and stand additionally rejected as being unpatentable over Sukiennik in view of Nosaki and further in view of Matthews (rejection (b)). Appellants have not argued this rejection separate from the rejection of these claims based on Sukiennik and Nosaki, instead merely arguing that Matthews does not overcome the deficiencies of the basic combination.

Accordingly, we shall sustain this additional rejection

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of claims 8 and 9 for the reasons stated above, our affirmance once again being designated a new ground of rejection pursuant to 37 CFR § 1.196(b).

Claims 11-16, 18, 39, 49 and 57 stand rejected as being unpatentable over Sukiennik in view of Nosaki and further in view of Nishino (rejection (c)), and claims 30, 45 and 54 stand rejected as being unpatentable over Sukiennik in view of Nosaki and further in view of Sneyd (rejection (d)). Each of these claims calls for an absorbent article comprising, inter alia, a bicomponent cover including a first material having openings formed therethrough and a nonapertured second material, with the second material being different from the first material. We have carefully reviewed the Nishino and Sneyd references additionally applied by the examiner against these claims but find nothing therein which makes up for the deficiencies of the basic combination of Sukiennik and Nosaki noted above with respect to this claim limitation.

Accordingly, we shall not sustain the standing § 103 rejection of claims 11-16, 18, 39, 49 and 57 based on Sukiennik, Nosaki and Nishino (rejection (c)), or the standing

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§ 103 rejection of claims 30, 45 and 54 based on Sukiennik, Nosaki and Sneyd (rejection (d)).

Summary

The rejection of claims 1-10, 25, 26, 28-30, 37, 38, 42-48, 52-56 and 60-63 as being unpatentable over Sukiennik in view of Nosaki (rejection (a)) is reversed as to claims 1-3, 25, 26, 28-30, 37, 42-48, 52-56 and 60-63, but is affirmed as to claims 4-10 and 38.

The rejection of claims 8 and 9 as being unpatentable over Sukiennik in view of Nosaki and Matthews (rejection (b)) is affirmed.

The rejection of claims 11-16, 18, 39, 49 and 57 as being unpatentable over Sukiennik in view of Nosaki and Nishino (rejection (c)) is reversed.

The rejection of claims 30, 45 and 54 as being unpatentable over Sukiennik in view of Nosaki and Sneyd (rejection (d)) is reversed.

In each instance, our affirmance is designated a new ground of rejection pursuant to 37 CFR § 1.196(b).

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

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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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; 37 CFR § 1.196(b)

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge))
)	
)	
LAWRENCE J. STAAB)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

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Thomas J. Connelly
Kimberly-Clark Corporation
Patent Department
401 North Lake Street
Neenah, WI 54956