

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte McNEIL-PPG, INC.

Appeal 2007-3158
Reexamination Control 90/006,467
Patent 6,310,269 B1
Technology Center 3700

Decided: May 30, 2008

Before TEDDY S. GRON, JAMESON LEE, and MARK NAGUMO,
Administrative Patent Judges.

GRON, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING (37 CFR §41.52(a)(1))

Appellant asks for rehearing of Appeal 2007-3158 under 37 CFR §41.52(a)(1). The regulation requires Appellant to state with particularity those points which the Board of Patent Appeals and Interferences (Board) is perceived to have misapprehended and/or overlooked in its original Decision On Appeal, mailed November 8, 2007 (Decision). Having considered all the points that the Board is said to have misapprehended and/or overlooked in its Decision, we deny rehearing of Appeal 2007-3158.

DENIED.

Discussion

Appellant requests rehearing for two reasons. In the Decision On Appeal, dated November 8, 2007, the Board is said to have (Request For Rehearing Under 37 C.F.R. § 41.52 (RH), pages (pp.) 2-3):

(1) misapprehended and/or overlooked the facts that Figures 8-11 of Japanese Unexamined Utility Model 55-168330, dated May 21, 1979 (hereafter Sasaki), are not drawn to scale and do not necessarily depict the subject matter Sasaki regards as its invention. Appellant argues that the drawings are a draftsman's representation of Sasaki's written description of the invention and do not necessarily depict what Sasaki regards as its invention; and

(2) misapprehended and/or overlooked the Examiner's findings, i.e., focusing anew on Sasaki's Figures 8 and 10, and substituting new findings and grounds of rejection under 35 U.S.C. § 102 for the Examiner's findings and grounds of rejection.

For the reasons stated, Appellant asks the Board to either (a) reconsider and reverse its ultimate finding based on Sasaki's Figures 8 and 10 that reexamined Claims 1 and 3 of U.S. Patent 6,310,269 B1 are unpatentable under 35 U.S.C. § 102(b) over Sasaki; or (b) "designate its affirmance [of the Examiner's final rejection] as a New Ground of Rejection under 37 C.F.R. § 41.50(b)" (RH, p. 1, first full para.). We deny both of Appellant's requests.

First, in Appellant's Brief (App. Br.), Appellant directed the Board to consider two key elements said to be missing from the tampon Sasaki describes, namely "the relative rib compression and spacing from adjacent ribs" (App. Br., p. 8). Focusing on the two key elements, the Board found

both reasonably depicted in Sasaki's Figures 8 and 10. Figures 8 and 10, considered in conjunction with Figures 5, 6, and 9 and Sasaki's written description of its tampon, reasonably appear to show the two key elements in a tampon defined by Appellant's claims. Thus, Appellant's argument that "the Examiner's analysis [of Sasaki] does not provide for a 'generally cylindrical compressed core'" (RH, p. 4, para. 1 and 2) is raised for the first time in this request for reconsideration, which is improper.

The Board affirmed the Examiner's final rejection over the applied prior art, properly reading Sasaki for everything it reasonably would have disclosed to a person having ordinary skill in the art and properly comparing what appears to be the closest comparable drawings. The Examiner stated (Ans., p. 5):

Sasaki discloses that in figures 6, 8 and 10-11, the drawstring compresses the center of the tampon (i.e. fiber core), even if only relied on for the fact that the string where sewn together with the fabric provides a compression which is not found in other areas where the string is not sewn with the absorbent. Therefore, the Sasaki reference does provide a tampon wherein the fiber core is more compressed than each of the ribs.

The Examiner also said (Ans., p. 5):

For example, the applicant refers to pages 2-3 of the English translation [of Sasaki]. The examiner also references this section The section makes reference to the compressed masses 15 as shown in figure 8.

The Board did not enter a new ground of rejection. The Board referred specifically to Figures 8 and 10. As stated in Sasaki (Sasaki, p. 3):

Figure 8 is a view of the anterior end face of a tampon that has been obtained by . . . [the] device [of Figure 7]. Figure 9 is a view on the side face of that tampon [having ribs 15 sewn together at a generally

cylindrical compressed center]. Figure 10 is the same view as in Figure 8 showing the state before body fluid absorption and Figure 11 is a view of the anterior end face showing the state of that tampon when it is swollen by absorption of body fluids.

The Board stated (Decision, p. 5): “Sasaki describes Figure 9 relative to Figures 8, 10, and 11” Then, the Board found (Decision, p. 6):

. . . Sasaki’s Figures 8 and 10 reasonably appear to depict the ribs of its tampon as being compressed less at the distal ends than at their ends proximal to the drawstring at the center of the drawn fiber strips.

. . . Sasaki’s Figures 8 and 10 reasonably appear to depict separation of each of the ribs from its adjacent ribs generally at its end proximal to the drawstring at the center of the drawn fiber ribs which is greater than the separation of each of the ribs from its adjacent ribs generally at its end distal to the drawstring at the center of the drawn fiber ribs.

Even if the Board drew its findings more from Sasaki’s Figures 8 and 10 than from Sasaki’s written description of its invention, which focus Appellant alleges is different from that of the Examiner, the Board did not overstep the limits of propriety. *See In re Hedges*, 783 F.2d 1038, 1039 (Fed. Cir. 1986)(the PTO should not be constrained from pointing to other portions of the same references in contravention of Appellant’s position). All three figures were referred to by the Examiner. The Board’s emphasis on Figures 8 and 10 rather than Figure 11 does not change the thrust of the rejection. Figure 11 is the swollen counterpart of Figures 8 and 10, and shows the same features. Figures 8, 10, and 11 all show more space between the ribs of the tampon at their ends proximal to the center (core) than at their ends distal to the center (core).

Finally, the Board strictly followed the sound guidance of *In re Aslanian*, 590 F.2d 911, 914 (CCPA 1979) (“[d]rawings are evaluated ‘on the basis of what they reasonably disclose and suggest to one skilled in the art’” (Decision, p. 3). Appellant cites *In re Wilson*, 312 F.2d 449, 454 (CCPA 1963), for the proposition that one skilled in the art cannot and should not rely on drawings to show dimensions (here relative rib separation and/or compression) where drawings are not to scale and were never intended to show dimensions (here relative rib separation and/or compression). On the other hand, Sasaki’s drawings can and should be considered for everything they reasonably appear to show in the context of the entire document.

It cannot be presumed without evidence that persons having ordinary skill in the art would have understood that Sasaki did not intend its drawings, which reasonably appear to show rib separation proximal to the core that is greater than the rib separation distal to the core, to show what they reasonably appear to show. Nor can it be presumed without evidence that persons having ordinary skill in the art would have understood that Sasaki did not intend its drawings, which reasonably appear to show ribs more compressed at their ends proximal to the core than at their ends distal to the core, to show what they reasonably appear to show. To take the opposite view without any evidence, few if any drawings could ever be relied upon to show what they reasonably appear to show. That view is contrary to the direction of *In re Aslanian, supra*. In any event, Appellant’s argument about what Sasaki intended to show is misplaced. What matters is what the disclosure would have shown to one with ordinary skill in the art, not whether that disclosure was or was not intentional.

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Conclusion and Order

Having considered Appellant's Request For Rehearing, dated December 28, 2007, and all the points that Appellant alleges that the Board misapprehended and/or overlooked in its original decision in Appeal 2007-3158, mailed November 8, 2007, and for the reasons stated herein, it is:

ORDERED that rehearing of Appeal 2007-3158 is DENIED; and
FURTHER ORDERED that the application is remanded to the Examiner for action consistent with the views expressed herein.

DENIED

qsg

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