

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte WILLIAM T. BALL

Appeal No. 2006-2338
Application No. 10/326,449
Technology Center 3700

ON BRIEF

Before FRANKFORT, CRAWFORD and HORNER, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the examiner's final rejection of claims 1 and 4-6, all of the claims pending in the application. Claims 2 and 3 have been canceled.

We affirm.

BACKGROUND

The appellant's invention relates to an overflow system for a bathtub and a method of sealing an overflow fluid port of a bathtub for testing for leaks. Claim 4, reproduced below, is representative of the subject matter on appeal. A copy of all of the claims on appeal can be found in the appendix to the appellant's brief.

4. An overflow system for a bathtub which has a bottom, and adjacent side and endwalls, a drain port in the bottom, and overflow port in an endwall, with said overflow port being in communication with a vent pipe, comprising:
 - a drain pipe adapted to be in communication with said drain port and said overflow port,
 - said drain pipe having an inverted L-shape, including a horizontal leg extending into and through the overflow port of the bathtub and terminating with a flat perimeter edge, and a vertical leg extending downwardly for connection to a fluid drain system,
 - and an expandable plug having a resilient washer with a smooth and continuous outer perimeter that is removably positioned in the interior of the horizontal leg and expanded to frictionally seal the horizontal leg against fluid flow.

The examiner relies upon the following as evidence of unpatentability:

Taylor, Jr. <i>et al.</i> (Taylor)	4,683,597	Aug. 04, 1987
Ball	5,890,241	Apr. 06, 1999

Appellant's admitted Prior Art (AAPA), Specification, page 3, line 17 – page 4, line 34

The following rejections are before us for review.

1. Claims 1, 4 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Taylor and AAPA.
2. Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Taylor, AAPA and Ball.¹

Rather than reiterate in detail the conflicting viewpoints advanced by the examiner and the appellant regarding this appeal, we make reference to the examiner's answer (mailed February 13, 2006) for the examiner's complete reasoning in support of the rejections and to the appellant's brief (filed October 14, 2004) and reply brief (filed April 17, 2006) for the appellant's arguments.

OPINION

In reaching our decision in this appeal, we have carefully considered the appellant's specification and claims, the applied prior art, and the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations that follow.

¹ The examiner withdrew the rejection of claim 6 under 35 U.S.C. § 112, first paragraph. Answer, p. 3.

Rejection of Claims 1, 4 and 5

The appellant argues claims 1, 4 and 5 as a group. As such, we select claim 4 from the group as a representative claim on which to base our decision. See 37 C.F.R. § 41.37(c)(1)(vii) (2004).

In the rejection of independent claim 4, the examiner determined that Taylor discloses a conventional practice of leak testing a bathtub overflow system of the type including a drain port, an overflow port, and a drain pipe, in which the overflow port is closed with an expandable plug during the leak testing. Answer, p. 3. The examiner found that Taylor teaches all the claimed elements except for the specific type of overflow system having an inverted L-shape. The examiner relied on the applicant's admitted prior art that an inverted L-shape is a common type of overflow system in the bathtub art. Answer, p. 4. The examiner found that it would have been obvious to one having ordinary skill in the art at the time the invention was made to implement the conventional leak testing practice, as taught by Taylor, on a common inverted L-shape overflow system, as disclosed by the applicant, to allow leak testing of the overflow system. Answer, p. 4. In particular, the examiner determined that "a worker in the bathtub overflow system art would merely need to follow the teachings of Taylor to arrive at the claimed invention." Answer, p. 5.

The appellant contends that the examiner failed to particularly identify any suggestion, teaching, or motivation to combine the prior art references such as the nature of the problem to be solved, the teachings of the prior art or the knowledge of persons of ordinary skill in the art. Brief, p. 8. We disagree with the appellant's position.

We find explicit motivation in the Taylor reference itself to combine its teaching with the common inverted L-shaped overflow system that would have led one of ordinary skill in the art to the claimed invention. In particular, as noted by the examiner on page 3 of the Answer, Taylor teaches that it was known in the prior art to use an expandable plug, such as a dollar plug with an expandable rubber “accordion” washer, to seal an overflow drain port during pressure testing. Taylor, col. 1, lines 15-36. We find, thus, that Taylor teaches using the same expandable plug for the same purpose of sealing an overflow drain port during leak testing as in the claimed invention. One having ordinary skill in the art at the time the invention was made, possessed with the teaching of Taylor and the knowledge that L-shaped overflow systems were common in the art, would have been led to apply an expandable plug to an L-shaped overflow system to seal the overflow port during testing, because the L-shaped overflow system is just another type of commonly-used drain overflow system, on which leak testing must be performed. As such, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used such an expandable plug on a common inverted L-shaped overflow drain system in order to perform leak testing as taught by Taylor.

The appellant also argues that there is no motivation to use an expandable plug as claimed to seal the overflow drain port, because Taylor discourages the use of expandable plugs for this purpose due to their tendency to blow out under pressure. Brief, p. 9. Even if Taylor discourages the use of expandable plugs for the purpose of pressure testing, it still does not remove the fact that expandable plugs had been used in the prior art for this purpose. *See In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) (“A known or obvious

composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.”) The applicant has asserted no discovery beyond what was obvious in view of the prior art.

The appellant further contends that the claimed resilient washer, having a smooth and continuous outer perimeter, solves the problem of blow out and is an unobvious improvement over the accordion-style dollar plug disclosed in Taylor. Brief, p. 9. We see no difference between the resilient washer disclosed in Taylor and the claimed resilient washer.

Claim 4 recites, “an expandable plug having a resilient washer with a smooth and continuous outer perimeter.” The dollar plug shown in Figure 1 of Taylor includes a larger rubber washer (13) having raised areas completely encircling the washer to form bellows, similar to an accordion. Each raised area is a strip that forms a smooth and continuous perimeter about the washer. Similarly, the perimeter of the washer taken about the valley between adjacent raised strips is also shown as smooth and continuous in Figure 1. The appellant’s claims do not further limit the shape of the outer surface of the resilient washer to distinguish it from the accordion-style washer of Taylor. Accordingly, we sustain the examiner’s rejection of claims 1, 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Taylor in view of AAPA.

Claim 6

The examiner rejected claim 6 under 35 U.S.C. § 103(a) as unpatentable over Taylor, AAPA and Ball. The examiner found that Ball teaches that it is common practice to associate a “cover” with an overflow opening and thus it would have been obvious to associate a cover with the Taylor overflow opening in order to enhance appearance. Answer, p. 4. The appellant did not separately argue

the patentability of claim 6. Rather, the appellant relied on the arguments for patentability of claims 1, 4, and 5. Brief, p. 10. Finding no separate basis for patentability of this dependent claim, we also sustain the examiner's rejection of claim 6 as unpatentable under 35 U.S.C. § 103(a).

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 and 4-6 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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