

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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte

David Goldberg

Appeal No. 2003-1450
Application No. 09/640,325

ON BRIEF

Before WINTERS, LIEBERMAN and SCHEINER, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner

refusing to allow claims 1 through 9, which are all the claims pending in this application.¹

THE INVENTION

The invention is directed to a method for treating diaper rash using an applicator having a particular structure. Additional limitations are described in the following illustrative claims.

THE CLAIMS

Claims 1 and 8 are illustrative of appellant's invention and are reproduced below.

1. A method for treating diaper rash comprising applying an anti-diaper rash agent from an applicator to the skin of a baby wherein the applicator comprises an elongated housing containing said anti-diaper rash agent, an elliptically domed applicator portion at one end of the housing and slots formed through said elliptical domed applicator portion and a means for forcing said cream of said applicator through said elongated slots in said elliptically domed applicator portion.

8. The applicator according to claim 7 wherein said elliptically domed applicator portion is made from a plastic containing an antibacterial agent.

THE REFERENCES OF RECORD

As evidence of obviousness, the examiner relies upon the following references:

Moss	4,816,254	Mar. 28 1989
Dornbusch et al.	5,547,302	Aug. 20, 1996
Franta et al. (Franta)	5,879,096	Mar. 09 1999
Eguchi et al. (Eguchi)	JP 10029907	Mar. 02 1998

¹Claims 10 and 11 have been allowed by the examiner. See Answer, page 2.

THE REJECTIONS

Claims 1 through 6 and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Moss in view of Franta.

Claims 1 through 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Moss in view of Franta and further in view of Dornbusch.

Claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Moss in view of Franta and further in view of Eguchi.

OPINION

We have carefully considered all of the arguments advanced by the appellant and the examiner and agree with the examiner for the reasons stated herein that the rejection of claims 1 through 7 and 9 under § 103(a) is well founded. Accordingly, we affirm this rejection. We agree with the appellant that the rejection of claim 8 under § 103(a) is not well founded. Accordingly, we reverse this rejection.

As an initial matter, it is the appellant's position that, "[t]he claims of each group stand or fall together." See Brief, page 6. We interpret the term "group" in the context

of the Brief as corresponding to the specific claims associated with each ground of rejection. Accordingly, we select claims 1 and 8 as representative of the claimed subject matter and limit our consideration thereto. See 37 CFR §1.192(c)(7)(2002).

The Rejection of claims 1-7 and 9

It is the appellant's position that the references cannot be combined and that, "nowhere in Moss does it suggest that the ointment therein would be put into some kind of applicator in the sense of Appellant's invention." See Brief, page 6. We disagree.

Moss is directed to an ointment for treating skin irritations such as diaper rash. See Abstract and column 1, lines 5-16. Moss states that application of the ointment, "may be performed by hand, but preferably with a suitable medical applicator or swab." As the examiner has stated however, "Moss does not expressly teach the specific applicator that can be used for administration of the composition" See Answer, page 4.

Accordingly, the use of a well known medical applicator suitable for application of an ointment would have been obvious to the person having ordinary skill in the art. In this respect the examiner has relied upon a reference to Franta. We find that Franta is directed to a dispenser for gels or creams. See column 1, lines 4-6. We find the gels or creams include pharmaceuticals. See column 1, lines 30-31. We find that the particular dispensers disclosed by Franta are designed to prevent weeping such that there is no liquid phase separation of the cream to flow through the apertures and down the sides of the

container onto the hands of the user. See column 1, lines 17-27 and 38-46. In our view, Franta provides ample motivation for use of its medical applicator in dispensing the ointment of Moss by disclosing a medical applicator which not only provides an alternative to performing the application of the ointment disclosed in Moss by hand, but simultaneously prevents weeping and phase separation.

As to the applicator itself, we find no argument in the Brief that the applicator of Franta fails to comply with any of the requirements of the claimed subject matter. The only substantive argument presented by the appellant is that in Franta, “the slots or holes extend transversely and do not extend longitudinally” See Brief, page 7. The claimed subject matter however, in contrast, only requires “elongated slots” and contains no requirement directed to the orientation of the slots.

Furthermore, the appellant submits that, “Appellant’s invention is designed to be used mostly in the upside down position and is not designed to be used in upward or right side up position such as a deodorant stick.” See Brief, page 6. We find however, no limitation in the claimed subject matter directed to the orientation of the applicator at the time of application. In addition, we find no limitation in the disclosure of Franta limiting the use of the disclosed application to any specific position.

Finally, the appellant argues that, “the utilization of a domed applicator portion made from a plastic which is residue resistant and non-porous is of a particular advantage. . . .” See Brief, page 7. In this respect we find that Franta discloses a domed applicator,

Abstract, and column 2, lines 39-41. We find that the domed applicator is prepared from a plastic, i.e., polypropylene. See column 3, lines 50-53. We further note however, that there is no requirement in the claimed subject matter that the domed applicator made from a plastic be non-porous or residue resistant.

Based upon the above reasons, we have determined that the examiner has established a prima facie case of obviousness. Furthermore, upon reconsideration of all the evidence and argument submitted by appellant, we have, determined from the totality of the record that the preponderance of the evidence weighs in favor of obviousness within the meaning of 35 U.S.C. § 103. See In re Oetiker 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Accordingly, the decision of the examiner is sustained as to claims 1 through 7 and 9, claim 1 being representative of the rejection of Moss in view of Franta and Moss in view of Franta and Dornbusch.

In this respect a discussion of Dornbusch, directed to a dispenser containing a cap is not needed in reaching our decision inasmuch as the limitations further disclosed by Dornbusch are not required by claim 1 which is representative of the claimed subject matter.

The Rejection of Claim 8

In contrast to the claimed subject matter previously discussed, the subject matter of claim 8 further requires that, "said elliptically domed applicator portion is made from a plastic containing an antibacterial agent." In order to meet this limitation, the examiner

relies upon a tertiary reference to Eguchi. The Eguchi reference is directed to a plastic material having a high level of antibacterial and antifungal activity. See Abstract and page 1. We find that Eguchi may be utilized in a molded plastic product. See page 1. Eguchi, however, lacks any suggestion that the antibacterial plastic may be utilized in preparing a medical applicator. Moreover, in treating diaper rash, one would necessarily have to make contact between the antibacterial product of Eguchi and the more sensitive areas of an infant skin, i.e., the genitalia and anal areas of the infant. On the record before us however, there is no evidence to show that the utilization of the product of Eguchi would be either appropriate or safe.

Accordingly, in our view the only suggestion for combining the Eguchi reference with that of Moss and Franta comes from the teachings of the appellant. Based upon the above finding and analysis, we conclude that the examiner has not established a prima facie case of obviousness with respect to claim 8. See *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("[T]he best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.").

DECISION

The rejection of claims 1 through 6 and 9 under 35 U.S.C. §103(a) as being

unpatentable over Moss in view of Franta is affirmed.

The rejection of claims 1 through 7 under 35 U.S.C. §103(a) as being unpatentable over Moss in view of Franta and further in view of Dornbusch is affirmed.

The rejection of claim 8 under 35 U.S.C. §103(a) as being unpatentable over Moss in view of Franta and further in view of Eguchi is reversed.

The decision of the examiner is affirmed-in-part.

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

SHERMAN D. WINTERS)
Administrative Patent Judge)
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PAUL LIEBERMAN
Administrative Patent Judge

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