

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LAURA G. S. VAN RIJSWIJCK, GRETCHEN LOUISE ELDER, MAURICIO ROLANDO ODIO, SUSAN BALDWIN and MICHELLE DENISE ROSEMAN

Appeal No. 2001-2366
Application No. 08/926,533

ON BRIEF

Before COHEN, ABRAMS, and BAHR, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 7-13, 17 and 23, as amended after the final rejection. Claims 3, 4, 6, 14-16, 18-22, 25, 26 and 28-42 have been withdrawn from consideration as being directed to a non-elected invention.

WE REVERSE AND ENTER A NEW REJECTION UNDER 37 CFR 1.196(B).

BACKGROUND

The appellants' invention relates to a method of improving skin condition of a wearer in an area covered by a treated absorbent article. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the Brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Roe	5,607,760	Mar. 4, 1997
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Claims 1, 7-13, 17 and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Roe.¹

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (Paper No. 32) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 31) and Reply Brief (Paper No. 33) for the appellants' arguments thereagainst.

¹The rejection of claims 1, 7-13, 17 and 23 under 35 U.S.C. § 112, second paragraph, set forth in the final rejection (Paper No. 21) was not repeated in the Answer.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

New Rejection Entered By The Board

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity, considering that, in making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. See, for example, In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). Analyzing the claims in the light of this guidance by our reviewing court has caused us to conclude that all of the claims on appeal are indefinite. Therefore, pursuant to our authority under 37 CFR 1.196(b), we enter the following new rejection:

Claims 1, 7-13, 17 and 23 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicants regard as the invention.

Independent claim 1 recites a method of improving the skin condition of a wearer in an area covered by a treated absorbent article. The first three steps of the method call for (a) the article to be applied to the wearer, (b) at least a portion of the skin care composition carried by the article to be transferred to the wearer, and (c) the used article then to be removed from the wearer. The fourth step of the method reads as follows:

(d) repeating steps (a), (b) and (c) with one or more additional treated articles with sufficient frequency to transfer a cumulative amount of the skin care composition to the skin in the area covered by the treated article, said cumulative amount being sufficient to improve skin condition in the area covered by the treated absorbent article, relative to skin covered by an untreated absorbent article that does not comprise the skin care composition (emphasis added).

The phrase “sufficient frequency to transfer a cumulative amount of skin care composition to the skin” does not appear in the original disclosure and, from our perspective, guidance is not provided as to how frequently a new treated article must be applied in order to fall within the scope of the claimed method. The only mention of the frequency of replacing a used treated article with a new treated article is found on pages 8 and 51-52 of the specification, where it is stated that continual use of treated articles will “typically include changes every 3 to 4 hours during the day and a fresh article before overnight sleep.” Considering an overnight sleep to be eight hours (1 article), and changing articles every three or four hours for the remaining sixteen hours of the day (4 or 5 articles) then, according to the above guidelines, one of ordinary skill

in the art would be informed that it would be normal to use a total of 5 or 6 articles in a twenty-four hour period, for an overall rate of about one every four hours. Presumably this rate, and any greater rate, would qualify as a “sufficient frequency” for replacing the treated articles in accordance with the claimed method. However, no explicit information has been provided from which the artisan can determine the lower and upper limits of the range of “sufficient frequency,” that is, how few and how many article changes are intended to fall within the scope of the claim.

This issue is complicated by considering the phrase “a cumulative amount,” which also has not been defined in the specification, and which is the goal of the “sufficient frequency” of applications. On its face, a “cumulative” amount would mean that each treated article adds an amount of treatment substance to the skin of the wearer over and above the amount present at the time of the previous treated article was applied, so that the more treated articles applied the more substance accumulates on the skin of the user, as would be the case when additional coats of paint are applied one over the other to a wall. However, considering the phrase in the light of the specification raises the question of whether this interpretation is an accurate representation of the inventive method, for it could be postulated that because the amount of the substance present on the wearer’s skin would constantly be subject to degradation from being absorbed into the skin and from the effect of outside influences such as urine, wash water, and the like, it would not, in fact, accumulate as new treated

articles are applied to the skin. Thus, what is meant by “cumulative amount” is not clear. The claim further states that this cumulative amount must be “sufficient to improve skin condition” in the area treated relative to skin in an untreated area. No explanation of this limitation is apparent in the specification in that there is no information from which the artisan can determine what level of accumulation (“cumulative amount”) of skin care composition must be reached to be “sufficient to improve skin condition” in the treated area as opposed to the untreated area.

We are mindful that the appellants are free to claim their invention in broad terms and is entitled to the broadest reasonable interpretation of the claim language. However, because a patentee has the right to exclude others from making, using and selling the invention covered by the patent, the public must be apprised of exactly what the patent covers, so that those who would approach the area circumscribed by the claims of a patent may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. It is to this that the second paragraph of 35 U.S.C. § 112 is directed. See In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). It is our opinion that claim 1 fails to meet this requirement because the indefiniteness of “sufficient frequency,” “cumulative amount,” and “sufficient to improve skin condition” cause the metes and bounds of the claim not to be determinable.

The same situation is present in independent claim 23.

The Examiner's Rejection

The examiner has rejected all of the claims as being unpatentable over Roe. However, as we explained above, no definite meaning can be ascribed to certain terms in the claims. Since it is clear to us that considerable speculation and assumptions are necessary to determine the metes and bounds of what is being claimed, and since a rejection under 35 U.S.C. § 103 cannot be based upon speculation and assumptions, we are constrained to reverse the examiner's rejection. In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). We hasten to point out, however, that this action should not be construed as an indication that the claimed subject matter would not have been obvious in view of the prior art cited against the claims. We have not addressed this issue, for to do so would require on our part the very speculation which formed the basis of our rejection under Section 112.

SUMMARY

The rejection of claims 1, 7-13, 17 and 23 as being unpatentable over Roe is not sustained.

Pursuant to 37 CFR 1.196(b), a new rejection of claims 1, 7-13, 17 and 23 under 35 U.S.C. § 112, second paragraph, has been entered.

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 that, "A new ground of rejection shall not be considered final for purposes of judicial review."

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

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

REVERSED; 37 CFR 1.196(b)

IRWIN CHARLES COHEN
Administrative Patent Judge

NEAL E. ABRAMS
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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