

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES F. HARGADEN

Appeal No. 96-1882
Application No. 08/214,013¹

ON BRIEF

Before ABRAMS, FRANKFORT and STAAB, *Administrative Patent Judges*.
ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claim 5, which is the only claim remaining of record in the application, all others having been canceled.

¹Application for patent filed March 16, 1994. According to appellant, this application is a continuation of Application 07/916,957 filed July 20, 1992, now abandoned.

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The appellant's invention is directed to a portable toilet seat. The claim before us on appeal is reproduced in an appendix to the Brief.

THE REFERENCES

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

Barnes	654,301	Jul. 24, 1900
French patent (Cocu)	628,635	Oct. 26, 1927

THE REJECTION

Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Cocu in view of Barnes.

The rejection is explained in the Examiner's Answer.

The opposing viewpoints of the appellant are set forth in the Brief.

OPINION

The claim stands rejected as being obvious in view of the combined teachings of Cocu and Barnes. 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 *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness under 35 U.S.C.

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§ 103, 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. 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 claim defines in detail the structure of the appellant's portable toilet seat, including a body having a centrally located aperture, first and second spaced inner support walls disposed concentrically about the aperture and defining an unobstructed receiving groove therebetween to accommodate the upper rim of a bucket, and first and second sets of radial support members extending, respectively, from the edge of the aperture to the first inner support wall, and from the second inner support wall to the outer edge of the body.

Cocu discloses a toilet seat made of solid wood. It is provided on its underside with an annular groove for receiving

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the upper edge of a container. However, Cocu does not disclose the concentrically disposed first and second support walls and the radially disposed first and second radial support members that are required by the claim.

The Barnes reference discloses a toilet seat that is made of "hard rubber" for the purpose of overcoming certain problems with wooden seats. The body has an arcuate upper surface and a concave lower surface. To provide lateral strengthening, the annular interior chamber is provided with a plurality of radially oriented webs (7) which span the entire width of the chamber.

It is the examiner's position that one of ordinary skill in the art would have found it obvious to construct the claimed toilet seat in view of the teachings of Cocu and Barnes. We do not agree.

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, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). We fail to perceive any teaching, suggestion or incentive in either reference which would have led one of ordinary skill in the art to modify the Cocu toilet seat such that (1) it had a substantially annular rigid body with an arcuate upper surface

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and a concave lower surface in place of the solid wooden seat, (2) annular walls to define the unobstructed edge receiving groove rather than a cutout groove in the underside of the solid wood seat, and (3) first and second sets of radially oriented support members which together span the width of the underside of the seat except for the continuous groove. From our perspective, the only suggestion for combining the references in the manner proposed by the examiner is found in the hindsight accorded one who first views the appellant's disclosure, which is improper. As our reviewing court stated in *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992):

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" (citations omitted).

It is our view that the combined teachings of the two applied references fail to establish a *prima facie* case of obviousness with regard to the subject matter recited in the claim. Therefore, we will not sustain the rejection.²

²We note that the appellant submitted with the Appeal Brief evidence of commercial success of his invention (Exhibits A, B
(continued...))

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The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge))	
)	
)	
CHARLES E. FRANKFORT)	BOARD OF PATENT
Administrative Patent Judge))	APPEALS AND
)	INTERFERENCES
)	
)	
LAWRENCE J. STAAB)	
Administrative Patent Judge))	

²(...continued)
and C). The examiner failed even to acknowledge the presence of
this material, much less deal with it. However, since we have
not sustained the rejection, we need not consider this material.

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