

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROLAND W. GERSTENBERGER and ROBERT L. BUCK

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Appeal No. 1998-2811  
Application 08/670,137

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ON BRIEF

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Before McQUADE, NASE and GONZALES, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Roland W. Gerstenberger et al. appeal from the final rejection of claims 1 through 16 and 29 through 32, all of the claims pending in the application. We reverse.

The invention relates to "feminine hygienic interlabia pads" (specification, page 1). Claim 1 is illustrative and

reads as follows:<sup>1</sup>

1. A biodegradable absorbent pad comprising:

an inner liquid absorbent biodegradable sliver;

a soft outer biodegradable non-woven web covering having elongated edges; said outer covering having been formed by the joining of said elongated edges by a process other than heat sealing; said outer covering surrounding a substantial portion of said sliver;

said outer covering being liquid permeable, wherein liquid will wick through said outer covering into said inner absorbent sliver;

said pad enabled to absorb an amount of water per unit dry weight greater than eight grams water per gram dry weight.

The references relied upon by the examiner as evidence of obviousness are:

Nelson et al. (Nelson)	1,985,667	Dec. 25, 1934
Gerstenberger et al. (Gerstenberger)	4,995,150	Feb. 26, 1991

Claims 1, 3 through 8, 29 and 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gerstenberger.

Claims 2, 9 through 16, 31 and 32 stand rejected under 35

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<sup>1</sup>Our review of the appealed claims indicates that the references to "said elongated sealed edges" in claim 3 lack a proper antecedent basis (there is no prior recitation that the edges are "sealed") and that the recitation in claim 16 of the water absorption range is somewhat garbled. These informalities are deserving of correction in the event of further prosecution before the examiner.

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U.S.C. § 103 as being unpatentable over Gerstenberger in view of Nelson.

Reference is made to the appellants' main and reply briefs (Paper Nos. 19 and 21) and to the examiner's answer (Paper No. 20) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

Gerstenberger discloses an interlabia absorbent pad 12 sewn to define elongated panels 86 and 88 (see Figure 2). In its basic construction, the pad consists of an inner rope 16 of absorbent rayon fiber and an outer, liquid-permeable, polypropylene web cover 34 having a longitudinal heat-sealed seam 82.

The Gerstenberger pad does not meet the limitations in independent claim 1 requiring the web covering to be "biodegradable" and to have elongated edges joined "by a process other than heat sealing." As indicated above, Gerstenberger's web covering is made of polypropylene<sup>2</sup> and its

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<sup>2</sup>The record before us establishes that polypropylene is not biodegradable. See, for example, page 2 in the

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elongated edges are joined by a heat-sealing process. Furthermore, the test results set forth on pages 9 through 13 of the appellants' specification indicate that the Gerstenberger pad also does not meet the limitation in claim 1 requiring the pad to be capable of absorbing water in an amount "greater than eight grams water per gram dry weight."

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id.

In the present case, the examiner has failed to advance any factual basis to supply the aforementioned deficiencies in Gerstenberger. Since Gerstenberger alone does not justify a conclusion that the differences between the subject matter

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appellants' specification, and U.S. Patent Nos. 4,944,734 (column 1, lines 35 through 39) and 5,190,533 (column 1, lines 23 through 27), both of which are of record.

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recited in claim 1 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 a person having ordinary skill in the art, we shall not sustain the standing 35 U.S.C. § 103 rejection of claim 1, or of claims 3 through 8, 29 and 30 which depend therefrom, as being unpatentable over Gerstenberger.

Claim 2 depends from claim 1 and further defines the web covering as being made of a biodegradable material taken from the group consisting of rayon and cotton. It follows from the above discussion that the Gerstenberger pad does not meet these limitations. Similarly, the Gerstenberger pad does not meet the limitations in independent claim 9 requiring the web covering to be made from a "biodegradable material taken from the group consisting of rayon and cotton" and to have elongated edges joined "by a process other than heat sealing."

In rejecting claims 2 and 9 under § 103, the examiner has

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concluded (see pages 5 and 6 in the answer) that it would have been obvious to one of ordinary skill in the art to provide the Gerstenberger pad with an outer cotton covering as taught by Nelson. Nelson discloses an absorbent pad consisting of a filler body 10 of highly absorbent fibrous material and a tubular fabric casing 11 having elongated edges joined by sewing. The fabric of the casing preferably is gauze loosely woven from threads of vegetable fiber such as cotton (see page 2, column 1, lines 8 through 10), but may be any suitable soft, flexible, knit or braided absorbent material (see page 2, column 2, lines 15 through 19).

Even if the combination of Gerstenberger and Nelson proposed by the examiner were assumed to be proper, it would not meet the limitations in claims 2 (via parent claim 1) and 9 requiring the web covering to be "non-woven." Thus, the combined teachings of Gerstenberger and Nelson would not have suggested an absorbent pad comprising a web covering having all of the attributes required by claims 2 and 9.

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Accordingly, we shall not sustain the standing 35 U.S.C. § 103 rejection of claims 2 and 9, or of claims 10 through 16, 31 and 32 which depend from claim 9, as being unpatentable over Gerstenberger in view of Nelson.

The decision of the examiner to reject claims 1 through 16 and 29 through 32 is reversed.

REVERSED

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JOHN P McQUADE	)	
Administrative Patent Judge	)	
	)	
	)	BOARD OF PATENT
JEFFREY V. NASE	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JOHN F. GONZALES	)	
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