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Ex parte Dussaud

Patent and Trademark Office Board of Patent Appeals
 and Interferences
 No. 666-06

Released June 9, 1988

United States Patents Quarterly Headnotes

PATENTS

[1] Practice and procedure in U.S. Patent and Trademark Office -- Declaration/Affidavits (§ 110.0913)
 Examiner improperly held that declaration, which stated why artisan would not look to carpet manufacturing process and equipment field to solve problem in application of elastic to web in curvilinear pattern, was not persuasive on issue of whether particular reference constituted analogous prior art, since holding is improperly grounded on fact that declarant, though skilled in art of diaper manufacturing, is not expert on carpet making, and since examiner thus did not accord fair evidentiary weight to declarant's skepticism.

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[2] Patentability/Validity -- Obviousness -- Relevant prior art (§ 115.0903)
 Examiner's characterization of problem addressed by applicants' claimed method of attaching elastic to disposable diapers as "the laminating of continuous running sheets utilizing a hot melt adhesive" was broader than particular problem actually addressed by applicants, and resulted in consideration of prior art that is not truly analogous.

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[3] Patentability/Validity -- Obviousness -- Combining references (§ 115.0905)
 Examiner erred in holding that applicants' invention was obvious in view of two prior art references in combination, since there is no express or implied suggestion in teachings of two references which would have motivated person of ordinary skill in art to combine them in manner proposed by examiner.

Appeal from decision of Jerome Massey, primary examiner.

Patent application of Jacques Dussaud and Raphael De Jonckheere, serial no. 605,970, filed May 1, 1984. From decision refusing allowance of claims 10 through 18 and 21, applicants appeal. Reversed.

I. William Millen and Millen & White, Arlington, Va., for applicants.

Before Milestone, Winters, and Skinner, examiners-in-chief.
 Winters, examiner-in-chief.

Appeal from the examiner's decision refusing to allow claims 10 through 18 and 21, which are all the claims remaining in this application.

Claim 10 is representative:

10. A method of continuously attaching an elongated narrow elastic element to a moving flexible sheet material to be employed as an outer moisture impermeable envelope for receiving an absorbent pad of a disposable diaper, said elastic element fitting in a stretched condition substantially along a curvilinear-shaped-cut-out of said envelope to allow a leg therethrough when said envelope is constructed as a diaper, said method comprising the steps of:

- (a) passing an elongated narrow elastic element, along a longitudinal path of travel, in a stretched condition;
- (b) intermittently depositing liquid adhesive material at high temperature on said elastic element during said passing step (a);
- (c) passing said elastic element, with adhesive material thereon, over a fixed guide means;
- (d) passing said elastic element with adhesive material over a carriage means, arranged down-stream of the fixed guide means in the direction of travel, and capable of being moved intermittently in a transverse direction;
- (e) feeding said flexible sheet around the peripheral surface of a rotary drum such that the sheet remains in contact with said drum for about one-half the rotation of said drum, said drum having a smooth outer surface

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which is maintained at a substantially constant temperature, said temperature being less than the temperature of said liquid adhesive, the difference between the temperature of the adhesive at the time of contact with said flexible sheet and the temperature of said peripheral surface of the drum being at least 20 degreesC; and (f) positioning said movable carriage immediately next to the periphery of said *1819 rotary drum at a location such that said carriage means and said drum are not in contact with each other and such that the adhesive coated elastic element contacts said flexible sheet supported by said drum, and said sheet together with said elastic element remain in contact with said drum for at least a portion of the rotation of said rotary drum before leaving it, moving said carriage means intermittently in a direction transverse to the direction of rotation of said drum whereby said elastic element is laid-down on said

drum in an oscillating path, and whereby said elastic element is intermittently attached in a stretched condition along a curved-shaped line only by laying said elastic element on said flexible sheet due to the temperature difference between the drum and the adhesive material;

and with the provision that steps (e) and (f) are conducted on a single drum and said temperature difference is sufficient to lead to an immediate adhesion effect capable of withstanding the transverse forces to which said elastic element is subjected owing to the movement of said carriage means.

The prior art references relied on by the examiner are:

Penman	3,150,023	Sep. 22, 1964
Bourgeois	3,828,367	Aug. 13, 1974
Buell	4,081,301	Mar. 28, 1978
Klasek et al. (Klasek)	4,293,367	Oct. 06, 1981
Teed	4,405,397	Sep. 20, 1983

Claims 10 through 16 and 21 stand rejected under 35 USC 103 as unpatentable over Klasek in view of the combined teachings of Buell, Penman, and Teed. Claims 17 and 18 stand rejected under the same statutory provision as unpatentable over the same combination of references, further taken in view of Bourgeois.

OPINION

We shall not sustain these rejections.

Initially, we consider the question whether the Penman reference is from a nonanalogous art. First, we find it clear that this reference is not within the field of appellants' endeavor. On the contrary, Penman relates to the art of carpet manufacture whereas appellants' field of endeavor is the art of manufacturing disposable diapers. Indeed, each of the patents issued to Klasek, Buell, Teed, and Bourgeois relates to the art of making diapers, as does appellants' specification disclosure. Pen-

man, which stands apart, relates to the art of making carpets.

[1] Second, it is our judgment that Penman is not reasonably pertinent to the *particular* problem with which appellants were involved, i.e., the application of an elastic strip to a web in a curvilinear pattern. In determining this latter point, we have evaluated and weighed the Courtray declaration filed under Rule 132 wherein declarant sets forth reasons why the artisan "would not look to the carpet manufacturing process and equipment field to solve a problem in the application of elastic to a web in a curvilinear pattern". See Paper No. 15, page 1. We note that the examiner entered and considered the declaration (see Paper Nos. 18 and 22) but found same "not persuasive" because, according to the examiner, declarant merely offers his opinion on the art of carpet making. The examiner discounted that opinion because declarant is not established as an expert in that art. We disagree with the examiner's analysis. The examiner does not deny that declarant is skilled in the art of man-

ufacturing diapers, although declarant does not claim to have the same level of skill in the art of making carpets. In this regard, we note that persons having ordinary skill “could not possibly be aware of every teaching in every art”. See *In re Wood*, 559 F.2d 1032, 202 USPQ 171, 174 (CCPA 1979). Certainly, declarant expresses skepticism whether a person having ordinary skill in the art of manufacturing disposable diapers would consider the carpet manufacturing process and equipment filed as reasonably pertinent to the particular problem with which the appellants were involved. As stated in *In re Dow Chemical Company*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988), skepticism expressed by an expert in the art is entitled to fair evidentiary weight.

[2] We also find that the examiner's characterization of the problem in Paper No. 22, *i.e.*, “the laminating of continuous running sheets utilizing a hot melt adhesive”, is broader than the particular problem with which appellants were involved. Precise definition of the problem is important in determining whether a reference is from a nonanalogous art. Defining the problem too narrowly may result in excluding consideration of relevant prior art. By the same token, defining the problem too broadly, as done here, may result in considering prior art as “analogous” which is inconsistent with real world considerations. See *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985), vacated, 475 U.S. 809, 229 USPQ 478 (1986), *aff'd* on *1820 remand, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987).

Having applied the two-fold test for determining whether a reference is from a nonanalogous art, see *In re Wood*, *supra*, we hold that on the facts of this case the Penman reference constitutes nonanalogous art. It is therefore not available as a reference in evaluating the obviousness of appellants' claimed invention under 35 USC 103.

[3] Turning to a consideration of the Teed patent of record, we find that Teed discloses a method for manufacturing disposable diapers wherein elastic strips are applied in a straight line. This is illustrated in Figure 8, note rectilinear elastic strips (16) therein. Klasek, on the other hand, discloses a method for manufacturing dis-

posable diapers wherein the elastic strips are applied in a curvilinear profile, and Klasek requires that the web and elastic be secured together by a pair of juxtaposed rolls acting in concert. See particularly Klasek, Figures 4 and 9. Certainly, Klasek's method involving a pair of rolls *could* be modified per the disclosure of Teed which appears to illustrate the use of a single roller. In our view, however, such proposed modification amounts to a hindsight reconstruction of the prior art patents in order to arrive at appellants' invention. Without having the benefit of appellants' disclosure, the artisan would view Klasek's pair of rolls as serving an important function in facilitating the application of elastic strips in a curvilinear profile. As discussed *supra*, the elastic strips in Teed are applied in a straight line and we disagree that the artisan would have found it obvious to substitute a single roller from Teed for a pair of rollers in Klasek, whose objective is to apply elastic strips in a curvilinear profile.

The mere fact that the prior art could be modified in the manner proposed by the examiner would not have made the modification obvious unless the prior art suggested the desirability of the modification. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) and cases cited therein. We have carefully reviewed the Klasek and Teed references in their entireties, and we find no express or implied suggestion in the collective teachings of these references which would have motivated the artisan to combine them in the manner proposed.

In conclusion, we hold that the Penman reference constitutes nonanalogous art and is therefore not available as a reference in evaluating the obviousness of appellants' claimed invention under 35 USC 103. With respect to the Teed patent of record, we conclude that Teed is not properly combinable with the “primary” reference to Klasek in the manner proposed by the examiner. Penman and Teed are essential to the examiner's case of obviousness. The examiner does not contend, nor do we find, that the combination of Klasek and Buell or the combined teachings of Klasek, Buell and Bourgeois are sufficient to establish the obviousness of appellants' claimed invention. Accordingly, the exam-

iner's decision refusing to allow claims 10 through 18
and 21 is reversed.

REVERSED.

P.T.O. Bd.Pat.App. & Int.
Ex Parte Dussaud
1988 WL 252372, 7 U.S.P.Q.2d 1818

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