

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte THOMAS N. SPINA and ALBERT MALETSKY

Appeal 2008-2016
Application 10/178,814
Technology Center 1600

Decided: October 31, 2008

Before DEMETRA J. MILLS, RICHARD M. LEBOVITZ, and
FRANCISCO C. PRATS, *Administrative Patent Judges*.

MILLS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

This is an appeal under 35 U.S.C. § 134. The Examiner has rejected the claims for indefiniteness and for obviousness. We have jurisdiction under 35 U.S.C. § 6(b).

The following claim is representative.

1. A depilatory for removal of body hair comprising:

a water soluble, water dispersible hot melt adhesive blend coated on a first substrate and overlaid with a second substrate in a continuous fashion and cut to size dependent upon the area of the body to which it is applied, separation of said first and second substrate resulting in a first substrate having a water soluble, water dispersible hot melt adhesive blend on one side and a second substrate having a water soluble, water dispersible hot melt adhesive blend on one side, allowing application of the application of said water soluble, water dispersible hot melt adhesive blend on said first substrate and said second substrate to a portion of a user's skin, removal of said first substrate and said second substrate containing said water soluble, water dispersible hot melt adhesive blend from said user's skin removes body hair and any residue of said water soluble, water dispersible hot melt adhesive blend remaining on said user's skin is removable with water.

Cited References

Borglin	US 2, 326,609	Aug. 10, 1943
George	US 6,706,399 B1	Mar. 16, 2004

Grounds of Rejection

1. Claim 1 stands rejected under 35 U.S.C. § 112, second paragraph, for claim indefiniteness.
2. Claims 1-6 stand rejected under 35 U.S.C. § 103(a) as obvious over George in view of Borglin.

1. Claim 1 stands rejected under 35 U.S.C. § 112, second paragraph, for claim indefiniteness.

ISSUE

The Examiner contends that:

The claim recites a water-soluble, water-dispersible hot melt adhesive blend. The use of comma is inappropriate since the alternatives are just two there should be "And" or "OR to show if the two are required or one of them is required. Further, if "OR" of the claim is amended into "AND", it is not clear how one composition can be water-soluble and water-dispersible simultaneously. It is known that aqueous dispersions are comprised of water and a compound, which is water-insoluble. So it is unclear how can the same compound be water-soluble and water-insoluble.

(Ans. 3.)

Appellants do not contest this rejection in the Brief; however, we find the rejection to be without merit.

Thus the issue is whether the comma in claim 1 renders the claim indefinite.

PRINCIPLES OF LAW

Every patent's specification must "conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35 U.S.C. § 112, ¶ 2 (2000). Because the claims perform the fundamental function of delineating the scope of the invention, *Chimie v. PPG Indus., Inc.*, 402 F.3d 1371, 1379 (Fed. Cir. 2005), the purpose of the definiteness requirement is to ensure that the claims delineate the scope of the invention using language that adequately notifies the public of the patentee's

right to exclude, *Honeywell Int'l, Inc. v. Int'l Trade Comm'n*, 341 F.3d 1332, 1338 (Fed. Cir. 2003).

According to the Supreme Court, “[t]he statutory requirement of particularity and distinctness in claims is met only when [the claims] clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise.” *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236, 63 S. Ct. 165, 87 L.Ed. 232 (1942). The definiteness requirement, however, does not compel absolute clarity. Only claims “not amenable to construction” or “insolubly ambiguous” are indefinite. *See Novo Indus., L.P. v. Micro Molds Corp.*, 350 F.3d 1348, 1353 (Fed. Cir. 2003); *Honeywell Int'l*, 341 F.3d at 1338; *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001). Thus, the definiteness of claim terms depends on whether those terms can be given any reasonable meaning. Furthermore, a difficult issue of claim construction does not *ipso facto* result in a holding of indefiniteness. *Exxon Research & Eng'g*, 265 F.3d at 1375. “If the meaning of the claim is discernible, even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree, we have held the claim sufficiently clear to avoid invalidity on indefiniteness grounds.” *Id.* In this regard it is important to note that an issued patent is entitled to a statutory presumption of validity. *See* 35 U.S.C. § 282 (2000). “By finding claims indefinite only if reasonable efforts at claim construction prove futile, we accord respect to the statutory presumption of validity and we protect the inventive contribution of patentees, even when the drafting of their patents has been less than ideal.” *Exxon Research & Eng'g*, 265 F.3d at 1375 (citation omitted).

Datamize, LLC, v. Plumtree Software, Inc., 417 F.3d 1342, 1347 (Fed. Cir. 2005).

FINDINGS OF FACT

In the present case, the Specification, page 4, lines 3-7, discloses several water soluble or water dispersible polymers within the scope of the invention. The terms "water soluble" or "water dispersible" are both used in the Specification to describe hot melt adhesives. (Spec. 3, last para.)

ANALYSIS

Thus, we do not find the language in claim 1 to be indefinite under the law as both terms may describe a hot melt adhesive.

CONCLUSION OF LAW

For this reason, we do not find that the comma in claim 1 renders the claim indefinite.

The rejection of claim 1 for indefiniteness is reversed.

2. Claims 1-6 stand rejected under 35 U.S.C. § 103(a) as obvious over George in view of Borglin.

ISSUE

The Examiner contends that the combination of George and Borglin teaches a water soluble, water dispersible hot melt adhesive blend coated on a first substrate and overlaid with a second substrate, as claimed.

Appellant contends that the combination of references does not disclose this feature. (Br. 7.)

The issue is whether the combination of George and Borglin teaches a water soluble, water dispersible hot melt adhesive blend coated on a first substrate and overlaid with a second substrate, as claimed.

PRINCIPLES OF LAW AND ANALYSIS

An obviousness determination must reach all the elements in a claim. See e.g., *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)).

FINDINGS OF FACT

Figure 1 of the Specification discloses "adhesive blend 12 is melted and coated onto a first substrate 14 and is then overlaid with a second substrate 16." (Spec. 7.)

Borglin discloses a depilatory composition spread as a thin layer over a cloth of sufficient size to cover an area of the skin. (Borglin, col. 2, ll. 2-24.)

Neither George nor Borglin discloses or suggests a hot melt that is overlaid by both a first and second substrate as claimed.

ANALYSIS

We do not find the Examiner has presented sufficient evidence to support a prima facie case of obviousness. In particular, we do not find that the Examiner has provided evidence in the prior art of a water soluble, water dispersible hot melt adhesive blend coated on a first substrate and overlaid with a second substrate. Borglin discloses a depilatory composition spread

as a thin layer over a cloth of sufficient size to cover an area of the skin. Neither George nor Borglin discloses a hot melt that is overlaid by both a first and second substrate as claimed.

CONCLUSION OF LAW AND DECISION

The combination of George and Borglin does not disclose a water soluble, water dispersible hot melt adhesive blend coated on a first substrate and overlaid with a second substrate, as claimed. In view of the above, the obviousness rejection over George in view of Borglin is reversed.

In conclusion, the Examiner's decision rejecting claim 1 under 35 U.S.C. § 112, second paragraph, is reversed. The Examiner's decision rejecting claims 1-6 under 35 U.S.C. § 103(a) is reversed.

The decision of the Examiner is reversed.

REVERSED

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