

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DEAN L. RHOADES

Appeal 2007-4065
Application 10/295,397
Technology Center 3700

Decided: March 17, 2008

Before WILLIAM F. PATE, III, JENNIFER D. BAHR, and JOSEPH A.
FISCHETTI, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Dean L. Rhoades (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1-19 and 28-30. Claims 20-24, the only other pending claims, have been withdrawn from consideration as not

being directed to an elected invention. Claims 25-27 have been canceled.
We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

The Invention

Appellant's claimed invention is directed to a dermabrasion article comprising a dermabrasive soap composition and handle (Specification ¶ 6). Claims 1 and 10, reproduced below, are illustrative of the invention.

1. An apparatus comprising:

a solid composition including a plurality of abrasive particles and a plurality of cleansing agents; and

a handle protruding from a first side of the composition shaped to be held between at least two fingers,

wherein the composition is formed around a bottom section of the handle to secure the handle to the composition, the bottom section having a substantially planar member.

10. An apparatus comprising:

a cleansing means and exfoliation means including a plurality of abrasive particles and a plurality of cleansing agents; and

a gripping means to enable a human hand to hold the cleansing means, the gripping means attached to a structure within the cleansing means and exfoliation means.

The Rejections

The Examiner relies upon the following as evidence of unpatentability:

Staver	US 3,100,363	Aug. 13, 1963
Fowler	US 5,753,245	May 19, 1998
Kinsman	US 5,910,476	Jun. 8, 1999
Messenger	US 6,290,976	Sep. 18, 2001

The following rejections under 35 U.S.C. § 103(a) are before us for review.

- (1) Claims 1, 6-11, 16-19, and 28-30 stand rejected as unpatentable over Kinsman in view of Staver.¹
- (2) Claims 2 and 12 stand rejected as unpatentable over Kinsman in view of Staver and Messenger.
- (3) Claims 3, 4, 13, and 14 stand rejected as unpatentable over Kinsman in view of Staver and Fowler.
- (4) Claims 1, 5-11, 15-19, and 28-30 stand rejected as unpatentable over Staver in view of Kinsman.
- (5) Claims 1, 3-8, 10, 11, 15-19, and 28-30 stand rejected as unpatentable over Staver in view of Fowler.²

The Examiner provides reasoning in support of the rejections in the Answer (mailed March 29, 2006). Appellant presents opposing arguments in the Appeal Brief (filed February 16, 2006) and Reply Brief (filed May 30, 2006).

¹ The Examiner has withdrawn the rejection of claims 5 and 15 as unpatentable over Kinsman in view of Staver (Answer 4).

² The Examiner has withdrawn the rejection of claim 9 as unpatentable over Staver in view of Fowler (Answer 4).

THE ISSUES

The first issue presented in this appeal is whether Staver's handle comprises a bottom section having a substantially planar member, as called for in claims 1 and 11. This issue turns on whether the portion of the handle encompassed by Staver's peripheral edge 27 (fig. 5) is a substantially planar member or Staver's securing base element 18c (fig. 7) can reasonably be considered part of the handle, notwithstanding that it is bonded to cake material 11.

The second issue is whether the portion of the handle encompassed by Staver's peripheral edge 27 is disk shaped, as called for in claims 8 and 18.

A third issue is whether Staver's handle comprises a "gripping means" as recited in claim 10.

A fourth issue is whether either the handle portion encompassed by Staver's peripheral edge 27 or securing base element 18c is a plate, as called for in claims 28 and 30.

A fifth issue is whether either the Figure 5 embodiment or the Figure 7 embodiment of Staver includes a handle having a bottom section comprising a shaft extending from the handle and a base plate coupled to the shaft, as recited in claim 29.

A sixth issue is whether Staver's soap cake has a shape that is substantially a disk, as called for in claims 5 and 15.

A seventh issue is whether it would have been obvious to combine the teaching of using corundum abrasive material in Messenger with the abrasive-containing soap of Kinsman.

FINDINGS OF FACT

1. Kinsman teaches a soap bar containing abrasives (col. 1, ll. 13-14), such as pumice, talc, sand, or a combination thereof (col. 7, l. 35-36). Kinsman's soap bar is useful for removing heavy amounts of soil from the skin (col. 2, ll. 14-16).
2. Staver teaches a soap cake 11 and handle (col. 1, ll. 7-14) or holding means (col. 3, ll. 43 and 63). From our review of Figures 2, 5, and 7 of Staver, we find Staver's soap cake 11 to be circular in plan view and generally flat and thin, inasmuch as its height dimension is ostensibly smaller than its diameter.
3. Staver's Figure 5 embodiment includes a member 17c formed with a securing element 18a and a holding means or handle 21b secured to one another by a fastening means 20. The securing base element 18a includes a shoulder 22 and a peripheral edge 27 protruding beneath the shoulder 22. Peripheral edge 27 occupies space under shoulder 22 to reduce the amount of material required to form the soap cake 11 and the amount of material that may be left around the base when all of the soap material is worn away directly beneath surface 19. (col. 3, ll. 40-53) Viewing Staver's Figure 5 in combination with Staver's Figure 2 sectional view of the Figure 1 embodiment, a person of ordinary skill in the art would understand the surface 19 of the Figure 5 embodiment to be a circular planar surface.
4. Staver's Figure 7 embodiment is a detachable handle arrangement comprising a securing base element portion 18c bonded to the soap cake material 11 and provided with means (the shaft and knob on the

securing base element portion 18c) for receiving and holding a detachable handle 21a (col. 4, ll. 6-10).

5. As illustrated in Appellant's Figure 5 and Staver's Figures 10 and 11, Staver's handle is designed to accommodate the user's fingers against a narrow shank or stem 41 and between lower surface 43 of a relatively broad flange or head 42 and opposed surface 44 of member 17 (or securing base element 18a, for example), akin to Appellant's T-shaped cross bar and protective disk 205. Consequently, Staver's holding means "includes means enabling the hand to hold said member . . . between a pair of adjacent fingers" such that there is "a tendency for the opposed surfaces 43 and 44 to wedge the fingers between the same," thereby preventing slippage (col. 4, ll. 51-65). We thus find that Staver's handle, including the broad flange or head 42, narrow shank or stem 41, and the lower structure (securing base element 18a, for example) about which the soap cake 11 is formed, permits the user to grip the handle and soap cake in substantially the same manner as Appellant's T-shaped cross bar and protective disk 205.
6. Appellant discloses an embodiment of handle 101 comprising separate hard plastic pieces corresponding to the T-shaped top cross bar, protective disk 205, and lower disk structure 307 (fig. 3). The separate pieces are tapped through their centers to provide a threaded hole for receiving a central screw to fasten the pieces together. (Specification ¶ 18) Dermabrasive soap composition 103 is formed around the lower disk structure 307 (*id.*) This embodiment evidences that the components of a handle in accordance with Appellant's

- invention need not be formed as one unitary piece and, further, that the soap composition is formed around a portion of the handle as described in Appellant's invention.
7. Messenger teaches that corundum particles form a mildly skin abrasive powder (Abstract) that is an improvement over other abrasives used in dermabrasion products in that it avoids ripping of skin pores and the tearing of facial skin (col. 3, ll. 8-12).
 8. Fowler discloses a skin cleansing soap bar comprising loofah particles (col. 4, l. 45). Appellant does not dispute the Examiner's statement that loofah is a type of sponge (Answer 6, 8).

DISCUSSION

Rejections (1), (4), and (5)

Rejections (1), (4), and (5) are grounded on the Examiner's combination of the skin abrasive soap bar of either Kinsman or Fowler with the handle of Staver (Answer 5, 7, and 8). Appellant does not dispute the Examiner's determination that it would have been obvious to combine either the soap of Kinsman or the soap of Fowler with the handle of Staver. Rather, Appellant's arguments against each of these rejections are based on perceived deficiencies of Staver. Inasmuch as Appellant raises the same issues with respect to each of these rejections, we discuss these three rejections together, addressing each of Appellant's arguments in turn.

Appellant argues that Staver's handle lacks a bottom section having a substantially planar member, as recited in claims 1 and 11 (Appeal Br. 10-11, 19, 24; Reply Br. 5-6). The Examiner contends that either the peripheral edge 27, or the portion of the handle encompassed within peripheral edge

27, of Staver's Figure 5 or, alternatively, the securing base element 18c of Staver's Figure 7 embodiment is a substantially planar member (Answer 5, 9).

In particular, Appellant focuses on Staver's use of the terminology "peripheral edge" 27 and argues that such an edge cannot be characterized as a "planar member" (Appeal Br. 11). This argument is not persuasive. While Staver does use the terminology "peripheral edge," the description of such edge as occupying space beneath the shoulder 22 so as to reduce the amount of material needed to form the soap cake (Fact 3) suggests that, by peripheral edge, Staver intends to refer to the portion of the handle beneath the shoulder 22. In any event, even assuming that Staver's "peripheral edge 27" in fact refers to the peripheral edge, and not the portion of the handle encompassed within said peripheral edge, the Examiner's position that the portion of the handle encompassed within the peripheral edge 27, which has a circular, planar lower surface 19 (Fact 3), is a substantially planar member is well taken.

Appellant also argues that Staver's securing base element 18c (fig. 7) is embedded in soap cake 11 and thus is part of the soap cake, not part of the handle (Appeal Br. 11-12; Reply Br. 6). This argument is not well taken. Appellant's claims 1 and 11 do not require that the handle be formed as a one-piece unitary structure. In fact, Appellant's disclosed handle is not limited to a one-piece unitary structure (Fact 6). Further, claims 1 and 11 recite that the composition is formed around the bottom section of the handle. Consequently, the fact that Staver's securing base element 18c is bonded to the soap cake 11 (Fact 4) does not distinguish it from the bottom section of the handle recited in claims 1 and 11.

For the foregoing reasons, Appellant's argument does not demonstrate error in the Examiner's rejections of claims 1 and 11, and claims 6, 7, 9, 16, 17, and 19, which Appellant has not argued separately from claims 1 and 11, as being unpatentable over Kinsman in view of Staver and over Staver in view of Kinsman. Appellant's argument likewise fails to demonstrate error in the rejection of claims 1 and 11, and claims 3, 4, 6, 7, 16, 17, and 19, which Appellant has not argued separately from claims 1 and 11, as unpatentable over Staver in view of Fowler.

Appellant argues that Staver's peripheral edge 27 is not a bottom section of the handle having a disk shape, as called for in claims 8 and 18 (Appeal Br. 13-14, 20-21, 25-26). This argument appears to stem from Appellant's position that Staver's "peripheral edge" 27 is merely an edge and not a bottom portion having a disk shape. As discussed above, Staver's description of such edge 27 as occupying space beneath the shoulder 22 so as to reduce the amount of material needed to form the soap cake (Fact 3) suggests that, by peripheral edge, Staver intends to refer to the portion of the handle beneath the shoulder 22. In any event, even assuming that Staver's "peripheral edge 27" in fact refers to the peripheral edge, and not the portion of the handle encompassed within said peripheral edge, the Examiner's position that the portion of the handle encompassed within the peripheral edge 27, which has a circular, planar lower surface 19 (Fact 3), is a bottom portion having a disk shape is well taken. Appellant's argument is not persuasive of error in the Examiner's rejections of claims 8 and 18 as unpatentable over Kinsman in view of Staver, over Staver in view of Kinsman, and over Staver in view of Fowler.

Appellant argues that Staver's handle is not a "gripping means" as recited in claim 10 (Appeal Br. 14-15, 21-22, 26-28; Reply Br. 7-8). Appellant's position, in essence, is that "gripping means to enable a human hand to hold the cleansing means" is a recitation of means for performing a specified function covered by the sixth paragraph of 35 U.S.C. § 112 and, thus, must be construed to cover the corresponding structure described in Appellant's specification and equivalents thereof. According to Appellant, Staver's handle lacks a second structure to shield a user's hand from contact with the underlying abrasive soap cake and thus is neither the structure described in Appellant's specification nor an equivalent thereof (Appeal Br. 14-15, 22, 27; Reply Br. 7-8).

In order to meet a "means plus function" limitation, the prior art must (1) perform the identical function recited in the means limitation and (2) perform that function using the structure disclosed in the specification or an equivalent structure. *Cf. Carroll Touch Inc. v. Electro Mechanical Sys. Inc.*, 15 F.3d 1573, 1578 (Fed. Cir. 1994).

The function performed by the "gripping means to enable a human hand to hold the cleansing means" is enabling a human hand to hold the cleansing means. The structure described in Appellant's Specification for performing that function is Appellant's T-shaped cross bar and protective disk 205. We find that Staver's handle, including the broad flange or head 42, narrow shank or stem 41, and the lower structure about which the soap cake 11 is formed, is a like structure that permits the user to grip the handle and soap cake, the identical function recited in the "gripping means" limitation, in substantially the same manner as Appellant's T-shaped cross bar and protective disk 205 (Fact 5). We thus conclude that Staver's handle

meets the “gripping means” recitation of Appellant’s claim 10. Appellant’s argument is not persuasive of error in the Examiner’s rejections of claim 10 as unpatentable over Kinsman in view of Staver, over Staver in view of Kinsman, and over Staver in view of Fowler.

Appellant argues that neither the “peripheral edge 27” nor securing base element 18c of Staver is a “plate” as called for in claims 28 and 30 (Appeal Br. 15, 22-23, and 28). This argument appears to stem from Appellant’s position that “peripheral edge 27” is just an edge and securing base element 18c is not part of the handle. This argument is not well taken, for the reasons discussed above with regard to claims 1 and 11, and thus does not demonstrate error in the rejections of claims 28 and 30 as unpatentable over Kinsman in view of Staver, over Staver in view of Kinsman, and over Staver in view of Fowler.

Additionally, Appellant argues that Staver lacks a bottom section comprising a shaft, as called for in claim 29 (Appeal Br. 16-17, 23, 29; Reply Br. 9-10). Specifically, claim 29 recites “the bottom section comprises a shaft extending from the handle and a base plate coupled to the shaft.” The recitation of the shaft extending *from* the handle in claim 29 appears to be somewhat imprecise or misdescriptive of Appellant’s disclosed invention. The handle in claim 29 is defined as including both a planar member and a base plate, which ostensibly correspond to disks 205 and 307, as illustrated in Appellant’s Figure 3. Thus, the shaft, apparently illustrated in Figure 3, extends between portions of the handle and does not extend *from* the handle as a whole. Consistent with Appellant’s underlying disclosure, we interpret the limitation “extending from the handle” as

requiring that the shaft extend from some portion of the handle, not that it be a projection from the handle as a whole.

The handle of Staver's Figure 7 embodiment comprises a shaft extending from securing base element 18c and between element 18c and handle 21a (Fact 4). As discussed above, we find no error in the Examiner's position that securing base element 18c forms part of the structure of Staver corresponding to the "handle" recited in claims 1 and 11. Appellant's argument fails to demonstrate reversible error in the rejections of claim 29 as unpatentable over Kinsman in view of Staver, over Staver in view of Kinsman, and over Staver in view of Fowler.

Finally, Appellant argues that Staver does not expressly teach a substantially disk shaped soap cake material and thus does not satisfy the limitation in claims 5 and 15 that "the composition has a shape that is substantially a disc"(Appeal Br. 19-20, 24-25). We do not agree. A "disk" is generally understood to be "a thin, flat, circular thing of any material." *Webster's New World Dictionary* 405 (David B. Guralnik ed., 2nd Coll. Ed., Simon & Schuster, Inc. 1984). We find Staver's soap cake 11 to be circular in plan view and generally flat and thin, inasmuch as its height dimension is ostensibly smaller than its diameter (Fact 2). Staver's soap cake 11 thus has a shape that is substantially a disk. Appellant's argument fails to demonstrate the Examiner erred in rejecting claims 5 and 15 as unpatentable over Staver in view of Kinsman and Staver in view of Fowler.

In light of the above, we sustain rejections (1), (4), and (5).

Rejection (3)

In contesting the Examiner's rejection of claims 3, 4, 13, and 14 as unpatentable over Kinsman in view of Staver and Fowler, Appellant simply argues that Fowler does not cure the perceived deficiencies of the combination of Kinsman in view of Staver discussed above with respect to claims 1 and 11 (Appeal Br. 18). Having found this argument unpersuasive, for the reasons discussed above with respect to claims 1 and 11, we likewise find this argument unpersuasive of error in the Examiner's rejection of claims 3, 4, 13, and 14 as unpatentable over Kinsman in view of Staver and Fowler. We sustain the rejection.

Rejection (2)

Appellant argues that in the absence of Appellant's disclosure, a person of ordinary skill in the art would not be motivated to combine the applied references as proposed by the Examiner by adding corundum crystals to Kinsman's soap bar (Appeal Br. 17-18,; Reply Br. 10). In particular, Appellant argues that Messenger neither teaches nor suggests that corundum particles are suitable for use in a bar soap, such as that of Kinsman, for removing heavy amounts of soil from the skin (Fact 1). According to Appellant, one of ordinary skill in the art would understand that abrading the skin with corundum particles as used in Messenger, while the skin is covered in heavy soils, may cause infection or injury to the skin of the user (Appeal Br. 18). Appellant does not provide any evidence to support that argument. An attorney's arguments in a brief cannot take the place of evidence. *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974).

Although the requirement of demonstrating a teaching, suggestion, or motivation (the TSM test established by the Court of Customs and Patent Appeals) to combine known elements in order to show that the combination is obvious may be “a helpful insight,” it cannot be used as a rigid and mandatory formula. *KSR Int’l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). While there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

In any event, we do find motivation in Messenger to combine corundum crystals with Kinsman’s soap. As pointed out by the Examiner (Answer 13), Messenger clearly teaches an advantage to using corundum crystals over other known abrasives in skin cleansing compositions (Fact 7). Messenger thus would have prompted a person of ordinary skill in the art to use corundum crystals in Kinsman’s soap bar in order to provide a mild skin abrasive that avoids ripping of skin pores and the tearing of facial skin. Moreover, Messenger’s teaching belies Appellant’s argument that abrading the skin with corundum particles as used in Messenger, while the skin is covered in heavy soils, may cause infection or injury to the skin of the user.

In light of the above, Appellant’s argument does not demonstrate error in the Examiner’s rejection of claims 2 and 12 as unpatentable over Kinsman in view of Staver and Messenger. We sustain the rejection.

Appeal 2007-4065
Application 10/295,397

CONCLUSION

The decision of the Examiner to reject claims 1-19 and 28-30 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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