

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACK MAZE

Appeal No. 96-0984
Application 08/132,529¹

ON BRIEF

Before CALVERT, COHEN and MEISTER, ***Administrative Patent Judges***.
MEISTER, ***Administrative Patent Judge***.

DECISION ON APPEAL

Jack Maze (the appellant) appeals from the final rejection of claims 1-10, 12, 14 and 15, the only claims remaining in the application.² We reverse.

¹ Application for patent filed October 6, 1993.

² Claim 2 was amended, and claims 11 and 13 canceled, by an amendment filed subsequent to final rejection on February 21, 1995 (Paper No. 6).

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The appellant's invention pertains to a disposable bed pan having a seat and a texture formed on that portion of the seat which comes into contact with the skin of a user. Independent claim 1 is further illustrative of the appealed subject matter and reads as follows:

1. A disposable molded all plastic sanitary bed pan comprising a bowl having a seat at an upper edge of said bowl, and a texture formed on a surface of that portion of said seat which comes into contact with the skin of a patient, said texture having interconnected depressions forming communication passageways for allowing an escape of air through said interconnected depressions at an interface between patient and seat, whereby said bed pan is much less likely to cling and stick to said patient.

The references relied on by the examiner are:

Bridger	3,740,096	June 19, 1973
Glass	4,368,548	Jan. 18, 1983

Claims 1-10, 12, 14 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Glass in view of Bridger. It is the examiner's position that:

Glass teaches a molded plastic bedpan including a "bowl" 14, a "flange" 24 which forms a "seat," and "strengthening vertical wall member" 26. The "bowl" 14 is sloped from front to back as claimed and the "flange" 24 changes pitch as claimed. Although Glass lacks a "texture" comprising "interconnected depressions" on the "seat," attention is directed to Bridger who teaches another device on which a person may sit, i.e., a chair, the "seat" of which has a "texture" which may be "roughened to prevent sliding forward of a person seated thereon" (col. 3, lines 22-24). It would have been obvious to one of ordinary

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skill in the art to provide a "texture," as suggested by Bridger, on the "seat" surface of the Glass bedpan, in order to prevent a patient seated thereon from sliding relative to the bowl. [Final rejection, pages 4 and 5.]

In support of this position the answer states that:

A roughened surface, as per the Bridger patent, has the effect of preventing sliding relative to the seat. It also has the inherent effect of providing the seat surface with air passageways comprised of criss-crossing valleys interrupted by peaks. These features are characteristic of all roughened surfaces and such knowledge is well within the realm of ordinary skill. Therefore, by providing a roughened surface on a seat, as suggested by Bridger, one is both preventing sliding relative to the seat and inherently creating criss-crossing air passageways. [Pages 5 and 6.]

We will not support the examiner's position. Initially we note that in rejecting claims under 35 U.S.C. § 103 the examiner bears the initial burden of presenting a **prima facie** case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met does the burden of coming forward with evidence or argument shift to the applicant. *Id.* If the examiner fails to establish a

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prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Although we agree with the examiner that it would have been obvious to provide the seat on the bed pan of Glass with a roughened surface in order to achieve Bridger's expressly stated advantage of preventing relative sliding movement between the seat and a user,³ we cannot agree that there is a reasonable basis to conclude that Bridger's roughened surface or texture inherently provides interconnected depressions having communicating air passageways ("[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art," *Ex parte Levy*, 17 USPQ2d

³ Notwithstanding the appellant's arguments to the contrary, "[a]s long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor" (*In re Beattie*, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992)) and all the utilities or benefits of the claimed invention need not be explicitly disclosed by the prior art references to render the claims unpatentable under § 103 (*see In re Dillon*, 919 F.2d 688, 692, 696, 16 USPQ2d 1897, 1901, 1904 (Fed. Cir. 1990) (in banc), *cert. denied*, 500 U.S. 904 (1991)).

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1461, 1464 (Bd. Pat. App. & Int. 1990)). It simply does not follow that just because the texture of a surface is rough that it has interconnected depressions with communicating passageways. For example, a rough surface can be formed by spaced apart depressions having no interconnecting passageways whatsoever. While of course it is possible that some roughened surfaces may have interconnected depressions with communicating passageways, inherency may not be established by probabilities or possibilities. **See *In re Oelrich***, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and ***Rijckaert***, 9 F.3d at 1534, 28 USPQ2d at 1957.

Since (1) there is no reasonable basis to conclude that the roughened surface of Bridger inherently has interconnected depressions with communicating passageways and (2) the examiner has not provided a factual basis for establishing the obviousness of such an arrangement (**see *In re GPAC Inc***, 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995) and ***In re Warner***, 379 F.2d

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1011, 1017, 154 USPQ 173, 178 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968)), we will not sustain the rejection of the appealed claims under 35 U.S.C. § 103 based on the combined teachings of Glass and Bridger.

The decision of the examiner is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	
IRWIN CHARLES COHEN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS
)	AND
)	INTERFERENCES
)	
JAMES M. MEISTER)	
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