Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte CHARLES JAMES SHIMALLA

Appeal No. 2002-2298
Application No. 09/442,442

ON BRIEF

Before ABRAMS, STAAB, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 44 to 47, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to an apertured web of material having improved aperture formation (specification, p. 1). A copy of the independent claims under appeal is set forth in the opinion section below.

Claims 44 to 47 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over U.S. Patent No. 5,567,376 to Turi et al. (Turi).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 11, mailed April 8, 2002) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 10, filed January 14, 2002) and reply brief (Paper No. 12, filed June 17, 2002) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the Turi patent, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The claimed subject matter

Claims 44 and 46, the independent claims on appeal, read as follows:

44. An apertured web made by the process comprising the steps of providing an apparatus comprising:

(1) a support structure having at least one outwardly facing support surface;

(2) a forming member mounted on said support structure and having a mounting surface on one side facing toward said one support surface of said support structure and having a web-engaging forming surface on the other side, said web-engaging forming surface including recesses, said forming member defining drain holes extending from said recesses through said forming member to said mounting surface, at least one of said drain holes extending at least partly over said one support surface of said support structure; and

(3) a porous structure that is disposed between said support structure and said forming member mounting surface and that defines at least one open area which is located at least partly between said one support surface and said one drain hole and which extends laterally beyond said one support surface to accommodate fluid flow from said one drain hole past said one support surface;

supporting a starting web of material on said web-engaging forming surface;

directing fluid against said starting web to cause portions of said starting web to be deformed into said recesses and to cause the formation of apertures through said starting web to define said apertured web as said fluid flows through said apertures;

draining at least some of said fluid at least (a) through said one drain hole, (b) through said one open area, and (c) past said one support surface; and removing said apertured web from said forming surface, wherein said apertured web has a reduced number of incompletely formed apertures relative to an apertured web made using a corresponding apparatus comprising said support structure and said forming member but not said porous structure.

46. An apertured web made by the process comprising the steps of providing an apparatus comprising:

(1) a support structure having at least one outwardly facing support surface;

(2) a forming member mounted on said support structure and having a mounting surface on one side facing toward said one support surface of said support structure and having a web-engaging forming surface on the other side, said web-engaging forming surface including recesses, said forming member defining drain holes extending from said recesses through said forming member to said mounting surface, so that at least one of said drain holes faces said one support surface of said support structure, at least one of said drain holes extending at least partly over said one support surface of said support structure; and

(3) a porous structure that is disposed between said support structure and said forming member mounting surface and that defines at least one curved surface which faces said one drain hole and which is located between said one drain hole and said one support surface;

supporting a starting web of material on said web-engaging forming surface;

directing fluid against said starting web to cause portions of said starting web to be deformed into said recesses and to cause the formation of apertures through said starting web to define said apertured web as said fluid flows through said apertures;

draining at least some of said fluid at least (a) through said one drain hole, (b) alongside said curved surface, and (c) past said one support surface; and removing said apertured web from said forming surface, wherein said apertured web has a reduced number of incompletely formed apertures relative to an apertured web made using a corresponding apparatus comprising said support structure and said forming member but not said porous structure.

The examiner's rejection

In the rejection before us in this appeal (answer, pp. 4-5), the examiner ascertained that Turi discloses in Figure 16 a fabric that is placed on a belt, which is passed multiple times under a manifold with water jets to perforate the film, with a vacuum source under the belt in the area of the manifold (column 7, lines 15-20). It was unclear to the examiner why any of the holes of the moving belt would be blocked

to prevent fluid flow and reduce perforation over the course of multiple passes under the water jet manifold. The examiner then concluded that the film product is taken as having no reduction in formation of the apertures. Next, the examiner stated that if the above disclosure is not taken as an anticipation, the examiner takes the position that "it would have been obvious to one of ordinary skill in the art based on the above analysis that there is no reduction in aperture formation with the process of Figure 16." Lastly, the examiner declared that "[n]o weight is given to applicant's process limitations as long as a similar product is taken as being produced by the process cited in [Turi]."

The appellant's argument

The appellant argues (brief, pp. 3-5; reply brief, pp. 1-2) that there is no evidence that the apparatus shown in Figure 16 of Turi would produce an apertured web as set forth in the claims under appeal (i.e., an apertured web having a reduced number of incompletely formed apertures relative to an apertured web made using a corresponding apparatus comprising a support structure and a forming member but without a porous structure in between).

Our position

We will not sustain the rejection of claims 44 to 47 under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103.

In our view, the claims under appeal are not drawn to just any apertured web and that the claims under appeal are not necessarily anticipated by an apertured web having only completely formed apertures therein. In that regard, the claims under appeal are drawn to an apertured web having a reduced number of incompletely formed apertures **relative to** an apertured web made using a corresponding apparatus comprising a support structure and a forming member but without a porous structure in between. Thus, the claimed apertured web must have a reduced number of incompletely formed apertures when compared to an apertured web made using a support structure and a forming member but without a porous structure in between. To determine if a prior art apertured web anticipates the claimed subject matter, the prior art apertured web must be compared to see if it has a reduced number of incompletely formed apertures when compared to an apertured web made using a support structure and a forming member but without a porous structure in between. Thus, the product-by-process limitation set forth in the claims does affect the product itself (i.e., the claimed apertured web) and therefore can impart patentability to the product. See In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even

though the prior product was made by a different process.). See also Atlantic Thermoplastics Co. v. Faytex Corp., 970 F.2d 834, 8443-47, 23 USPQ2d 1481, 1488-91 (Fed. Cir. 1992).

In our view, the appellant has not been provided with a rationale supporting a conclusion that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process. In that regard, the examiner has not established that the apertured web produced by Turi would have a reduced number of incompletely formed apertures when compared to an apertured web made using a support structure and a forming member but without a porous structure in between. In fact, since Turi does not have a porous structure in between the support structure (i.e., conveyor belt 62) and the forming member (i.e., backing member 64), the apertured web produced by Turi would have the same number of incompletely formed apertures, not a reduced number of incompletely formed apertures as set forth in the claims under appeal.

For the reasons set forth above, the decision of the examiner to reject claims 44 to 47 under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 44 to 47 under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS Administrative Patent Judge	)
LAWRENCE J. STAAB Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)

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