

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(2) is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEAN-LOUIS GUERET

Appeal No. 1998-3312
Application 08/354,803

HEARD: February 7, 2000

Before FRANKFORT, STAAB and NASE, Administrative Patent
Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final
rejection of claims 1-8, 11, 17, 18, 25-29 and 32. Claims 9,

Appeal No. 1998-3312
Application No. 08/354,803

10, 12, 13, 19-24, 30 and 31 are withdrawn from consideration
as

being directed to a non-elected invention. Claims 14-16 have
been canceled.

Appellant's invention relates to a device shown in
Figures 1-5 for applying a pasty product, i.e., lipstick (B),
said device including a tubular element (1) with a slideway
(2) for mounting a cup (3) which is intended to receive a
stick of product (B), a cylindrical casing (11) having at
least one helical slot (13) for accepting the stub (4) of the
cup (3), sleeve (14) for accepting therein the cylindrical
casing (11) and a flexible bearing (F) provided between the
cylindrical casing (11) and the tubular element (1). The
object of the invention is to provide a device that is
relatively simple to produce, especially in regards to molding
and demolding operations and including a flexible bearing
mechanism (F) that provides a good elastic self centering and
anti-vibration effect to better protect the pasty product
against shock. Representative claim 1 is set forth below.

Appeal No. 1998-3312
Application No. 08/354,803

--1. Device for applying a pasty product, presented in the form of a stick, comprising:

- a tubular element with a slideway in which is mounted so that it can slide a cup intended to receive the stick of product and including at least one stub engaged in a slideway;

- a cylindrical casing in the wall of which there is provided at least one helical slot, this casing being fitted tightly onto the tubular element and being held on the latter by axial abutment means, the stub of the cup being engaged in a slot of the casing;

- and an outer sleeve in which the casing is immobilized, while the tubular element can turn relative to the said casing and sleeve,

- flexible bearing means being provided between the two components consisting of the casing and the tubular element, these bearing means including plural tongues, which are flexible in the radial direction, provided on one of the two components and designed to interact with a bearing surface which is inclined radially of the axis of the tubular element, provided on the other component,

the flexible bearing means (F) consisting of said plural tongues (15-15d; 115-315) and the inclined bearing surface (20-20d; 120-320) being situated, in the axial direction, beyond the lower end of the outer sleeve(14-14d; 114-314), thereby to provide sufficient radial space to accommodate the flexible bearing means.--

The prior art references of record relied upon by the examiner as evidence of obviousness are:

Appeal No. 1998-3312
Application No. 08/354,803

Gruska	3,515,493	June 2, 1970
Holloway et al. (Holloway)	5,324,126	June 28, 1994
British Patent	1 427 931	March 10, 1976
Japanese Patent	4-72333	June 3, 1992
European Patent 1992 ¹	0 491 579	June 24,

Claim 25 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-8, 11, 17, 18, 25-29 and 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Holloway in view of Gruska, British Patent '931, Japanese Patent '333, and European Patent '579.

Rather than attempt to reiterate the examiner's full

¹ Translations of the Japanese and European patents, prepared for the U.S. Patent and Trademark Office, have been relied upon in deciding the issues before us on appeal. A copy of each of these translations is attached to this decision.

Appeal No. 1998-3312
Application No. 08/354,803

commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding the rejections, we make reference to the final rejection (Paper No. 9, mailed December 6, 1996) and the examiner's answer (Paper No. 18, mailed February 4, 1998) for the reasoning in support of the rejections, and to appellant's brief (Paper No. 17, filed July 9, 1997) and Reply Brief (Paper No. 19, filed April 6, 1998) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner.

We first turn to the rejection of claim 25 under 35 U.S.C.

§ 112, second paragraph, as being indefinite for failing to

Appeal No. 1998-3312
Application No. 08/354,803

particularly point out and distinctly claim the subject matter which appellant regards as the invention. Specifically, claim 25 includes a recitation "all these rubbing means," which has no antecedent basis in claim 25 or in claim 1 from which it depends. We note that in Paper No. 8, received September 18, 1996, appellant attempted to change all of the occurrences of "rubbing means" to "--bearing means--" in the specification and claims, including in claim 1. As presented by appellant in the Reply Brief, the failure to correct claim 25 is an obvious oversight and pre-authorizes the examiner to make the correction when the Appeal is decided. Appellant's willingness to cooperate to fix the problem is greatly appreciated, but the fact is that claim 25 includes a term that has no antecedent basis. We also note that claim 18 also includes the term "rubbing means" and should be addressed when claim 25 is addressed.

In light of the forgoing, we shall sustain the standing rejection of claim 25 under 35 U.S.C. § 112, second paragraph.

Next we turn to the rejection of the claims on appeal

Appeal No. 1998-3312
Application No. 08/354,803

under 35 U.S.C. § 103. In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness (see In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)), which is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art (see In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)). The conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

With this as our background, we look to the examiner's rejection of claims 1-8, 11, 17, 18, 25-29 and 32 under 35 U.S.C. § 103 as being unpatentable over Holloway in view of

Appeal No. 1998-3312
Application No. 08/354,803

Gruska, British Patent '931, Japanese Patent '333, and
European Patent '579.

Before looking at the teachings of the applied references, we look to the requirements of independent claim 1 on appeal. Claim 1 on appeal requires, in summary, a device for applying a pasty product, presented in the form of a stick comprising a tubular element (1) with a slideway, shown as (2) in Figures 1 and 2, a cylindrical casing, shown as (11) in Figure 1, an outer sleeve, shown as (14), in which the casing is immobilized, and a flexible bearing means, shown as (F), provided between the casing and the tubular element (1) and including a plurality of tongues (15), which are flexible in the radial direction and a bearing surface (20) which is inclined radially of the longitudinal axis of the tubular element (1), wherein the plurality of tongues and the inclined bearing surface are situated axially beyond the lower end of the outer sleeve (14).

Now we look to the prior art applied by the examiner. The Holloway reference teaches a similar device for applying a

Appeal No. 1998-3312
Application No. 08/354,803

past product, said device including a tubular element (50) with a slideway (60), a cylindrical casing (30) having at least one helical slot (40), an outer sleeve (46) in which the cylindrical casing (30) is immobilized, and a flexible tab (76) and an inclined bearing surface (190). Holloway fails to teach a flexible bearing means as set forth in claim 1 on appeal including a plurality of tongues designed to interact with a bearing surface which is inclined radially of the axis of the tubular element and being situated beyond the lower end of the outer sleeve.

The Gruska patent teaches a holder for a pasty product including a tubular element (23) with a slideway (28) and a base (43), a cylindrical casing (31) having two helical slots (35, 36), an outer sleeve (39) in which the cylindrical casing (31) is immobilized and a flexible bearing means including tongues (31A) defined by slots (47, 51, 52) in the end of the casing (31) and an inclined surface (45A) on the base (43) of the tubular element (23). As shown in Figure 8, the outer sleeve (39) extends over and beyond the flexible bearing means (31A, 45A).

Appeal No. 1998-3312
Application No. 08/354,803

The examiner's position is noted on page 4 of the answer with respect to the remaining references used under 35 U.S.C. § 103 to reject the claims on appeal. The British patent '931, the Japanese Patent '333 and the European Patent '579, teach, respectively, the use of sealing discs, sliding agents and an outer base and cover. None of these limitations are present in independent claim 1. Therefore, we will only consider the combination of Holloway and Gruska in addressing claim 1.

As indicated above, Holloway fails to disclose a flexible bearing means consisting of a plurality of tongues and an inclined bearing surface being situated, in an axial direction, beyond the lower end of the outer sleeve. Gruska teaches a flexible bearing means (31A, 45A) including a plurality of tongues and an inclined surface and fails to teach situating the bearing means in an axial direction beyond the lower end of the outer sleeve (39).

After reviewing the combined teachings of Gruska and Holloway, we reach the conclusion that the subject matter of

Appeal No. 1998-3312
Application No. 08/354,803

claim 1 on appeal would not have been suggested to one of ordinary skill in the art at the time the invention was made. In that regard, as pointed out by the appellant (Brief, pp. 5-6) there is no suggestion, motivation, or teaching in the prior art whereby a person of ordinary skill would have included the flexible bearing means of Gruska in the casing and tubular element of Holloway that extends beyond the lower end of the outer sleeve absent the use of impermissible hindsight. Further, we agree with the appellant (Reply Brief, pp 2) that the incorporation of the slits taught by Gruska to form flexible tongues in the skirt (34) of Holloway would disrupt the smooth frictional operation between the flexible tab (76) and the smooth inner wall (44) of the base (34) taught by Holloway, thereby teaching away from the proposed combination.

Since all the limitations of claim 1 are not obvious over the applied prior art, we shall not sustain the rejection of independent claim 1 and claims 2-8, 11, 17, 18, 25-29 and 32 which depend therefrom under 35 U.S.C. § 103.

Appeal No. 1998-3312
Application No. 08/354,803

Upon further review of the prior art of record, we observe that the European reference 0 491 579 appears to disclose (in Fig. 2) the claimed subject matter of claim 1 as follows; a device for applying a pasty product including a tubular element (3) with a slideway (4, 5), a cylindrical casing (12) including a helical slot (13, 14), an outer sleeve (18), and a flexible bearing including plural tongues (202a, 202b) which are flexible in the axial as well as the radial direction and designed to interact with a bearing surface (201) that is at least in part inclined radially of the axis of the tubular element (3), and wherein the plural tongues (202a, 202b) and the inclined bearing surface (201) are situated, in an axial direction, beyond the lower end of the outer sleeve (18) shown in Figure 2A. This application is REMANDED back to the examiner to ascertain if there are any differences between claim 1 on appeal and the European reference 0 491 579, to consider a rejection of claim 1 under 35 U.S.C. § 102(b) if no differences exist and under 35 U.S.C. § 103 if differences are found.

In addition to the foregoing, we note that it would be

Appeal No. 1998-3312
Application No. 08/354,803

appropriate for appellant to file an amendment correcting the minor § 112, second paragraph, problems with claims 18 and 25 during the time that this application is again pending before the examiner.

CONCLUSION

To summarize, the decision of the examiner to reject claim 25 under 35 U.S.C. § 112, second paragraph, is affirmed and the decision of the examiner to reject claims 1-8, 11, 17, 18, 25-29, and 32 under 35 U.S.C. § 103 is reversed. Upon return of the application, the examiner should consider the claims on appeal in light of this decision and take appropriate action.

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

AFFIRMED-IN-PART and REMANDED

Appeal No. 1998-3312
Application No. 08/354,803

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

CEF:lmb

YOUNG & THOMPSON
SECOND FLOOR
745 SOUTH 23RD STREET
ARLINGTON, VA 22202