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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARRY R. FEIST

Appeal No. 1997-3342
Application No. 08/389,086

HEARD: February 7, 2000

Before COHEN, MCQUADE, and GONZALES, Administrative Patent Judges.

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1 through 9, which are all of the claims pending in this application.

We REVERSE.

Appellant’s invention relates to absorbent articles, such as diapers, having a Z-folded barrier cuff in the front and

back waist regions. As explained at page 51 of the specification

> [t]he Z-folded barrier cuff design allows both sufficient lateral spacing of the barrier cuffs for the genitals in the front and for BM containment in the back as well as sufficient cuff height in the crotch area for good fit into the leg crease and good containment of body exudates.

Claims 1 and 5, the only independent claims, are illustrative of the subject matter on appeal and are reproduced in an "Appendix" attached to the brief.

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

Robertson	5,026,364	Jun. 25, 1991
Vandemoortele et al. (Vandemoortele)	WO 93/09739 (published International application)	May 27, 1993

The following rejections are before us for review:

(I) claims 1 and 2 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Vandemoortele;[1]

[1] We note the statement on page 3 of the answer that claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) is a typographical error, as evident from the final rejection (paper no. 16).

(II) claims 3 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Vandemoortele;

(III) claims 5 through 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Vandemoortele in view of Robertson;[2] and

(IV) claims 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Vandemoortele in view of Robertson.

The full text of the examiner's rejections and the responses to the arguments presented by appellant appear in the answer (Paper No. 23, mailed September 2, 1999), while the complete statement of appellant’s arguments can be found in the brief (Paper No. 19, filed November 25, 1996).

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the

[2] The reference to “Claims 5-9" at page 6, line 1 of the answer appears to be a typographical error and a reference to claims 5-7 was intended.

examiner. As a consequence of our review, we make the determinations which follow.

The appellant argues that the reference to Vandemoortele is not prior art. Specifically, the appellant urges that the affidavit of Barry R. Feist[3] (the Feist affidavit) is sufficient under 37 CFR § 1.131 to antedate the reference to Vandemoortele. We agree for the reasons set forth below. Since Vandemoortele is not prior art to the claims under appeal, it follows that the decision of the examiner to reject claims 1 and 2 under 35 U.S.C. § 102(a) and claims 3 through 9 under 35 U.S.C. § 103 is reversed.[4]

The Feist affidavit does establish completion of the article shown on page 42 of Exhibit A in this country before the publication date of the Vandemoortele reference.

The examiner considered the Feist affidavit to be insufficient for the following reasons.

First, the examiner considered that the Feist affidavit did not establish reduction to practice of the article shown

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[3] See the affidavit attached to Paper No. 15, filed May 10, 1996.

[4] The present application was filed on February 14, 1995, as a continuation under former 37 CFR 1.62, based on prior application No. 08/071,899, filed on June 3, 1993.

on page 42 of Exhibit A prior to May 27, 1993, the effective date of the Vandemoortele reference. We do not agree. The affidavit unequivocally states at paragraph 2 that "[p]rior to May 27, 1993, I had completed my invention as described and claimed in the subject application in this country." The affidavit also states at paragraph 2b that "[t]he product depicted in the laboratory notebook was made and tested prior to May 27, 1993." In support thereof, the affidavit is accompanied by Exhibit A, a copy of pages 41 through 43 of affiant's laboratory notebook.[5] Notebook page 42 contains a drawing in the upper right-hand corner of a diaper having "Z fold at ends." Immediately below this drawing is an end view of the product showing the Z fold and the words "Z fold in cuffs glued in place." Page 43 of Exhibit A includes an entry noting that

> Ed Carlin and Dan Falcone modified some [illegible] IBC Trimfit product to see how this cuff design would work on [date redacted]. The cuff looked good on the diaper so on [date redacted], we made one at [illegible] (me & Jim Gajewski for his packet orientation). Jim then tried it on his daughter

[5] As permitted by Office procedure, appellant has removed the dates on the notebook pages in Exhibit A. See Manual of Patent Examining Procedure (MPEP) § 715.07 (7th ed., Jul. 1998).

> that evening overnight. It performed well by not leaking. Fit was also good.

This showing, in our view, is sufficient to establish reduction to practice prior to May 27, 1993.

Second, the examiner considered that the Feist affidavit did not establish a reduction to practice of the absorbent article set forth in the claims since the limitations set forth in the last four lines of claim 1 and the waist cap recited in claims 5 through 9 are not shown in Exhibit A.

Our review of the affidavit reveals that Exhibit A clearly discloses a diaper having a Z folded barrier cuff glued in place at the longitudinal ends of the diaper. The end view of the diaper found on notebook page 42 shows glue located between the three portions or legs of the Z folded cuff. In our view, this is as much of the invention as is shown by Figures 8 and 9 of Vandemoortele. Therefore, if the examiner is correct and claim 1 reads on the diaper shown in Figures 8 and 9 of Vandemoortele, it must also read on the diaper shown on page 42 of Exhibit A. It logically follows that the Feist affidavit establishes a

reduction to practice of an article which falls within the scope of claim 1.

As to the invention defined by claims 5 through 9, the examiner has taken the position that it would have been obvious to position a waistcap/waistband over one end of each barrier cuff disclosed in Figures 8 and 9 of Vandemoortele in view of the teaching of Robertson (answer, page 6).

Where the differences between the claimed invention and the disclosure of the reference are so small as to render the claims obvious over the reference, an affidavit or declaration under 37 CFR § 1.131 is required to show no more than the reference shows. In re Stryker, 435 F.2d 1340, 1341, 168 USPQ 372 (CCPA 1971). Since we have already determined, supra., that the Feist affidavit establishes reduction to practice of an article which falls within the scope of claim 1 and shows as much of the invention as is shown by Figures 8 and 9 of Vandemoortele, it follows that the Feist affidavit is also sufficient to overcome the standing 35 U.S.C. § 103 rejections of claims 5 through 9.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 and 2 under 35 U.S.C. § 102(a) and claims 3 through 9 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN Administrative Patent Judge	)	
JOHN P. MCQUADE Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOHN F. GONZALES Administrative Patent Judge	)	

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