

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JOHN S. YUTCHEFF and GEORGE V. BUONOCORE

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Appeal No. 98-1032  
Application 08/620,658<sup>1</sup>

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ON BRIEF

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Before FRANKFORT, STAAB and BAHR, *Administrative Patent Judges*.

STAAB, *Administrative Patent Judge*.

*DECISION ON APPEAL*

This is a decision on an appeal from the final rejection of claims 1 to 16 and 19. Two amendments have been filed subsequent to the final rejection, both of which have been

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<sup>1</sup> Application for patent filed March 22, 1996.

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entered.<sup>2</sup> As a result of these amendments, claims 2, 7 and 15 have been canceled and claims 21-23 have been added.

Accordingly, claims 1, 3-6, 8-14, 16, 19 and 21-23 are before us on appeal. No other claims are pending.

Appellants' invention "relates to a hand held soap saver and [soap lather] dispenser for use in bath, shower or sink, that also functions as a novelty ornamental toiletry accessory" (specification, page 1). Independent claim 1, a copy of which appears in an appendix to appellants' brief, is illustrative of the appealed subject matter.

The references of record relied upon by the examiner in support of a rejection under 35 U.S.C. § 103 are:<sup>3</sup>

Hoy	1,511,969	Oct. 14, 1924
Jones	1,909,966	May 23, 1933
West	2,779,128	Jan. 29, 1957
Mezey	3,426,464	Feb. 11, 1969
Monnet (French Patent Document)	1,128,833	Jan. 10, 1957

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<sup>2</sup> See the advisory letter mailed March 27, 1997 (Paper No. 11).

<sup>3</sup> Our understanding of the French patent to Monnet and the German patent document to Kolloch is derived from translations thereof prepared in the Patent and Trademark Office. Copies of these translations are attached to this opinion.



permeating the lather dispensing body portion onto said scrubbing surface." Independent claims 1 and 10 contain similar limitations, with claim 1 adding that the body portion is "shaped as a piggy bank . . . configuration."

Considering Monnet, the examiner's primary reference, we find that the Figures 3-4 embodiment thereof comprises a lather dispenser and scrubbing implement having a hollow body portion 2 made of water impervious material (translation, page 5, lines 3-4) and a lather dispensing body portion 1 made of water absorbent material (translation, page 5, lines 1-3), with the body portion having a lowermost opening (defined by the inner peripheral edge of flange 4) and an upper opening 7a for receiving soap chips (translation, page 3, lines 4-9) closable by sliding plates 11a, 11b. We further find that the opening 7a is an elongated opening in that it is longer than it is wide. In this regard, the length of the opening 7a is seen in Figure 3 to be the distance between the edges of the opening, whereas the width of the opening 7a can be reasonably inferred<sup>4</sup> to be no greater than the vertical dimension of the

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<sup>4</sup> In approaching the question of obviousness, it is proper to take into account not only the specific teachings of

plates 11a, 11b as seen in Figure 4. In that Monnet's opening 7a is elongated, it may properly be considered to be a "slot" within the broad meaning of the term.<sup>5</sup> We still further find that the Figures 3-4 device of Monnet reasonably appears to be capable of the mode of operation called for in the independent claims. That is, when the plates 11a, 11b are retracted to uncover the opening 7a of Monnet's Figures 3-4 device, said opening constitutes a slot that is capable of allowing for the introduction of soap and water into the reservoir body to thereby provide for the production of lather within the reservoir body for permeating the exterior surface of the sponge 1.

Based on the above findings, we are in accord with the examiner that Monnet discloses in Figures 3-4 a device that is

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a reference, but also the inferences which one skilled in the art would reasonably have been expected to draw from the reference disclosure. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). Here, the inference is based on the fact that the opening 7a is designed to be obturated or closed by the plates 11a, 11b (translation, page 4, lines 7-10).

<sup>5</sup> During patent prosecution, claims must be given their broadest reasonable interpretation consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969).

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substantially similar in structure to that which is called for in the independent claims, in particular claims 6 and 10 which do not call for the "piggy bank" configuration for the hollow body portion. As to the mode of operation language of the independent claims, the issue is not whether one of ordinary skill in the art would have operated Monnet's Figures 3-4 device in the manner set forth in the functional language of the independent claims, as appellants would apparently have us believe, but rather whether the reference device is capable of such operation. See *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971). See also *Ex parte Cordova*, 10 USPQ2d 1949, 1950-51 (Bd. Pat. App. & Int. 1987). Since we have found that Monnet's Figures 3-4 device is capable of operating in the manner called for in the claims, the functional language of the independent claims on appeal does not in this instance serve to patentably distinguish over Monnet. With respect to the "piggy bank" configuration limitation of claim 1, it is our view that it would have been obvious to one of ordinary skill in the art to configure the hollow body portion of Monnet's dispenser in the shape of a

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fanciful animal such as a pig in light of the teaching of Mezey of making a lather dispenser and scrubbing implement in the form of a fictional character or animal to make the implement amusing and attractive to children.

In light of the foregoing, we will sustain the standing § 103 rejection of independent claims 1, 6 and 10 as being unpatentable over the applied prior art.<sup>6</sup> We will also sustain the standing § 103 rejection of claims 3-5, 8, 9 and 11-14 and 16 since these claims have not been argued with any reasonable degree of specificity apart from the independent claims from which they depend. *See, for example, In re King*, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986).

Claims 21-23 depend from claims 1, 6 and 10, respectively, and further call for the dispenser to consist of only two parts, namely the reservoir portion and the water absorbent body. However, neither dependent claims 21-23 nor

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<sup>6</sup> In view of our findings with respect to the opening 7a of Monnet's Figures 3-4 device and the capability of said device to function in the manner called for in the claims, some of the references relied upon by the examiner in rejecting the claims may be superfluous.

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the independent claims from which they respectively depend precludes the reservoir portion and/or the water absorbent body that constitute the dispenser from being made of a plurality of elements. Accordingly, claims 21-23 do not patentably distinguish over Monnet since the Figures 3-4 device thereof may be considered to "consist of" only a reservoir portion 2 and a water absorbent body 1, with the reservoir portion 2 comprising a cap element 2 and a pair of retractable plates for covering the opening in the cap element. We therefore will also sustain the § 103 rejection of claims 21-23.

Turning to claim 19, the examiner considers that "dehydrated sponges are old and conventional" and that "the use of a dehydrated sponge provides no patentable moment" (answer, page 5). Even if we were to accept the examiner's above quoted position, the examiner has not even addressed the additional securing means limitation found in the last 4 lines of claim 19. Accordingly, we do not consider that the examiner has satisfied his initial burden of establishing a prima facie case of obviousness with respect to claim 19. On this basis alone, we cannot sustain the examiner's § 103

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rejection of claim 19.

We have carefully considered appellants' arguments directed to the claims whose rejection we have sustained. Our position with respect to these arguments should for the most part be clear from our discussion above. In addition, we simply do not agree with appellants' position (brief, page 11) to the effect that in order to establish obviousness the problem solved by the inventor must be shown by the applied prior art. While the problem solved by appellants is one of the factors to be considered in resolving the issue of obviousness under 35 U.S.C. § 103, it is not determinative. See *In re Beattie*, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); *In re Dillon*, 919 F.2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed. Cir. *en banc*), *cert. denied*, 500 U.S. 904 (1991). Also, to the extent appellants contend that Kolloch is non-analogous art (brief, page 13), we do not agree. In our view, Kolloch's cleaning fluid dispenser is clearly analogous art in that it is reasonably pertinent to the problem with which appellants were involved, namely, the fabrication of a soap dispenser. See *In re Wood*, 599 F.2d

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1032, 1036, 202 USPQ 171, 174 (CCPA 1979). In other words, the teachings of Kolloch, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering the fabrication of a like dispenser. See *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992).

Pursuant to 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claims 1, 3-6, 8-14, 16, 19 and 21-23 are rejected under 35 U.S.C. § 112, first paragraph, as being based on an original disclosure that does not provide descriptive support for the invention as now claimed.

The test for determining compliance with the written description requirement found in the first paragraph of 35 U.S.C. § 112, first paragraph,

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. The content of the drawings may also be considered in determining compliance with the written description requirement.

*In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed.

Cir. 1983) (citations omitted).

In the present case, each of the independent claims on appeal have been amended during prosecution to recite a mode of operation that includes introducing soap *and water* into the slot of the hollow body reservoir to induce the formation of lather *within the reservoir*, with the lather then in effect *permeating and passing through* the water absorbent body portion to form a lathered exterior scrubbing surface. There is no descriptive support whatsoever in the original disclosure for this mode of operation.<sup>7</sup> In this regard, even if a person skilled in the art would realize from a reading of appellants' original disclosure that the disclosed dispenser structure is inherently capable of operating in the manner now claimed, a proposition with which we do not necessarily agree, that does not mean that such mode of operation is *described* as part of appellants' invention. See *In re Winkhaus*, 527 F.2d 637, 640, 188 USPQ 129, 131 (CCPA 1975) ("That a person

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<sup>7</sup> In contrast, appellants' original disclosure indicates a mode of operation that includes introducing only soap chips into the hollow body portion through the slot, and that "[b]y wetting the sponge, a lather may be induced" (specification, page 5).

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skilled in the art might realize from reading the disclosure that such a step is *possible* is not a sufficient indication to that person that that step is part of appellants' invention." ).

We further note that claim 10 has been amended during prosecution to recite that the hollow body portion is made of *relatively* water impervious material. There is not descriptive support for this recitation.

In summary, the standing § 103 rejection of claims 1, 3-6, 8-14, 16, 19 and 21-23 is affirmed with respect to claims 1, 3-6, 8-14, 16 and 21-23, but is reversed with respect to claim 19. In addition, a new rejection of all of the pending claims pursuant to 37 CFR § 1.196(b) has been made.

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

In addition to affirming the examiner's rejection of one or more claims, 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

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ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

37 CFR § 1.196(b) also provides that the appellant, 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. . . .

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion

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of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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)*

CHARLES E. FRANKFORT )

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Administrative Patent Judge	)	
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LAWRENCE J. STAAB	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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