

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHER H. SHERIDAN

Appeal No. 1999-0023
Application No. 08/374,907

ON BRIEF

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

DECISION ON APPEAL

This is an appeal from the final rejection of claims 3 through 9, 11 through 15, and 18 through 25. Claims 16 and 17 stand allowed. These claims constitute all of the claims remaining in the application.

Appellant's invention pertains to a liquid pervious thin film or fabric sheet of synthetic and/or natural materials that has been treated with a substantially non-aqueous composition intended to be the liquid pervious topsheet of a disposable

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absorbent article such as a diaper or incontinent brief, an incontinent bed sheet or pad, and a wound dressing. A basic understanding of the invention can be derived from a reading of exemplary claims 3, 18, and 23 through 25, respective copies of which appear in the APPENDIX to the brief (Paper No. 13).

As evidence of obviousness, the examiner has applied the documents listed below:

Buck et al (Buck)	4,263,363	Apr. 21, 1981
Pregozen	5,141,803	Aug. 25, 1992

The following rejections are before us for review.

Claims 3 through 9 and 11 through 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Pregozen.

Claims 18 through 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Pregozen in view of Buck.

The full text of the examiner's rejections and response to the argument presented by appellant appears in the answer (Paper

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No. 14), while the complete statement of appellant's argument can be found in the brief (Paper No. 13).

OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellant's specification and claims,¹ the applied teachings,² and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determinations which follow.

¹ Claim 18 sets forth "The" disposable absorbent article for the first time; thus, it would appear to be more appropriate for "The" to be --A--.

² In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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We do not sustain the respective rejections of appellant's claims under 35 U.S.C. § 103.

Claim 3 appears below.

A liquid pervious thin film or fabric sheet formed of synthetic and/or natural materials which has been treated with a substantially non-aqueous composition comprising propylene glycol, at least one non-water soluble skin protectant and at least one surfactant.

In determining that the content of this claim would have been obvious, the examiner relies solely upon the patent to Pregozen. As to the claim limitation of a "substantially non-aqueous composition" of specified components, the examiner concludes that such would have been an "obvious matter of design choice" i.e. substituting a non-aqueous media for an aqueous media (answer, pages 3 and 5). The examiner did not determine that the claimed subject matter would have been obvious to one having ordinary skill in the art at the time of the present invention. On the other hand, appellant argues that the rejection is based upon hindsight since the applied patent lacks

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any suggestion of a non-aqueous composition (brief, pages 5 through 9).

Based upon the examiner's rejection rationale, we share appellant's point of view that the patent to Pregozen would not have been suggestive of a substantially non-aqueous composition to one having ordinary skill in the art. Throughout the disclosure of Pregozen the patentee makes it abundantly clear that an aqueous composition is used to practice the invention. Thus, we readily perceive that nothing within the reference document itself would have motivated one of ordinary skill to use a substantially non-aqueous composition, as claimed, as a design choice alternative or otherwise. Accordingly, when we set aside in our minds the teaching in appellant's underlying disclosure, we readily discern that only reliance upon impermissible hindsight would have enabled one of ordinary skill in the art to effect the invention of appellant's claim 3 based upon the Pregozen patent. As to the Buck reference, it was not applied by the examiner to address the non-aqueous limitation of claim 3 and does not overcome the deficiency of the Pregozen teaching. Since the prior art, as applied by the examiner, would not have been

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suggestive of the subject matter of claim 3, the rejection thereof cannot be sustained. The other claims on appeal incorporate the limitations of claim 3; thus, the rejection of claims 4 through 9, 11 through 15, and 18 through 25 cannot be sustained.

REMAND TO THE EXAMINER

The following matters are brought to the examiner's attention.

1. Claim 3 sets forth a "substantially" non-aqueous composition, while the underlying specification (pages 12 and 18) recites a treatment composition that is "entirely nonaqueous". The examiner should assess whether the claimed term of degree "substantially" when modifying the language "non-aqueous composition" renders the entire claim recitation understandable and definite (35 U.S.C. § 112, second paragraph), in light of the underlying disclosure, to thereby permit the metes and bounds of claim 3 to be ascertainable. In making this assessment, it is necessary to determine whether the specification provides some standard for measuring that degree. See Seattle Box Company,

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Inc. V. Industrial Crating & Packing, Inc., 731 F.2d 818, 826,
221 USPQ 568, 574 (Fed. Cir. 1984)).

2. Claim 3 is an article claim which incorporates a product by process limitation wherein a thin film or fabric has been "treated with a substantially non-aqueous composition". If a product or article is the same as or obvious from a product or article of the prior art, a claim is unpatentable even though the prior art product was made by a different process. See In re Thorpe, 777 F.2d, 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). The examiner should compare the characteristics of the resulting article of appellant's claim 3, for example, and with those of prior art articles that may be made by other processes to ascertain if the final article characteristics are the same, keeping in mind that an aqueous solution treatment may nevertheless yield a non-aqueous composition on the final (dried) article.

In summary, this panel of the board has:

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JEFFREY V. NASE
Administrative Patent Judge

PAUL LIEBERMAN
Administrative Patent Judge

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