

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEAN-LOUIS H. GUERET

Appeal No. 2001-1466
Application 09/055,899

HEARD: October 23, 2001

Before FRANKFORT, STAAB, and MCQUADE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Jean-Louis H. Gueret originally took this appeal from the decision of the examiner (Paper No. 20) to reject claims 1 through 3, 5 through 17, 25, 26, 33 and 37 through 43. The examiner has since withdrawn the rejections of claims 42 and 43, which now stand allowed. Hence, the appeal as to these two claims is hereby dismissed, leaving for review the standing rejections of claims 1 through 3, 5 through 17, 25,

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26, 33 and 37 through 41. Claims 4, 18 through 24, 27 through 32 and 34

through 36, the only other claims pending in the application, stand withdrawn from consideration pursuant to 37 CFR § 1.142(b).

THE INVENTION

The invention relates to a unit for packaging and applying liquid products such as nail varnish, lipstick, glue, writing corrector, stain remover and the like. Representative claim 1 reads as follows:

1. A unit for packaging and applying a liquid product, comprising:
 - a reservoir containing the product and having an opening;
 - a removable closure for closing off said opening in a leaktight manner;
 - an applicator fitted inside the reservoir and including a first end in liquid communication with the product inside the reservoir and a second end opposite said first end, said second end forming an application surface which is movable axially between a first position in which the application surface emerges outside the reservoir through said opening, and a second position in which said application surface is contained in a leaktight manner inside the reservoir,
 - wherein said applicator comprises at least one block of an absorbent material which is capable of being at least partially compressed, and wherein said applicator is mounted to the reservoir such that said applicator is saturated with the product when said second end moves from said second position to said first position.

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THE PRIOR ART

The references relied on by the examiner as evidence of obviousness are:

Schultz	2,975,464	Mar. 21,
1961 Capezzuto	3,132,370	May
12, 1964		
Gueret	5,002,415	Mar. 26,
1991		

THE REJECTIONS

Claim 9 stands rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which is non-enabling with respect to the subject matter claimed.

Claims 12 through 17 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

Claims 1 through 3, 5 through 11, 25, 26, 33 and 37 through 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schultz in view of Capezzuto and Gueret.

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Attention is directed to the appellant's main and reply briefs (Paper Nos. 22 and 24) and to the office actions dated May 25, 2000 and September 13, 2000 and the examiner's answer (Paper Nos. 18, 20 and 23) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.¹

DISCUSSION

I. The 35 U.S.C. § 112, first paragraph, rejection of claim 9

Earlier in the prosecution of the application (see Paper No. 12), the appellant elected the species shown in Figure 3 in response to a restriction requirement (Paper No. 7). In this species, the product reservoir includes a bellows-type member 20 which permits the reservoir to be compressed so as to at least partially compress the applicator and move the product into contact therewith.

¹ The references in the examiner's answer (see page 4) to multiple prior office actions for an explanation of the appealed rejections is improper. MPEP § 1208 limits incorporation by reference in an answer to a single prior office action.

Claim 9 depends indirectly from claim 1 and further defines the applicator recited therein as including a wick soaking in the product. The rejection at hand rests on the examiner's determination that the appellant's specification is non-enabling with respect to a liquid product packaging and applying unit having both the wick recited in claim 9 and the compressible reservoir of the elected species, which features the examiner considers to be incompatible. But even if it is assumed for the sake of argument that the wick and compressible reservoir, as disclosed, are incompatible, and notwithstanding the appellant's election of the Figure 3 species, the fact remains that claim 9 does not expressly recite, or otherwise require the claimed unit to include, the compressible reservoir. Thus, the examiner's position that the claim is directed to a combination of features not enabled by the appellant's disclosure is unsound.²

² A review of the instant application reveals a bit of ambiguity as to the relationship between the wick and the applicator. For example, pages 4 and 7 in the specification indicate that the wick is a separate element which is connected to the first (inner) end of the applicator; claim 9, on the other hand, recites that the applicator includes the wick. In the same vein, the recitation in claim 9 that the applicator includes a wick soaking in the product seemingly conflicts with the recitation in parent claim 6 that the first

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Hence, we shall not sustain the standing 35 U.S.C. § 112, first paragraph, rejection of claim 9.

II. The 35 U.S.C. § 112, second paragraph, rejection of claims 12 through 17

Claim 12 depends indirectly from claim 1 and further defines the applicator recited therein as being fitted so as to slide inside the neck of the claimed liquid product packaging and applying unit. The examiner considers this claim, and claims 13 through 17 which depend therefrom, to be indefinite because the Figure 3 species elected by the appellant does not include such a slidable applicator. The examiner characterizes the issue as being one of disagreement with the appellant as to whether claims 12 through 17 read on the elected Figure 3 species, and relies on MPEP § 821 for justification of the subject rejection under these circumstances.

(inner) end of the applicator is located above the level of the product. It is also noted that the references in claim 3 to the "body" lack a proper antecedent basis. These matters should be addressed in any further prosecution before the examiner.

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MPEP § 821 recently was amended (MPEP Eighth Edition, August 2001) to eliminate the directive instructing examiners to enter a 35 U.S.C. § 112, second paragraph, rejection in the event of a disagreement with an applicant as to whether claims read on elected subject matter. Moreover, even if it is assumed for the sake of argument that claims 12 through 17 do not read on the elected Figure 3 species, the examiner has not explained, nor is it apparent, why this circumstance alone would render the metes and bounds of these claims unclear.

Since the examiner has not advanced any other reason why claims 12 through 17 might be indefinite, we shall not sustain the standing 35 U.S.C. § 112, second paragraph, rejection thereof.

III. The 35 U.S.C. § 103(a) rejection of claims 1 through 3, 5 through 11, 25, 26, 33 and 37 through 41

Schultz, the examiner's primary reference, discloses a container for dispensing liquid products such as shoe polish, household cleaners, coatings, solvents and the like. The container includes a sponge-like applicator which is specifically designed not to become fully saturated during use

in order to prevent the loss of the product due to spilling and splashing. As described by Schultz,

A designates a container, such as a glass bottle, comprising a generally cylindrical bottom member 42, a cup-like section 43, a constricted neck portion 44, an aperture 45, and a sponge-like insert 46.

The sponge-like insert 46 is provided in its lower portion with a relatively thin downwardly depending wick 47 which extends into the liquid within the bottom member 42. . . . The container A is provided with a cap member 34 including a cork stopper 35 which fits snugly into the cup-like section 43 and compresses the sponge-like insert 46. When the cap 34 is inserted, the cork stopper 35 compresses the sponge-like insert 46 and, in effect, evacuates the interstitial spaces therein. Consequently, when the cap 34 is removed and the cork stopper 35 withdrawn, the compressive force on the sponge-like insert 46 is released and liquid is drawn up there into for dissemination into the atmosphere through the exposed top portion.

In use, the container A is filled with a suitable liquid L, such as polish, cleaning solvent, and the like, and, thereafter, the oversized sponge-like insert or applicator 46 is placed within the cup-like section 43; whereupon, the cap 34 is threaded on the cup-like section 43, compressing the sponge-like applicator 46 tightly within the cup-like section 43. The bottle or container A is then up-ended for a few moments, causing the liquid L to flow through the aperture or port 45 and saturate the compressed applicator 46. Since the applicator 46 is compressed, it will absorb much less liquid than its normal capacity.

After the bottle A has been up-ended for a few moments to allow the applicator 46 to absorb as much liquid as possible in its compressed condition, the bottle A is then turned back to the upright position, whereupon, any excess liquid L not absorbed by the applicator 46 will drain down along

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the arcuate wall into the bottom member 42. The cap 34 is then removed, permitting the applicator 46 to expand so as to assume the position shown in Fig. 1, at which time the applicator 46 becomes about half-saturated due to the fact that the expanded applicator 46 now has a much greater volumetric capacity than it had when it was compressed. . . . By properly selecting the porosity and normal size of the applicator 46 in relation to the volumetric size of the cup-like section 42 and the viscosity of the liquid with which it is to be used, it is easily possible to have the applicator 46 retain just the right amount of liquid for covering the object to which the liquid is to be applied [page 1, column 1, line 72, through page 1, column 2, line 56].

As conceded by the examiner, Schultz does not meet the limitation in independent claim 1 requiring the applicator to be "saturated with the product when second end [which forms the application surface] moves from said second position [inside the reservoir] to said first position [outside the reservoir]." The examiner nonetheless concludes that

[b]ecause the Schultz applicator is intended to function in a manner identical to that claimed with the exception of the "saturation" limitation, the burden is on appellant to establish that the "saturation " limitation is critical to patentability. See In re Aller, 220, F.2d 454, 457 (C.C.P.A. 1955). Appellant has not done so [answer, page 9].

The examiner's reliance here on In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) is not well taken. Aller stands for the principle that in situations where a

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difference between a claim and the prior art normally would involve an unpatentable modification, under some circumstances the difference may impart patentability if the applicant meets the burden of showing that it is critical in the sense that it produces a new and unexpected result different in kind and not merely in degree from the results of the prior art (see Aller at 220 F.2d 456, 105 USPQ 235). In the present case, Schultz expressly and very forcefully teaches away from the "saturation" limitation in claim 1. Thus, Schultz clearly fails to establish a prima facie case that this limitation involves an unpatentable or obvious modification. Consequently, the appellant is under no burden to show criticality in order to demonstrate patentability. This deficiency in Schultz finds no cure in Capezzuto and/or Gueret which were applied by the examiner for their disclosures of compressible reservoirs.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 1, or claims 2, 3, 5 through 11, 25, 26, 33 and 37 through 41 which depend therefrom, as being unpatentable over Schultz in view of Capezzuto and Gueret.

SUMMARY

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The decision of the examiner:

a) to reject claim 9 under 35 U.S.C. § 112, first paragraph, is reversed;

b) to reject claims 12 through 17 under 35 U.S.C. § 112, second paragraph, is reversed; and

c) to reject claims 1 through 3, 5 through 11, 25, 26, 33 and 37 through 41 under 35 U.S.C. § 103(a) is reversed.

REVERSED

CHARLES E. FRANKFORT)
Administrative Patent Judge)
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) BOARD OF PATENT
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) APPEALS AND
LAWRENCE J. STAAB)

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Administrative Patent Judge) INTERFERENCES
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