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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DEBRA GAY GEHRING

Appeal 2014-004556
Application 12/485,073¹
Technology Center 3700

Before JENNIFER D. BAHR, STEFAN STAICOVICI, and
FREDERICK C. LANEY, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Debra Gay Gehring (Appellant) appeal under 35 U.S.C. § 134(a) from the Examiner's Final decision rejecting claims 1–5, 7, and 10–19.² We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We REVERSE and ENTER NEW GROUNDS OF REJECTION PURSUANT TO OUR AUTHORITY UNDER 37 C.F.R. § 41.50(b).

¹ According to Appellant, the real party in interest is The Procter & Gamble Company. Br. 1 (filed Nov. 25, 2013).

² Claims 6, 8, 9, and 20 have been cancelled. *Id.*

INVENTION

Appellant's invention relates to "a reusable wipes container." Spec. 1, l. 6.

Claims 1 and 16 are independent. Claim 1 is illustrative of the claimed invention and reads as follows:

1. A reusable container for storing and dispensing wipes, the wipes container comprising:
 - a. an upper container shell hingedly joined to a lower container shell such that the upper and lower shells can be configured in an open position and a closed position, wherein an interior storage space is defined by the upper and lower shells when the shells are in the closed position, the upper and lower shells being at least partially separable from one another to enable a user to replenish a depleted wipes supply in the container;
 - b. an opening in the upper shell that enables a user to access at least one wipe stored in the interior storage space, and a lid connected to the upper shell and disposed over the opening; wherein the upper and lower shells are formed of a molded synthetic polymeric foam material wherein the synthetic polymeric foam has an Effusivity value at 23° C and 32° C of from 200-300, according to the Sensory Warm Test, and the lid is formed of a different polymeric material than the shells.

REJECTIONS

The following rejections are before us for review:

- I. The Examiner rejected claims 1–3, 5, 10–12, and 15–18 under 35 U.S.C. § 103(a) as unpatentable over Reinke (US 6,910,579 B2, iss. June 28, 2005), Miller (US 2007/0084742 A1, pub. Apr. 19, 2007), and Ishikawa (US 5,699,912, iss. Dec. 23, 1997).
- II. The Examiner rejected claims 4 and 7 under 35 U.S.C. § 103(a) as unpatentable over Reinke, Miller, Ishikawa, and Kolb (US 3,471,356, iss. Oct. 7, 1969).

III. The Examiner rejected claim 13, 14, and 19 under 35 U.S.C. § 103(a) as unpatentable over Reinke, Miller, Ishikawa, and Richardson (US 5,165,567, iss. Nov. 24, 1992).

Rejection I

The Examiner finds that although the combined teachings of Reinke, Miller, and Ishikawa disclose most of the limitations of independent claims 1 and 16, they fail to disclose the claimed effusivity value range of the molded polymeric foam material. *See* Final Act. 3, 7 (transmitted June 24, 2013). Nonetheless, the Examiner finds that “the EVA of Miller would *inherently* have the claimed effusivity value” range. *See id.* at 4 (emphasis added).

In response, Appellant argues that the Examiner “has not shown that the EVA foam mentioned by Miller et al. would *necessarily* have only a particular range of effusivity (falling within the range of [Appellant’s] claims), or that this would be recognized by a person of ordinary skill in the art.” Br. 7 (emphasis added).

It is well settled that a certain characteristic may in fact occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *See In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). “Inherency [] may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). In this case, Appellant presents persuasive evidence that “compression molded EVA foam as taught by Miller et al. may have an [e]ffusivity [v]alue outside of the recited range.” Br. 7. More specifically,

Appellant correctly points to the Specification and notes that samples 8C, 9C, and 11C are compression molded EVA foam, which are like Miller's material (*see* Miller, para. 55), and have an effusivity value at 23° C and 32° C outside the claimed range of 200–300. *See id.* (citing Spec. 16, ll. 3–4 and Table I). Although we appreciate the Examiner's position that sample 12C shown in Table I of Appellant's Specification has an effusivity value overlapping the claimed range (*see* Ans. 3–4 (transmitted Dec. 24, 2013)), because sample 12C is part of Appellant's Specification, it does not constitute prior art against the claimed effusivity range subject matter. *In re Pleuddemann*, 910 F.2d 823 (Fed. Cir. 1990).

As such, although Miller discloses compression molded EVA foam material, this does not mean that Miller's molded foam material necessarily has an effusivity value at 23° C and 32° C of 200–300, as called for by each of independent claims 1 and 16. Accordingly, the combined teachings of Reinke, Miller, and Ishikawa fail to disclose explicitly or inherently the claimed effusivity value range.

The Examiner further attempts to present an alternative position stating that, "it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice." Final Act. 4, 7 (citing *In re Leshin*, 277 F.2d 197 CCPA (1960)); *see also* Ans. 3. However, the Examiner's mere reliance on *In re Leshin* amounts to a *per se* rule that eliminates the need for fact-specific analysis of claims and prior art and is legally incorrect. Our precedents do not establish any rules of obviousness, just as those precedents themselves expressly declined to create such rules. *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995).

In conclusion, for the foregoing reasons, we do not sustain the rejection under 35 U.S.C. § 103(a) of claims 1–3, 5, 10–12, and 15–18 as unpatentable over Reinke, Miller, and Ishikawa.

Rejections II and III

The Examiner's use of the Kolb and Richardson disclosures does not remedy the deficiencies of the combined teachings of Reinke, Miller, and Ishikawa, as discussed *supra*. See Final Act. 9–10. Accordingly, for the same reasons as discussed above, we also do not sustain the rejections under 35 U.S.C. § 103(a) of claims 4 and 7 as unpatentable over Reinke, Miller, Ishikawa, and Kolb and of claims 13, 14, and 19 as unpatentable over Reinke, Miller, Ishikawa, and Richardson.

NEW GROUND OF REJECTION

We make the following new ground of rejection pursuant to 37 C.F.R. § 41.50(b).

Claims 1 and 16 are rejected under 35 U.S.C. § 103(a) as unpatentable over Reinke and Ishikawa.

Reinke discloses a reusable wipes container 10 made from injection molded polypropylene including, an upper shell 14 hingedly connected to a lower shell 12, together forming an interior storage space 18, wherein the upper and lower shells are configured in open and closed positions and partially separable to enable a user to replenish a depleted wipes supply. See Reinke, col. 2, l. 57–col. 3, l. 2; col. 4, ll. 39–40; and Fig. 1. Reinke further discloses an opening 20 in upper shell 14 that enables a user access to

storage space 18 and a lid 21 connected to upper shell 14. *See id.*, at col. 3, ll. 10–15.

Reinke fails to disclose that the material of lid 21 is different from the material of shells 12, 14. Ishikawa discloses a wipes container having a stationary lid member 21 made from soft polypropylene and a movable lid member 23 made from hard polypropylene. *See* Ishikawa, col. 1, ll. 39–40 and 66–67; col. 5, ll. 4–11; and Fig. 1. Therefore, it would have been obvious for a person of ordinary skill in the art to make lid 21 of Reinke’s container from a harder, different plastic than the material of shells 12, 14, as taught by Ishikawa, in order to provide a rigid lid for easy opening and closing.

Reineke, as modified by Ishikawa, fails to disclose that the material of the shells has an effusivity value at 23° C and 32° C in the range of 200–300 and a thermal conductivity at 23° C and 32° C in the range of 0.04–0.190 W/mK, according to the Sensory Warm Test.

However, the selection of a suitable material is a matter of obvious design choice. *In re Leshin*, 277 F.2d 197 CCPA (1960). In the context of a rejection based on design choice, the relevant issue is whether the alleged differences between the claimed invention and the prior art “result in a difference in function or give unexpected results.” *See In re Rice*, 341 F.2d 309, 314 (CCPA 1965). Here, the materials described in Appellant’s Table I are commercially available and the material properties of effusivity³ and

³ “One such characteristic may be the *commonly* known property of effusivity, sometimes referred to as thermal inertia.” Spec. 1, ll. 24–25 (emphasis added).

thermal conductivity⁴ are well known. *See* Spec. 15, ll. 17–25 and 16, ll. 3–4. Furthermore, Appellant’s Specification describes, “[s]uitable effusivity values for the presently disclosed wipes containers may include an [e]ffusivity value at 25° C and 32° C of less than 500, for example, from 100 to 400, 200 to 300, or any value within these ranges, when measured according to the Sensory Warmth Test.” Spec. 11, ll. 30–33. As for the claimed thermal conductivity range, Appellant’s Specification states that in addition to materials having a thermal conductivity value within the claimed range of 0.04–0.190 W/mK, materials having a thermal conductivity of 0.01 and 0.03 W/mK, which are outside the claimed range, can equally be used. *See id.* at 14, ll. 11–13.

As such, whether the effusivity value of the material used for making the claimed containers, is within the claimed range of 200–300, or outside this range (but below 500), the resulting reusable wipe containers are suitable for holding wipes. In a similar vein, whether the thermal conductivity value of the material used for making the claimed containers is within the claimed range of 0.04–0.190 W/mK, or outside this range, i.e., 0.1 or 0.3 W/mK, the resulting reusable wipe containers are suitable for holding wipes. In other words, there is no evidence of record to express the criticality of the claimed ranges and, thus, the claimed effusivity range of 200–300 and the claimed thermal conductivity range of 0.04–0.190 W/mK do not “result in a difference in function or give unexpected results.” *Rice*, 341 F.2d at 314. Accordingly, the mere selection of a known plastic

⁴ An artisan must be presumed to know something about the art apart from what the references disclose. *See In re Jacoby*, 309 F.2d 513, 516 (CCPA 1962).

material having the claimed ranges for effusivity and thermal conductivity to make Reinke's plastic container, as modified by Ishikawa, would have been an obvious design choice for a person skilled in the art.

With respect to claims 2–5, 7, 10–15, and 17–19, although we decline to reject every claim under our discretionary authority under 37 C.F.R. § 41.50(b), we emphasize that our decision does not mean the remaining claims are patentable. Rather, we merely leave the patentability determination of these claims to the Examiner. *See* MPEP § 1213.02.

SUMMARY

The Examiner's decision to reject claims 1–5, 7, and 10–19 is reversed.

We enter a new ground of rejection of claims 1 and 16 under 35 U.S.C. § 103(a) as unpatentable over Reinke and Ishikawa.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the prosecution will be remanded to the Examiner. The new ground of rejection is

binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

REVERSED; 37 C.F.R. § 41.50(b)