New matter/Not supported by disclosure

The examiner rejected claims 1 to 14 for lack of support in the original disclosure. Amendments made to the disclosure during the prosecution were also rejected as adding new matter to the application. The Board determined that the amendments to the disclosure could be reasonably inferred from the original wording and that there was support in the original and in the amended disclosure for the rejected claims.

Application returned to the examiner.

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 484,830, having been rejected under Subsection 47(2) of the Patent Rules, the Applicant asked that the Final Action of the Examiner be reviewed. The rejection has consequently been considered by the Patent Appeal Board and by the Commissioner of Patents. The findings of the Board and the ruling of the Commissioner are as follows:

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This decision deals with the Applicant's request that the Commissioner of Patents review the Examiner's Final Action on patent application number 484,830 (Class 2-98.02) which was filed on June 21, 1985. The Applicant is Kimberly-Clark Corporation assignee of inventor Kenneth M. Enloe and the invention is entitled "DIAPERS WITH ELASTICIZED SIDE POCKETS". The Examiner issued a Final Action on May 26, 1992 rejected claims 1 to 14 inclusive on the grounds that they claim material which is not supported by the specification of the application as originally filed.

The application relates to a disposable diaper which has fecal containment flaps positioned along each side of the diaper. Figures 1 and 2 of the application as reproduced below show the Applicant's diaper with the containment flaps.

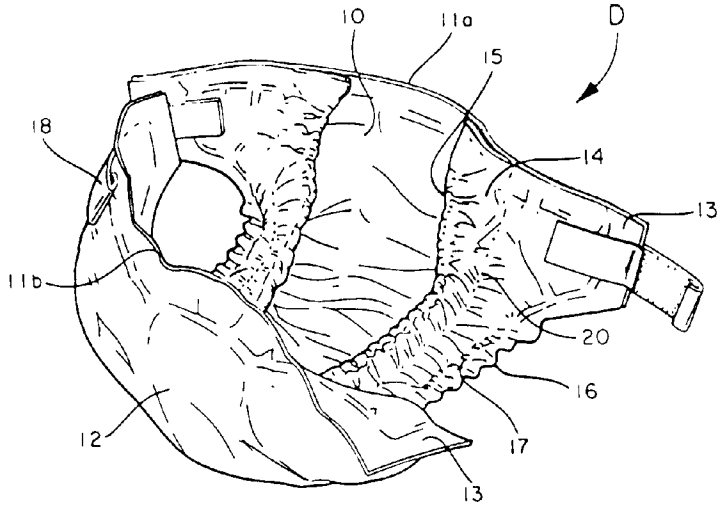

FIG. 1

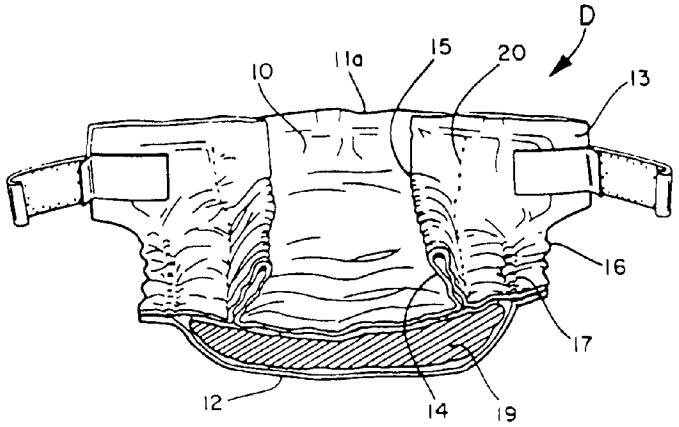

FIG. 2

The Applicant's diaper consists of a front waist portion 11b and a back waist portion 11a each of which has a projection 13 which fits around the wearer's waist. Tape tabs 18 hold the diaper in place. The diaper has a fluid impervious backing 12 which is sealed peripherally to a liner 10 and there is an absorbent matrix 19

between the backing and the liner. The diaper also has flaps 14 which extend toward the central region of the diaper from near the side 16.

In refusing claims 1 to 14 of the application the Examiner, in the Final Action, stated, in part, that:

> Refusal of claims 1 to 14 is maintained for lack of support in the disclosure in accordance with Rule 25
>
> The amendment of the disclosure on page 2 (8, 9) describing the flaps as being separately attached to the liner is considered to be new matter which is contrary to Rule 52 and is likewise refused
>
> In a series of voluntary amendments the disclosure and the claims were changed to introduce new matter of the flaps being attached rather than formed from the liner These changes incorporate the possibility of using materials for the flap other than those used for the liner The amendments were not required either because of imperfection in draftsmanship or non-compliance of statutory requirements. The new matter cannot reasonably be inferred from the specification and is refused under Section 52 of the Patent Rules

The Board notes at this time due to changes in the Patent Act that came into force on October 1, 1996 it is new Rules 174(2) and 181 which now apply to the application rather than former Rules 25 and 52.

In its November 18, 1992 response to the Final Action, the Applicant stated, in part, that:

> (Page 2) It is Applicant's position that Applicant is entitled to claims of the scope of present claims 1 to 14 and that the feature of the flaps being attached to the body liner is subject matter which was present in the application as originally filed At the very least, the subject matter is reasonably inferable from the application as originally filed
>
> (Page 4) The part of the claims relevant to the Examiner's rejection is that which relates to the flaps being "attached to or formed from said liner" The Examiner has taken the position that the phrase "attached to" adds new subject matter to the application
>
> (Page 5) The disclosure of this application, as originally filed, described the problems in known diaper constructions, and particularly those problems relating to side leakage around the legs of the wearer, such as leakage of liquidized materials, in spite of the use of elasticized leg portions (page 1, lines 10 to 33) It was indicated in the original disclosure that the invention generally involved the providing of a "flap" inwardly from each side of the diaper and using elasticization means near its innermost edge for causing the flap to form a second inwardly facing barrier (page 2, lines 2 to 9) In the detailed description of one embodiment of the invention, reference was also made to "a flap 14 which is sealed along a seal line 20", (page 2, lines 34 and 35)
>
> Two embodiments of the invention were shown in the accompanying drawings, and as the Examiner has noted, both of the illustrated embodiments show the flaps being formed from the same piece of material as the liner The invention, however, was not limited to the embodiments shown in the drawings, and additional aspects of the invention were disclosed in the originally filed description and claims In particular, page 4, lines 6 and 7 of the description stated that the "flap material is preferably soft, conformable

> and vapor and/or fluid permeable" (underlining added) The description further pointed out that a suitable flap material is "made of a fine mesh with a basis weight of 0 7 to 0 8 ounces per square yard and may be a spunbonded diaper liner of the type used throughout the diaper" (page 4, lines 7 to 10)(underlining added)
>
> (Page 26) In view of the above, it is submitted that one has to conclude that the wording "attached to" as first used in the first amendment to this application on June 10, 1987 should not in any way be considered to represent any different and new matter to the application as originally filed, and would have been envisioned and understood by a person to whom the description is directed It is further submitted that since the generic phrase "attached to" is supported by general disclosure of what was originally described and illustrated, the Applicant is not obliged to restrict the claims to a specific embodiment by using the wording "formed from" alone Additionally, wording of the type required by the Examiner may render the claim ambiguous It is Applicant's view, therefore, that the application is in condition for allowance, and that there is no need to change either the description at page 2, lines 8-9, or the claims 1 to 14

Claim 7 is representative of the claims under rejection :

> A unitary diaper having a fluid pervious liner, a fluid impervious backing essentially coterminous therewith and an absorbent matrix positioned between said liner and said backing, a waist portion formed by a first and a second end of said diaper with fastening means on at least one of said ends for securement about the waist of the baby when the diaper is worn, a crotch portion substantially centrally disposed with respect to said ends, and two essentially symmetrical, oppositely disposed elasticized leg portions with each leg portion generally transversely corresponding to and disposed outwardly from said crotch portion, and two elasticized flaps extending toward each end and formed from or attached to said liner, a pair of waste containment pockets being defined by said pair of flaps and said liner

The underlined portion "or attached to" is basically the text that was added to the description and forms the basis of the Examiner's objection. In other words, the Examiner has refused present claims 1 to 14 under Rule 25 [now Rule 174(2)] as not being fully supported by the description. Rule 174(2) reads as follows:

> (2) Every claim must be fully supported by the description

The Examiner, then relies on the authority of Rule 25 [now Rule 181] to refuse the amendment to the description which added wording to explicitly set forth that the flaps are attached to the liner. Rule 181 reads as follows:

> No person shall amend the specification or drawings to describe or add matter not reasonably to be inferred from the specification or drawings as originally filed

The Examiner believes that this amendment added subject matter that was not contained in the original application and which could not be reasonably inferred from the subject matter which was disclosed and claimed in the application when it was filed. This wording was first submitted with the Applicant's letter of June 10, 1987.

In order to decide if the present description contain new subject matter, it is necessary to study the originally filed description, drawings and claims to determine what material was originally present.

The structural relationship between the diaper liner and the flaps was not described in any detail, although there are several places where brief mention is made of this relationship. Original page 2 lines 34 and 35 state that "a flap 14 which is sealed along seal line 20, is provided " and original page 4 lines 6 to 10 state "The flap material is preferably soft, conformable and vapor and/or fluid permeable. A suitable material made of a fine mesh with a basis weight of 0 7 to 0 8 ounces per square yard and may be a spunbonded diaper liner of the type used throughout the diaper".

Also, there is no mention of the structural relationship between the liner and the flaps in original claim 1. However, original claim 4, which depends on claim 1, adds that the flap is formed of the same material as the liner.

When the Board considers the original specification, in its entirety, it is led to the conclusion that the Applicant contemplated one diaper construction in which the flaps were formed from the liner and another construction in which the flaps were formed from a separate piece of material which was subsequently attached to the liner.

It is obvious that a diaper liner must be permeable to liquids or else it would be incapable of carrying out its major functions and would lack utility. However, the description discloses a flap which could be permeable to fluids, to vapours or to fluids and vapours. Because of this description, the liner and the flap could have substantially different premeabilities and, therefore, must be composed of different materials which are joined or attached to each other at some later stage of the manufacturing process.

The flap <u>may</u> be made of spunbonded material. This wording indicates that this is an embodiment which is contemplated but it is not an essential feature of the diaper. If it is not made of the same material as the liner it must be made of some other material which would require the flap to be manufactured separately and to then be attached to the liner. The statement in claim 4 that the flap is formed of the same material as the liner indicates that in claim 1 the possibility exists that the flap is made of either the same or different material. Again, if the flap is made of a different material from the liner, it must be manufactured separately and then attached to the liner.

As a result of the foregoing, the Board is led to the conclusion that the applicant had contemplated, at the time of filing of the application, a diaper construction in which the flap was not formed from the liner. If it was not formed from the liner, it must have been formed separately and then attached to the liner. This means that the amendment to the description which specifically set forth that the flap is attached to the liner complies with Rule 174(2) [former Rule 52] and does not add new subject matter to the application. The material set forth in the rejected claims (present claims 1 to 14) is supported by the description, in compliance with Rule 181.

In summary, the Board recommends that the refusal of claims 1 to 14 be withdrawn and that the application be returned to the Examiner for further prosecution.

P.J. Davies	M. Howarth	M. Wilson
Chairman	Member	Member

I concur with the findings and the recommendation of the Patent Appeal Board. Accordingly, I return the application to the Examiner for further prosecution consistent with the Board's recommendation.

S. Batchelor
Commissioner of Patents

Dated at Hull, Quebec
this 29 day of January 97