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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAMES SCHAEFFER and CLIFF BRIDGES

Appeal 2015-005239
Application 11/911,922
Technology Center 1700

Before LINDA M. GAUDETTE, CHRISTOPHER L. OGDEN, and LILAN REN,
Administrative Patent Judges.

GAUDETTE, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants¹ appeal under 35 U.S.C. § 134(a) from the Examiner's decision² twice rejecting claims 8, 13, 15, and 23–29. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

Claim 8, the sole independent claim on appeal, is representative of the claimed invention, and is reproduced below:

8. A dry limited use cloth activatable by exposure to a source of water comprising:

two hydroentanglement-bonded nonwoven fabric layers, wherein each said fabric layer has a first outer expansive surface and a second inner expansive surface, wherein each said fabric layer has a hydroentangled three-dimensional image comprising at least one raised portion in said outer expansive surface; and

at least one personal care composition positioned between said inner expansive surfaces of said fabric layers, wherein said personal care composition comprises a dry soap, and wherein said personal care composition is visibly distinct through at least one of said fabric layers and provides visual indication of the available amount of composition remaining within said cloth after each use.

The claims stand rejected as follows (*see* Act. 3–7):

1. claims 8, 13, 15, 24–26, 28, and 29 under pre-AIA 35 U.S.C. § 102(e) as anticipated by Benjamin et al. (US 2005/0125877 A1, pub. June 16, 2005 (“Benjamin”)); and

2. claims 8, 13, 15, and 23–29 under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Benjamin.

¹ Appellants identify the real party in interest as PGI Polymer, Inc. Appeal Brief filed Nov. 13, 2014 (“Br.”), 1.

² Non-Final Office Action mailed July 15, 2014 (“Act.”).

Rejection under 35 U.S.C. § 102(e)

Appellants contend the Examiner's anticipation rejection is improper because it "is premised on multiple instances of picking and choosing one option over others shown for various features in Benjamin, and then combining only those selected options in an effort to inherently construct a dry limited use cloth *as recited* in claim 8 on appeal." Br. 10. Appellants argue "the Examiner cites and relies on the contents of no less than ten (10) different paragraphs of Benjamin, viz., paragraphs [0099], [0097], [0092], [0094], [0112], [0113], [0115], [0116], [0066], and [0086], which are not related to each other by the reference as a disclosure of a single common embodiment." *Id.* at 6. The Examiner, in response, maintains the anticipation rejection is proper because the "different paragraphs of Benjamin . . . were cited to establish the totality of the teachings of Benjamin." Examiner's Answer, mailed Feb. 10, 2015 ("Ans."), 8. The Examiner contends "Appellant has not established that there is any need for picking and choosing, as Appellant has not established any inconsistencies between the paragraphs recited." *Id.*

Under 35 U.S.C. § 102(e), a reference anticipates if it clearly and unequivocally discloses the claimed invention or directs those skilled in the art to the invention without any need for picking, choosing, and combining various disclosures not related directly to each other by the teachings of the cited reference. *See In re Arkley*, 455 F.2d 586, 587–88 (CCPA 1972). "[A] reference can anticipate a claim even if it 'd[oes] not expressly spell out' all the limitations arranged or combined as in the claim, if a person of skill in the art, reading the reference, would 'at once envisage' the claimed arrangement or combination." *Kennametal, Inc. v. Ingersoll Cutting Tool Co.*, 780 F.3d 1376, 1381 (Fed. Cir. 2015) (quoting *In re Petering*, 301 F.2d 676, 681 (1962)).

Having reviewed the paragraphs in Benjamin relied upon by the Examiner in rejecting the claims, we are not convinced that the ordinary artisan would have immediately envisaged the combination of features recited in appealed claim 8. The Examiner identifies a teaching in Benjamin of each of the individual features recited in claim 8. The Examiner does not identify, however, a clear description of an embodiment that includes a combination of the features recited in claim 8, nor does the Examiner identify disclosure that reasonably could be considered as directing the artisan to the invention without the need for picking, choosing and combining unrelated disclosures. For example, Benjamin identifies hydroentanglement as one of several suitable manufacturing techniques for producing the nonwoven sheet members of the disclosed disposable, nonwoven mitt. Benjamin ¶ 92. Benjamin describes several different embodiments for the surface of the nonwoven sheet members, one of which includes an optional raised surface (e.g., a 3-D image). *See id.* ¶ 97. Benjamin also lists a visual indicator as one of several types of suitable usage indicators. *See id.* ¶ 86. The Examiner does not identify, however, an embodiment that includes hydroentanglement-bonded nonwoven fabric layers having three-dimensional images thereon, as well as a visual indicator of the available amount of composition remaining. Nor does the Examiner explain persuasively why the ordinary artisan would at once envisage this particular combination despite Benjamin's disclosure of a number of other suitable techniques for manufacturing the nonwoven sheet members, several different options for the outer surface structure of the nonwoven sheet members, and a variety of usage indicators. The Examiner does not explain clearly how Benjamin provides direction to select the specifically claimed features from these various options to achieve the claimed combination.

In sum, Appellants have argued persuasively that the evidence relied on by the Examiner fails to support a finding that the ordinary artisan, upon reading Benjamin, would at once envisage the invention as claimed in claim 8. Accordingly, we do not sustain the rejection of claims 8, 13, 15, 24–26, 28, and 29 under pre-AIA 35 U.S.C. § 102(e) as anticipated by Benjamin.

Rejection under 35 U.S.C. § 103(a)

Appellants argue Benjamin fails to disclose or suggest at least five limitations recited in claim 8. *See* Br. 14–17. Appellants also argue Benjamin fails to teach the limitations recited in each of the dependent claims. *Id.* at 18–25. We are persuaded by and, therefore, limit our discussion to Appellants’ argument that the Examiner fails to identify a teaching or suggestion of a dry limited use cloth comprising a “personal care composition [that] is visibly distinct through at least one of said fabric layers [of the cloth] and provides visual indication of the available amount of composition remaining within said cloth after each use,” as recited in claim 8. *See* Br. 16–17.

The Examiner determines “the invention is obvious because Benjamin discloses the claimed constituents and discloses that they may be used alternatively or in combination.” Act. 6. With respect to the above-quoted claim 8 limitation, the Examiner makes the following findings: Benjamin discloses a mitt comprising a nonwoven sheet member that releasably carries a benefit composition on the exterior surface, interior, and/or interior surface. *Id.* at 4 (citing Benjamin ¶ 66). Benjamin discloses that the mitt may include a usage indicator that is a separate feature, part of the benefit composition, or part of a child graphic. *Id.* (citing Benjamin ¶ 86). “Benjamin teaches that in one optional embodiment the usage indicator provides a visual signal during the use of the mitt when at least a portion

of the benefit composition has been released from the mitt.” *Id.* (citing Benjamin ¶ 86).

Appellants argue the evidence relied on by the Examiner is insufficient to support a finding that Benjamin teaches or suggests an indicator that is visibly distinct through a nonwoven sheet member. *See* Br. 16–17. Appellants argue that although Benjamin teaches the individual features of a benefit composition on an interior surface of the mitt, a benefit composition that includes a usage indicator, and a mitt containing a visual indicator, the Examiner fails to identify a teaching or suggestion of using these three features in combination. *Id.* at 17 (“Benjamin does not specifically teach or suggest that the indicator can be used in *every* benefit composition of the reference.”). Appellants further argue that the Examiner does not explain why the ordinary artisan would have had a reasonable expectation of success in combining these features. *See id.* (“Benjamin does not specifically teach or suggest that the indicator . . . remains visually detectible if used on an interior surface of one of the nonwoven sheet members of the mitt.”).

In response, the Examiner again provides citations to Benjamin’s disclosure of each individual feature, but fails to clearly identify a reason why the ordinary artisan would have selected and combined these features to achieve a “personal care composition [that] is visibly distinct through at least one of said fabric layers [of the cloth] and provides visual indication of the available amount of composition remaining within said cloth after each use,” as recited in claim 8. *See* Ans. 9–10. The Examiner does not identify any direction in Benjamin to select, from among the numerous possible choices, the particular combination of features recited in claim 8. *See PharmaStem Therapeutics, Inc. v. ViaCell, Inc.*, 491 F.3d 1342, 1364 (Fed Cir. 2007) (explaining that an obviousness rejection predicated on selection of one or more components from numerous possible choices may be

appropriate if the prior art provides direction as to which of many possible choices is likely to be successful). Nor does the Examiner identify in Benjamin a teaching or suggestion to support a finding that the ordinary artisan would have expected an indicator on the interior of Benjamin's mitt to be "visibly distinct through at least one of [the] fabric layers" as recited in claim 8. *See* Ans. 10 (arguing that "if the usage indicator is part of the benefit composition and provides a visual signal indicating that at least a portion of the benefit composition has been released, the composition must be visually distinct through one of the fabric layers, as otherwise it would be impossible to have a visual signal," but failing to identify a teaching or suggestion that a visual indicator can be used when the benefit composition is located on only an interior surface of the mitt). Rather, on the record before us, the only basis for the Examiner's combination is improper hindsight reasoning.

Accordingly, we do not sustain the rejection of claims 8, 13, 15, and 23–29 under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Benjamin.

REVERSED