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SCA Hygiene Products AB c/o Buchanan Ingersoll & Rooney, PC 1737 King Street, Suite 500 Alexandria, VA 22314			PHILIPS, BRADLEY H	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LUCAS BÄCK, TONY KARLSSON, and
LENNART NILSSON

Appeal 2017-001869
Application 13/994,970¹
Technology Center 3700

Before STEFAN STAICOVICI, WILLIAM V. SAINDON, and
BRANDON J. WARNER, *Administrative Patent Judges*.

SAINDON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner’s rejections of claims 1–5, 7, 8, and 12–14, which are all of the pending claims. Final Office Action (November 30, 2015) (“Final Act.”). We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

¹ Appellants identify SCA Hygiene Products AB as the real party in interest. Appeal Brief (April 21, 2016) (“Appeal Br.”), 2.

CLAIMED SUBJECT MATTER

The claimed subject matter relates to disposable absorbent pants in the form of boxer shorts. Spec. 4–5. Claim 1 is the sole independent claim and is reproduced below with emphasis added:

1. An absorbent pant article in the form of boxer shorts comprising:

a garment shell including a front body panel, a back body panel, and a crotch panel positioned between the front and back body panels, an absorbent core arranged in at least the crotch panel, side seams connecting the front body panel to the back body panel, and a pair of leg openings and hanging legs, said article having a longitudinal direction and a transverse direction, wherein

each of said front body panel, back body panel and crotch panel is made of elastic web material, the leg openings are located in the crotch panel and do not extend into the front and back body panels, and said side seams extend into the crotch panel, and the width of the crotch panel in a relaxed condition of the elastic web material, as measured in the transverse direction between the side seams of the article, is at least 7% larger than the width of any of the front and back body panels in a relaxed condition of the elastic web material of the front and back body panels, as measured between the side seams of the article, and

the elastic web material in the crotch panel is a separate elastic web material attached to the elastic web material of the front and back body panels, and the elastic web material in the crotch panel is joined to the elastic web material in at least one of the front and back body panels while at least the elastic web material of said at least one of the front and back body panels is held in an elongated condition, and the elastic web material in the crotch panel is in a relaxed condition or in a less elongated condition as compared to the elastic web material in said at least one of the front and back body panels, or alternatively the elastic web material in the crotch panel is the same and integral with the elastic web material in the front and back body panels, and exhibits a quality of having been exerted to a treatment that has extended or deformed the elastic web material in the crotch panel

in the transverse direction of the absorbent pant article so that the width of the crotch panel is larger than the width of any of the front and back body panels.

EVIDENCE

Igaue et al. (“Igaue”)	US 4,743,241	May 10, 1988
Coenen et al. (“Coenen”)	US 2005/0120466 A1	June 9, 2005
Turner et al. (“Turner”)	US 2010/0262103 A1	Oct. 14, 2010

REJECTIONS

The Final Office Action includes the following rejections under pre-AIA 35 U.S.C. § 103(a):

1. Claims 1–5, 7, and 12–14 are rejected as unpatentable over Coenen and Igaue.
2. Claim 8 is rejected as unpatentable over Coenen, Igaue, and Turner.

ANALYSIS

A dispositive issue in this appeal is whether the rejections address sufficiently the limitation requiring the elastic web material in the crotch panel to “exhibit[] a quality of having been exerted to a treatment that has extended or deformed . . . the crotch panel in the transverse direction . . . so that the width of the crotch panel is larger than the width of . . . the front and back body panels.”² The Examiner’s rejections both rely on Coenen to teach a transverse deformation treatment (Final Act. 4 (citing Coenen, Fig. 4 and ¶¶ 116, 121)), and Igaue to teach a wider crotch panel (*id.*). *See also*

² The transverse direction corresponds to the width x of the worn article. Spec. 11:2–4; Fig. 1 (depicting an article in accordance with the disclosed invention, with the x-axis shown for reference).

Examiner's Answer (Sept. 22, 2016) ("Ans."), 6 (stating that the rejections address the limitations of "deformation in the transverse direction (Coenen) and a crotch panel wider than the front or back body panels (Igaue[])").

Appellants argue that Coenen's deformation treatment actually serves to shorten the crotch panel (in the longitudinal direction), and does not serve to widen it relative to the front and back panels. Appeal Br. 8. The Examiner responds that "nothing in the claims requir[e] that the transverse deformations *cause* the crotch panel to be wider than the front and back body panels." Ans. 5. The Examiner additionally asserts that the limitation is a product-by-process limitation and "the claim is unpatentable even though the prior product was made by a different process." *Id.* at 6. The Examiner goes on to note that Coenen teaches a deformation in the transverse direction and Igaue discloses a crotch panel wider than the front or back body panels; thus, according to the Examiner, the claim limitations are satisfied. *Id.* In their Reply Brief of November 15, 2016 ("Reply Br."), Appellants argue that the phrase "so that" in the claim means that the deformations result in a wider crotch panel. *See* Reply Br. 6. Appellants also reply to the Examiner's product-by-process position by stating that the resulting products are not the same because Coenen's corrugations shorten the crotch panel. *Id.* at 6–7.

Reviewing the record before us, we agree with Appellants. Claim 1 recites that the crotch panel "exhibits a quality of having been exerted to a treatment that has extended or deformed the . . . material . . . in the transverse direction." Regardless of whether one labels this recitation as functional, structural, or product-by-process language, the claim describes the physical characteristics of the panel. It has deformations or extensions in

the transverse direction. Claim 1 further recites that these deformations or extensions happen “so that the width of the crotch panel is larger” than the remainder of the article. Again, regardless of labels, the claim describes deformations or extensions that make the panel “so that” it is wider than another portion of the article. Based on the plain language of the claim, the transverse extensions/deformations have a structure that makes the crotch panel wider. In other words, the claim requires that the deformations or extensions must have physical characteristics that cause the crotch panel to be wider. As made clear in the Specification, there is more than one way to achieve a wider crotch panel (e.g., compressed front/back panels vs. deformed/extended crotch panel). Spec. 11:20–30, 12:5–9. These different treatments result in structurally different articles. The article where the crotch panel is not deformed is different from the article where the crotch panel is deformed, even if both articles have wider crotch panels.

Assuming for the sake of argument that the limitation at issue is a product-by-process limitation, the prior art structure still must be measured against the structure resulting from the process. *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1317 (Fed. Cir. 2006) (“[t]he patentability of a product does not depend on its method of production”). The key here is that the structure of the crotch panel in claim 1 is indelibly tied to the treatment it undergoes. The deformations are not just a method of producing the crotch panel, they structurally change the crotch panel into something different.

In sum, under the broadest reasonable interpretation consistent with the Specification, claim 1 does not just claim an article with a wider crotch panel, it claims an article with a wider crotch panel due to the structure that

results from the claimed treatment. Thus, the prior art must have the same structure as an article having undergone the claimed treatment.

In the Examiner's rejections, the Coenen deformations do not make the crotch panel wider. As shown in Figure 12 of Coenen, for example, it is apparent that the corrugations run parallel to the transverse direction, i.e., in the longitudinal direction. *See also* Coenen ¶¶ 116 (noting that the article rolls over a drum with teeth that push the article into grooves), 122 (similar, but the treatment is applied only in the crotch area); Appeal Br. 8; Reply Br. 4–6. With the teeth forming the deformations parallel to the transverse direction, the corrugations in Coenen do not serve to widen the crotch panel. Because the Coenen article, even in view of Igaue, does not have the same structure as an article having undergone a treatment “so that the width of the crotch panel is larger,” in the manner required by sole independent claim 1, we do not sustain either rejection.³

DECISION

The Examiner's rejections are reversed.

REVERSED

³ The second rejection, which adds Turner to address a limitation of dependent claim 8, likewise relies on Coenen to teach the crotch panel treatment. Final Act. 9.