

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 41

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RHONDA TRACY

Appeal No. 2002-0913
Application No. 09/107,643

HEARD: December 12, 2002

Before STAAB, McQUADE, and NASE, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

Rhonda Tracy appeals from the examiner's final rejection of claims 7-40, all the claims currently pending in the application.

We affirm-in-part and enter a new rejection pursuant to 37 CFR § 1.196(b).

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Appellant's invention pertains to a disposable diaper, and in particular to a disposable diaper having a padded waistband and legholes. A further understanding of the invention can be derived from a reading of exemplary claims 7 and 8 which appear in the appendix to appellant's corrected main brief.

The references relied upon by the examiner in the final rejection are:

McConnell et al (McConnell)	3,461,872	Aug. 19, 1969
Lindquist et al (Lindquist)	3,572,342	Mar. 23, 1971
Foreman	4,816,025	Mar. 28, 1989
	(effective filing date Oct. 10, 1986)	

The following rejections are before us for review:

(1) claims 11 and 12, rejected under 35 U.S.C. § 101 "because there exists a positive recitation of a human and/or human anatomy as part of the claimed invention" (answer, page 8);

(2) claims 7, 8, 11-13, 15, 16, 18, 21, 23-26, 28, 31, 33-36 and 38, rejected under 35 U.S.C. § 102(b) as being anticipated by Foreman;

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(3) claims 7, 12 and 32, rejected under 35 U.S.C. § 103(a) as being unpatentable over Foreman in view of Lindquist; and

(4) claims 7-40, rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over McConnell.

Reference is made to appellant's main and reply briefs (Paper Nos. 35 and 37) and to the examiner's answer (Paper No. 36) for the respective positions of appellant and the examiner regarding the merits of these rejections. In addition, appellant also relies on the declaration of inventor Rhonda Tracy executed January 28, 1999 (Tracy I)¹ and the declaration of inventor Rhonda Tracy executed April 18, 2000 (Tracy II).²

Rejection (1)

The rejection of claims 11 and 12 under 35 U.S.C. § 101 is not sustained.

¹Tracy I was submitted as an attachment to Paper No. 7.

²Tracy II was filed as an attachment to Paper No. 19.

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Claim 11 is directed to an improved disposable diaper comprising, in pertinent part,

a horizontally oriented strip, said strip being distinct from the top and bottom sheets, said strip being located at the waistband between the plastic edge and the wearer at a position *so that the strip contacts the skin of the wearer.* [Emphasis added.]

Claim 12 depends from claim 11 and adds that strip of the disposable diaper is a padded member.

In responding to appellant's argument, the examiner explains the rationale for the rejection of claims 11-12 under § 101 as follows:

[T]he claims state "the strip contacts the skin of the wearer", therefore the article must be in use in order to satisfy this limitation, the article as it is presently claimed cannot stand on its own without the wearer being present. By changing the word "contacts" into "is capable of contacting" or "is provided to contact" it states that the article is fully capable of performing his [this?] function, but recites only limitations of the article, the wearer need not be present. [Answer, pages 11-12.]

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In the present instance, we consider that claim 11 is directed to a disposable diaper *per se* which does not require the presence of the wearer. This interpretation is both consistent with appellant's specification as a whole and appellant's view of the scope of claims 11 and 12 (see pages 39-40 of the main brief). In that we do not agree with the examiner's interpretation of claims 11-12, which interpretation is essential to the standing § 101 rejection, it follows that we shall not sustain this rejection.

Rejection (2)

A threshold issue in the examiner's rejections based on Foreman is whether Foreman qualifies as prior art against the appealed claims.

The Foreman patent issued on March 28, 1989 on an application filed on October 30, 1987. The front page of the Foreman patent indicates that the application that matured into the Foreman patent was a continuation of an application filed on October 10, 1986. Thus, on its face, the effective filing date of the Foreman patent is October 10, 1986 (i.e., the filing date

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of its parent), and appellant does not argue otherwise. Appellant asserts, however, that the appealed claims should be accorded the benefit of the filing date of design application Serial No. 07/093,681 filed September 8, 1987, which design application is the first application in a line of applications that can be traced forward to the present application. This would nullify Foreman as a bar under 35 U.S.C. § 102(b) against the appealed claims.³ Appellant would then rely on the Tracy I declaration to swear behind 35 U.S.C. § 102(e) effective filing date of Foreman. Thus, appellant's effort to eliminate Foreman as a reference involves two steps, the first step being to gain benefit of the September 8, 1987 filing date of the '681 design application, and the second step being to use the Tracy I declaration to swear behind the October 10, 1986 effective filing date of Foreman. Appellant must prevail on both issues in order to eliminate Foreman as a reference.

The examiner considers that the appealed claims should not be accorded the benefit of the filing date of the '681 design

³Foreman would still qualify as a reference under 35 U.S.C. § 102(e) because the effective filing date of October 10, 1986 of the Foreman patent is earlier than the September 8, 1987 filing date of the '681 design application.

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application, and that, accordingly, Foreman qualifies as a bar under 35 U.S.C. § 102(b). On this basis, the examiner takes no position with respect to the sufficiency of the Tracy I declaration to swear behind the October 10, 1986 effective filing date of Foreman. We shall consider both issues of appellant's effort to eliminate Foreman as a prior art reference.

Issue (1): Should the appealed claims be accorded the benefit of the filing date of the '681 design application?

Under 35 U.S.C. § 120, a later filed application shall be accorded the benefit of the filing date of an earlier filed application if, among other things, the invention (i.e., claims) of the later application are disclosed in the earlier filed application in the manner provided by the first paragraph of 35 U.S.C. § 112. Thus, in order for a claim in the later filed application to be accorded the benefit of the filing date of the earlier filed application, the earlier filed application must, among other things, provide descriptive support within the meaning of 35 U.S.C. § 112, first paragraph, for the claim of the later filed application. *Transco Prods. Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 557, 32 USPQ2d 1077, 1081 (Fed.

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Cir. 1994), *cert. denied*, 513 U.S. 1151 (1995); *In re Van Langenhoven*, 458 F.2d 132, 136, 173 USPQ 426, 429 (CCPA 1972).

The test for determining compliance with the written description requirement found in the first paragraph of 35 U.S.C. § 112 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). The content of the drawings may also be considered in determining compliance with the written description requirement. *Id.* Claim limitations which are urged to be inherent in the disclosure must be shown as having clear support from the necessary and only reasonable construction to be given the disclosure by one skilled in the art. *Kennecott Corp. v. Kyocera Int'l, Inc.*, 835 F.2d 1419, 1423, 5 USPQ2d 1194, 1198 (Fed. Cir. 1987), *cert. denied*, 486 U.S. 1008 (1988).

In addition, a disclosure that merely renders the later-claimed invention obvious is not sufficient to meet the written

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description requirement; the disclosure must describe the claimed invention with all its limitations. See *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1158-60, 47 USPQ2d 1829, 1832-34 (Fed. Cir. 1998); *Lockwood v. American Airlines, Inc.*, 107 F.3d 1656, 1571-72, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991); *In re DiLeone*, 436 F.2d 1404, 1405, 168 USPQ 592, 593 (CCPA 1971); *In re Wohnsiedler*, 315 F.2d 934, 937, 137 USPQ 336, 339 (CCPA 1963). Although it may be *apparent* that the particular later claimed construction *could* be utilized for an article of manufacture, that does not mean that such a construction is *described* as part of the invention. That a person skilled in the art might realize from reading a disclosure that a particular later claimed construction is *possible* is not a sufficient indication to that person that said construction is part of invention. See *In re Winkhaus*, 527 F.2d 637, 640, 188 USPQ 129, 131 (CCPA 1975).

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In the present instance, the examiner has concluded that there is no descriptive support in the '681 design application⁴ for the requirement of independent claims 7, 8, 11, 21 and 31 that the body portion of the disposable diaper comprises "a plastic layer," or the requirement of independent claim 7 calling for a "soft padding member" located along a waistband portion, or the requirement of independent claim 8 calling for "a strip non-abrasive material" located along a waistband portion. We agree. Simply put, there is no basis in the disclosure of the '681 design application for concluding that the disposable diaper disclosed therein possesses the features noted by the examiner.

We also consider that there are a number of other limitations set forth in the appealed claims for which this is no descriptive support in the '681 design application. These include the requirement that the padding member of claim 7 and the strip of claim 8 are "distinct from all of said body-portion layer[s]," the requirement of claim 11 that the horizontally oriented strip located at the edge of the waistband is "distinct from the top and bottom sheets," and the requirement of claim 21

⁴The drawing figures of the '681 design application are included as an attachment to this decision.

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calling for a "discrete member" interposed between the edge of the waistband and the wearer. Here, consistent with the disclosure of the present application, we consider the claim terminology "distinct" and "discrete" as requiring that the member or strip is a separate element relative to the diaper's body portion layers or sheets; however, for all the '681 design application discloses, the strips seen at the front and back waistband portions may be folded over extensions of an underlying body portion layer.

We also find a lack of descriptive support in the '681 design application for the requirement of claim 7 that the plastic layer of the diaper has an edge along which the padding member is located, and the similar language found in claims 8, 11 and 21. In this regard, notwithstanding appellant's argument on page 10 of the main brief to the contrary, we find no descriptive support in the '681 design application of the claim requirement that the edge of the outer layer necessarily extends to the edge of the diaper at either one of the waistband portions.

Other limitations of the appealed claims for which we find no descriptive support in the '681 design application are the

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limitation of claims 12 and 32 that the strip is a "padding member," the limitation of claims 13, 23 and 33 that the strip or member is a "cushion," the limitation of claims 14, 22 and 34 that the strip or member "is configured to soften the effect on the skin of the wearer of the plastic edge," the limitation of claims 15, 26 and 35 that the strip or member provides "an additional barrier against leakage," the limitation of claims 17, 27 and 37 that the strip or member "is absorbent," the limitation of claims 19, 29 and 39 that the strip or member "is an absorbent padding member positioned to provide an additional barrier against leakage," and the limitation of claims 20, 30 and 40 that the strip or member "is absorbent . . . to provide an additional barrier against leakage." For example, and with respect to claims 15, 19, 20, 26, 30, 35, 39 and 40, it does not necessarily follow from the mere presence of a strip or member at an edge of a diaper that the strip provides a barrier against leakage, as appellant appears to argue, since the ability of a material to act as a barrier against leakage depends, among other things, upon the composition of that material, which the '681 design application does not address.

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Appellant's arguments and evidence concerning these matters have been considered but are not persuasive. In short, the above-noted claim limitations are not inherent in the disclosure of the '681 design application because it has not been shown that the limitations in question have clear support from the necessary and only reasonable construction to be given the disclosure of the '681 design application by one skilled in the art. *Kennecott Corp.*, 835 F.2d at 1423, 5 USPQ2d at 1198.

As to the Tracy II declaration relied upon by appellant in conjunction with these matters, we have carefully considered this declaration but find it to be insufficient in its purpose of establishing what one of ordinary skill in the art would have understood the '681 design application to disclose. By way of example, take paragraph 5 of Tracy II, wherein declarant states:

I understood that the outermost layer illustrated in my figures 1-3 of my design application Serial No. 93,681 represented a plastic layer of a disposable diaper. Due to the prevalent nature of disposable diapers having the outer layer as plastic in that time era, I believe that the person of ordinary skill in the diaper designing art would understand from my figures and from the title of my design patent application that the outer layer was plastic.

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Declarant's statement as to what *declarant* understood the figures of the '681 design application to represent ("I understood that the outermost layer illustrated in my figures 1-3 of my design application Serial No. 93,681 represented a plastic layer") is of little probative value as to what one of ordinary skill in the art would have understood those figures to represent. Further, declarant's *opinion* as to what one of ordinary skill in the art would have understood the '681 design application to disclose ("I believe that the person of ordinary skill in the diaper designing art would understand from my figures and from the title of my design patent application that the outer layer was plastic") fails because it recites a conclusion and few, if any, facts to buttress that conclusion. *See, for example, In re Grunwell*, 609 F.2d 486, 491, 203 USPQ 1055, 1059 (CCPA 1979) and *In re Brandstadter*, 484 F.2d 1395, 1405, 179 USPQ 286, 294 (CCPA 1973). Finally, the facts asserted by declarant to support declarant's opinion (the "prevalent nature of disposable diapers having the outer layer as plastic in that time era" and the similar statements in paragraph 3 of the declaration) are not supported by objective evidence. Moreover,

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there is evidence in the record to the contrary.⁵ For these reasons, Tracy II is not persuasive that the '681 design application provides descriptive support within the meaning of the first paragraph of 35 U.S.C. § 112 for the "plastic layer" limitation or any of the other above noted limitations of the appealed claims.⁶

In light of the foregoing, we conclude that appellant has not established that the appealed claims should be accorded the benefit of the filing date of the '681 design application.

Issue (2): Has appellant established that the claimed invention was completed prior to the effective filing date of Foreman?

Assuming, *arguendo*, that the appealed claims can be accorded

⁵In the '681 design application, the Figure 3 sectional view of an edge of the diaper is *not* cross hatched in the manner conventionally used to indicate plastic. In addition, see U.S. Patent 4,230,113, issued to Mehta on October 28, 1980, and cited by appellant in the Information Disclosure Statement filed June 30, 1998 (Paper No. 4). Mehta states at column 2, lines 33-38, that the outer moisture impervious layer of the disposable diaper thereof may comprise waterproofing treated cotton sheeting.

⁶We do not consider Tracy I, discussed below, to address issue (1).

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the benefit of the filing date of the '681 design application, Tracy I does not antedate the October 10, 1986 effective filing date of Foreman.

The requirements for antedating a reference under 37 CFR § 1.131 are quite specific. Under this rule, the inventor of the subject matter of the rejected claims must submit an appropriate oath or declaration to overcome the reference by establishing a completion of the invention including an actual reduction to practice prior to the effective date of the reference or conception of the invention prior to the effective date of the reference coupled with due diligence from a time as least just prior to said effective date to a subsequent reduction to practice or to the filing of a U.S. patent application. See 37 CFR § 1.131(b) and *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1617 (Fed. Cir. 1989). An invention is completed when there is conception and a reduction to practice of the invention. *Dunn v. Ragin*, 50 USPQ 472, 474, (Bd. Pat. Inter. 1941).

For the reasons that follow, Tracy I does establish an actual reduction to practice prior to the effective filing date

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of the reference patent. The only portions of Tracy I relevant to an actual reduction prior to the effective filing date of Foreman are paragraphs 3 and 4, which refer to a model or prototype being created and left with appellant's first patent counsel, Roger Van Epps, on or about October 3, 1986. However, there is no evidence of record as to the nature of the model or prototype, or as to whether the model or prototype was tested to see if it worked for its intended purpose. Nor is there any corroboration for the facts alleged in paragraphs 3 and 4. On this basis, we conclude that Tracy I does not establish an actual reduction to practice prior to the effective filing date of Foreman.

Tracy I also does not establish conception of the invention prior to the effective filing date of the reference patent coupled with due diligence to a constructive reduction to practice (i.e., the filing of the '681 design application). Assuming that the disclosure document 166,418 referred to in paragraph 2 of Tracy I establishes conception of the invention prior to Foreman's effective filing date, due diligence from just prior to Foreman's October 10, 1986 effective filing date to the September 8, 1987 filing date of the '681 design application has

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not been established. In particular, there is an unexplained gap of over six months between the March 2, 1987 date when appellant reviewed and signed the application papers (Tracy I, paragraph 7) and the application was filed in the PTO (Tracy I, paragraph 8).⁷ Appellant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966). This has not been done.

Accordingly, appellant has not established that the claimed invention was completed prior to the effective filing date of Foreman, and Foreman has not been removed as a reference against the appealed claims.

The merits of the § 102 rejection based on Foreman.

Turning to the merits of the anticipation rejection of 7, 8, 11-13, 15, 16, 18, 21, 23-26, 28, 31, 33-36 and 38 based on Foreman, Foreman discloses a disposable diaper comprising an absorbent core 44, a liquid impervious backsheet 42 made of

⁷It should not be assumed that we consider Tracy I to establish due diligent from just prior to the effective filing date of Foreman up to March 2, 1987.

plastic (column 8, lines 42-45), and a liquid pervious topsheet 38. The diaper also includes first barrier cuffs 62 (Figure 2) disposed along the longitudinal edges of the diaper, and second barrier cuffs 262 (Figure 3) disposed along the waistband portions 22, 24 of the diaper. The second barrier cuffs extending along the waistband portions each include a flap portion 274 and a channel portion 275. In describing the channel portion of the second barrier cuff, Foreman states (column 5, lines 56-61) that the tunnel at the distal (inner) edge 266 of the barrier cuff is formed by folding the end of the cuff member back upon itself and securing it to another segment of the cuff member "to present a *soft nonjagged* edge to the wearer" (emphasis added). As to the flap portions of the barrier cuffs, Foreman further explains that the flap portions seen in Figures 1, 2, and 3 (column 11, line 13) are "preferably hydrophobic, liquid impermeable, *compliant, soft feeling and non-irritating to the wearer's skin*" (column 11, lines 31-34; emphasis added) since the flap portions contact the wearer when in use. Concerning the material of the barrier cuffs, which include the flap portions, Foreman states (column 11, lines 1-4) that they may be made from a wide variety of materials includes *foams* and *elastic foams*. Finally, Foreman also discloses (column 13, 24-35) that the

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barrier cuffs may additionally be provided with *absorbent means* secured to or within the barrier cuffs capable of absorbing and retaining fluids, said absorbent means preferably being a layer of airfelt secured along the inner surface of the barrier cuff.

At the outset, we observe that appellant does not challenge the merits of the rejection of claims 11, 15, 16, 18, 21, 24-26, 28, 31, 34-36 and 38 as being anticipated by Foreman other than to assert that these claims should be accorded the filing date of the '681 design application, which would remove Foreman as a reference. Since we have determined *supra* that Foreman is a proper reference, this argument is not persuasive. Accordingly, the standing § 102 rejection of these claims based on Foreman is sustained.

We also sustain the anticipation rejection of claims 7, 8, 12, 13, 23 and 33 based on Foreman. Like the examiner, we consider that the tunnel at the distal edge 266 of Foreman's second barrier cuff 262, which presents a *soft nonjagged edge* to the wearer, constitutes a soft padding member that presents a soft surface to the wearer, as broadly claimed in claims 7 and 12. We also consider that said tunnel constitutes a strip of

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non-abrasive material presenting a cushioned surface to the wearer, as broadly claimed in claims 8, 13, 23 and 33. In addition, the flap portion 274 adjacent the proximal edge 264 of Foreman's second barrier cuff 262, which is described as being *compliant, soft feeling and non-irritating to the wearer's skin* and which may be made from *foam* or *elastic foam*, constitutes a soft padding member of non-abrasive material that presents a soft cushioned surface to the wearer, as now claimed. Accordingly, it is our view that both the tunnel at the distal edge of Foreman's second barrier cuff and the flap portion of Foreman's second barrier cuff respond to the soft padded member and non-abrasive cushion member limitations of claims 7, 8, 12, 13 and 23. For similar reasons, the flap portion 74 adjacent the proximal edge 64 of Foreman's first barrier cuff responds to the leg hole strip being a cushion limitation of claim 32.

Rejection (3)

We sustain the rejection of claims 7, 12 and 32 as being unpatentable over Foreman in view of Lindquist.

Claim 7 is directed to a disposable diaper comprising, among

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other things, a soft padding member located along at least one of the waistband portions. Claim 12 depends from claim 11 and adds that the strip of non-abrasive material of base claim 11 is a padding member. Claim 32 depends from claim 31 and adds that the distinct strip located at the leg hole of base claim 31 is a padded member.

As noted in our treatment of the anticipation rejection based on Foreman, the tunnel at the distal edge 266 of Foreman's barrier cuff 262, which presents a *soft nonjagged edge* to the wearer, comprises a soft padding member as broadly claimed. In addition, the respective flap portions 74, 274 of Foreman's first and second barrier cuffs 62, 262, which are described as being *compliant, soft feeling and non-irritating to the wearer's skin* and which may be made from *foam or elastic foam*, comprise soft padding members at the waistband portions and leg hole portions. Viewed in this light, Foreman provides response for all limitations of claims 7, 12 and 32, making the teachings of Lindquist mere surplusage in this rejection. While a rejection over a single reference such as Foreman that responds to all limitations of claims would ordinarily be based on 35 U.S.C. § 102 rather than 35 U.S.C. § 103, the practice of nominally

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basing a rejection on § 103 when, in fact, the actual ground of rejection is that the claims are anticipated by the prior art has been sanctioned by a predecessor of our present review court in *In re Fracalossi*, 681 F.2d 792, 215 USPQ 569 (CCPA 1982) and *In re Pearson*, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974). For these reasons, appellant's arguments of nonobviousness with respect to these claims are simply not germane to the novelty issue discussed above. The standing § 103 rejection of claims 7, 12 and 32 is therefore sustained.

Rejection (4)

We do not sustain the rejection of claims 7-40 as being anticipated by or, in the alternative, as obvious over McConnell.

McConnell discloses a diaper retaining garment "for retaining a diaper, generally of the disposable type, in position adjacent the perineal region of a wearer" (column 1, lines 21-28). The garment consists of a generally rectangular sheet of flexible polymeric cellular material having snap fasteners secured at its four corners. Folded about the side and end edges of the sheet is an elastic strip 21 and an overlying outer strip

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22 which is preferably made of a woven fabric or scrim. The purpose of the outer strip 22 is "to prevent contact of the wearer with the elastic material forming strip 21" (column 3, lines 32-33). Figure 5 shows a disposable absorbent diaper pad for use in conjunction with the retaining garment. Figure 6 illustrates the retaining garment with the disposable diaper pad retained therein. According to McConnell, with retaining garments and disposable diaper pads of this type, "the diaper supporting and retaining garment is reused many times while the disposable diaper pads are discarded after becoming soiled in use" (column 1, lines 45-47).

Upon review of the examiner's explanation of the rejection on page 6 of the answer, it is clear that in rejecting appellant's claims as being anticipated by or obvious in view of McConnell the examiner reads the claimed disposable diaper comprising a body portion having a layer of liquid-absorbent material and a plastic layer on the combination of the retaining garment and the disposable diaper pad of the reference, with McConnell's sheet of flexible polymeric cellular material 10 corresponding, in the examiner's view, to the claimed "plastic layer" of the disposable diaper and with McConnell's disposable

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diaper pad corresponding to the claimed "liquid-absorbent material" of the disposable diaper.

Like appellant, we believe the examiner has misapplied McConnell is attempting to read the claimed "disposable diaper" comprising a layer of liquid-absorbing material and a plastic layer on McConnell's combined reusable retaining garment and disposable diaper pad. We arrive at this conclusion notwithstanding the examiner's observation, admittedly correct, that the reusable retaining garment of McConnell "is fully capable of being disposed . . . after one use" (answer, page 11). Simply put, one of ordinary skill in the art would not consider the appealed claims, when read in light of the specification, to encompass within their scope the combination of a reusable retaining garment and a disposable pad such as taught by McConnell. This is especially so in view of McConnell's disclosure at column 1, lines 45-47, that the retaining garment thereof is of the type intended to be reused many times.

For this reason alone, the rejection of claims 7-40 as being anticipated by or, in the alternative, obvious over McConnell cannot be sustained.

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New Ground of Rejection

Pursuant to our authority under 37 CFR § 1.196(b), we enter the following new rejection.

Claims 14, 17, 19, 20, 22, 27, 29, 30, 32, 37, 39 and 40 are rejected under 35 U.S.C. § 102(b) as being anticipated by Foreman.

These claims depend for various ones of the independent claims on appeal and additionally call for the claimed member or strip of the respective base claims to be (1) configured to soften the effect on the skin of the wearer of the plastic edge (claims 14 and 22), (2) absorbent (claims 17, 27 and 37), (3) an absorbent padding positioned to provide an additional barrier against leakage (claims 19, 29 and 39), (4) absorbent and positioned to provide an additional barrier against leakage (claims 20, 30 and 40), and (5) a padding member (claim 32).

As noted above, Foreman's barrier cuffs 62, 262 comprise flap portions 74, 274 that are *compliant, soft feeling and non-irritating to the wearer's skin* (column 11, lines 31-34), and

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that may be made from *foam* or *elastic foam* (column 11, lines 1-4). Further, the barrier cuffs may include *absorbent means* such as a layer of airfelt secured along the inner surface of the barrier cuff to absorb and retain fluids (column 13, lines 24-35). Barrier cuffs made in accordance with these directives (i.e., having flap portions of foam or elastic foam and including a layer of absorbent airfelt material on the inner surface of the cuff to absorb and retain fluids) constitute soft, absorbent "padding members" as broadly claimed that are configured to soften the effect on the skin of the plastic backsheet 42. Hence, the second barrier cuffs 262 of Foreman positioned at the waistband portions of the diaper respond to the claimed strip or member located at the waistband of claims 14, 17, 19, 20, 22, 27, 29 and 30, and the first barrier cuffs 62 of Foreman positioned at the sides of the crotch of the diaper respond to the claimed strip located at the leg holes of claims 32, 37, 39 and 40.

Summary

The rejection of claims 11 and 12 under 35 U.S.C. § 101 is reversed.

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The rejection of claims 7, 8, 11-13, 15, 16, 18, 21, 23-26, 28, 31, 33-36 and 38 under 35 U.S.C. § 102(b) as being anticipated by Foreman is affirmed.

The rejection of claims 7, 12 and 32 under 35 U.S.C. § 103(a) as being unpatentable over Foreman in view of Lindquist is affirmed.

The rejection of claims 7-40 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over McConnell is reversed.

Pursuant to 37 CFR § 1.196(b), we have entered a new rejection of claims 14, 17, 19, 20, 22, 27, 29, 30, 32, 37, 39 and 40 under 35 U.S.C. § 102(b) as being anticipated by Foreman.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

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Regarding any affirmed rejection, 37 CFR § 1.197(b)
provides:

(b) Appellant may file a single request for rehearing
within two months from the date of the original
decision. . . .

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

Should the appellant elect to prosecute further before the
Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to
preserve the right to seek review under 35 U.S.C. §§ 141 or 145

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with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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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).

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

LJS:svt

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Application No. 09/107,643

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