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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RYAN VIDOTTO and DEBORAH VIDOTTO

Appeal 2018-002720
Application 14/800,106¹
Technology Center 3700

Before LINDA E. HORNER, WILLIAM A. CAPP, and
JEFFREY A. STEPHENS, *Administrative Patent Judges*.

Opinion for the Board filed by HORNER, *Administrative Patent Judge*

Opinion Concurring filed by CAPP, *Administrative Patent Judge*

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134(a) of the Examiner’s rejections of claims 1–4, 6–14, and 16–20, which are all of the pending claims. Final Office Action (February 24, 2017, “Final Act.”). We have jurisdiction under 35 U.S.C. § 6(b).

¹ The Good Life Services LLC (“Appellant”) is the Applicant under 37 C.F.R. § 1.46 and is identified as the real party in interest. Appeal Brief (September 26, 2017, “Appeal Br.”) 4.

The Examiner rejected the claims as failing to comply with the written description requirement and as unpatentable over various combinations of the prior art. As to written description, Appellant argues that the disclosure reasonably conveys that Appellant had possession of the invention. As to obviousness, Appellant argues that the combined prior art fails to teach all the elements of the claimed subject matter.

For the reasons explained below, we agree with the Examiner that the disclosure does not reasonably convey that Appellant had possession of the invention; however, we find that the Examiner has failed to show that the combined teachings of the prior art render the claimed subject matter obvious to one having ordinary skill in the art. Because we agree with the Examiner about unpatentability of the pending claims as to one of the grounds of rejection, we AFFIRM.

CLAIMED SUBJECT MATTER

The claimed subject matter relates to “cleaning hair trimmings from a person’s ears after cutting a person’s hair” using a microfiber swab. Specification (July 15, 2015, “Spec.”) 2:2–4. Claims 1 and 11 are the independent claims on appeal. Claim 1 is illustrative of the subject matter on appeal and is reproduced below.

1. A method performed by a barber or hair stylist, the method comprising:

cutting a person’s hair, resulting in loose hair trimmings falling into the person’s ears; and

applying a microfiber swab to one of the person’s ears to remove the loose hair trimmings resulting from cutting the person’s hair, the microfiber swab comprising a handle and at least a first microfiber head secured to a first end of the handle, the first microfiber head comprising a naturally electrostatic

microfiber cloth that is split during a manufacturing process to produce electrostatically charged multi-stranded fibers that comprise a structure defining a plurality of fiber spaces, attract the loose hair trimmings into the fiber spaces, and hold the loose hair trimmings in the fiber spaces.

Appeal Br. 21 (Claims Appendix). Independent claim 11 is directed to a product kit comprising a plurality of microfiber swabs, wherein the head of each swab comprises a “naturally electrostatic microfiber cloth,” and instructions for use of the swab to remove loose hair trimmings from a person’s ears. *Id.* at 23.

EVIDENCE

Shabo	US 4,913,682	Apr. 3, 1990
Mitchell, Jr. (“Mitchell”)	US 6,012,463	Jan. 11, 2000
Webb	US 6,629,329 B1	Oct. 7, 2003
Mangold	US 2005/0267395 A1	Dec. 1, 2005
Morales	US 2007/0299457 A1	Dec. 27, 2007
Edme	US 2012/0283616 A1	Nov. 8, 2012
Teggatz	US 2012/0316381 A1	Dec. 13, 2012

REJECTIONS

The Final Office Action includes the following rejections:

1. Claims 1–4, 6–14, and 16–20 are rejected under 35 U.S.C. § 112(a) as failing to comply with the written description requirement.
2. Claims 1–4, 6, and 8 are rejected under 35 U.S.C. § 103 as unpatentable over Morales, Mangold, and Teggatz.
3. Claim 7 is rejected under 35 U.S.C. § 103 as unpatentable over Morales, Mangold, Teggatz, and Shabo.
4. Claim 9 is rejected under 35 U.S.C. § 103 as unpatentable over Morales, Mangold, Teggatz, and Webb.

5. Claim 10 is rejected under 35 U.S.C. § 103 as unpatentable over Morales, Mangold, Teggatz, and Edme.
6. Claims 11–14, 16, and 18 are rejected under 35 U.S.C. § 103 as unpatentable over Morales, Mangold, Teggatz, and Mitchell.
7. Claim 17 is rejected under 35 U.S.C. § 103 as unpatentable over Morales, Mangold, Teggatz, Mitchell, and Shabo.
8. Claim 19 is rejected under 35 U.S.C. § 103 as unpatentable over Morales, Mangold, Teggatz, Mitchell, and Webb.
9. Claim 20 is rejected under 35 U.S.C. § 103 as unpatentable over Morales, Mangold, Teggatz, Mitchell, and Edme.

ANALYSIS

Written Description

The Examiner found that the Specification fails to reasonably convey to one skilled in the art that the inventors had possession of the claimed “naturally electrostatic microfiber” as recited in independent claims 1 and 11. Final Act. 3. Appellant admits that the Specification “does not use the specific term ‘naturally electrostatic.’” Appeal Br. 12. But Appellant asserts that one of ordinary skill in the art would reasonably understand the description in the Specification of a microfiber cloth that is “positively charged” to render it able to “attract other substances having an electrostatic charge” is a disclosure of a ‘naturally electrostatic’ microfiber cloth.” *Id.* at 12–13. Appellant reasons that because the Specification does not describe or show in the Figures that the heads are charged by a separate appliance or apparatus, i.e., a man-made power source, one of ordinary skill in the art would reasonably understand that they must be naturally electrostatically charged. *Id.* at 13. The Examiner responds that the Specification is silent as

to “how the microfibers receive their charge” and that “one of ordinary skill in the art would not know if the microfiber is inherently charged or if an outside source is required to give charge to the microfibers.” Ans. 12.

To satisfy the written description requirement, “the [original] specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). “[T]he test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Id.* The claimed invention need not be recited *in haec verba* in the original specification in order to satisfy the written description requirement. *Id.* at 1352. When an explicit limitation in a claim is not present in the written description it must be shown that a person of ordinary skill would have understood that the description requires that limitation. *Hyatt v. Boone*, 146 F.3d 1348, 1353 (Fed. Cir. 1998). It is not enough to satisfy the written description requirement that the claimed subject matter would have been obvious to a person of ordinary skill in view of the written description. *See ICU Med., Inc. v. Alaris Med. Sys., Inc.*, 558 F.3d 1368, 1377 (Fed. Cir. 2009); *see also Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1566–67 (Fed. Cir. 1997) (explaining that “an applicant complies with the written description requirement by describing the invention, with all its claimed limitations, not that which makes it obvious” (internal quotation marks omitted)).

We agree with the Examiner’s finding that because the Specification is silent as to how the microfibers are “positively charged,” the disclosure of

the original application does not provide a sufficient showing that one having ordinary skill in the art would understand Appellant to have been in possession of a “naturally electrostatic” microfiber cloth. Appellant seeks to have us infer what one having ordinary skill in the art would understand from the omission in Appellant’s Specification of disclosure of an external means for positively charging the microfibers. Appellant did not provide any evidence to support such an inference. Attorney argument cannot take the place of evidence. *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974).

Appellant does not appear to be arguing that all microfiber cloths are inherently naturally electrostatic. *See* Appeal Br. 13 (Appellant arguing that one of ordinary skill in the art would recognize that loose hair trimmings are naturally charged and that the described and illustrated microfiber cloth also must be naturally electrostatic because no battery or other power source is disclosed). Nor has Appellant provided evidence that the claimed electrostatic charge is an inherent characteristic of all microfiber cloths. Thus, we do not have sufficient evidence on the record before us to support a finding that a person having ordinary skill in the art would understand that the disclosed microfiber cloth is necessarily naturally electrostatic. It is not enough to satisfy the written description requirement that the use of a “naturally electrostatic” microfiber cloth would have been obvious to a person of ordinary skill in view of the written description.

For these reasons, we sustain the rejection of claims 1–4, 6–14, and 16–20 under 35 U.S.C. § 112(a) for failing to comply with the written description requirement.

Obviousness

In the rejection of independent claim 1, the Examiner found that Morales teaches a method for removing debris from an ear using a swab that has a handle and at least one head. Final Act. 4. The Examiner found that Morales does not teach that the method is performed by a barber to remove loose hair trimmings after the barber has cut a person's hair, or that the swab contains electrostatically charged microfibers. *Id.* The Examiner found that Mangold teaches a microfiber swab to remove impurities, skin particles, dirt, etc. and Teggtatz teaches a microfiber that is electrostatically charged. *Id.* at 4–5. The Examiner determined that it would have been obvious to modify Morales's swab to use microfibers on the head to provide “improved gripping for removal of debris” and to further modify the microfibers to be electrostatically charged to “increase the ability of the fibers to scrub the area it is applied to.” *Id.* at 5. As to the remaining steps not disclosed in the prior art, the Examiner found that “it is well known in the art for a barber to cut hair and that during this process small hairs fall into a person's ears and are subsequently cleaned.” *Id.* at 4. The Examiner made similar findings and provided similar reasoning in the rejection of independent claim 11. *Id.* at 8–9.

Appellant argues that the rejections should be reversed because the prior art references do not disclose “a naturally electrostatic microfiber cloth.” Appeal Br. 17 (arguing that Teggtatz's microfiber material is “artificially charged” by electrodes). The Examiner responds that Teggtatz discloses the advantage of having a microfiber that is charged into the bent shape to enhance the scrubbing qualities of the fibers. Ans. 16. The Examiner also understood Appellant to have asserted that microfibers are

inherently charged, and, stated that if that is the case, then Teggatz merely provides enablement for one skill in the art to the advantages of maintaining the charge for cleaning purposes. *Id.* (citing Appeal Br. 13).

We agree with Appellant that the Examiner has not provided adequate reasoning to explain why one having ordinary skill in the art would have been led to modify Morales with the teaching of Teggatz to result in the “naturally electrostatic microfiber cloth” of independent claims 1 and 11. Teggatz discloses an embodiment that uses transmission of electrical impulses to place a charge potential across the microfibers to cause them to bend in accordance with the electrical potential gradient applied. Teggatz ¶ 24. Teggatz teaches that by directionally charging the microfibers, the orientation of the microfibers may be controlled toward or away from particular areas of the skin and may be used to impart a scrubbing action to the applicator head. *Id.* Thus, Teggatz relies on transmission of electrical impulses from an external source to cause the microfibers to bend in a particular manner. The Examiner has not explained why one having ordinary skill in the art, seeking to enhance the scrubbing qualities of the fibers as proposed by the Examiner, would have been led to modify Morales to use “naturally electrostatic microfiber cloth” in lieu of the technique disclosed in Teggatz. Further, as discussed above, we do not understand Appellant to argue in its briefs that all microfibers are inherently naturally electrostatic.

Thus, the Examiner has not provided an adequate explanation to support a determination of obviousness of independent claims 1 and 11. The remaining rejections of dependent claims 2–4, 6–10, 12–14, and 16–20

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suffer from the same deficiency. For this reason, we do not sustain the rejections under 35 U.S.C. § 103 of claims 1–4, 6–14, and 16–20.

DECISION

The rejection of claims 1–4, 6–14, and 16–20 under 35 U.S.C. § 112(a) is sustained.

The rejections of claims 1–4, 6–14, and 16–20 under 35 U.S.C. § 103 are not sustained.

Because we have sustained at least one ground of rejection of each of the pending claims, the decision of the Examiner as to unpatentability of claims 1–4, 6–14, and 16–20 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).

AFFIRMED

OPINION CONCURRING

CAPP, *Administrative Patent Judge*

I concur in the result reached by the majority as I agree that the pending claims are unpatentable due to failure to comply with the written description requirement.

I write separately because I question the propriety and/or need of reaching a prior art rejection that finds an element of pending claims missing from the prior art when, in the first instance, such element is not adequately described in Appellant's Specification. *See Ex parte Smith*, Case No. 2008-5902, 2008 WL 4998624, *4 (BPAI 2008), *Cf. In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970); *In re Steele*, 305 F.2d 859, 863 (CCPA 1962). I would affirm the written description rejection and not reach the art rejection.

Nevertheless, I concur in the result to affirm the Examiner's rejection.