

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JEAN-LOUIS GUERET

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Appeal No. 2003-1076  
Application No. 09/779,873

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HEARD: September 25, 2003

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Before KIMLIN, KRATZ and POTEATE, Administrative Patent Judges.

POTEATE, Administrative Patent Judge.

DECISION ON REQUEST FOR REHEARING

Appellant requests rehearing of the decision on appeal (“Decision”), paper no. 20, mailed September 25, 2003, affirming the examiner’s final rejection of claims 1-46 under 35 U.S.C. § 103 as unpatentable over appellant’s admitted prior art (page 1, lines 15-19 of the

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specification) in view of Kellett, Battice et al. and Gettings et al. Having again reviewed the entire record in light of the arguments raised in appellant's Request for Rehearing, paper no. 21, received December 3, 2003, we remain of the opinion that the examiner's rejection is proper. Accordingly, appellant's request is denied for the reasons' discussed in greater detail below.

Appellant first argues that the Board's decision applies new grounds of rejection as to claims 1 and 15 and request that the Board issue a revised decision identifying the rejections as new grounds of rejection under 37 CFR § 1.196(b), to allow appellant an opportunity to respond thereto. See Request for Rehearing, pages 3-5.

37 CFR § 1.1.96(b) provides that in those cases where the Board has "knowledge of any grounds not involved in the appeal for rejecting any pending claim, it *may* include in the decision a statement to that affect with it's reasons for so holding for periods...." (emphasis added.) Thus, the Board is not required, and in this case, has chosen not to include new grounds of rejection under 35 U.S.C. § 102. Moreover, contrary to appellant's assertion, the decision clearly states that we are in agreement with the *examiner's findings and conclusions* of obviousness as to claims 1 and 15. See, e.g., Decision, pages 6 and 9 ("we are in agreement with the examiner").

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Appellant next argues that his Reply Brief was either misapprehended or overlooked. 37 CFR § 1.196(a) provides that the Board of Appeals “in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner....the affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any grounds specifically reversed.” In rendering its decisions, the Board considers the entire record.

Like appellant’s Appeal Brief, paper number 15, received October 28, 2002, appellant’s Reply Brief, paper number 17, received January 15, 2003, focus in large part on appellant’s contention that the prior art is non-analogous. However, as pointed out in our decision (page 6, first full paragraph and page 8, second paragraph) “and repeatedly argued by the examiner” (see e.g., Final Rejection, paper number 9, mailed May 8, 2002, pages 3-4) and Examiner’s Answer (paper number 16, mailed November 13, 2002, page 5, last paragraph) appellant’s arguments are simply not directed to the claimed invention or to the prima facie case of obviousness set forth by the examiner.

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In rejecting the claims, the examiner relies on appellant's admitted prior art as found in the specification:

The invention seeks to improve known packaging, an applicator devices that use a porous structure for application purposes or for wiping an applicator so as to reduce the quality of preservative (as) contained in substance to as little as possible." See page 1, lines 15-19.

Thus, contrary to what appellant asserts, the admitted prior art relied upon by the examiner is not limited to devices for *applying cosmetics* or to devices where in the applicator comes in *direct contact* with a human body (see, e.g., Reply Brief, pages 4 and 5). Thus, as stated in our decision, we are in agreement with the examiner that one of ordinary skill in the art, upon considering known packaging and applicated devices that use a porous structure, would have been motivated to look to Kellett, Battice et al. and Gettings et al., all of which are directed to porous structures containing biocides in attempting to reduce the quality of preservative required in such devices. See In re Kronig, 539 F.2d 1300, 1304, 190 USPQ 425, 427-428 (CCPA 1976) (obviousness does not require that references be combined for the reasons contemplated by the inventor, rather, all that is required is that the prior art as a whole provide some motivation or suggestion to combine the references).

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Moreover, as repeatedly stated by the examiner and reiterated in our Decision, appellant's arguments are simply not directed to the invention as claimed. Appellant's claims are simply not limited to devices for applying cosmetic products or to applicators which contact the human body. Thus, since appellant's arguments focus on features which are simply not found in the claims, they are unpersuasive and over coming to examiner's prima facie showing of obviousness.

Appellant's request for rehearing further includes arguments that the secondary references do not anticipate the claimed invention. As explained above, the claims have not been rejected under 35 U.S.C. § 102(b). Accordingly, we do not consider the arguments set forth on pages 11-13 of appellant's request for rehearing.

#### CONCLUSION

Appellant's request for rehearing has been granted to the extent that our decision has been reconsidered.

Appellant's request that we reverse the decision of the examiner, finally rejecting claims 1-46 under 35 U.S.C. § 103 as unpatentable over the admitted prior art in view of Kellett, Battice et al. and Gettings et al. and that we enter new grounds of rejection under 35 U.S.C. § 102 is denied.

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

REHEARING

DENIED

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|-----------------------------|---|-----------------|
| EDWARD C. KIMLIN            | ) |                 |
| Administrative Patent Judge | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
| PETER F. KRATZ              | ) | BOARD OF PATENT |
| Administrative Patent Judge | ) | APPEALS AND     |
|                             | ) | INTERFERENCES   |
|                             | ) |                 |
| LINDA R. POTEATE            | ) |                 |
| Administrative Patent Judge | ) |                 |

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