

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JURGEN RIDDER and JOHANNES HUBINGER

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Appeal No. 2000-1455  
Application 08/911,913

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ON BRIEF

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Before CALVERT, COHEN, and BAHR, Administrative Patent Judges.  
CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 2, 4, 19 and 20. The other claims in the application stand withdrawn from consideration under 37 CFR § 1.142(b), as being drawn either to a nonelected invention (claims 21 to 25) or to nonelected species (claims 3 and 5 to 18).

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The claims on appeal are drawn to a mat for sanitary facilities. Claim 1, the only independent claim, reads<sup>1</sup>:

1. A mat for sanitary facilities comprising a carrier of flexible, plastic with suction cups on a bottom side thereof and a layer of nonwoven fabric on a top side of the carrier; wherein the carrier is formed of a thermoplastic elastomer is joined to the nonwoven fabric by having been back-injected onto the nonwoven fabric.

The appealed claims are reproduced in the new appendix filed on November 30, 2000.

The reference applied in the final rejection is:

Hausch (German patent)                      3,303,993                      Aug. 9,  
1984<sup>2</sup>

An additional reference, applied herein in a rejection pursuant to 37 CFR § 1.196(b), is:

Harper, Ed., Handbook of Plastics, Elastomers, and Composites  
(2d. Ed. 1992) pp. 7.1, 7.2 and 7.37 to 7.41 (Handbook).

The following rejections are before us:

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<sup>1</sup> We note that in this claim the comma after "flexible" should be deleted, and --and-- apparently should be inserted after "elastomer".

<sup>2</sup> A translation of this document, prepared by the USPTO, is forwarded to appellants herewith.

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(1) Claims 1 and 4, anticipated by Hausch, under 35 U.S.C.  
§ 102(b).

(2) Claims 1, 2, 4, 19 and 20, unpatentable over Hausch, under  
35 U.S.C. § 103(a).

The Hausch Reference

The first portion of Hausch's disclosure which is of particular relevance to this case is in the paragraph bridging pages 6 and 7, discussing the prior art. According to the translation furnished by appellants with their brief<sup>3</sup>, the pertinent portion (the first two sentences) of this paragraph reads<sup>4</sup>

Elastic mats of the aforementioned type are known in which a fabric or nonwoven is coated with foamed plastic and a slip-proof surface structure is formed on the plastic layer. Suction cups are then bonded onto the bottom of the plastic layer or attached in some other

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<sup>3</sup>Erroneously described in footnote 2 of the brief as "a translation of the paragraph spanning pages 5 & 6 of the Hauser {sic} reference."

<sup>4</sup> This translation differs from the enclosed USPTO translation in that in appellants' version the German expression "ein Gewebe oder ein Flies" is translated as "a fabric or nonwoven," while in the USPTO version it is translated as "a woven fabric or fleece" (see trans., p. 4). We will utilize appellants' version here.

way.

Hausch discloses two different embodiments of his invention, shown in Figs. 2 and 3. The Fig. 3 embodiment is of more interest in the present case; as described at page 7, line 15 et seq. of the translation, the liner (mat) of this embodiment consists of an unfoamed plastic layer 5 having integral suction cups 4, and a foamed plastic layer 6 with nubbins 3 on its upper surface. Layers 5 and 6 may be attached together by gluing or welding (trans. page 8, lines 9 to 11), or layer 6 may be directly molded on layer 5 (id, lines 12 to 15). Hausch states that various plastics are suitable (trans. page 7, lines 11 to 14), particularly PVC, which gives "an especially soft and flexible liner" (trans. page 8, lines 1 and 2).

§ 102(b) Rejection

The examiner takes the position that Hausch's above-discussed disclosure of the prior art anticipates claim 1. He asserts that Hausch discloses a thermoplastic elastomer, and that the recitation of the thermoplastic elastomer "having been back-injected onto the nonwoven fabric" is a process

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limitation which carries little if any weight in a claim to a known product (answer, page 4).

We do not find any disclosure in Hausch itself of a thermoplastic elastomer, but as the examiner points out, the attached abstract states that "Various types of resin are suitable, e.g., PVC and other thermoplastics." However, assuming for the purpose of this decision that the PVC disclosed by Hauser is inherently a thermoplastic, and further assuming that Hausch's disclosure that PVC is suitable for his invention constitutes a disclosure that it would also be suitable for the prior art mats disclosed by him at pages 6 to 7, there is still no disclosure of a thermoplastic elastomer. The examiner's assertion that "'elastomer' is definitive of virtually any resilient plastic" (answer, page 6) is not well taken, since "thermoplastic elastomer" (TPE) is a term of art.<sup>5</sup> Since claim 1 requires a TPE and Hausch does not expressly or inherently disclose it, claim 1 is not anticipated. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d

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<sup>5</sup> See, e.g., page 7.1 of the Handbook. See also 8 Kirk-Othmer Encyclopedia of Chemical Technology 626 (3d Ed. 1979) (copy attached).

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1429, 1431 (Fed. Cir. 1997).

The § 102(b) rejection therefore will not be sustained.

§ 103(a) Rejection

The basis of this rejection as stated by the examiner in the examiner's answer is not particularly clear.

Nevertheless, since Hausch does not teach or suggest the use of a TPE, as recited in claim 1, and the examiner has cited no other evidence from which it might be concluded that it would have been obvious to make any of the mats disclosed by Hausch out of a TPE, the rejection will not be sustained.

Rejection Pursuant to 37 CFR 1.196(b)

Claim 1 is rejected under 35 U.S.C. § 103(a) as unpatentable over Hausch in view of the Handbook. As discussed above, Hausch discloses a prior art elastic mat having a layer of nonwoven fabric coated with a "carrier" of foamed plastic with suction cups attached to its bottom side. Since this disclosed mat is elastic, and TPEs are well known elastic polymers which may be foamed, as disclosed on pages 7.1, 7.2, 7.40 (last line) and 7.41 of the Handbook, it would have been obvious to one of ordinary skill in the art to

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utilize a TPE as the foamed plastic of the known elastic mat disclosed by Hausch, in order to obtain the art-recognized advantages thereof.

It is not clear whether "back injection" of the TPE onto the nonwoven fabric as recited in claim 1 would be inclusive of the coating process disclosed by Hausch<sup>6</sup>, but in any event, assuming that it would not, it appears that the prior art mat described by Hausch (as modified in view of the Handbook) would have essentially the same structure and characteristics as the mat recited in claim 1.<sup>7</sup> Appellants have the burden of proving that it would not. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977).

Remand to the Examiner

The application is remanded to the examiner to determine whether claims 2, 4, 19 and 20 should be rejected as unpatentable over Hausch in view of the Handbook, alone or in view of other prior art.

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<sup>6</sup>In their brief (page 4, line 21; page 5, line 23; page 6, lines 6 and 7) appellants refer to their claimed TPE as "back-sprayed" rather than "back-injected."

<sup>7</sup>Claim 1 does not require the suction cups to be an integral part of the carrier.

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Conclusion

The examiner's decision to reject claims 1, 2, 4, 19 and 20 is reversed. Claim 1 is rejected pursuant to 37 CFR § 1.196(b), and the application is remanded to the examiner.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that 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 proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the

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application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

REVERSED, § 1.196(b) AND REMANDED

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IAN A. CALVERT	)
Administrative Patent Judge	)
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IRWIN CHARLES COHEN	)
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