

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOANNE M. LANTZ, DAVID L. ZENKER, THOMAS H. ROESSLER,
ROB D. EVERETT, LYNN C. BRUD, BARBARA A. GOSSEN, ERIC M. JOHNS
and CYNTHIA H. NORDNESS

Appeal No. 97-2963
Application No. 08/284,728¹

ON BRIEF

Before COHEN, NASE, and CRAWFORD, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 13, 15 to 19 and 21 to 27, which are all of the claims pending in this application.

¹ Application for patent filed August 2, 1994. According to the appellants, the application is a continuation of Application No. 08/053,531, filed May 3, 1993, now abandoned.

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We REVERSE.

BACKGROUND

The appellants' invention relates to an absorbent article having an umbilical protection feature. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Roessler et al. (Roessler)	4,762,521	Aug. 9, 1988
Lippert et al. (Lippert)	4,861,652	Aug. 29, 1989
Ahr et al. (Ahr)	4,909,802	Mar. 20, 1990
Tracy	5,064,421	Nov. 12, 1991

Claims 1 to 13, 15 to 19 and 21 to 27 stand rejected under 35 U.S.C. § 112, first paragraph, for failing to provide an adequate written description of the invention.

Claims 1 to 13 and 22 to 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lippert.

Claims 15 to 19 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lippert in view of Roessler.

Claims 1 and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tracy in view of Roessler, Lippert and Ahr.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer² (Paper No. 17, mailed September 10, 1996) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 16, filed July 15, 1996) and reply brief (Paper No. 18, filed October 25, 1996) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and

² Manual of Patent Examining Procedure (MPEP) § 1208 provides that "Examiners may incorporate in the answer their statement of the grounds of rejection merely by reference to the final rejection (or a single other action on which it is based, MPEP § 706.07). Only those statements of grounds of rejection as appear in a single prior action may be incorporated by reference. An examiner's answer should not refer, either directly or indirectly, to more than one prior Office action." We note that the examiner's answer in this case incorporated by reference portions of four prior Office actions.

claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Written description

We will not sustain the examiner's rejection of claims 1 to 13, 15 to 19 and 21 to 27 under 35 U.S.C. § 112, first paragraph.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 217 USPQ 1089, 1096 (Fed. Cir. 1983). Thus, a rejection based on the written description requirement is fully defeated by a specification which describes the invention in the same terms as the claims. See In re Bowen, 492 F.2d 859, 864, 181 USPQ 48, 52 (CCPA 1974).

We have reviewed the specific concern stated by the examiner in this rejection of claims 1 to 13, 15 to 19 and 21 to 27, but find nothing therein which supports a rejection based upon the written description requirement of 35 U.S.C. § 112, first paragraph. Specifically, the original disclosure at page 39, lines 28-29, describes the resilient patch 84 as being composed of a material that is substantially non-elastomeric. In addition, the original disclosure at page 40, line 31, to page 41, line 6, describes the nonwettable resilient patch 84 as being composed of a fibrous, nonwoven material which is substantially non-elastomeric and does not generate gathers in the front waistband margin of the article. Thus, it is clear that the claimed term "resilient, non-elastomeric" was described in the original specification.

For the reasons set forth above, the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the subject matter recited in the appealed claims.

The obviousness issues

Rejections based on Lippert

We will not sustain the examiner's rejection of claims 1 to 13 and 22 to 27 under 35 U.S.C. § 103 as being unpatentable over Lippert. Likewise, we will not sustain the examiner's rejection of claims 15 to 19 and 21 under 35 U.S.C. § 103 as being unpatentable over Lippert in view of Roessler.

Obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded

assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

Lippert teaches a diaper having a centrally located elasticized panel positioned along the edge of the front and/or rear waistband portions of the diaper. As shown in Figure 1, elastic members 44 and 44a are secured to the end margins 34 to gather and shirr the waistbands of the diaper. Lippert discloses (column 3, lines 17-22) that the elastic member 44 can be connected to either the inner or outer surface of the backsheet 12. Lippert also teaches (column 6, lines 33-67) that the elastic member 44 is composed of an elastomeric, cloth-like, nonwoven fibrous material, such as an elastomeric stretch-bonded laminate or individual discrete strips of elastomeric material secured to one or more nonwoven fibrous layers.

The appellants argue (brief, pp. 12-15) that Lippert does not disclose or suggest an absorbent article having "an outermost fibrous layer of substantially nonwetttable, resilient, non-elastomeric material" connected to overlie the polymer film of the outer cover and having a substantially ungathered front waistband.

We agree. We see no teaching, suggestion or motivation in the applied prior art (i.e., Lippert alone and in combination with Roessler) to arrive at the claimed invention absent use of impermissible hindsight. Accordingly, the decision of the examiner to reject independent claim 1 and dependent claims 2 to 13, 15 to 19 and 21 to 27 under 35 U.S.C. § 103 is reversed.

Rejection based on Tracy

We will not sustain the examiner's rejection of claims 1 and 27 under 35 U.S.C. § 103 as being unpatentable over Tracy in view of Roessler, Lippert and Ahr.

Tracy discloses a diaper having a padded waistband. As shown in Figures 2 and 4, the diaper 2 includes padded strips 50 to cover the plastic waistline band from the inside to the outside of the diaper. Tracy teaches (column 2, lines 39-54) that the padded strips 50 are of soft material in the form of a strip of cotton or other non-abrasive material which is bent over the waistline portion 10 formed by border sections 40, 42 to protect the skin and to provide an additional absorbent barrier to alleviate leakage.

The appellants argue (brief, pp. 17-19) that applied prior art does not disclose or suggest an absorbent article having "an outermost fibrous layer of substantially nonwetable, resilient, non-elastomeric material" connected to overlie the polymer film of the outer cover and having a substantially ungathered front waistband. We agree. Once again, we see no teaching, suggestion or motivation in the applied prior art (i.e., Tracy, Ahr, Lippert

and Roessler) to arrive at the claimed invention absent use of impermissible hindsight. In fact, we see no teaching, suggestion

or motivation in the applied prior art to make Tracy's absorbent strips 50 nonwetable. Accordingly, the decision of the examiner to reject independent claim 1 and dependent claim 27 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 13, 15 to 19 and 21 to 27 under 35 U.S.C. § 112, first paragraph, is reversed and the decision of the examiner to reject claims 1 to 13, 15 to 19 and 21 to 27 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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)	
MURRIEL E. CRAWFORD)	
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APPLICATION NO. 08/284,728

APJ NASE

APJ CRAWFORD

APJ COHEN

DECISION: **REVERSED**

Prepared By: Delores A. Lowe

DRAFT TYPED: 16 Jun 98

FINAL TYPED: