

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARCANGELO BIONDO and GIUSEPPE BIONDO

Appeal 2008-4325
Application 10/744,760
Technology Center 3700

Decided: November 17, 2008

Before WILLIAM F. PATE, III, JENNIFER D. BAHR and DANIEL S.
SONG, *Administrative Patent Judges.*

SONG, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants appeal under 35 U.S.C. § 134 (2002) from a Final Rejection of claims 1-7, 16, 19, 25 and 28-34. Claims 8-15, 17, 18, 20-24, 26 and 27 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

The Appellants claim a tub having a handheld shower that is retractably mounted to the deck rail of the tub.

Independent claim 1 reads as follows:

1. A combination comprising:
 - a tub comprising a whirlpool tub comprising at least one deck, the deck having a through hole formed therein;
 - a handheld shower assembly positioned to flow water into the tub and having a portion constructed to be received in the through hole formed in the deck;
 - a flexible hose connected to the handheld shower assembly and operatively connected to a hot water conduit and to a cold water conduit to supply hot water and cold water to the handheld shower assembly and with the proviso that the handheld shower assembly is not connected to a diverter for diverting water from the handheld shower assembly to another spout, shower device or faucet for flowing water into the whirlpool tub.

Independent claims 25 and 30 are similarly directed to a combination of a tub and a handheld shower and recite that no diverter is present.

Independent claims 19 and 28 do not recite that no diverter is present, but recite other structural limitations.

The prior art relied upon by the Examiner in rejecting the claims is:

Breda	6,112,342	Sep. 5, 2000
Raisch	6,381,770	May 7, 2002

The Examiner rejected claims 1-7, 16, 19, 25 and 28-34 under 35 U.S.C. § 103(a) as unpatentable over Raisch and Breda.

We AFFIRM.

ISSUE

The main issues raised in the present appeal are whether the Appellants have shown that the Examiner erred in rejecting the pending

claims because there is insufficient motivation to combine Raisch and Breda, the suggested combination would change the principle of operation of Raisch, and Breda teaches away from the modification suggested in the combination.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Raisch describes a combination including a tub (not enumerated), a pull-out spout unit 24 (i.e., a handheld shower assembly) positioned to flow water into the tub, and a flexible hose 30 connected to the spout unit and the hot/cold pressured water supply 28 for supplying hot and cold water to the spout unit, wherein the spout unit is not connected to a diverter (col. 2, ll. 40-56; figs. 1 and 2).

2. Raisch does not describe a deck having a through hole or a portion of the handheld shower assembly being received in such a through hole of the deck.

3. Raisch teaches that use of handheld extendable water faucets in spas is known in the art (col. 1, ll. 9-10).

4. Breda describes a whirlpool tub including a hand-shower 120 (i.e., handheld shower assembly) that is received in a through hole on the deck of the tub (col. 12, ll. 52-55; fig. 17), and a plurality of jets W1-W5 (col. 14, ll. 43-45).

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 127 S.Ct. at 1739. The Court explained that “[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability.” *Id.* at 1740. The Court further explained that “[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to

the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.” *Id.* at 1742.

The Court noted that to facilitate review, obviousness analysis should be made explicit, but “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim.” *Id.* at 1741, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

ANALYSIS

Claims 1-7, 16, 25¹, 29 and 30-34

The Appellants initially point out that claims 1-7 and 16 recite a combination of a tub or whirlpool tub and a handheld shower “with the proviso that the handheld shower assembly is not connected to a diverter,” while claims 25, 29 and 30-34 recite a similar combination “with the proviso that no diverter is present.” (App. Br. 10). Except for claim 16 for which an additional argument is set forth, the Appellants argue these claims together as a group in the Appeal Brief. Thus, we select representative claim 1 to decide the appeal of claims 1-7, 25, 29 and 30-34, with claims 2-7, 25, 29 and 30-34 standing or falling with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii).

¹ The heading in the Appeal Brief: “1. Separate Patentability of Claims 1-7, 16, 29 and 30-34” does not identify independent claim 25 (App. Br. 10). However, this appears to be a typographical error because under the heading, the Appellants identify claim 25 with the other claims as reciting the limitation “with the proviso that no diverter is present” (App. Br. 10). Thus, for the purposes of this appeal, we understand the Appellants’ arguments as being applicable to independent claim 25 as well as the claims identified in the heading.

The Examiner rejects independent claim 1 stating that Raisch describes the claimed combination except for the recited through hole in the deck for receiving a portion of the handheld shower assembly (FF 1-3; Ans. 3). To cure this deficiency of Raisch, the Examiner relies on Breda which illustrates a pull-out showerhead that is mounted on a hydrotherapy tub deck (FF 4) to conclude that claim 1 would have been obvious (Ans. 3).

The Appellants first contend that the Examiner failed to establish the required motivation to modify Raisch to result in Appellants' claimed invention, and that the Examiner is using impermissible hindsight (App. Br. 11). The Examiner states that mounting the spout unit (i.e., handheld shower assembly) of Raisch in a hole of a tub as claimed would have been obvious because such mounting is already known in the art as shown by Breda which is directed to the same art (Ans. 3). The Examiner further states that motivation for combining the references is provided because "both references are of identical nature i.e. tubs with handheld faucets" (Ans. 4), and that "the only substitution advanced by the examiner is that it would have been obvious to the ordinary artisan to mount the faucet of Raisch in a location on the tub deck as shown by Breda" (Ans. 5).

With regard to the Appellants' argument regarding motivation, we note that obviousness analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim. *See KSR*, 127 S.Ct. at 1741. The Appellants' invention differs from the Raisch with respect to the specific location where the handheld shower assembly is mounted. However, mounting of a handheld shower assembly at the recited location is already well known and practiced in the art as evidenced by Breda (FF 4) as

well as the Appellants' admitted prior art (spec. ¶ [0002]; fig. 1). We find that it would have been obvious to one of ordinary skill in the art to select from the known mounting locations for the handheld shower assembly, including the location described in Breda, in view of the fact that there are only a finite number of identified, predictable locations for mounting a handheld shower assembly of a tub. *See id.* at 1742.

Moreover, we further note that merely altering a position of a component in a device does not render the device patentable. *See In re Japikse*, 181 F.2d 1019 (CCPA 1950) (specific positioning of a starting switch of a hydraulic power press held unpatentable because shifting the position of the starting switch would not have modified the operation of the device); *In re Kuhle*, 526 F.2d 553, 555 (CCPA 1975) (particular placement of a contact in a conductivity measuring device is an obvious matter of design choice). Thus, in view of the above, the Appellants' invention of claim 1 is merely a predictable variation which yields predictable results and would have been obvious to one of ordinary skill. *See KSR*, 127 S.Ct. at 1739-40.

The Appellants also contend that the modification of Raisch in view of Breda would change the principle operation of Raisch (App. Br. 12 and 13). However, the "principle operation" referred to by the Appellants actually relates to the "basic principles" under which the prior art device was designed to operate. *In re Ratti*, 270 F.2d 810, 813 (CCPA 1959) ("This suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the *basic principles* under which the [primary

reference] construction was designed to operate.” (Emphasis added; prior art reference omitted)). In *Ratti*, the modification suggested by the Examiner changed the basic principle of sealing from attaining sealing through a rigid, press-fit, interface between the components, to attaining sealing by providing a resilient interface between the components. *Id.* at 811-13. Such a modification fundamentally changes the technical basis of how a seal performs its sealing function and how a sealed interface is attained.

Thus, “a change in the basic principles” refers to change that is fundamental in scope so as to relate to scientific or technical principles under which the invention is designed to operate. It cannot be said that “change in the basic principles” occurs by mere rearrangement of the components in the prior art device. Otherwise, any modification to a prior art device can be considered “a change in the basic principles”, thereby eliminating the need for obviousness analysis under 35 U.S.C. § 103.

The basic principle under which the handheld shower assembly of Raisch is designed to operate is not changed at all by relocating the mounting location to that taught in Breda. As noted *supra*, the Examiner is relying on Breda to establish the fact that mounting of a handheld shower in the location claimed by the Appellants is well known and practiced in the art. Hence, the Appellants’ argument that the basic principle of Raisch is changed by the relocation of the handheld shower assembly is unpersuasive.

The Appellants’ related argument that there is no suggestion as to how the flexible hose would be connected to the hot/cold pressured water supply (App. Br. 13) is not persuasive because “it is not necessary that the inventions of the references be physically combinable to render obvious the

invention under review.” *In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983). In this regard, we agree with the Examiner (Ans. 5 and 6) that one of ordinary skill would know how to appropriately connect the flexible hose to the hot/cold pressured water supply when the handheld shower assembly is relocated to the tub as shown in Breda.

The Appellants further argue that Breda teaches away from the Examiner’s proposed modification because Breda teaches the necessity of a diverter valve (App. Br. 13 and 14; Reply Br. 2 and 3). However, the Appellants’ argument is not persuasive because as discussed *supra*, Breda is merely relied upon for showing for mounting the handheld shower in a known location, i.e., the deck of the tub. Raisch is relied upon for describing a handheld shower that does not have a diverter valve. Moreover, mere description of an implementation in the prior art that differs from the Appellants’ claimed invention, without more, does not show that the prior art is “teaching away” from the invention claimed. *See In re Fulton*, 391 F.3.d 1195, 1201 (Fed. Cir. 2004).

The Appellants also contend that the Examiner ignores the limitation of independent claim 1 reciting that the tub comprises “a whirlpool tub” (App. Br. 15; Reply Br. 1). This argument is not persuasive. The Examiner states that Raisch teaches that the use of handheld shower assembly in spas is known in the art (col. 1, ll. 8-10), and in the relevant art, “spa” is another term for “whirlpool,” thereby addressing the recited limitation (Ans. 5 and 6). We also note that to any extent that spa is not the same as a whirlpool, Breda clearly teaches a whirlpool tub having a handheld shower assembly (FF 4) and the Appellants themselves have admitted that use of such

handheld shower assemblies in whirlpool tubs is known (spec. ¶ [0002]; fig. 1).

The Appellants further contend that the Examiner ignores the limitation of independent claim 1 reciting the operative connection of the flexible hose to hot and cold water conduits to supply hot and cold water to the handheld shower assembly (App. Br. 15). However, this argument is also not persuasive because as the Examiner states, Raisch describes a corresponding “hot/cold-pressured water supply 28” (Ans. 5 and 6) to which extensible hose 30 is fluidically (i.e., operatively) connected for supplying hot and cold water to the handheld shower assembly (col. 2, ll. 40-43).

Therefore, in view of the above, we conclude that the Appellants have not shown that the Examiner erred in rejecting independent claim 1 as unpatentable over Raisch and Breda. Likewise, we also conclude that the Appellants have not shown that the Examiner erred in rejecting claims 2-7, 25, 29 and 30-34 as unpatentable over Raisch and Breda. *See* 37 C.F.R. § 41.37(c)(1)(vii).

In addition to the arguments discussed *supra* relative to claim 1, the Appellants also argue that with respect to claim 16, the Examiner ignored the limitation reciting inclusion of water jet units (App. Br.15; Reply Br. 1 and 2). However, the Examiner states that Raisch teaches the use of handheld shower assembly in whirlpools which possesses the recited “water jet units” (Ans. 6). The Examiner also states that Breda clearly teaches jet units W that are positioned in the tub (col. 14, ll. 43-45; fig. 17; Ans. 6). Hence, the Examiner did not ignore these limitations, but instead, has found the limitation to be inferentially described in Raisch as well as obvious in

view of Breda. Therefore, the Appellants have also failed to show that the Examiner erred in rejecting claim 16 as unpatentable over Raisch and Breda.

Claims 19 and 28

The Appellants contend that the Examiner ignored the limitations of dependent claim 19 that recite “a whirlpool tub” and inclusion of a plurality of jet units (App. Br. 15). However, these arguments are unpersuasive for the reasons already discussed *supra* relative to independent claim 1 and dependent claim 16.

Moreover, the Appellants’ contention that the Examiner failed to address the limitation “a whirlpool tub” recited in independent claim 28 (App. Br. 15) is also not persuasive for the reasons already discussed *supra* relative to independent claim 1.

Therefore, in view of the above, we conclude that the Appellants have not shown that the Examiner erred in rejecting claims 19 and 28 as unpatentable over Raisch and Breda.

CONCLUSION

The Appellants have not shown that the Examiner erred in rejecting claims 1-7, 16, 19, 25 and 28-34 under 35 U.S.C. § 103(a) as unpatentable over Raisch and Breda.

ORDER

The Examiner’s rejection of claims 1-7, 16, 19, 25 and 28-34 is
AFFIRMED.

Appeal 2008-4325
Application 10/744,760

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) (2007).

AFFIRMED

MAT

Reising Ethington Barnes & Kisselle, P. C.
P. O. Box 4390
Troy MI 48099-4390