

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ELIZABETH WILKES

Appeal No. 1997-4353
Application No. 08/390,102¹

ON BRIEF

Before KRASS, FLEMING and RUGGIERO, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed February 17, 1995. According to appellant, this application is a continuation-in-part of Application No. 08/210,035 filed March 17, 1994, now abandoned.

Appeal No. 1997-4353
Application No. 08/390,102

This is a decision on appeal from the final rejection of claims 1 through 5 and 8 through 11, all of the claims remaining in the application.

The invention is directed to a disposable, sanitary cover for telephone handsets.

Representative independent claim 1 is reproduced as follows:

1. A telephone handset protector for the normal user contact areas of the handle, the mouth piece and ear piece of the telephone handset comprising:

a flat unitary sheet of sound permeable material with:

a) a central portion extending laterally sufficiently wide to substantially encircle the handle of a telephone handset;

b) a mouth piece portion sufficient in size to cover the face of the mouthpiece of a telephone;

c) an earpiece portion sufficient in size to cover the face of the earpiece of the telephone handset; and

d) said mouthpiece and earpiece face covering portions each connected to said central portion by respective connecting portions of said sheet of sufficient length to allow said mouthpiece face covering and earpiece face covering portions to normally extend from the rear of a telephone handset and to fall in place over the respective mouthpiece and earpiece faces of the telephone handset;

e) said connecting portions to said mouthpiece face covering portion and said earpiece face covering portion each

Appeal No. 1997-4353
Application No. 08/390,102

extending laterally substantially less than the lateral dimension of said central portion;

said protector including an adhesive on each of said central portion, said mouthpiece portion and said earpiece portion of said protector.

The examiner relies on the following references:

O'Connor 1988	4,751,731	Jun. 14,
Dale et al. (Dale) 1991	5,012,513	Apr. 30,

Claims 1 through 5 and 8 through 11 stand rejected under 35 U.S.C. § 103 as unpatentable over O'Connor in view of Dale.

Reference is made to the briefs and answers for the respective positions of appellant and the examiner.

OPINION

We reverse.

The examiner contends that O'Connor discloses the claimed subject matter but for the mouthpiece and earpiece portions of the protector extending from the rear of the handset and the central portion of the protector encircling the handset handle and having an adhesive. The examiner then relies on Dale for providing such features and concludes that it would have been

Appeal No. 1997-4353
Application No. 08/390,102

obvious to combine Dale with O'Connor, modifying O'Connor's protector with a central portion and adhesive means encircling the handset handle and further modifying O'Connor's protector by extending the mouthpiece and earpiece portions from the rear of the handset.

In our view, the examiner has failed to establish a prima facie case of obviousness with regard to the instant claimed subject matter.

While at first glance, the applied references appear to be relevant to the instant claimed subject matter, further analysis reveals little in common between not only the applied references themselves but also between the applied references and the instant claimed subject matter.

While the instant claimed subject matter is directed to a protector for a telephone handset wherein the user is protected from contamination from portions of the telephone in normal user contact areas of the handle, O'Connor is directed to a disinfecting device for a telephone handset and Dale is directed not to the protection of a telephone user but, rather, to the protection of the telephone itself from damage. Now, it may be convincingly argued that, as claimed, e.g.,

Appeal No. 1997-4353
Application No. 08/390,102

claim 1, there is nothing which requires protection from contamination. However, the claimed structure is clearly not shown by either of the references, we find no reason for the skilled artisan to have combined the references and, even if combined, it is our view that the instant claimed subject matter would not be reached.

More particularly, the claims call for a flat, unitary sheet of "sound permeable material" having, inter alia, mouthpiece and earpiece face covering portions connected to a central portion such that the mouthpiece face covering and earpiece face covering portions to "normally extend from the rear of a telephone handset and to fall in place over the respective mouthpiece and earpiece faces of the telephone handset" [claim 1 with similar language in independent claim 8].

We find no such "sound permeable material" disclosed in Dale. As for O'Connor, the material employed in the disinfecting device appears to be one of many, e.g., paper, plastic, etc. However, the material appears immaterial in O'Connor for purposes of sound permeability since O'Connor's

Appeal No. 1997-4353
Application No. 08/390,102

disinfecting device does not appear to be employed when the telephone is in use.

Clearly, O'Connor, which doesn't even appear to disclose a device which is to be used while the telephone is in use, does not disclose such a unitary structure as claimed. The structure in O'Connor's Figure 2 is to be placed on the front of the handset for disinfecting. It is not placed on the handset from the rear wherein mouthpiece and earpiece face portions "fall in place" over the respective mouthpiece and earpiece faces of the telephone handset.

Turning to Dale to supply the deficiency of O'Connor is to no avail. Dale is not directed to disinfecting the telephone handset as in O'Connor, but, rather, to the protection of the handset itself from damage by vandals, for example. The handset covering in Dale has a strong shank 16 and the cover is made of impact energy absorbing material. Therefore, it is not clear why the skilled artisan having O'Connor before him/her and seeking to perhaps extend the protection afforded by O'Connor's device would even look to Dale for guidance. Thus, we see nothing that would have led the artisan to combine the teachings of O'Connor and Dale.

Appeal No. 1997-4353
Application No. 08/390,102

Moreover, even if such a combination were to be made, it is our view that the instant claimed subject matter would still not be reached. While the artisan would have had no reason to place the sanitizing device 35 in O'Connor on the handset from the rear of the handset, even if, arguendo, the teaching of Dale was incorporated into O'Connor in the sense of a covering placed on the handset from the rear as in Figures 1 and 2 of Dale, there still would be no structure as claimed, wherein the mouthpiece and earpiece face covering portions "fall in place over the respective mouthpiece and earpiece faces of the telephone handset." In fact, it does not appear that O'Connor's mouthpiece and earpiece face covering portions are actually in place during telephone use and Dale, contrary to the examiner's view, does not appear to have any cover over either the mouthpiece or the earpiece. In both embodiments of Dale, endcover 12 appears to surround a periphery of the mouthpiece and earpiece but the mouthpiece and earpiece are not covered. Accordingly, we see no way in which any combination of O'Connor and Dale would meet, or make obvious, the claimed subject matter.

Appeal No. 1997-4353
Application No. 08/390,102

While independent claim 10 uses slightly different language and does not refer to the mouthpiece and earpiece portions extending from the "rear" and falling "in place," the claim still calls for a "unitary flat sheet of sound permeable tissue" and having a certain configuration whereby the central portion lies in the open palm and fingers of the user's hand so as to wrap the sheet around the handset and so as to have the mouthpiece and earpiece portions "foldable..." Thus, the claim requires "sound permeable tissue" and, as discussed supra, Dale is devoid of any such teaching and, to the extent O'Connor teaches such, O'Connor's device is not used when the telephone is in use or, as claimed, "during ordinary use of said telephone handset." Moreover, neither of the references teaches nor suggests mouthpiece and earpiece portions of the flat unitary structure which are foldable with respect to the rest of the sheet.

Further, the "adhesive means," as set forth in each of the independent claims, is not taught or suggested by either of the references. While O'Connor teaches adhesive material 23, 42, 43 in securing the disinfectant device to the telephone handset, it is not taught as an "adhesive coated

Appeal No. 1997-4353
Application No. 08/390,102

strip positioned on an edge region" of the central portion of the flat unitary structure or that there is any adhesive on the central portion of the structure. While Dale discloses glue strips along a central portion of the covering, these epoxy glue strips are meant for more permanent affixation. It is true that the instant claims do not specify the temporary nature of the adhesive and so the epoxy glue of Dale would appear to meet the claimed limitation of an "adhesive means for securing at least a portion of said central portion...comprising an adhesive coated strip positioned on an edge region of said central portion." However, there would have been no reason for the artisan to modify O'Connor, which teaches an adhesive around the mouthpiece and earpiece of the handset, to include an epoxy on edge regions of a central region which, in O'Connor, would be along the edges of interconnecting member 40.

In any event, since we find no cogent reason for combining O'Connor and Dale and we find that even if combined, the instant claimed invention would not be had, we will not sustain the examiner's rejection of claims 1 through 5 and 8 through 11 under 35 U.S.C. § 103.

Appeal No. 1997-4353
Application No. 08/390,102

Appeal No. 1997-4353
Application No. 08/390,102

The examiner's decision is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	

bae

Appeal No. 1997-4353
Application No. 08/390,102

John E. Wagner
Wagner & Middlebrook
3541 Ocean View Boulevard
Glendale, CA 91208