

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PHILIPPE BODIN, MICHEL EUGENE
and LUC MICHELET

Appeal No. 96-1237
Application No. 07/994,770¹

ON BRIEF

Before THOMAS, GARRIS and FRANKFORT, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 10 through 12 and 21². The only other claims remaining in

¹ Application for patent filed December 22, 1992.

² In claim 21, the phrase "insulation matter" should read --insulation mattress--, and this informality should be corrected in any further prosecution that may occur.

Appeal No. 96-1237
Application No. 07/994,770

the application, which are claims 1 through 9 and 14 through 20, stand withdrawn from further consideration by the examiner.

The subject matter on appeal relates to a sound and thermic insulation mattress. With reference to Figure 2 of the appellants' application drawing, the mattress 20 comprises an opening 22 having a compressible water repellent foam insert 24 therein and at least one adhesive strip 30 glued onto at least one of the two opposing faces of the insert and a portion of the insulating mattress directly surrounding the opening. This appealed subject matter is adequately illustrated by independent claim 10 which reads as follows:

10. Sound and thermic insulation mattress to be secured to a support and comprising an insulating mattress having at least one opening; a compressible water repellent foam insert having two opposing faces and being mounted in said opening of said mattress, said insert being large enough to substantially fill said opening, being watertight and having sound and thermic insulation properties; and at least one adhesive strip glued onto at least one of the two opposing faces of said insert, said adhesive strip having a surface larger than that of the insert so as to keep said insert in place and to also cover no more than at least a portion of the insulating mattress directly surrounding said opening to ensure a sealed link between said insert and said insulating mattress when said mattress is secured to said support.

The prior art relied upon by the examiner as evidence of obviousness is set forth below:

Cunnington	2,129,167	Sep. 6, 1938
Millard	3,182,119	May 4, 1965

Appeal No. 96-1237
Application No. 07/994,770

The Admitted Prior Art shown in Figure 1 of the drawing and discussed on pages 2 and 3 of the specification for this application.

The claims on appeal stand rejected under 35 U.S.C. § 103 as being unpatentable over the Admitted Prior Art in view of Cunnington and further in view Millard³. On page 4 of the Answer, the examiner expresses his obviousness conclusion in the following manner:

It would have been obvious to one of ordinary skill in the art to place a resilient spacer in the hole of the admitted prior art tape and insulation seal [shown at the upper portion in Figure 1 of the appellants' drawing] in order to improve the insulation ability of the taped hole because of the teachings of Cunnington. It further would have been obvious to use a foam spacer because of the teachings of Millard to use foam as a resilient spacer.

We refer to the Brief and Reply Brief and to the Answer for a complete exposition of the respective viewpoints expressed by the appellants and the examiner concerning the above noted rejection.

Opinion

The rejection before us cannot be sustained.

Obviousness cannot be established by combining pieces of prior art absent some teaching, suggestion or incentive

³ The appealed claims will stand or fall together; see page 2 of the Answer and 37 CFR 1.192(c)(5)(1993).

Appeal No. 96-1237
Application No. 07/994,770

supporting the combination. In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). From our perspective, the prior art applied by the examiner simply does not contain the requisite teaching, suggestion or incentive for combining pieces of this prior art in such a manner as to obtain the here claimed invention. Our fundamental reason for reaching this determination is the fact that the various individual features of the applied prior art relied upon by the examiner concern differing problems, functions and purposes.

Specifically, the spacer element of Cunningham performs a spacing function for the purpose of militating against the problem of insulation compression (e.g., see lines 21 through 32 in the first column on page 2). This function and purpose are not applicable to the Admitted Prior Art shown at the upper portion in Figure 1 of the appellants' drawing since the insulation of this prior art does not possess a compression problem. Indeed, there is no insulation at all at the location of this admitted prior art structure into which the examiner proposes placing Cunningham's spacer element. Further, the Millard patent not only fails to cure this defect but possesses a similar one (i.e., the problem, function and purpose associated with patentee's grommet do not appropriately correspond to those

Appeal No. 96-1237
Application No. 07/994,770

of the Admitted Prior Art or for that matter the Cunnington reference).

Under these circumstances, it is our belief that the prior art combination proposed by the examiner is the result of impermissible hindsight reconstruction based upon the appellants' own disclosure rather than some teaching, suggestion or incentive based upon the prior art. In re Deminski, 796 F.2d 436, 443, 230 USPQ 313, 316 (Fed. Cir. 1986). As a consequence, we cannot sustain the examiner's § 103 rejection of claims 10 through 12 and 21 as being unpatentable over the Admitted Prior Art in view of Cunnington and further in view of Millard.

The decision of the examiner is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge))	
)	
)	
BRADLEY R. GARRIS)	BOARD OF PATENT
Administrative Patent Judge))	APPEALS AND
)	INTERFERENCES
)	
)	
CHARLES E. FRANKFORT)	
Administrative Patent Judge))	

Appeal No. 96-1237
Application No. 07/994,770

Michael N. Meller
P.O. Box 2198
Grand Central Station
New York, NY 10163