

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SEE AUN SOON and JORG MULLER

Appeal No. 2005-2531
Application No. 10/148,759

ON BRIEF

Before GARRIS, PAK and KRATZ, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1 and 3-14.

With reference to figures 2-8 of the appellants' drawing, the subject matter on appeal relates to an apertured elastic member 200 having a first direction 210 and a second direction 220 perpendicular to the first direction, and having a plurality of apertures 230 aligned in a pattern of rows 240 and having a substantially constant thickness dimension 260, the member

Appeal No. 2005-2531
Application No. 10/148,759

comprising a plurality of repeating units 270, wherein a repeating unit comprises a portion of a first aperture from a first row and a portion of a second aperture from a second row, wherein the second row is adjacent to the first row, and a nonapertured region 250 extending between adjacent rows of apertures, and wherein the nonapertured region of the repeating unit has substantially the same cross sectional area everywhere along the repeating unit in a plane that is parallel to the second direction. This appealed subject matter is adequately illustrated by independent claim 1 which reads as follows:

1. An apertured elastic member having a first direction and a second direction perpendicular to said first direction, said apertured elastic member having a plurality of apertures aligned in a pattern of rows substantially parallel to said first direction, and said apertured elastic member having a substantially constant thickness dimension, the apertured elastic member comprising:

a plurality of repeating units, wherein a repeating unit comprises a portion of a first aperture from a first row and a portion of a second aperture from a second row, wherein the second row is adjacent to the first row, and a nonapertured region extending between adjacent rows of apertures, and wherein the nonapertured region of the repeating unit has substantially the same cross sectional area everywhere along the repeating unit in a plane that is parallel to the second direction.

The references set forth below are relied upon by the examiner as evidence of obviousness:

Appeal No. 2005-2531
Application No. 10/148,759

Fahrenkrug et al. (Fahrenkrug)	5,376,198	Dec. 27, 1994
Palumbo	6,106,925	Aug. 22, 2000

Under 35 U.S.C. § 103(a):

Claims 1, 3-12 and 14 are rejected as being unpatentable over Fahrenkrug; and claims 1, 3-8, 13 and 14 are rejected as being unpatentable over Palumbo.

OPINION

For the reasons which follow, neither of these rejections can be sustained.

As correctly indicated by the appellants in their brief, the examiner's expositions of these rejections as presented in the final Office action¹ do not identify any claim difference relative to the applied prior art and correspondingly do not identify any teaching or suggestion in the Fahrenkrug and Palumbo prior art which would have motivated those skilled in this art to provide the apertured elastic members of these references with the asserted difference, thereby resulting in subject matter corresponding to that of appealed independent claim 1. It follows that the examiner, in formulating these rejections, has failed to comply with established legal precedents and guidelines

¹The "**Grounds of Rejection**" section of the answer (see page 3) contains only statements of these rejections without explanatory expositions.

Appeal No. 2005-2531
Application No. 10/148,759

regarding obviousness under 35 U.S.C. § 103. See the legal authority cited in the brief, most notably Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). Also see, the Manual of Patent Examining Procedure (MPEP) § 2141 et seq.

Although the rejections do not clearly state a basis for the examiner's conclusion of obviousness, the "**Response to Argument**" section of the answer (see pages 3-8) provides some clarity to this matter. Specifically, in their brief, the appellants argue that appealed independent claim 1 differs from Fahrenkrug and Palumbo respectively by requiring that "the nonapertured region of the repeating unit has substantially the same cross sectional area everywhere along the repeating unit in a plane that is parallel to the second direction" and that these references contain no teaching or suggestion concerning this difference. In her response to this argument, the examiner argues that the applied references teach "a spacing of the apertures in the elastic layer . . . that is a structural equivalent of the corresponding element disclosed in the specification, [i.e.,] the repeating unit having substantially the same cross sectional area everywhere along the repeating [unit]" (answer, page 5 regarding Fahrenkrug; answer, page 7 regarding Palumbo). The examiner further elaborates on her position by explaining that "the

Appeal No. 2005-2531
Application No. 10/148,759

spacing of [Fahrenkrug and Palumbo] perform the function, [i.e.,] the ability to absorb liquids through the openings in the layer to pull liquid away from the skin surface, as specified by in [sic] the specification in substantially the same manner as the function is performed by the corresponding element, [i.e.,] the repeating unit, described in the specification" (answer, page 5 regarding Fahrenkrug; answer page 7, regarding Palumbo). Finally and significantly, the examiner acknowledges that "[each of Fahrenkrug and Palumbo] does fail to teach of [sic] the claim limitations of claimed invention" but argues that "the apertures [of these references] are an equivalent function of the repeating unit provided in the [appellants' claimed] elastic member" (answer, page 5 regarding Fahrenkrug; answer, page 7 regarding Palumbo).

The examiner's aforequoted rebuttals to argument reflect that her obviousness conclusion is not based on a proposed modification of the applied references but instead is based on the assertion that these references teach an aperture/spacing arrangement which is structurally and functionally equivalent to the repeating units of appealed independent claim 1. This rationale is wholly inadequate to establish a prima facie case of unpatentability for multiple reasons.

Appeal No. 2005-2531
Application No. 10/148,759

First, the fact that the here claimed and prior art members are for the purpose of absorbing liquids plainly does not support the examiner's proposition that the spacing/aperture arrangements of Fahrenkrug and Palumbo are functionally or structurally equivalent to the appealed claim 1 feature "wherein the nonapertured region of the repeating unit has substantially the same cross sectional area everywhere along the repeating unit in a plane that is parallel to the second direction." This lack of equivalency is evinced, for example, by the specification disclosure concerning figures 9-13 and particularly by the first whole paragraph on specification page 17.

Second, even if the examiner's equivalency determination were assumed to be proper, her concomitant obviousness conclusion still would be in error. For over forty years, it has been well settled that the mere existence of functional and mechanical equivalents is inadequate to establish a prima facie case of obviousness. In re Flint, 330 F.2d 363, 367-68, 141 USPQ 299, 302 (CCPA 1963); In re Scott, 323 F.2d 1016, 1019-20, 139 USPQ 297, 299 (CCPA 1963). Also see MPEP § 2144.06 (Revision 2, May 2004).

Appeal No. 2005-2531
Application No. 10/148,759

Under the circumstances recounted above, we cannot sustain either the Section 103 rejection of claims 1, 3-12 and 14 as being unpatentable over Fahrenkrug or the Section 103 rejection of claims 1, 3-8, 13 and 14 as being unpatentable over Palumbo.

REMAND

Pursuant to our authority in 37 CFR § 41.50(a)(1)(September 2004), we hereby remand this application to the examiner for the purpose of taking further action consistent with our comments below.

The appellants' independent claim 1 at three different points contains the term "substantially" which is a word of degree that may render a claim indefinite under the second paragraph of 35 U.S.C. § 112 depending upon whether an artisan is provided with some standard for measuring the degree in question. See Seattle Box Co. v. Indus. Crating & Packing, Inc., 731 F.2d 818, 826 and 829, 221 USPQ 568, 573-74 and 576 (Fed. Cir. 1984). Also see MPEP, § 2173.05(b)(Revision 2, May 2004). Compare Verve LLC v. Crane Cams, Inc., 311 F.3d 1116, 11120, 65 USPQ2d 1051, 1054 (Fed. Cir. 2002).

More specifically, we observe that the claim 1 phrases "substantially parallel" on line 3 and "substantially constant thickness dimension" on lines 4-5 are expressly defined on pages

Appeal No. 2005-2531
Application No. 10/148,759

13-14 of the appellants' specification. These definitions provide an artisan with a standard for reasonably measuring the degree encompassed by these claim phrases. However, we find no express definition in the specification for the phrase "substantially the same cross sectional area" on the penultimate line of claim 1. The lack of an express definition raises the issue of whether an artisan would have any standard for reasonably measuring the degree encompassed by this last mentioned claim phrase. For example, while dependent claim 4 evinces that a variation of 10 percent or less is encompassed by the phrase "substantially the same cross sectional area," we find nothing in the application record which evinces that 10 percent is the upper limit of this variation or whether degrees of variation higher than 10 percent are encompassed by the phrase under consideration.

In light of the foregoing, in response to this remand, the examiner (and the appellants) must address and resolve on the written record of this application whether the claim phrase "substantially the same cross sectional area" complies with the second paragraph requirements of Section 112, and if so, why, and conversely if not, why not.

Appeal No. 2005-2531
Application No. 10/148,759

In addition, the examiner (and the appellants) must consider whether the appealed claims patentably distinguish over the prior art including Fahrenkrug and Palumbo based on reasoning completely unrelated to the unacceptable rationale discussed above in relation to the Section 103 rejections advanced on this appeal. The issue to be considered is whether the aforementioned prior art includes repeating units which are encompassed by independent claim 1 when given (as it must be) its broadest reasonable interpretation consistent with the appellants' specification. In re Hyatt, 211 F.2d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). To facilitate our following exposition of this issue, we will discuss the prior art by referring to figures 9-13 of the appellants' drawing (i.e., just as the appellants did on pages 5-10 of their brief).

In their above noted discussion of figures 9-13, the appellants implicitly have presumed that the apertured elastic member 400 shown in these figures possesses only the repeating units 470 as displayed in figures 9 and 11. This presumption is incorrect. For example, this member also possesses repeating units whose left and right borders (when viewed from direction

Appeal No. 2005-2531
Application No. 10/148,759

420) are the same as depicted in figure 9 but whose upper and lower borders (when viewed from direction 410) correspond to the upper and lower borders of apertures 430.

Thus, the figure 9 member includes repeating units which are spaced (claim 1 does not exclude spaced repeating units) and which include a nonapertured region extending between adjacent rows of apertures 430 whose upper and lower borders correspond to the upper and lower borders of these apertures. Because of this last mentioned circumstance, the width of the nonapertured region 450 inside these repeating units is constant and is defined by the width between adjacent row apertures. Due to this constant width dimension and due to the constant thickness dimension 460 of the figure 9 member, the cross sectional area of the aforementioned nonapertured region also would be constant and would be the cross sectional area illustrated in figure 12 of the appellants' drawing.

Viewed from this perspective, the member of figures 9-13 necessarily includes a nonapertured region of a repeating unit which has "the same cross sectional area everywhere along the repeating unit in a plane that is parallel to the second direction" as required by the appellants' independent claim. Again, this is because independent claim 1, when given its

Appeal No. 2005-2531
Application No. 10/148,759

broadest reasonable interpretation consistent with the specification, does not exclude the previously discussed repeating units and nonapertured region of the figures 9-13 member² (e.g., claim 1 does not require that the plurality of repeating units abut one another at the upper and lower boundaries).

Therefore, in response to this remand, the examiner (and the appellants) must address and resolve on the written record of this application whether some or all of the pending claims should be rejected under 35 U.S.C. § 102 or 35 U.S.C. § 103 over, for example, either Fahrenkrug or Palumbo based on the reasoning and analysis set forth above.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004)), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is not made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) does not apply.

²On specification page 17, the first full paragraph and particularly the last sentence thereof indicates that the apertured elastic member of figures 9-13 constitutes prior art. The appellants should clarify whether this member is indeed prior art.

Appeal No. 2005-2531
Application No. 10/148,759

SUMMARY

The decision of the examiner is hereby reversed.

The application is hereby remanded to the examiner.

REVERSED and REMANDED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
CHUNK K. PAK)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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)	
PETER F. KRATZ)	
Administrative Patent Judge)	

BRG:hh

Appeal No. 2005-2531
Application No. 10/148,759

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