Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte PETER DOUGLAS SPINKS
and
SIMON PAUL SPINKS

Appeal No. 2003-0683
Application No. 09/319,680

ON BRIEF

Before COHEN, FRANKFORT, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 9 and 11 to 13, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to spring units for beds, divan beds, mattresses, and other upholstery units (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

Claims 1 to 9 and 11 to 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 1,192,510[1] to Fischmann.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the final rejection (Paper No. 17, mailed April 22, 2002) and the answer (Paper No. 20, mailed August 29, 2002) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 19, filed July 29, 2002) and reply brief (Paper No. 21, filed November 5, 2002) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the Fischmann patent, and to the respective positions articulated by the appellants and the examiner. As a consequence of our

[1] Issued July 25, 1916.

review, we will not sustain the rejection of claims 1 to 9 and 11 to 13 under 35 U.S.C. § 102(b) for the reasons which follow.

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgirg v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)) (internal citations omitted):

> Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Thus, a prior art reference may anticipate when the claim limitation or limitations not expressly found in that reference are nonetheless inherent in it. See In re Oelrich, 666 F.2d at 581, 212 USPQ at 326; Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 630, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates. See In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). However, inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art. See Mehl/Biophile Int'l Corp. v. Milgraum, 192 F.3d 1362, 1365,

52 USPQ2d 1303, 1305-06 (Fed. Cir. 1999); Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1946-47 (Fed. Cir. 1999).

Claims 1 and 8, the independent claims on appeal, read as follows:

> 1. A spring unit (2) for incorporation into a mattress, said mattress having a first surface and a second surface, and said spring unit comprising a first spring (4) having a first end and a second end, and a second spring (6) having a first end and a second end, said second spring being located within said first spring (4) and having no connection to said first spring (4) so as to be freely movable within said first spring (4) from the first end of said first spring to the second end, wherein in a first position of the mattress the first end of the second spring (6) is adjacent the first end of the first spring (4) and the first surface of the mattress, and in a second, reversed position of the mattress, the first end of the second spring is adjacent the second end of the first spring (4) and the second surface of the mattress.
>
> 8. A bed, divan, mattress or other upholstery unit incorporating a plurality of spring units each comprising a first pocketted spring (A) having two ends and a second pocketted spring (B) located within said first pocketted spring (A), wherein said second pocketted spring (B) has no connection to said first pocketted spring (A) so as to be freely movable within said first pocketted spring from one end of said first spring to the other end.

Fischmann's invention relates to cushions of the type in which springs are used as a resilient foundation and is particularly applicable for use with automobiles, ambulances and the like, having for its object to provide means whereby the abnormal shock due to sudden compression of the cushion will be absorbed, thereby preventing the total collapse of the cushion and the consequent shock to a person who may be seated thereon. Fischmann's invention consists essentially of the construction and

arrangement of the parts whereby the primary springs forming the foundation of the cushion are reinforced, either directly or indirectly, by further resilient members which may be of greater strength than the primary springs. Pockets are preferably provided for the accommodation of the springs and a suitable fibrous material extends around the pockets both between the same and between the outer covering of the cushion.

As shown in Figures 1-3[2] of Fischmann, primary springs 1 form the foundation of a cushion and are attached directly to the frame of the cushion, where such a frame is employed, but it is preferred to dispense with such frame and arrange the springs in fabric pockets 2. The fabric pockets being surrounded by felt or other suitable fibrous material 3 in such a manner that the internal construction of the cushion will be in the form of a series of spring containing rolls A extending from side to side. The series of rolls preferably being covered with a layer of fibrous material 4 between the same and the outer covering or envelop 5.

Fischmann teaches (page 1, line 78, to page 2, line 7) that:

> Where cushions are so provided with main or primary springs only, especially where used in connection with automobiles, it is found that they work very satisfactorily under ordinary conditions, but upon the vehicle passing over a very uneven surface the violent shock will effect the total collapse of the cushion,

[2] Figure 1 is a sectional perspective view of part of a cushion. Figure 2 is a sectional detail view illustrating the primary spring within one of the pockets and a secondary spring concentrically disposed within the primary spring and also provided with a pocket. Figure 3 is transverse section of Figure 2.

> beneath the weight of the person seated thereon, the shock therefore being directly transmitted to the person with consequent discomfort.
>
> In the present case the total collapse of the cushion under such circumstance is prevented by the resilient reinforcement of the said springs 1 for a part of their length in such manner that after the primary springs 1 have been compressed to a certain extent the reinforcement will come into operation, thereby increasing the proportion of force necessary for the further compression of the cushion. The most convenient form of such resilient reinforcement are secondary springs 6 substantially shorter than the primary springs, although, for example, pads of porous rubber or the like may be used for a similar purpose if desired. These springs 6 may be concentrically arranged within the springs 2, or may be integral therewith as indicated in Fig. 4 whereby the primary springs 2 are practically self reinforced.
>
> 7 are fabric pockets surrounding the reinforcing springs 6 and preventing noise, which may be caused by contact between the primary and secondary springs, while also having as one of their objects to retain the said secondary springs in a state of partial compression, if so desired, in order to increase their efficient operation.

The appellants argue throughout both briefs that Fischmann does not disclose that his secondary spring 6 is freely movable within the primary spring 2 from one end of the primary spring 2 to the other end of the primary spring 2. We agree. In our view, the examiner's position (answer, pp. 3-5) that Fischmann's secondary spring 6 is inherently freely movable within the primary spring 2 from one end of the primary spring 2 to the other end of the primary spring 2 is shear speculation, not the natural result flowing from the disclosure of Fischmann. While Fischmann does not specifically disclose any connection preventing the secondary spring 6 from freely moving within the primary spring 2 from one end of the primary spring 2 to the other end of the

primary spring 2, this is not, in our opinion, sufficient to inherently disclose that secondary spring 6 is freely movable within the primary spring 2 from one end of the primary spring 2 to the other end of the primary spring 2. Moreover, the appellants set forth in both briefs ample reasons why an artisan would not desire an automobile seat cushion to have a secondary spring be freely movable within the primary spring 2.

For the reasons set forth above, the subject matter of the claims under appeal is not disclosed in Fischmann. Accordingly, the decision of the examiner to reject claims 1 to 9 and 11 to 13 under 35 U.S.C. § 102(b) is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 9 and 11 to 13 under 35 U.S.C. § 102(b) is reversed.

REVERSED

IRWIN CHARLES COHEN Administrative Patent Judge	)	
CHARLES E. FRANKFORT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)	

DAVID A. JACKSON
KLAUBER & JACKSON
411 HACKENSACK AVENUE
HACKENSACK, NJ 07601

JVN/jg