There is great consumer demand for jeans that can be produced for sale with a faded look. One way to produce fading is to wash jeans with bleaching solutions, but the result is a substantially uniform fading that does not appear very natural. As an alternative, “stone-washing”—in which clothing is washed in water mixed with pumice and possibly also bleach—may be used to produce non-uniform fading, but this fading tends to be concentrated in seam areas.

In 1985, Scolorito Pantaloni (“Scolo”) discovered that he could produce more randomly distributed fading by dry-tumbling jeans in the presence of porous granules treated with a bleaching substance. Scolo filed an application for an Italian patent on December 12, 1985. On October 8, 1986, Scolo filed an application for a U.S. patent, claiming priority based on the Italian application. Scolo’s U.S. application made the following claim:

1. A method of producing randomly faded cloth comprising:
   (1) infusing porous granules with a bleaching substance;
   (2) dry-tumbling the bleach-bearing granules and cloth material together; and
   (3) removing the granules from the cloth material.

A PTO examiner rejected claim 1 as obvious over the combination of a British patent issued in 1879 and a newspaper article published in the Boise Herald on September 3, 1986. The Boise Herald article disclosed the washing of jeans with porous granules in a washing machine, and also disclosed the removal of granules from the jeans after washing was complete. The British patent disclosed the use of bleach during a wash with water. On the basis of these references, the examiner concluded that it was obvious to use porous granules and bleach together during washing. According to the examiner, porous granules would naturally become infused with bleach during such washing.

After Scolo responded to this rejection, the examiner rejected claim 1 a second time based on a combination of three new references: (1) U.S. Patent No. 4,601,845, filed on April 2, 1985, and issued on July 22, 1986; (2) U.S. Patent No. 4,575,887, filed on August 29, 1984, and issued on March 18, 1986; and (3) U.S. Patent No. 3,945,936, filed on January 29, 1974, and issued on March 23, 1976. The ’845 patent disclosed the use of bleaching catalysts consisting of porous zeolite granules treated with specific types of salt. The ’887 patent disclosed the use of porous pumice granules for stone-washing. The ’936 patent disclosed the use of bleaching material in a
dryer. Based on these references, the examiner concluded that it was obvious to bleach clothing
in a tumble dryer by using porous granules treated with a bleaching substance.

What arguments might Scolo have used to overcome the first rejection? What arguments
can he use to overcome the second?