

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte J. FRANK KOENIG

Appeal No. 1998-1610
Application No. 08/551,319¹

ON BRIEF

Before ABRAMS, FRANKFORT and GONZALES, Administrative Patent Judges

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1 through 17, 23 through 27 and 29 through 32. Claims 18 through 22, the other claims remaining in the application, stand withdrawn from consideration under 37 CFR

¹Application for patent filed November 01, 1995.

Appeal No. 1998-1610
Application No. 08/551,319

§ 1.142(b) as being directed to a nonelected invention. Claim
28

has been canceled. The appellant has confined the appeal to only claims 1 through 17 (brief, page 2). Consequently, the appeal as to claims 23 through 27 and 29 through 32 is hereby dismissed, leaving for review the standing rejections of claims 1 through 17.

We REVERSE.

The subject matter on appeal is directed to a sleeping pad for use in an infant's crib. An understanding of the invention can be derived from a reading of exemplary claim 1, a copy of which can be found in the "Appendix" to the main brief (Paper No. 9).

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Padjen 1940	2,203,921	Jun. 11,
Thorn 1969	3,430,272	Mar. 04,
Spann 1986	4,603,445	Aug. 05,
Saviez 1989	4,809,374	Mar. 07,
Hargest et al.	5,317,767	Jun.

Appeal No. 1998-1610
Application No. 08/551,319

07, 1994
(Hargest)

Claims 1, 3 and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C.

§ 103 as obvious over Spann.²

Claims 5 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Spann.³

Claim 2 stands rejected under 35 U.S.C. § 103 as being unpatentable over Spann in view of Saviez.

Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Spann in view of Hargest.

Claims 8 through 12 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Thorn in view of Spann.

Claim 13 stands rejected under 35 U.S.C. § 103 as being

² We note the following errors in claim 1 (line numbers refer to the claim as it appears in the "Appendix"): line 1, "infants" should read -- infant's--, and line 16, "passageways" should read --passageway--.

³ As a result of an apparent typographical error in Amendment A, filed October 28, 1996 (Paper No. 5), the words "as in claim 1" in original claim 5 were omitted. For purposes of our review, we construe claim 5 as being dependent on claim 1. Correction of claim 5 in Paper No. 5 is in order upon return of this application to the jurisdiction of the examiner.

Appeal No. 1998-1610
Application No. 08/551,319

unpatentable over Thorn in view of Spann and further in view of Hargest.

Claim 14 stands rejected under 35 U.S.C. § 103 as being unpatentable over Thorn in view of Spann and further in view of Saviez.

Claims 16 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Thorn in view of Spann and further in view of Padjen.

The full text of the examiner's rejections and the responses to the arguments presented by appellant appear in the answer

(Paper No. 12), while the complete statement of appellant's arguments can be found in the main and reply briefs (Paper Nos. 9 and 13, respectively).

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we have made the

Appeal No. 1998-1610
Application No. 08/551,319

determinations which follow.

The rejection of claims 1, 3 and 7 under 35 U.S.C. § 102(b)

We reverse the examiner's rejection of claims 1, 3 and 7 under 35 U.S.C. § 102(b).

Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997), In re Paulsen, 30 F.3d 1475, 1478-1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994),

In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990), and RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Claim 1, drawn to a sleep pad for use in an infant's crib, requires (a) a pad member having a top, a bottom and

Appeal No. 1998-1610
Application No. 08/551,319

sides, (b) a plurality of substantially planar, four-sided passageways extending through said pad member from said top to said bottom, each one of said passageway sides extending perpendicular to said top and said bottom and abuts against an adjacent one of said passageway sides from said top to said bottom; and (c) at least said passageway sides are formed from a foam material having low compressibility whereby when an infant is supported on said pad member, said passageway sides retain their shape throughout and readily transmit gaseous and liquid fluids therethrough and away from the crib in an unrestricted manner. Consistent with the underlying specification (page 13), we understand the claimed recitation of "a foam material having low compressibility" to denote a foam material that is sufficiently firm so that the passageways maintain their shape and will not distort under the weight of an infant.⁴

The patent to Spann is concerned with a foam mattress (Fig. 12) or a foam pad for use as a mattress cover and the

⁴ At page 14 of the specification, the preferred foam material is described as a polyethylene foam marketed under the trade name ETHAFOAM®.

Appeal No. 1998-1610
Application No. 08/551,319

like. With reference to the embodiment illustrated in Figures 1-3, Spann describes the pad as having a plurality of upstanding projections or promontorys A each having a planar apex surface B. The projections are disposed in patterns such as aligned rows and are integrally carried by a base portion C of foam material formed in a flat synthetic foam blank. Base portion C includes connecting portions D which taper toward the medial portion of the pad forming a tapering ridge 12. The ridge 12 tapers outwardly such that the connecting portion D terminates to form a V-shaped notch 13. According to Spann, such a construction provides limited independent movement for each of the projections A. In addition, Spann teaches that each of the projections A may be depressed (see Fig. 3) substantially independently of the neighboring projections. Individual movement and depression of the projections A cause air to move between the voids formed between the projections A as a person reclining on the pad moves or turns and produces an air pumping action promoting increased air flow with better transfer of heat and moisture. See, col. 4, lines

Appeal No. 1998-1610
Application No. 08/551,319

8-54 and col. 5, lines 65-68. Spann teaches that the described

pad may be made from an open cell polyurethane foam having a density of about 1.63 pounds per cubic foot and an indentation load deflection of about 34 to 38 (col. 5, lines 40-45).

Appellant argues (main brief, pages 8 and 9) that Spann does not anticipate claim 1 because the reference does not disclose: (1) passageway sides extending perpendicular to the top and bottom of the pad and abutting against an adjacent one of said passageway sides from said top to said bottom;⁵ and (2) passageway sides formed from a foam material having low compressibility whereby the sides retain their shape throughout under the compressive weight of an infant.

The examiner's response (answer, page 10) to argument (1) is that Spann clearly shows "passageway sides extending perpendicular to said top and said bottom and abutting against an adjacent one of said passageway sides from said top

⁵ Based on the underlying disclosure and the recitation in claim 1 that the passageways are "substantially planar," we understand the limitation to require, inter alia, that each passageway side be perpendicular to said top and said bottom along its entire length.

Appeal No. 1998-1610
Application No. 08/551,319

to said bottom" in Figure 16A.

We do not agree. Spann describes the embodiment shown in Figure 16A as having voids that extend entirely through the pad.

However, as shown in Figure 16A, the voids or apertures 43 extend only in the areas between the promontorys. Thus, the voids in Figure 16A do not have sides that extend from the tops of the promontorys (which form the top of the pad) to the bottom of the pad as required by claim 1. Figure 16A also fails to show that the voids are substantially planar and four-sided and that each side is perpendicular to the top and bottom of the pad.

As to argument (2), the examiner has acknowledged (answer, sentence bridging pages 3 and 4) that Spann fails to expressly disclose passageway sides formed from a foam material having low compressibility whereby the sides retain their shape throughout under the compressive weight of an infant. However, the examiner contends that "Spann appears to

Appeal No. 1998-1610
Application No. 08/551,319

teach a foam material that arguably performs this function"
(id. at 4).

We cannot support the examiner's position. Inherency may not be established by probabilities or possibilities. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). To establish inherency, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). In this case,

the disclosure of the reference itself precludes a finding that

the void or passageway sides in Spann will necessarily retain their shape throughout under the compressive weight of an infant. Spann explicitly discloses that the upstanding projections A, which form the sides of the voids, may be depressed as shown in Figure 3 (col. 4, lines 45-49). In fact, Spann views this independent movement of the projections as a positive thing because it creates a pumping action which

Appeal No. 1998-1610
Application No. 08/551,319

causes air to flow from hole to hole. Thus, it is clear to us that not only would the sides of the voids in Spann not retain their shape throughout under the compressive weight of an infant, but that such would be contrary to the intended function of the disclosed pad.

Since Spann does not disclose every limitation recited in claim 1, expressly or inherently, it does not anticipate that claim. In re Schreiber, supra. Claims 3 and 7, which depend on claim 1, are likewise not anticipated.

The rejections of claims 1, 3 and 5-7 under 35 U.S.C. § 103

We reverse the examiner's rejections under 35 U.S.C. § 103.

We agree with appellant's argument (main brief, page 10) that Spann does not teach or suggest the limitation in claim 1

that "each one of said passageway sides extends perpendicular to said top and said bottom . . . from said top to said bottom."

Appeal No. 1998-1610
Application No. 08/551,319

Rather, Spann shows in each of the figures which depict a void extending from the top to the bottom of the pad, namely, Figures 1-3, 9-11 and 18, that the void sides are not perpendicular to the top of the pad throughout their length. The examiner has not explained why it would have been obvious to one of ordinary skill in the art to modify the pad disclosed by Spann to provide void sides perpendicular to the top of the pad throughout their length. Furthermore, Spann teaches that the V-shaped notches 13 between projections A which are formed by the tapering connecting portions D afford the independent movement for the upstanding projections A sought by Spann (col. 4, lines 43-49 and col. 5, lines 53-63). Thus, Spann actually teaches away from forming the sides of the voids perpendicular to the top throughout their length, since such a modification would result in the elimination of the V-shaped notches 13 and the independent movement for the upstanding projections A which are critical to Spann.

We also agree with appellant's argument (main brief, pages 10 and 11) that because Spann's projections A must compress in

Appeal No. 1998-1610
Application No. 08/551,319

order to cause pumping of air through the voids, it would not have been obvious to vary the compressibility of the foam material suggested by Spann to provide a sufficiently stiff pad which effectively retains the basic shape of the passageways when supporting the weight of an infant.

Since all the claimed limitations are not suggested by the prior art, it follows that a prima facie case of obviousness has not been established by the examiner.⁶ Claims 5 and 6 are dependent on claim 1 and contain all of the limitations of that claim. Accordingly, the examiner's rejection of claims 1, 3 and 5 through 7 under 35 U.S.C. § 103 will not be sustained.

The rejections of claims 2 and 4 under 35 U.S.C. § 103

Our review of Saviez and Hargest, which are used in combination with Spann to reject claims 2 and 4, respectively,

⁶ A prima facie case of obviousness requires that all the claim limitations be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

Appeal No. 1998-1610
Application No. 08/551,319

reveals that neither reference supplies the deficiencies in Spann discussed above. Since claims 2 and 4 are dependent on claim 1 and contain all of the limitations of that claim, we will not sustain the standing 35 U.S.C. § 103 rejection of these claims.

The rejections of claims 8-17 under 35 U.S.C. § 103

We begin with the examiner's rejection of claims 8 through 12 and 15. Independent claim 8 is directed to the combination of an infant's crib and a sleeping pad. All of the sleeping pad limitations in claim 1 are found in paragraph (b) of claim 8. The examiner has rejected claim 8, as well as dependent claims 9 through 12 and 15, as unpatentable over Thorn in view of Spann. However, Thorn does not supply the deficiencies noted above with respect to Spann. Since all of the claimed limitations in claims 8 through 12 and 15 would not have been suggested by the combined teachings of Thorn and Spann, we

Appeal No. 1998-1610
Application No. 08/551,319

will not sustain the standing

35 U.S.C. § 103 rejection of these claims.

Claims 13, 14, 16 and 17 are dependent, directly or indirectly, on claim 8. Hargest, Saviez or Padjen is used in addition to Thorn and Spann to reject one or more of claims 13, 14, 16 and 17. Like Hargest and Saviez discussed above, Padjen fails to supply the deficiencies in Spann previously noted. Accordingly, we will not sustain the standing 35 U.S.C. § 103 rejections of these claims.

In summary, all of the examiner's rejections of claims 1 through 17 are reversed.

REVERSED

NEAL E. ABRAMS)
Administrative Patent Judge)
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Appeal No. 1998-1610
Application No. 08/551,319

CHARLES E. FRANKFORT
Administrative Patent Judge

JOHN F. GONZALES
Administrative Patent Judge

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Appeal No. 1998-1610
Application No. 08/551,319

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