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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JOHN JOSEPH MCMANAMY and CARL MELVIN OGBURN

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Appeal 2009-008781  
Application 11/221,338  
Technology Center 3600

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Before LINDA E. HORNER, WILLIAM F. PATE, III, and  
FRED A. SILVERBERG, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

### STATEMENT OF THE CASE

John Joseph McManamy and Carl Melvin Ogburn (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner's decision rejecting claims 1 and 4, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b). We REVERSE.

### THE INVENTION

Appellants' claimed invention is composite mattress for use in confinement facilities and institutions and having a pliable transparent polymeric cover material to help prevent concealment of contraband. Spec. 3:5-7. Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A composite mattress for use in penal and correctional institutions comprising:
  - a. a flexible, compressible polymeric foamed filling material, cotton, polyester or synthetic batting formed in the shape of a mattress, and
  - b. a pliable transparent flame retardant polymeric cover encapsulating said filling material wherein said polymeric cover material is fluid resistant, anti-microbial and UV resistant and includes a nylon, polyester or similar open weave fabric support material.

### THE REJECTION

Appellants seek review of the Examiner's rejection of claims 1 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Hicks (GB 772,025; published April 10, 1957) and Karafa (US 6,351,864 B1, published March 5, 2002). In particular, the Examiner found that it would have been obvious to

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one of ordinary skill in the art, at the time of the invention, to have used conventional mattress covering materials, with conventional properties, as the material of construction for Hicks's transparent mattress cover, because Karafa recognizes the desirability of using such materials, with their desired properties, as mattress covers, to protect the mattress from fluid penetration, fire and microbes. Ans. 4.

### ISSUE

The issue presented by this appeal is:

Would the claimed composite mattress having “a pliable transparent flame retardant polymeric cover ... wherein said polymeric cover material is fluid resistant, anti-microbial and UV resistant and includes a nylon, polyester or similar open weave fabric support material” have been obvious to one having ordinary skill in the art at the time of the invention in view of the teachings of Hicks and Karafa?

### FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence.

1. Hicks discloses a demonstration mattress with a spring unit 1, upper filling 2, lower filling 3, and a cover 4. Hicks 1, ll. 55-56. Hicks discloses the cover 4 can be made of a transparent flexible, tear resistant material comprising sheet polyvinyl chloride covering the whole or part of the mattress. Hicks 1, ll. 28-36.

2. Hicks discloses that “[i]t would not be a wise practice to use the sheet polyvinyl chloride for the surface of a mattress for normal use, but it is, of course, possible in a normal mattress to make the sides and ends of the cover of transparent material without ill effect.” Hicks 2, ll. 13-19.
3. Hicks does not disclose that the transparent cover is made of a material that is flame retardant, fluid resistant, anti-microbial, or UV resistant. Hicks also does not disclose that the transparent cover includes a nylon, polyester or similar open weave fabric support material.
4. Karafa discloses foam filled, plastic covered bedding for use as mattresses and pillows in correctional institutions, wherein the mattress portion 20 is formed from padding material 22 and a surrounding covering 60. Karafa, col. 1, ll. 6-9; *id.* at col. 3, ll. 2-3 and l. 40. Covering 60 is formed from a sheet plastic material, such as nylon 6 warp knitted fabric with a polyurethane transfer coating, or vinyl based or vinyl coated materials, or PVC or polyolefin laminated or coated fabrics, or other heat sealable covering materials with antibacterial, antifungal, fluid penetration resistant, and fire resistant characteristics. Karafa, col. 3, ll. 42-51; *id.* at col. 5, ll. 1-3.
5. Karafa does not disclose that the covering material is transparent, the desirability of making the covering material transparent, or that

any of the disclosed covering materials were capable of being made transparent.

### ANALYSIS

We understand the Examiner's proposed combination to be based on using the mattress construction of Hicks, i.e., the spring unit and upper and lower fillings, and modifying the transparent polyvinyl cover of Hicks to have the characteristics of the covering material used in Karafa.

First, if one were to simply substitute the material of Karafa for the cover of Hicks, then the mattress of Hicks would no longer be suitable as a demonstration mattress because Karafa does not disclose that its covering material is transparent (Fact 5).

Second, if the Examiner's position is that it would have been obvious to design a covering material that has all of the desirable characteristics disclosed in Karafa but that is still transparent, then we find this reasoning lacks sufficient evidentiary support. There is no evidence in the record that such a transparent material was in existence at the time of Appellants' invention (Facts 1-5), and Appellants' evidence seems to indicate that a great deal of experimentation and research was necessary to develop such a material.<sup>2</sup> As such, it is not clear that such a modification would have been within the skill level of a person having ordinary skill in the art.

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<sup>2</sup> Appellants submitted a Declaration of John McManamy dated November 6, 2006, which shows that it took Appellants and their supplier three years to devise a suitable transparent mattress cover material.

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Further, even if such a transparent material having the claimed properties was known in the art, or was within the skill level of one having ordinary skill in the art, the Examiner has not provided adequate reasoning with rational underpinning as to why one having ordinary skill in the art would have been led to modify the transparent covering of Hicks to have all of the characteristics disclosed in Karafa for use in the demonstration mattress of Hicks, since Hicks advises against using its transparent covering on the surface of a mattress for normal use (Fact 2).

As such, we will not sustain the rejection of independent claim 1 and its dependent claim 4 under § 103 as being unpatentable over Hicks and Karafa.

#### CONCLUSION

The claimed composite mattress having “a pliable transparent flame retardant polymeric cover ... wherein said polymeric cover material is fluid resistant, anti-microbial and UV resistant and includes a nylon, polyester or similar open weave fabric support material” would not have been obvious to one having ordinary skill in the art at the time of the invention in view of the teachings of Hicks and Karafa.

#### DECISION

The decision of the Examiner to reject claims 1 and 4 is REVERSED.

REVERSED

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