

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

Appeal No. 1999-2100
Application No. 08/850,825¹

ON BRIEF

Before ABRAMS, STAAB and NASE, ***Administrative Patent Judges.***

ABRAMS, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1-8, which constitute all of the claims of record in the application.

¹ Application for patent filed May 2, 1997.

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The appellant's invention is directed to a disposable plastic slipper. The claims on appeal have been reproduced in an appendix to the Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Rigsby 1962	3,058,241	Oct. 16,
Ito 1977	4,030,212	Jun. 21,
Krippelz 1978	4,112,599	Sep. 12,
Kolsky 1994	5,274,846	Jan. 4,

THE REJECTIONS

The following rejections stand under 35 U.S.C. § 103:

(1) Claims 1 and 3 on the basis of Krippelz and Kolsky.²

² Since claim 3 depends from claim 2, which stands rejected on the basis of Krippelz, Kolsky and Ito, it is apparent that claim 3 should not have been included in this rejection, but with claims 2 and 4. Moreover, since claim 4 depends from claim 1 and adds only that the two elements of the slipper be heat bonded together, a feature that is taught by Krippelz, we are at a loss to understand why claim 4 has
(continued...)

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(2) Claims 2 and 4 on the basis of Krippelz, Kolsky and Ito.

(3) Claims 5-8 on the basis of Krippelz, Kolsky and Rigsby.

²(...continued)
been grouped with claim 2.

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OPINION

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and the appellant regarding the rejections, we make reference to the Examiner's Answer (Paper No. 17) and to the Appellant's Brief (Paper No. 16).

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, ***In re Keller***, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See ***Ex parte Clapp***, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure.

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See, for example, **Uniroyal ,Inc. V. Rudkin-Wiley Corp.**, 837
F.2d 1044, 1052, 5 USPQ2d 1434, 1052 (Fed. Cir.), *cert.*
denied, 488 U.S. 825 (1988).

The appellant's invention is directed to inexpensive plastic slippers of the type that are disposable. Objectives of the invention include providing such a slipper with soft cushioning and smooth inner and outer surfaces, as well as preventing the heel portion from folding under during use. As manifested in independent claim 1, the invention comprises a sole portion and a vamp portion, both of which are formed of a material

having a substantially planar thermoplastic top web and a substantially planar thermoplastic bottom web spaced apart by a thermoplastic middle web . . . being in the form of a plurality of bubbles bonded to the top and bottom webs so that the bubbles are hermetically sealed.

The claim concludes by stating that the bubbles provide a cushioning property and the spaced apart webs stiffen the sole to prevent it from folding under in use.

The examiner has rejected this claim as being unpatentable over Krippelz in view Of Kolsky. Krippelz is mentioned in the appellant's specification as the type of

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slipper over which he believes his invention to be an improvement. The Krippelz slipper is made from "bubble wrap" material, which has a planar web on one side and a plurality of upstanding bubbles on the other. The Krippelz slipper comprises two sheets of bubble wrap material arranged in layers. Although Krippelz teaches a first embodiment in which bubbles contact the ground and a second embodiment in which the planar web contacts the ground, it is basic to the invention that bubbles always contact the sole of the user's foot, and such is the case in both embodiments. The purpose of this is to provide effective ventilation so as to prevent "plastic raincoat effect," that is, heating and perspiration dampness against the user's skin (column 2, lines 17-22).

Therefore, insofar as the requirements of the appellant's claim 1 are concerned, Krippelz fails to disclose or teach the substantially planar top and bottom webs spaced apart by a middle web of a plurality of bubbles. Krippelz also has not recognized the problem of the folding under of the heel portions of this type of slipper.

Kolsky discloses a cushion material that can be used for mats including "protective" devices for human beings (column

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4, lines 64-67), such as gloves (Figure 19). As shown in Figure 1, the material is multi-layered, and at the very least comprises a layer of material (18) which is the type described in the appellant's claim 1 plus a layer of foam (14). It is the examiner's position that it would have been obvious to one of ordinary skill in the art to replace the two layers of plastic bubble-wrap material used in the Krippelz slipper with a layer of the plastic material disclosed by Kolsky as one of the elements in the cushioning material.

We do not agree. It is axiomatic that the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In the present situation, we fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to make the modification proposed by the examiner. The examiner has concluded that such a change would provide "better support, added cushioning and better energy absorption" than the material used by Krippelz (Answer, page 4). However, from our perspective, any advantages touted in Kolsky apply to the

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multilayered material and not to the bubble wrap material alone, for nowhere does Kolsky teach using it by itself. Moreover, the proposed change would have destroyed one of the objectives of the Krippelz invention, namely, the elimination of the "plastic raincoat effect," which would have operated as a disincentive to the artisan to do so.

We therefore are of the opinion that the combined teachings of Krippelz and Kolsky fail to establish a *prima facie* case of obviousness with regard to the subject matter recited in claim 1, and we will not sustain the rejection of this claim or of dependent claim 3, which stands rejected on the same basis. Inasmuch as Ito, which was cited against dependent claims 2 and 4, does not cure the problems with the basic combination, we also will not sustain the rejection of these two claims, which depend from claim 1.

Independent claim 5, which has been rejected on the basis of Krippelz, Kolsky and Rigsby, also requires the elements discussed above with regard to claim 1. Rigsby does not cure the deficiencies we found in the basic combination of references, and therefore the rejection of claim 5 fails also,

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along with that of claims 6 through 8, which depend from claim 5 and were rejected on the same grounds.

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SUMMARY

None of the rejections are sustained.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
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