



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO. Includes details for application 16/388,898 filed 04/19/2019 by Sarah Ann McCormick, attorney 14946MCQ, confirmation 8748. Also includes examiner KIDWELL, MICHELE M, art unit 3781, notification date 11/17/2021, and delivery mode ELECTRONIC.

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

- centraldocket.im@pg.com
mayer.jk@pg.com
pair_pg@firsttofile.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SARAH ANN MCCORMICK,
KEVIN RONALD KANYA, DIRK SAEVECKE, and
SARA LYN GIOVANNI

Appeal 2021-002928
Application 16/388,898
Technology Center 3700

Before STEFAN STAICOVICI, MICHAEL L. HOELTER, and
MICHAEL L. WOODS, *Administrative Patent Judges*.

HOELTER, *Administrative Patent Judge*.

DECISION ON APPEAL¹

STATEMENT OF THE CASE²

This is a decision on appeal, under 35 U.S.C. § 134(a), from the Examiner’s final rejection of claims 1–20. Non-Final Act. 1 (Office Action Summary). We have jurisdiction under 35 U.S.C. § 6(b). For the reasons

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as “The Procter & Gamble Company of Cincinnati, Ohio.” Appeal Br. 1.

² Appellant states that “[i]n related U.S. Patent Application Serial No. 16/388,900, a Notice of Appeal was filed on June 18, 2020 and an Appeal Brief was filed on August 5, 2020.” Appeal Br. 1. Appellant is referring to Appeal No. 2021-002219, on which a Decision was mailed November 8, 2021.

explained below, we AFFIRM the Examiner's rejections and we also enter NEW GROUNDS OF REJECTION of claims 1–20 pursuant to 37 C.F.R. § 41.50(b).

CLAIMED SUBJECT MATTER

The disclosed subject matter “is generally directed to absorbent articles designed and configured to leverage a greater amount of bio-based materials and/or to minimize the inclusion of unwanted materials towards providing a more pure end product to consumers desiring the same.” Spec. 1:4–6. Apparatus claims 1, 10, and 16 are independent. Claim 1 is illustrative of the claims on appeal and is reproduced below.

1. A package of absorbent articles comprising:
 - a. a package comprising a polymeric bag;
 - b. a plurality of absorbent articles disposed within the polymeric bag, wherein the absorbent articles are devoid of lotion, fragrance or perfume, chlorine, and green number 7 dye;
 - c. wherein each of the absorbent articles comprises bleached cellulosic fibers and an absorbent core comprising:
 - i. a core wrap comprising a first nonwoven layer and an opposing second nonwoven layer;
 - ii. absorbent material disposed between the first nonwoven layer and the second nonwoven layer; and
 - iii. an interior disposed channel defined by a portion of the first nonwoven layer being joined to the second nonwoven layer, wherein there is little to no absorbent material present within the channel; and
 - d. wherein the polymeric bag comprises a communication that the absorbent articles comprise are devoid of at least one of:
 - i. fragrance or perfume;
 - ii. lotion; and
 - iii. chlorine.

REFERENCES

Name	Reference	Date
Dobrin et al. (“Dobrin”)	US 5,571,096	Nov. 5, 1996
Stoyanov et al. (“Stoyanov”)	US 2005/0217812 A1	Oct. 6, 2005
Jackson	US 2008/0250681 A1	Oct. 16, 2008
Rosati et al. (“Rosati”)	US 2015/0283003 A1	Oct. 8, 2015
O’Connell	WO 2009/012284 A1	Jan 22, 2009

THE REJECTIONS ON APPEAL

Claims 1–8, 10–18, and 20 are rejected under 35 U.S.C. § 103 as unpatentable over Rosati, Jackson, and Stoyanov.

Claim 9 is rejected under 35 U.S.C. § 103 as unpatentable over Rosati, Jackson, Stoyanov, and Dobrin.

Claim 19 is rejected under 35 U.S.C. § 103 as unpatentable over Rosati, Jackson, Stoyanov, and O’Connell.

Claims 1–20 are provisionally rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1–20 of copending U.S. Application No. 16/388,900 filed April 19, 2019.

ANALYSIS

*The rejection of claims 1–8, 10–18, and 20
as unpatentable over Rosati, Jackson, and Stoyanov*

Appellant argues independent claims 1, 10, and 16 together. *See* Appeal Br. 3–6. Appellant presents no arguments with respect to dependent claims 2–8, 11–15, 17, 18, and 20 stating instead that they should be allowed because they depend from one of the independent claims. *See* Appeal Br. 6. We select claim 1 for review, with the remaining claims (i.e., claims 2–8,

10–18, and 20) standing or falling with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Claim 1 recites an absorbent article that is “devoid of . . . dye.” Claim 1 also recites that the bag containing a plurality of absorbent articles “comprises a communication” about the absorbent articles. The Examiner relies on Rosati for teaching an absorbent article that is devoid of all dyes and also for teaching the use of “graphics and/or indicia . . . formed on, printed on, positioned on and/or placed on outer portions of the packages.”³ Non-Final Act. 4, 6 (referencing Rosati ¶¶ 251, 101).

Addressing the “devoid of” claim limitation, Appellant acknowledges that “Rosati does teach a dye in paragraph [0101].” Appeal Br. 4. Appellant states, “[t]he question here is whether the references disclose or suggest that the absorbent articles are devoid of . . . dye” when, in fact, Rosati “disclose[s] dyes.” Appeal Br. 5. As per Appellant, “[t]he mere fact that the cited references are silent with respect to a negative limitation (i.e., devoid of . . . dye), without more, is not enough to establish the references disclose the negative limitation.” Appeal Br. 5.

Appellant appears to be missing the point of the Examiner’s rejection regarding Appellant’s negative claim limitation. The Examiner references paragraph 101 of Rosati as teaching “alternate embodiments.” Ans. 15; *see also* Non-Final Act. 6. The Examiner states that Rosati teaches a chemical treatment that “may include dyes, but it may also include other substances such as skin care compositions, surfactants, coatings or lotions” in lieu of

³ The Examiner relies on Jackson for also teaching use of “indicia for consumer use” and on Stoyanov for teaching use of “chlorine-free bleached [0014] pulp in an absorbent core.” Non-Final Act. 5.

dyes. Ans. 15. Because Rosati teaches that a dye is just one of many substances that may or may not be included in the final composition (*see* Rosati ¶ 101), then “dye would not be expected to be necessarily present” in all cases. Ans. 15; *see also* Non-Final Act. 6 (“dyes as a whole are not necessarily required to be present as previously discussed with respect to [0101] of Rosati”). Stated another way, the Examiner finds that although “Rosati does discuss dyes, [Rosati] describes that the dyes are optional.” Ans. 16. “As such, the negative limitation would appear to be proven by the prior art through the disclosure by Rosati that the dye is optional.” Ans. 16. Consequently, the Examiner finds that Rosati teaches the situation involving “the general exclusion of all dyes,” which would include the exclusion of the recited dye. Ans. 16. Hence, as per the Examiner, Rosati teaches the limitation “devoid of . . . dye.” Non-Final Act. 6; *see also* Ans. 15–16.

There is merit to the Examiner’s findings that the use of dye in Rosati’s absorbent material is optional, such that one skilled in the art would have been instructed by Rosati that a dye may be present in some instances, but absent (“devoid of”) in others. For clarity, paragraph 101 of Rosati states (*italics added*):

The term “chemical treatment”, as used herein, means at least a portion or region of a single or multi-layer substrate *that has a compound*, composition, or substance applied to at least a portion thereof. *Some examples are* one or more skin care compositions, surfactants, inks, *dyes*, pigments, hydrophilic coatings, hydrophobic coatings, lotions, enzyme inhibitors, vitamins, and/or active ingredients.

From a reading thereof, one skilled in the art would understand that some substrates may have compounds, etc. applied thereto that include “dyes,” but other substrates would have compounds, etc. applied thereto that

do not include “dyes.” This is consistent with the Examiner’s “optional” and “alternate” findings above regarding dyes being applied (or not) to absorbent articles. Accordingly, we do not fault the Examiner for relying on Rosati for teaching Appellant’s negative claim limitation directed to an absorbent article that is “devoid of . . . dye,” which would include Appellant’s cited dye.

Appellant also addresses the claim 1 limitation of “wherein the polymeric bag comprises a communication.” Appeal Br. 5. Appellant acknowledges that the Examiner considers this recitation “as printed matter.” Appeal Br. 6. Appellant understands that for “patentable weight, the printed matter and associated product must be in a functional relationship” and that in the instant case, “[t]he function is that the communication tells a shopper about features of absorbent articles within the packages so they can make a purchase decision.” Appeal Br. 6.

Although the Examiner delves into the functional relationship between printed matter and its substrate (*see* Non-Final Act. 5), the Examiner additionally finds that “Rosati anticipates the use of graphics and/or indicia relating to” absorbent articles on packaging. Non-Final Act. 4 (referencing Rosati ¶ 251). This paragraph 251 of Rosati teaches, “[g]raphics and/or indicia relating to properties of the absorbent articles may be formed on, printed on, positioned on, and/or placed on outer portions of the packages.”⁴ The Examiner then explains why it would have been

⁴ The Examiner also identifies where Jackson also “teaches the use of an indicia for consumer use.” Non-Final Act. 5 (referencing Jackson ¶ 27 (“If desired, one or more indicia may relate to the absence of a feature or step.”)).

obvious to utilize this teaching in Rosati (and Jackson) “in order to notify a consumer who may be particularly sensitive to scents, perfumes, etc. as taught by Jackson in [0027].” Non-Final Act. 5.

Appellant does not dispute such teachings in Rosati and Jackson, nor does Appellant explain why the Examiner might be in error for concluding that it would have been obvious to utilize such express teachings.

Accordingly, and based on the record presented, we are not persuaded the Examiner erred in rejecting claims 1–8, 10–18, and 20 as being unpatentable over Rosati, Jackson, and Stoyanov. We sustain their rejection.

The rejections of: (a) claim 9 as unpatentable over Rosati, Jackson, Stoyanov, and Dobrin; and, (b) claim 19 as unpatentable over Rosati, Jackson, Stoyanov, and O’Connell

Appellant presents no arguments with respect to dependent claims 9 and 19. *See Appeal Br. generally.* We sustain their rejections.

The provisional rejection of claims 1–20 on the ground of nonstatutory double patenting over claims 1–20 of copending U.S. Application No. 16/388,900 filed April 19, 2019

The above identified co-pending application was docketed as Appeal No. 2021-002219 on February 12, 2021. A Decision in that matter was mailed on November 8, 2021. No subsequent action has been taken in that case and thus, because U.S. Application No. 16/388,900 is presently still pending, we do not reach the merits of the Examiner’s provisional double patenting rejection because it would be premature to do so at this time, consistent with the holding of *Ex Parte Moncla*, 95 USPQ2d 1884, 1885 (BPAI 2010) (precedential).

NEW GROUNDS OF REJECTION

Each independent claim on appeal (i.e., claims 1, 10, and 16), and hence their dependent claims (i.e., claims 2–9, 11–15, and 17–20), includes the limitation of absorbent articles that are “devoid of . . . green number 7 dye.” Appellant contends, “[t]he question here is whether the references disclose or suggest that the absorbent articles are devoid of green number 7 dye.” Appeal Br. 5. However, that is not the only question that needs to be raised. For example, we note that Appellant’s Specification is silent as to what, exactly, “green number 7 dye” is, or what “undesirable” materials or features it possesses that might warrant its absence from absorbent articles. *See* Spec. 17:19–21, 29:17–24. In fact, because of the unknown nature of “green number 7 dye,” a person of ordinary skill in the art could not be made aware of the metes and bounds of this claim phrase, and hence of the full scope of each claim on appeal.

Further, there is no indication that “green number 7 dye” is a well-known dye, that it has a certain meaning in the industry, or that it falls within any of a number of classifications or descriptions by which dyes are often characterized. Instead, as intimated above, Appellant’s Specification only describes “green number 7 dye” as having “certain undesirable materials” (Spec. 17:19–21) without indicating the offending compound(s) or even what criteria is employed to determine if a material is “undesirable” or not.⁵ *See also* Spec. 29:17–24 (“free of at least one of the following undesired features . . . green number 7 dye”).

⁵ Appellant’s Specification states, “Absorbent articles of the present disclosure may be ‘devoid of’ or ‘free of’ particular undesirable materials, ingredients, or characteristics in some forms.” Spec. 3:26–27.

As is well known, the written description requirement mandates that the originally-filed disclosure convey sufficient information such that it can be determined that Appellant was in possession of that which is claimed. *See* 35 U.S.C. § 112(a). Here, Appellant’s Specification only conveys a desire for an absorbent article to be devoid of an undesirable dye without identifying either the chemical composition(s) or property provoking its banishment, or the standards by which “undesirable” is to be measured. To be clear, “a patent must be precise enough to afford clear notice of what is claimed, thereby apprising the public of what is still open to them.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 909 (2014). Furthermore, we are instructed that patent claims are indefinite if they “fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Id.* at 901.

Based on the above, it is concluded that the claim term “green number 7 dye” lacks proper written description support in Appellant’s Specification and that this term is also unclear as to its scope and meaning, thereby rendering the claim term indefinite as well. Thus, while we sustain the Examiner’s rejection as proffered (*see above*), we also reject claims 1–20 because these claims recite the term “green number 7 dye” which lacks adequate written description support and is indefinite for the reasons provided above. *See In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962) (holding that the Board erred in affirming a rejection of indefinite claims under 35 U.S.C. § 103(a), because the rejection was based on speculative assumptions as to the meaning of the claims). Further, as our reasoning supplements that presented by the Examiner, we designate our additional

rejections of these claims as new grounds of rejection under 37 C.F.R. § 41.50(b), in order to provide Appellant with a fair opportunity to respond.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/ Basis	Affirmed	Reversed	New Ground
1–8, 10–18, 20	103	Rosati, Jackson, Stoyanov	1–8, 10–18, 20		
9	103	Rosati, Jackson, Stoyanov, Dobrin	9		
19	103	Rosati, Jackson, Stoyanov, O’Connell	19		
1–20		Provisional Obviousness-type Double Patenting ⁶			
1–20	112	Written Description			1–20
1–20	112	Indefiniteness			1–20
Overall Outcome			1–20		1–20

⁶ As explained above, we do not reach this rejection per *Ex parte Moncla*, Appeal No. 2009-006448 (PTAB June 22, 2010) (holding that it is premature to address a provisional rejection) (designated precedential).

FINALITY OF DECISION

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, the Appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED; 37 C.F.R. § 41.50(b)