

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROBERT W. BENZINGER

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Appeal No. 98-2837  
Application 08/471,458<sup>1</sup>

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ON BRIEF

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Before ABRAMS, FRANKFORT and CRAWFORD, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3, 4, 6 through 13, 16, 19, 20, 24 and 26 through 29. Claims 2, 5, 14, 15, 21 through 23 and 25 have been canceled.

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<sup>1</sup> Application for patent filed June 6, 1995. According to appellant, this application is a continuation-in-part of Application 08/417,890, filed April 6, 1995, now abandoned.

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Claims 17 and 18 were not included in the appeal.<sup>2</sup>

Appellant's invention relates to a method of shaving wherein a razor is allowed to soak in a solution of witch hazel after each use, typically overnight, and is then used while wet with the solution for a subsequent shave. On page 5 of the specification, it is noted that the resulting shave is rapid and comfortable, and that if there happen to be cuts or nicks the witch hazel alleviates pain as well as constricting the cuts/nicks to rapidly interrupt bleeding. In addition, on page 6 of the specification, it is noted that using appellant's shaving method substantially extends the useful life time of the cutting edges of the blade. Independent claims 1 and 24 are representative of the subject matter on appeal and a copy of those claims, as reproduced from the Appendix to appellant's brief, is attached to this decision.

There are no prior art references relied upon by the examiner in rejecting the appealed claims.

Claims 1, 3, 4, 6 through 13, 16, 19, 20, 24 and 26 through 29 stand rejected under 35 U.S.C. § 101 "because the claimed invention is not supported by a specific asserted utility" (answer, page 3).

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<sup>2</sup> Decided concurrently herewith is the appeal in appellant's copending application Serial No. 08/471,457, filed June 6, 1995 (Appeal No. 98-2810).

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Rather than reiterate the examiner's full statement of the above-noted rejection and the conflicting viewpoints advanced by the examiner and appellant regarding the rejection, we make reference to the examiner's answer (Paper No. 27, mailed March 12, 1998) for the examiner's reasoning in support of the rejection, and to appellant's brief (Paper No. 23, filed January 12, 1998) and reply brief (Paper No. 28, filed April 16, 1998) for appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the additional evidence and product analysis report supplied by appellant, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determination that the examiner's rejection will not be sustained. Our reasons follow.

After reviewing the original disclosure, the examiner's position, the substantial evidence submitted by appellant in this case, and appellant's arguments in the brief and reply brief, we are of the opinion that the examiner's rejection of the appealed claims under 35 U.S.C. § 101 is clearly not sustainable. Appellant has set forth in the specification (e.g., page 5) that the claimed method of

shaving provides a shave which is rapid, smooth and comfortable, and that if there happen to be cuts, the witch hazel on the razor will alleviate pain as well as constricting any such cuts to rapidly interrupt bleeding. This asserted utility has not been challenged by the examiner and in our opinion would have been considered credible by a person of ordinary skill in the art, especially when considered in light of the evidence supplied by appellant in this case. Thus, since appellant has put forth one credible assertion of specific utility for the claimed subject matter, he has satisfied the utility requirement of 35 U.S.C. § 101. As noted in the Manual of Patent Examining Procedure, § 2107.01, even if other assertions of utility made by appellant were found not “credible,” such statements would not render the claimed invention lacking in utility.

Moreover, in this particular case, we share appellant’s view (brief, pages 5-9, and reply brief, pages 1-3) that a preponderance of the totality of the evidence under consideration establishes the credibility of both of appellant’s asserted utilities, i.e., that the claimed shaving kit assists in prolonging the useful life of the blade of a razor and in providing a smooth comfortable shave with minimal nicks and cuts. Like appellant, in view of the polishing of the cutting edges of the samples viewed in the photographs mentioned in paragraph 3 on page 3 of the “COOL IT™ Product Analysis Report, we find the examiner’s emphasis and reliance on this portion of the report, to the exclusion of the remainder of the report (particularly the ANALYSIS and CONCLUSIONS sections set forth on pages 4 and 5

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of the report), to be unwarranted. Nor do we find any comment in the record from the examiner regarding the evidence presented by appellant in the form of the eight items mentioned at the top of page 6 of appellant's brief.

In light of the foregoing, we will not sustain the examiner's rejection of claims 1, 3, 4, 6 through 13, 16, 19, 20, 24 and 26 through 29 under 35 U.S.C. § 101.

The decision of the examiner in this case is, accordingly, reversed.

**REVERSED**

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
	)	APPEALS AND
CHARLES E. FRANKFORT	)	INTERFERENCES
Administrative Patent Judge	)	
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MURRIEL E. CRAWFORD )  
Administrative Patent Judge )

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APPENDIX

1. A method of shaving with a shaver having a blade on a razor head portion of the shaver wherein the method extends the shaving lifetime of the blade while reducing cuts and nicks comprising:

soaking the razor head of the shaver with the blade thereon in a bath comprising a solution of witch hazel;

removing the shaver with the blade thereon from the bath;

shaving with the shaver having the blade thereon while the blade thereof has the solution of witch hazel from the bath thereon;

returning the shaver to the bath comprising the solution of witch hazel to store and soak until again shaving with the shaver having the blade; and

repeating the previous steps.

24. A method of shaving an area of the body with a shaver having a blade on a razor head portion of the shaver, wherein the area may include the face, legs or underarms, the method comprising:

(a) immersing the blade of the shaver in a bath containing a solution of witch hazel;

(b) coating the area to be shaved with a preconditioning material;

(c) shaving with the shaver while the blade thereof has the solution of witch hazel thereon;

(d) returning the shaver to the bath;

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(e) leaving the shaver with the blade thereon in the bath until the next shave;

and

(f) repeating steps (b)-(e), whereby the shaving lifetime of the blade is substantially increased.