

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**

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* HEATHER A. SOREBO, KAMI L. BECHYNE,  
McMANUS, and MARY LOU McDANIEL

JAMES D.

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A ppeal No. 2006-1928  
Application No. 10/760,877  
Technology Center 3700

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ON BRIEF

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Before CRAWFORD, BAHR and HORNER, *Administrative Patent Judges*.  
HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the examiner's final rejection of claims 1-8, all of the claims pending in the application.

We affirm in part.

## BACKGROUND

The appellants' invention relates to a resealable package for carrying a supply of interlabial pads in a hygienic condition. Claims 1 and 8 are representative of the subject matter on appeal, and a copy of these claims can be found in the appendix to the appellants' brief.

The examiner relies upon the following as evidence of unpatentability:

Burrow <i>et al.</i> (Burrow)	6,115,997	Sep. 12, 2000
Jones	6,059,100	May 09, 2000
May	US 2002/0064322 A1	May 30, 2002* *filed Nov. 29, 2000
McManus <i>et al.</i> (McManus)	6,601,706	Aug. 05, 2003
Kolterjohn <i>et al.</i> (Kolterjohn)	6,681,934	Jan. 27, 2004
Ling <i>et al.</i> (Ling)	6,705,465	Mar. 16, 2004

The following rejections are before us for review.

1. Claims 1-8 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Jones in view of Burrow and May.
2. Claim 8 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.
3. Claims 1-8 stand rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of McManus in view of May.
4. Claims 1-8 stand rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of Kolterjohn in view of May.

5. Claims 1-8 stand rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of Ling in view of May.

Rather than reiterate in detail the conflicting viewpoints advanced by the examiner and the appellants regarding this appeal, we make reference to the examiner's answer (mailed February 23, 2006) for the examiner's complete reasoning in support of the rejections and to the appellants' brief (filed January 4, 2006) and reply brief (filed March 29, 2006) for the appellants' arguments.

### OPINION

In reaching our decision in this appeal, we have carefully considered the appellants' specification and claims, the applied prior art, and the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations that follow. It is our view that, after consideration of the record before us, the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the prior art relied upon by the examiner and in view of the patented claims of the patents cited by the examiner in the obviousness-type double patenting rejection. It is also our view that the appellants' original disclosure provides sufficient written description for the subject matter recited in claim 8.

#### ***Rejection of Claims 1-8 under 35 U.S.C. § 103(a)***

The appellants appear to argue claims 1-7 as a group. As such, we will direct our review to claim 1 as a representative claim of the group.

In the rejection of independent claim 1, the examiner has determined that Jones teaches a feminine hygiene disposal package (10) for carrying pads comprising a receptacle (12) having an interior (14) in which a plurality of disposable containers (20) are located. (Examiner's Answer, p. 4). The examiner relies on Burrow to show that it is

well known to those skilled in the art to supply disposable feminine hygiene pads in a container that serves to carry new pads and to hold used pads. (Examiner's Answer, p. 4). The examiner found,

It would have been obvious to one of ordinary skill in the art to modify the system of Jones by incorporating a supply of pads in the containers in view of the teaching of Barrow [*sic*] in order to obviate [*sic*] the need to have a [*sic*] separate individual packages and economize material by using the same container twice. (Examiner's Answer, p. 4).

The examiner relied on May to teach a resealable closure mechanism having a slider device. The examiner found,

It would have been obvious to one of ordinary skill in the art to modify zip lock bags of Jones by constructing a closure comprising opposed slide fastener members extending across the respective front and back walls extending across the respective front and back walls generally adjacent the opening, and a slide fastener slidable relative to the front and back walls for releasably engaging the slide fastener members together to close the opening as taught by May, in order to permit easy access for opening the bag. (Examiner's Answer, p. 4).

The appellants present two arguments: (1) it would not have been obvious to one of ordinary skill in the art to modify the system of Jones in view of the teaching of Burrow; and (2) even when combined, Jones, Burrow, and May fail to teach or suggest a package comprising a receptacle and a supply of pads in the receptacle in a hygienic condition. (Appellant's Brief, pp. 7, 9)

With regard to motivation to combine Jones and Burrow, the appellants argue that one of ordinary skill in the art would not have been motivated by any of the cited references to modify Jones to provide a receptacle and a supply of pads therein in a hygienic condition because neither Jones, Burrow, nor May "teach or suggest placing

more than one feminine hygiene product into a single package to maintain the products in a hygienic condition.” (Appellant’s Brief, p. 10).

With regard to the deficiency of the prior art, the appellants contend that Jones lacks any disclosure or suggestion for placing a plurality of feminine hygiene pads in the main container (12). Rather, Jones discloses a container of disposal bags. (Appellant’s Brief, pp. 7-8). The appellants contend that Burrow fails to cure the deficiency of Jones, because Burrow discloses only that a single package can be used to package a new pad and then used to wrap the used pad for disposal. The appellants contend that Burrow fails to teach or suggest storing a plurality of pads in a single package in a hygienic condition. (Appellant’s Brief, p. 8). The appellants further contend that May fails to cure the deficiency of Jones and Burrow and that the examiner merely relied on May for its teaching of a slide closure. (Appellant’s Brief, p. 8).

In response to the appellants’ arguments, the examiner cites to col. 1, lines 23-30 of Burrow, which teaches that it is advantageous to individually package disposable feminine hygiene articles by wrapping a single cover sheet around the article and sealing it to itself such that the user can re-use the package for disposal by inserting a used version of the article inside the cover sheet, wrapping it closed, and re-sealing it. The examiner contends that this teaching of Burrow provides a suggestion to use the disposable containers (20) of Jones to store new pads prior to use, in addition to using the containers (20) for disposal of used pads to eliminate the need for separate individual packages and to economize material. (Examiner’s Answer, pp. 11-12).

We agree with the examiner’s position.

To determine whether a *prima facie* case of obviousness has been established, we were guided by the factors set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), *viz.*, (1) the scope and content of the prior art; (2) the differences between the prior art

and the claims at issue; and (3) the level of ordinary skill in the art.<sup>1</sup>

With regard to the scope and content of the prior art, we find that Jones discloses a feminine hygiene product disposal system (10) including a main container (12), a sealable top (16) and a plurality of disposal containers (20). Each disposal container (20) is designed for holding a used feminine hygiene product and has a sealable opening (24). (Jones, col. 3, lines 45-54). The sealable opening (24) is formed by a locking track (38). (Jones, col. 4, line 4). We further find that Burrow discloses that it is well known in the feminine hygiene product packaging art to individually package disposable feminine hygiene articles using a resealable cover sheet that allows the user to re-use the package for disposal of a used pad. (Burrow, col. 1, lines 23-30). We further find that May discloses that it was well known in the packaging closure art to use a slider device in a closure assembly of a resealable package. (May, page 3, para. [0034]).

With regard to the differences between the prior art and the claims at issue, we find that Jones fails to explicitly teach holding a supply of feminine hygiene products within the disposable containers (20) in a hygienic condition. We also find that although Burrow teaches using the same package for holding a new pad and discarding a used pad, Burrow also does not teach or suggest by itself using a main receptacle to hold a supply of pads that are packaged within individual disposable packages.

With regard to the level of skill in the art, the Examiner has attempted to make a finding as to the level of one of ordinary skill in the art, on which he relies in his obviousness conclusion. (Examiner's Answer, p. 10). Mere discussion of the level of ordinary skill without citation of a reference presents an evidentiary problem because there is no way for anyone to verify the truth of the statements. "Even if obviousness of

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<sup>1</sup> Although *Graham* also suggests analysis of objective evidence such as commercial success, long felt but unsolved needs, failure of others, etc., the appellants presented no such evidence for the Board's

the variation is predicated on the level of skill in the art, prior art evidence is needed to show what the level of skill was.” *In re Kaplan*, 789 F.2d 1574, 1580, 229 USPQ 678, 683 (Fed. Cir. 1986). Thus, if we were to adopt the examiner’s finding, there would be no way for a court reviewing our decision to verify whether we were correct. Also, mere numbers of years of education and/or experience are unhelpful to resolving the obviousness question because this description says nothing about what was concretely presumed to be known as a result of that education or experience. A more appropriate approach in an *ex parte* proceeding to determine the level of ordinary skill is to consider various factors including “type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962, 1 USPQ2d 1196, 1201 (Fed. Cir. 1986), *cited in In re GPAC, Inc.*, 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995). In a given case, every factor may not be present, and one or more factors may predominate. *Id.* at 962-63, 1 USPQ2d at 1201.

We find that the prior art of record in the present case demonstrates that one of ordinary skill in the art at the time of the invention was aware of the problem of being able to easily and discreetly carry multiple feminine hygiene products throughout the day, and that one of ordinary skill in the art had similarly solved this problem by creating composite packages for holding multiple individually-wrapped pads or similar products. (See e.g., International Patent Application, publication number WO 99/26576 (published June 3, 1999) and European Patent No. EP 0419770 (published April 3, 1991)). We further find that one of ordinary skill in the art at the time the invention was made was familiar with individually wrapping feminine hygiene products to maintain the articles in

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consideration.

a hygienic condition, and that it was well known to reuse the wrapping for disposal of used articles. (See Burrow, col. 1, lines 23-30). We further find that one of ordinary skill in the art was familiar with using a slider device to open and close resealable packages and that such slider device was common in packaging applications. (See May, page 1, paras. [0002] and [0003]). We further find that the packaging and closure arts deal generally with straightforward and simple technology.

In addition to our review of the *Graham* factors, we also considered the requirement of a showing of a “teaching, suggestion, or motivation” to modify or combine the prior art teachings. This requirement was recently described in *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1337 (Fed. Cir. 2006),

[T]he “motivation-suggestion-teaching” test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims. From this it may be determined whether the overall disclosures, teachings, and suggestions of the prior art, and the level of skill in the art – i.e., the understandings and knowledge of persons having ordinary skill in the art at the time of the invention-support the legal conclusion of obviousness. (internal citations omitted).

For the reasons discussed below, we hold that a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims.

“In considering motivation in the obviousness analysis, the problem examined is not the specific problem solved by the invention but the general problem that confronted the inventor before the invention was made. *Kahn*, 441 F.3d at 988, 78 USPQ2d at 1336

(citations omitted). In this case, the general problem to be solved was one of resealable hygienic packaging.

To establish a prima facie case of obviousness, the references being combined do not need to explicitly suggest combining their teachings. See e.g., *Kahn*, 441 F.3d at 987-88, 78 USPQ2d at 1337-38 (“the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references”); and *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (“for the purpose of combining references, those references need not explicitly suggest combining teachings.”).

An explicit teaching that identifies and selects elements from different sources and states that they should be combined in the same way as in the invention at issue, is rarely found in the prior art. As precedent illustrates, many factors are relevant to the motivation-to-combine aspect of the obviousness inquiry, such as the field of the specific invention, the subject matter of the references, the extent to which they are in the same or related fields of technology, the nature of the advance made by the applicant, and the maturity and congestion of the field.

...

Precedent has also recognized that “[t]he suggestion or motivation to combine references does not have to be stated expressly; rather it may be shown by reference to the prior art itself, to the nature of the problem solved by the claimed invention, or to the knowledge of one of ordinary skill in the art.”

*In re Johnston*, 435 F.3d 1381, 1385, 77 USPQ2d 1788, 1790-91 (Fed. Cir. 2006) (citing *Medical Instrumentation and Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1221-22 (Fed. Cir. 2003)). “The test for an implicit showing is what the combined teachings,

knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.”” *Kahn*, 441 F.3d at 987-88, 78 USPQ2d at 1336 (quoting *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)).

The appellants challenge the examiner’s showing of motivation to combine only Jones and Burrow. As such, we focus our review on this combination. We find that both Jones and Burrow are in the same field of feminine hygiene product packaging as the claimed invention and are directed to the same problem of resealable hygienic packaging as the claimed invention. As discussed above we find that Jones discloses a receptacle similar in structure to the claimed receptacle and housing multiple disposal containers for used pads, Burrow teaches that it was common to package pads in the same packaging that was later used to dispose of the pads, and May shows that slider devices were commonly used as closures for resealable receptacles. Based on these findings, we hold that the teaching in Burrow of using disposal containers for both storing new pads and disposing of used pads would have provided a clear suggestion to one skilled in the art at the time the invention was made to use the disposal containers (20) of Jones for storing new pads, to obviate the need to have separate containers for new and used pads and to economize material by using the same container twice. As such, one of ordinary skill in the art at the time of the invention, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims. Accordingly, we sustain the rejection of claims 1-7 as unpatentable over cited art.

The appellants separately argued the patentability of dependent claim 8. Specifically, the appellants argued that they used the term “horizontally” in reference to the orientation

of the pads relative to the top, sealed bottom and sealed sides of the receptacle and not as a reference to the orientation of the receptacle itself. (Appellants' Brief, pp. 10-11).

The examiner responded to the appellants' argument by noting that the appellants' original disclosure did not place any constraints on how to construe horizontal or that it had to be interpreted relative to the receptacle. The examiner pointed to Figure 1 of Jones, which discloses the main container (12) having containers (20) therein horizontally aligned relative to the ground. (Appellant's Brief, pp. 12-13). As such, the examiner found that the resultant device of Jones, as modified by Burrow, includes pads that are aligned horizontally from side to side in the receptacle, as recited in claim 8.

Even if we adopt the appellants' reading of claim 8 to require the pads to be oriented horizontally relative to the top, bottom and sides of the receptacle, we still do not deem this claim to be patentable over the teachings of Jones in view of Burrow and May.

The specification provides no reason why the alignment of the pads in a horizontal direction, *i.e.*, aligned side-to-side rather than top-to-bottom, is significant to the invention. The appellants also fail to provide any evidence or arguments in their briefs as to the significance of the claimed horizontal alignment. Mere changes in shape or rearrangement of parts of a device are matters of design choice and an insufficient basis for a finding of nonobviousness with a showing of significance of the change. *See In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (holding that appellants have presented no convincing argument that the particular configuration of their container is significant or is anything more than one of numerous configurations a person of ordinary skill in the art would find obvious for the purpose of providing mating surfaces in the collapsed container of the prior art) and *In re Japikse*, 181 F.2d 1019, 1023, 86 USPQ 70, 73 (CCPA 1950) (holding that shifting a starting switch of the prior art to a different

position was obvious because the overall operation of the device would not be affected by such change).

Further, there is at least a suggestion in Jones that the disposal containers (20) could be disposed in the main container (12) in either a vertical or horizontal arrangement, as shown in the two different embodiments of the disposal containers (20). In particular, Figure 2 shows a first embodiment of a disposal container (20) in which the pad, when inserted, would align from top-to-bottom, and Figure 3 shows a second embodiment of a disposal container (20) in which the pad, when inserted, would align from side-to-side. (See May, col. 3, lines 28-31). As such, we hold that alignment of the pads side-to-side within the receptacle would have been matter of design choice and obvious to one of ordinary skill in the art at the time of the invention. Accordingly, we sustain the rejection of claim 8 as unpatentable over cited art.

***Rejection of Claim 8 under 35 U.S.C. § 112, first paragraph***

The examiner has determined that claim 8 contains subject matter –pads being horizontally aligned from side to side in the receptacle – that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention at the time the application was filed.

The appellants direct our attention to page 7, paragraph [0033] of the specification and Figures 13 and 14 for written description support for claim 8.

We agree with the appellants' position.

The factual inquiry for determining whether a specification provides sufficient written description for the claimed invention is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. *Vas-Cath, Inc. v. Mahurkar*, 935

F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). In the present case, the appellants demonstrated possession of the claimed invention by describing all of the limitations of claim 8 in the specification using words, as shown on page 6, para. [0031] and page 7, para. [0033], and using figures, as shown in Figures 13 and 14. Accordingly we do not sustain the rejection of claim 8 under 35 U.S.C. § 112, first paragraph.

***Rejections of Claims 1-8 under Obviousness-Type Double Patenting***

The appellants argue that for each of the obviousness-type double patenting rejections, the examiner failed to set forth how each of the elements of claims 1-8 are taught or suggested by the claims of the primary references cited. (Appellants' Brief, pp. 12-13). The examiner, on pages 13-15 of the Answer, provides a detailed analysis of how the patented claims of Ling, Kolterjohn, and McManus render pending claims 1-8 obvious in view of May. The appellant failed to rebut this analysis in its reply brief.

The examiner provided the appellants with a sufficient detailed basis for the double patenting rejection, and despite this explanation, the appellants have refused to address the rejection. On this basis, and further upon our own review of the patented claims, we see no reason not to sustain the rejections. As such, we sustain the examiner's double patenting rejections of claims 1-8.

## CONCLUSION

To summarize, (1) the rejection of claims 1-8 under 35 U.S.C. § 103(a) is sustained, (2) the rejection of claim 8 under 35 U.S.C. § 112, first paragraph is not sustained, and (3) the rejections of claims 1-8 under the judicially-created doctrine of obviousness-type double patenting is sustained.

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

*AFFIRMED IN PART*

MURRIEL E. CRAWFORD  
Administrative Patent Judge

JENNIFER D. BAHR  
Administrative Patent Judge

LINDA E. HORNER  
Administrative Patent Judge

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