

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(2) is not binding precedent of the Board.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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte BRENDAN CONOLLY, JAMIE KALIKOW  
and PETER C. LEEDS

---

Appeal No. 1998-1329  
Application 08/642,595

---

HEARD: May 16, 2000

---

Before BARRETT, RUGGIERO and BARRY, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's

Appeal No. 1998-1329  
Application 08/642,595

rejection of claims 1, 2, 4-10, and 21, all of the claims pending in the present application. Claims 3 and 11-20 have been canceled.

The claimed invention relates to a sanitary cover for a telephone mouthpiece or earpiece. The cover includes a central portion and skirt portions extending from the central portion that include projections for engaging the groove formed in a conventional telephone handset. More particularly, Appellants indicate at pages 4 through 8 of the specification that the central and skirt portions are formed of first and second layers having different lengths or dimensions with the first layer being disposed on the second layer over its entire length. According to Appellants, the connection of the two layers of differing lengths or dimensions creates an uneven tension between the layers which permits the cover to retain its shape even though the covers may be folded and stacked for storage and packing.

Claim 1 is illustrative of the invention and reads as follows:

Appeal No. 1998-1329  
Application 08/642,595

1. A sanitary cover for a telephone mouthpiece or earpiece, the cover comprising:

a central portion;

a skirt portion extending from the central portion; and

at least one projection formed on the skirt portion and adapted to engage in a groove formed in a telephone handset;

wherein said central portion and said skirt portion include a first layer and a second layer having different lengths, said first layer and said second layer are disposed on top of each other such that said first layer is connected to said second layer along an entire length of said second layer to form an uneven tension between said first and second layers.

The Examiner relies on the following prior art:

Barriere	3,663,259	May 16,
1972		
Thompson	4,486,628	Dec. 04,
1984		
Lo et al. (Lo)	5,054,063	Oct.
01, 1991		

Claims 1, 2, 4-10, and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lo in view of Barriere and

Appeal No. 1998-1329  
Application 08/642,595

Thompson.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs<sup>1</sup> and Answers for the respective details.

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answers.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth

---

<sup>1</sup> The Appeal Brief was filed September 26, 1997. In response to the Examiner's Answer dated November 12, 1997, Appellants filed a Reply Brief on February 6, 1998 to which the Examiner responded with a Supplemental Examiner's Answer dated March 19, 1998.

Appeal No. 1998-1329  
Application 08/642,595

in claims 1, 2, 4-10, and 21. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044,

Appeal No. 1998-1329  
Application 08/642,595

1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S.  
825

(1988); Ashland Oil, Inc. v. Delta Resins & Refractories,  
Inc.,

776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert.  
denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v.  
Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933  
(Fed.

Cir. 1984). These showings by the Examiner are an essential  
part

of complying with the burden of presenting a prima facie case  
of

obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24  
USPQ2d

1443, 1444 (Fed. Cir. 1992).

Appellants' primary argument in the Briefs centers on  
their contention that the Examiner has not established that  
the "uneven tension" limitation of each of the independent  
claims 1 and 21 on appeal is taught or suggested by Lo, the  
primary reference relied upon for this feature, or any of the

other applied references. After careful review of the applied prior art in light of the arguments of record, we are in agreement with Appellants' position as stated in the Briefs. We note that the relevant portion of independent claim 21 recites:<sup>2</sup>

said first layer and said second layer being disposed on top of each other with said first layer being connected to said second layer over the entire dimensions of said second layer to form an uneven tension between said first and second layers for maintaining a predetermined shape of said sanitary cover.

In the "Response to argument" portion of the Answer (page 7), the Examiner, apparently recognizing the absence of any explicit disclosure of such "uneven tension" feature in Lo, attempts to address Appellants' argument by suggesting the inherent creation of such "uneven tension" between the cover layers in Lo during the molding process. We agree with Appellants, however, that such an assertion is based on unfounded speculation. There is no indication in Lo that any molding process is utilized, nor any evidence supplied by the

---

<sup>2</sup>A similar recitation appears in the concluding paragraph of independent claim 1.

Appeal No. 1998-1329  
Application 08/642,595

Examiner as to the obviousness of using a molding process, in the formation of Lo's sanitary cover. To establish inherency, evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and would be recognized as such by persons of ordinary skill. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) citing Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Id. citing Continental, 948 F.2d at 1269, 20 USPQ2d at 1749.

We also find the Examiner's further assertions (Answer, pages 8 and 9) as to the inherency of "uneven tension" between the two layers of Lo's cover to be unfounded. The Examiner draws attention to the Figure 4 illustration in Lo which shows a sharp cut at the periphery of the cover. From this illustration, the Examiner draws the conclusion that, since the layers are wrapped within each other to produce the sharp cut, the outer layer must be larger than the inner layer which

Appeal No. 1998-1329  
Application 08/642,595

would create the "uneven tension" between the layers as claimed. No evidence of record, however, has been offered by the Examiner as support for this conclusion. Similarly, the Examiner's reliance on the illustration in Figures 1 and 3 of Lo's cover in a folded configuration as an indication that the covers retain their shape and therefore establish the inherency of "uneven tension" in the layers is totally without support on the record. Lo's disclosure is completely silent with regard to any discussion of shape retention, let alone any indication that any such shape retention would be as a result of "uneven tension" between the cover layers. We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference, common knowledge or capable of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a prima facie case. In re Knapp-Monarch Co., 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); In re Cofer, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

With regard to the Barriere and Thompson references applied by the Examiner for teaching the features of a two

Appeal No. 1998-1329  
Application 08/642,595

layer cover and a telephone handset cover with a groove projection, respectively, we find nothing in the disclosure of either reference which would overcome the innate deficiencies of Lo discussed, supra.

Since all of the claim limitations are not taught or suggested by the applied prior art, it is our opinion that the Examiner has not established a prima facie case of obviousness with respect to the claims on appeal. Accordingly, we do not sustain the Examiner's 35 U.S.C. § 103 rejection of independent claims 1 and 21, nor of claims 2 and 4-10 dependent thereon.

Therefore, the Examiner's decision rejecting claims 1, 2, 4-10, and 21 is reversed.

Appeal No. 1998-1329  
Application 08/642,595

REVERSED

Lee E. Barrett	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
Joseph F. Ruggiero	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
Lance Leonard Barry	)	
Administrative Patent Judge	)	

JR/dm

Ostrolenk Faber Gerb & Soffen  
1180 Avenue of the Americas  
New York, NY 10036-8403