

`The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN ALLEN HOLT,
ALAN EDWARD SHERRY,
and
VERNON SANFORD PING III

Appeal No. 2001-1712
Application No. 09/456,968

ON BRIEF

Before OWENS, DELMENDO, and JEFFREY T. SMITH, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 (2002) from the examiner's final rejection of claims 30 through 40, which are all of the claims pending in the above-identified application.

The subject matter on appeal relates to a cleaning implement. Further details of this appealed subject matter are

recited in representative claim 30, the sole independent claim on appeal, reproduced below:

- 30. A cleaning implement comprising:
 - a. a handle; and
 - b. a removable cleaning pad comprising:
 - i. a scrubbing layer;
 - ii. an absorbent layer in direct fluid communication with the scrubbing layer, wherein the absorbent layer comprises a superabsorbent material; and
 - iii. an attachment layer for releasably attaching the cleaning pad to the handle.

The examiner relies on the following documents as evidence of unpatentability:

Newell	4,995,133	Feb. 26, 1991
Nichols	5,609,255	Mar. 11, 1997
Holt et al. (Holt)	6,048,123	Apr. 11, 2000 (filed Nov. 26, 1996)
Kresse et al. (Kresse) (published German appln.)	DE 43 00 920 A1	Jul. 21, 1994

Claims 30 through 40 on appeal stand rejected under the judicially created doctrine of non-statutory double patenting over claims 1 through 32 of the Holt patent.¹ (Examiner's answer of Jan. 11, 2001, paper 11, page 3.) Further, claims 30 through

¹ The Holt patent issued from application 08/756,999 filed Nov. 26, 1996, which formed the basis for the provisional double patenting rejection as set forth in the final Office action (paper 3) at p. 3.

39 on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over Nichols in view of Newell. (Id. at page 3.) Additionally, claim 40 on appeal stands rejected under 35 U.S.C. § 103(a) as unpatentable over Nichols in view of Newell and Kresse. (Id. at page 4.)

We affirm the double patenting rejection but reverse the 35 U.S.C. § 103(a) rejections.²

We first address the double patenting rejection. The appellants do not contest the examiner's double patenting rejection of the appealed claims over the claims of the Holt patent with any substantive argument on the merits. Rather, the appellants' position is that "[o]nce patentable subject matter has been identified in the present case, [the] [a]ppellants will file a terminal disclaimer to obviate this rejection." (Appeal brief, page 3.) The appellants, however, do not cite any legal authority for the proposition that the mere offer to file a terminal disclaimer overcomes a non-statutory double patenting rejection. We therefore uphold the examiner's holding (answer, pages 2 and 4) that the mere offer to file a terminal disclaimer does not obviate the rejection.

² The appellants submit that "[c]laims 30-40 stand or fall together." (Appeal brief filed Nov. 29, 2000, paper 9, p. 3.) 37 CFR § 1.192(c)(7) (1997).

Turning to the rejections based on prior art, Nichols describes a washable mop 10 including a mop handle 12, a mop head 20, a mop pad 28, and a storage device 40. (Column 2, line 64 to column 3, line 5; column 4, lines 9-11; Fig. 1.) According to Nichols (column 4, lines 36-53; Fig. 3), the mop pad includes a base member 30, a filler material (e.g., fiberfill batting) 32 for absorbing liquids, a fabric covering 34, a netting 36 for improving scrubbing action, and a securement device 38.

Thus, in contrast to the invention recited in appealed claim 30, Nichols's mop does not include an absorbent layer comprising a "superabsorbent material." (Answer, page 4.) In an attempt to account for this difference, the examiner relies on the teachings of Newell.

In contrast to Nichols, Newell describes a mop head comprising a plurality of web elements having involutions, which may be formed by subjecting web elements to an involution-forming treatment such as (a) successive tensioning and detensioning conditions, (b) compression conditions, (c) differential stressing conditions, (d) twisting conditions, and (e) combinations of such conditions. (Column 3, lines 39-48; Figs. 1-11.) Newell does teach that "in a single-use mop application, the web elements may be impregnated or otherwise

have associated therewith a super-absorbent material.” (Column 12, lines 3-6.)

The examiner held (final rejection, page 4): “It would have been obvious to one of ordinary skill to have modified the material (32) of Nichols as taught by Newell in order to enhance fluid take-up and retention capacity in wet mopping applications and also to provide an embodiment which possessed a single-use capability...” As pointed out by the appellants (appeal brief, page 3), however, Newell teaches the use of superabsorbent materials only in the context of a disposable, single-use string mop head, whereas Nichols relates to a washable and reusable mop head. While Newell might have led one of ordinary skill in the art to substitute the entire mop head of Nichols with the string mop head of Newell, the examiner has not identified any evidence to establish that one of ordinary skill in the art would have been led to selectively omit the web elements of Newell and add only the superabsorbent material into Nichols’s washable cleaning pad.

We therefore hold that the examiner has engaged in impermissible hindsight reconstruction using the appellants’ own specification as a blueprint to piece together bits from Nichols and Newell. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992); Interconnect Planning Corp. v. Feil, 774

Appeal No. 2001-1712
Application No. 09/456,968

F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985); W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

The Kresse reference has been cited only for claim 40 and does not remedy the fundamental deficiency of the examiner's analysis.³

In summary, we affirm the examiner's rejection under the judicially created doctrine of non-statutory double patenting of appealed claims 30 through 40. However, we reverse the 35 U.S.C. § 103(a) rejections of: (i) appealed claims 30 through 39 as unpatentable over Nichols in view of Newell; and (ii) appealed claim 40 as unpatentable over Nichols in view of Newell and Kresse.

The decision of the examiner to reject the appealed claims is affirmed.

³ We attach to this decision a complete English language translation of Kresse for consideration by the examiner and the appellants.

Appeal No. 2001-1712
Application No. 09/456,968

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Terry J. Owens)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
Romulo H. Delmendo)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
)	
Jeffrey T. Smith)	
Administrative Patent Judge)	

rhd/vsh

Appeal No. 2001-1712
Application No. 09/456,968

THE PROCTER & GAMBLE CO
INTELLECTUAL PROPERTY DIVISION
WINTON HILL TECHNICAL CENTER - BOX 161
6110 CENTER HILL AVE
CINCINNATI OH 45224