

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(2) is not binding precedent of the Board.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. 43

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HIRONORI NOMURA, TAIJI SHIMAKAWA,  
YOSHINORI MATSURA, HIROKI YAMAMOTO,  
and HIROFUMI OHNISHI

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Appeal No. 99-0920  
Application 08/629,323<sup>1</sup>

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HEARD: Jun. 10, 1999

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Before KIMLIN, GARRIS, and SPIEGEL, Administrative Patent  
Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application filed April 8, 1996 as a continuing application seeking reissue of U.S. Patent No. 5,147,487, issued September 15, 1992.

Appeal No. 99-0920  
Application No. 08/629,323

This is a decision on an appeal which involves claims 20 through 31, 33 and 34. The only other claims remaining in the application, which are claims 1 through 19, have been allowed by the examiner.

The subject matter on appeal relates to a method of manufacturing disposable underpants wherein the application of elastic therefore comprises the steps of providing curvilinear adhesive zones on one side of a first continuous web and laying a tensioned first continuous elastic member in a first non-linear pattern to bond with at least a portion of at least one of said adhesive zones. Further details of this appealed subject matter are set forth in representative independent claim 20 which reads as follows:

20. In a method for manufacturing disposable underpants, the step of applying the elastic comprising the steps of:

- a. providing curvilinear adhesive zones on one side of a first continuous web;
- b. laying a tensioned first continuous elastic member in a first non-linear pattern to bond with at least a portion of at least one of said adhesive zones;
- c. laying a second continuous elastic member in a second non-linear pattern to bond with at least a portion of said at least one of said adhesive zones, the first and second non-linear patterns being substantially symmetrically disposed about a longitudinally central line;

Appeal No. 99-0920  
Application No. 08/629,323

d. attaching said first continuous web to a second continuous web to form a continuous combined web; and

e. cutting off a central portion of said continuous combined web to form a web opening substantially surrounded by the first and second elastic members.

The references applied upon by the examiner in his § 103 rejection are:

Dickover et al. (Dickover)	4,464,217	Aug. 7, 1984
Mahoney et al. (Mahoney)	4,650,530	Mar. 17, 1987
Dussaud et al. (European)	0,048,011	Mar. 24, 1982

The following additional references have been referred to by the appellants and/or the examiner in support of their respective positions on the issues presented in this appeal:

Dussaud et al. (Dussaud)	4,801,345	Jan. 31, 1989
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The American Heritage Dictionary of the English Language (New College Edition), p. 326.

Gibilisco, "The Concise Illustrated Dictionary of Science and Technology," Tab Books, p. 262, 1993.

Walker, "Dictionary of Science and Technology," Larousse, p. 639, 1995.

Claims 31, 33 and 34 are rejected under the second paragraph of 35 U.S.C. § 112 for failing to particularly point

Appeal No. 99-0920  
Application No. 08/629,323

out and distinctly claim the subject matter which the appellants regard as their invention.

Claims 20 through 31 and 33 are rejected under the first paragraph of 35 U.S.C. § 112 for failing to satisfy the written description requirement of this paragraph.

Finally, claims 20 through 26, 29 and 33 are rejected under 35 U.S.C. § 103 as being unpatentable over the European reference in view of Dickover and Mahoney.<sup>2</sup>

We refer to the brief and to the answer for a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning the above noted rejections.

As a preliminary matter, certain of the appealed claims have been separately grouped and argued (e.g., see page 3 of

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<sup>2</sup> By an apparently inadvertent error on the examiner's part, claim 33 has not been listed in the statement of this rejection on page 5 of the answer. It is quite clear, however, that claim 33 should be included in the rejection since this claim is discussed in the body of the rejection in the sentence bridging pages 10 and 11 of the answer and more particularly since this claim is listed in the statement of this rejection in the final office action on page 2 thereof. Moreover, the appellants in their brief have considered claim 33 to be included in the above noted prior art rejection (e.g., see pages 3 and 4). Under these circumstances, we also consider claim 33 to be included in this rejection and further consider the examiner's aforementioned error to be harmless.

Appeal No. 99-0920  
Application No. 08/629,323

the brief) and will be treated accordingly in the opinion below.

OPINION

For the reasons which follow, we will sustain each of the rejections advanced on this appeal except for the section 112, second paragraph, rejection of claim 33.

The section 112, second paragraph, rejection

We agree with the examiner that the claim term "substantially" renders claim 31 indefinite. This is because we find nothing in the subject specification which provides some standard for measuring the degree of scope to be assigned the aforementioned claim term. Seattle Box Co., Inc. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 573-574 (Fed. Cir. 1984). Although the appellants make the unembellished contention that "the specification enables persons skilled in the art to understand the [claim 31] terminology 'substantially annular shape'" (brief, page 8), we find utterly no support for this contention, and the appellants point to none.

Appeal No. 99-0920  
Application No. 08/629,323

As for claim 34, it is the examiner's contention that this claim is rendered indefinite because the "symmetrically disposed" limitation in step c is inconsistent with the "deforming" limitation in step d. In our view, this position has some merit. Moreover, it is significant that the appellants have not specifically rebutted this position but instead have simply stated that it is their "opinion that claim 34 defines the invention in a sufficiently definite manner" (brief, page 8).

Under these circumstances, it is our determination that claim 34 is indefinite for the reasons expressed by the examiner in the answer.

In addition to the foregoing, we point out that claim 34 is inaccurate in that it recites laying a first continuous elastic member to bond with adhesive zones in step b and then recites deforming the first continuous elastic member to form a flat region in step d. In contrast, the paragraph bridging columns 4 and 5 of the appellants' reissue specification discloses that a flat region of the first elastic member is formed during (not after as indicated by the aforementioned claim 34 recitation) the laying step. In this regard, it is

Appeal No. 99-0920  
Application No. 08/629,323

well settled that a claim must accurately define the invention in order to satisfy the requirements of the second paragraph of section 112. In re Knowlton, 481 F.2d 1357, 1366, 178 USPQ 486, 493 (CCPA 1973).

For the above stated reasons, we will sustain the examiner's section 112, second paragraph, rejection of claims 31 and 34.

However, we will not sustain the corresponding rejection of claim 33 which recites that the curvilinear adhesive zones of parent claim 20 "include at least two diametrically opposite curvilinear portions". According to the examiner, this claim is indefinite because, "[w]hile two diametrically opposed curvilinear portions could provide an annular zone, they need not and it is unclear how this is any different from an annular zone" (answer, page 12). This concern on the examiner's part is simply irrelevant to the claim under review. This is because neither claim 33 nor its parent claim 20 recites "an annular zone". From our perspective, claim 33 defines the appellants' claimed invention with reasonable precision and particularity notwithstanding the examiner's aforementioned position to the contrary.

Appeal No. 99-0920  
Application No. 08/629,323

The section 112, first paragraph, rejection

The adhesive zones of the appellants' invention are now claimed as being "curvilinear", and the examiner considers this term to be not descriptively supported by the originally filed disclosure and more particularly not supported by the term "annular" which the appellants used in their originally filed disclosure to describe these adhesive zones. We agree with the examiner that the now claimed term "curvilinear" is not descriptively supported by the appellants' originally filed disclosure and therefore fails to satisfy the written description requirement set forth in the first paragraph of 35 U.S.C. § 112.

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. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

Appeal No. 99-0920  
Application No. 08/629,323

With this test in mind, we consider first the appellants' argument that "the term 'curvilinear' is not new matter since persons skilled in the art would be enabled by the original specification to practice the invention with patterns other than annular ones" (brief, page 7). The deficiency of this argument is apparent. That is, the argument is simply not relevant to the above noted test for written description compliance. Indeed, it is well settled that a specification may contain disclosure which is sufficient to enable one skilled in the art to make and use the invention yet fail to comply with the written description requirement. In re Barker, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), cert. denied, 434 U.S. 1238 (1978).

The appellants also argue that "annular adhesive zones fall within the definition of 'curvilinear adhesive zones' and therefore provide [descriptive] support for the claim language 'curvilinear adhesive zones'" (brief, page 7). This argument is similarly deficient in that it is founded upon an inappropriate, overly-broad test. This is because a specification which discloses a specific shape embodiment (in this case, "annular adhesive zones") does not inherently or

Appeal No. 99-0920  
Application No. 08/629,323

necessarily contain disclosure sufficient to meet the written description requirement relative to claims which are generic as to the shape (in this case, "curvilinear adhesive zones"); the missing descriptive matter must necessarily be present in the specification such that one skilled in the art will recognize such disclosure. Tronzo v. Biomet, Inc., 156 F.3d 1154, 1159, 47 USPQ2d 1829, 1834 (Fed. Cir. 1998).

Thus, to resolve the merits of the rejection before us, we apply the established test for description compliance and begin the application of this test with a review of the definitions for "annular" and "curvilinear". The definition of record for "curvilinear" is "[f]ormed, bounded, or characterized by curved lines" whereas the definition for "annular" is "[s]haped like or forming a ring" (Webster's II, New Riverside University Dictionary, 1984). These definitions plainly reveal that the originally disclosed phrase "annular adhesive zones" encompasses zone shapes which are like or in the form of a ring whereas the now claimed phrase "curvilinear adhesive zones" encompasses a broader variety of zone shapes since they need not be ring-like but only need be "characterized by curved lines".

Appeal No. 99-0920  
Application No. 08/629,323

In our study of the original specification disclosure, we find nothing and the appellants point to nothing which would reasonably convey to an artisan that the appellants had possession on the filing date of adhesive zone shapes other than those which are like or form a ring, which is to say annular shapes. More specifically, this disclosure would not reasonably convey shapes which are curvilinear but not annular, that is, shapes which are "characterized by curved lines" but not "like or forming a ring". Indeed, it is questionable whether shapes which are "characterized by curved lines" but not "like or forming a ring" would be even capable of achieving the function performed by this aspect of the appellants' invention (i.e., underpant leg-holes formed via adhesive zones with elastic members bonded thereto). Certainly, the appellants do not point to and we do not independently find any portion of the originally filed disclosure which would reasonably convey possession of "curvilinear adhesive zones" which are "characterized by curved lines" but not "[s]haped like or forming a ring" and which are capable of achieving the function in question.

Appeal No. 99-0920  
Application No. 08/629,323

In light of the foregoing, it is our determination that the record before us on this appeal reveals nothing in the originally filed specification disclosure (1) to suggest that adhesive zone shapes other than the annular shapes specifically disclosed therein are part of this disclosure (Tronzo v. Biomet, Inc., id.) or, stated otherwise, (2) which would reasonably convey to the artisan that the appellants had possession on the filing date of the now claimed subject matter (In re Kaslow, id.). It follows that we will sustain the examiner's section 112, first paragraph, rejection of claims 20 through 31 and 33 for failing to comply with the written description requirement set forth in this paragraph.<sup>3</sup>

The section 103 rejection

For the reasons expressed in the answer, we agree with the examiner's ultimate conclusion that it would have been

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<sup>3</sup> We here clarify that the claims included in this rejection have not been separately argued by the appellants in their brief (see pages 6 through 8 thereof) and accordingly fall together as a group (see 37 CFR § 1.192(c)(7)(1998)). It may be that the appellants have not separately argued any of these claims (such as dependent claim 30) because they consider all of them to embrace adhesive zone shapes which are, inter alia, "characterized by curved lines" but not "[s]haped like or forming a ring" and therefore consider them all to be impacted by the written description issue under consideration.

Appeal No. 99-0920  
Application No. 08/629,323

obvious for one with ordinary skill in the art to modify the European reference process by replacing the step of applying adhesive to the elastic members with the step of providing adhesive zones on the web in those areas where the elastic members are to be disposed in view of Dickover who teaches that it is known in this art to apply adhesive to either the elastic members or the web (e.g., see lines 30 through 34 in column 9).

With respect to independent claims 20 and 29, it is the appellants' basic position that the above discussed modification proposed by the examiner would not have been obvious because "the Dickover et al patent neither discloses, teaches nor suggests the feature of curvilinear adhesive zones" and more particularly in this last mentioned respect because "the adhesive zones in Figure 15 of the '217 patent [i.e., the Dickover patent] are linear in nature and there is no explicit teaching in that patent of curvilinear adhesive zones as presently claimed" (brief, page 4). This position is not well founded for a number of reasons. In the first place, as correctly indicated by the examiner in his answer, the teachings of Dickover in combination with those of the

Appeal No. 99-0920  
Application No. 08/629,323

European reference (e.g., see Figure 5) would have suggested applying, to the web, adhesive zones which are curvilinear as required by the independent claims under review.<sup>4</sup> Secondly, the appellants' contention that the adhesive zones in Figure 15 of Dickover "are linear in nature" is contrary to patentee's express disclosure that "FIG. 15 is a plan view . . . showing the elastic members secured in a non-linear configuration" (column 4, lines 24-28; emphasis added).

The appellants further argue that the oval adhesive zones feature of dependent claim 21 is neither taught nor suggested by the applied prior art. We cannot agree. From our perspective, Figure 5 of the European reference shows or at least would have suggested an oval shape and accordingly in combination with Dickover would have suggested the oval adhesive zones feature under consideration. Similarly, we are unpersuaded by the appellants' argument concerning the sinusoidal pattern feature of dependent claims 22 and 23. Indeed, this argument seems to be directly contrary to Figure

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<sup>4</sup> We here emphasize that the test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Appeal No. 99-0920  
Application No. 08/629,323

5 of the European reference which we view as explicitly showing a sinusoidal pattern.

Although the appellants have also commented upon dependent claims 24 through 28 (see the last paragraph on page 5 and the first paragraph on page 6 of the brief), the only reasonably specific argument we discern from these comments relates to the independent claim feature of curvilinear adhesive zones. Since we have concluded that such a feature would have been obvious, the appellants' comments concerning these dependent claims are unconvincing of the patentability thereof.

Under the circumstances recounted above, it is our determination that we should also sustain the examiner's section 103 rejection of claims 20 through 26, 29 and 33 as being unpatentable over the European reference in view of Dickover and Mahoney.

#### Summary

We have sustained each of the rejections advanced by the examiner on this appeal except for his section 112, second paragraph, rejection of claim 33.

The decision of the examiner is affirmed.

Appeal No. 99-0920  
Application No. 08/629,323

Appeal No. 99-0920  
Application No. 08/629,323

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

	Edward C. Kimlin	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	
	Bradley R. Garris	)	BOARD OF
PATENT	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
		)	
	Carol A. Spiegel	)	
	Administrative Patent Judge	)	

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Appeal No. 99-0920  
Application No. 08/629,323

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