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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/193,195	08/01/2005	Jamie S. Leach	4400-005	8661
23547	7590	03/01/2013	EXAMINER	
Mary M. Lee MARY M LEE, P.C. 1300 E. NINTH STREET SUITE 4 EDMOND, OK 73034-5760			BAKER, LORI LYNN	
			ART UNIT	PAPER NUMBER
			3751	
			NOTIFICATION DATE	DELIVERY MODE
			03/01/2013	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex Parte JAMIE S. LEACH

Appeal 2010-008920
Application 11/193,195
Technology Center 3700

Before, NEAL E. ABRAMS, CHARLES N. GREENHUT AND REMY J.
VANOPHEM, *Administrative Patent Judges*

VANOPHEM, Administrative Patent Judge

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of claims 9-24. We have jurisdiction under 35 U.S.C. § 6(b).

CLAIMED SUBJECT MATTER

Claim 9 is illustrative of the subject matter on appeal.

9. A contoured cushion comprising:
a central portion defined by a perimeter;
a outer portion surrounding the central portion, the outer portion having a top and a bottom and an outer sidewall, the sidewall having an upper edge and a lower edge and defining the circumference of the cushion, the top and bottom each having an inner edge and an outer edge, the inner edges of the top and bottom portion joined to the perimeter of the central portion and the outer edges joined to the sidewall;
wherein the central portion is depressed relative to the top of the outer portion;
first and second cinch assemblies on the outer sidewall of the outer portion for adjusting the circumference of the cushion to accommodate an infant, larger baby, or a pet, the first and second cinch assemblies being independently operable relative to each other.

REJECTIONS

Claims 20 and 21 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that Appellant, at the time the application was filed, had possession of the claimed invention.

Claims 13 and 14 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention.

Claims 9-12, 16, 20, 21, 23 and 24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Mintz (US 5,557,815, iss. Sep. 24, 1996”).

Claims 15, 16, 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Mintz in view of the teachings of Lincoln (US 7,252,330, iss. Aug. 7, 2007).

Claims 16-19 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Mintz as applied to claims 16 and 21 and further in view of the teachings of Alivizatos (US 5,297,237, iss. Jan. 18, 1994).

ANALYSIS

35 U.S.C. § 112, first paragraph

The Examiner’s basis for rejecting claims 20 and 21 under the first paragraph of 35 U.S.C. § 112 is that the application as originally filed did not provide written description support for the limitation in claims 20 and 21 “a generally flat panel.” Appellant relies on the original drawing FIGS. 1 and 2 for support for this claimed feature. App. Br. 3-4.

35 U.S.C. § 112, first paragraph requires a “written description of the invention” which is separate and distinct from the enablement requirement. The purpose of the “written description” requirement is broader than to merely explain how to “make and use”; the Appellant must also convey with reasonable clarity to those skilled in the art that, as of the filing

date sought, he or she was in possession *of the invention*. The invention is for purposes of the “written description” inquiry, *whatever is now claimed*.

Vas-Cath, Inc. v. Mahurkrr, 935 F.2d 1555, 1563-4 (Fed. Cir. 1991).

“Drawings alone *may* be sufficient to provide the ‘written description of the invention’ required by § 112, first paragraph.” *Id* at 1564.

In this case, we agree with the Appellant that FIGS. 1 and 2 illustrate that the depressed central portion 14 of the cushion 10 is “a generally flat panel,” as recited in claims 20 and 21. This is conveyed by the absence of contours being designated by the presence of curved lines as are used to represent the stuffing or filler material located between the upper portion 26 and the lower portion 28, and by the statement made by the inventor at page 7, lines 12-16 of the specification that the depressed central portion 14 is stitched so that “a thin layer of batting or filler material may be sandwiched . . . to provide a light cushioning effect within the depressed central portion 12. It therefore is our view that the specification and drawings convey with reasonable clarity to those skilled in the art, as of the filing date, that Appellant constructively possessed the invention as now claimed. This being the case, we will not sustain the rejection of claims 20 and 21 under 35 U.S.C 112, first paragraph.

35 U.S.C. § 112, second paragraph.

The Examiner’s position for rejecting claims 13 and 14 under the second paragraph of 35 U.S.C. § 112 is that the claims are indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention. The legal standard for definiteness under 35 U.S.C. § 112, second paragraph is whether “those skilled in the art would

understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565-1576 (Fed. Cir. 1986) (limitations omitted).

The Appellant argues that claims 13 and 14 are “reasonably definite” when read in light of the specification. App. Br. 5.

The Examiner finds that claims 13 and 14 are unclear as to the relationship between the “first and second tabs” on line 2 thereof, and the “adjustable tab(s)” on line 2 of claim 10. Ans. 4-5. We agree with the Examiner because it is unclear whether the first and second tabs recited in claim 13 and 14 refer back to the two tabs required by the parent claims or if claim 13 and 14 recite additional tabs. Therefore these claims are ambiguous and, as such, do not adequately define the metes and bounds of claim 13 and 14. Accordingly, we affirm the rejection of claims 13 and 14 under 35 U.S.C. 112, second paragraph.

Rejection of claims 9-12, 16, 20, 21, 23, and 24 as anticipated by Mintz

Appellant argues claims 9-12, 16, 20, 21, 23 and 24 as a group for the first ground of rejection. App.Br. 5-9. Appellant further argues dependent claims 15, 16, 21 and 22 and dependent claims 16-19 and 21 as separate groups for the second ground of rejection. We select claim 9 as the representative claim for each group. Claims 10-24 stand or fall with claim 9. *See* 37 C.F.R. § 41.37(c)(1)(vii).

The Examiner finds that Mintz discloses a cushion comprising: a central portion 26 defined by a perimeter (col. 3, lines 13-16); an outer portion including a top 12 having an inner edge (col. 3, lines 13-16) and an outer edge (Fig. 3), a bottom 10 having an inner edge (col.3, lines 13-16)

and an outer edge (Fig.3), a sidewall (at14) having upper and lower edges defining a circumference (Fig.3), and a filler 16; and cinch assemblies 18,20 each including a fastener strip of hook and loop material (col.3, lines 5-6), as claimed. Ans. 6. Re claim 9, the Examiner correctly finds that the cinch assemblies are capable of adjusting the circumference of the cushion, and are “independently operable relative to each other”, because they can be tied to each other in multiple different configurations.

Appellant contends that the tie strings 18, 20 disclosed by Mintz do not constitute the claimed cinch assemblies because using one tie from each pair of strings would accomplish the same thing. From this, Appellant concludes that the strings constitute a single cinch assembly as opposed to two cinch assemblies that are independently operable. We disagree. The Examiner correctly finds that Appellant’s claimed cinch assemblies are inherently flexible and given the length of the tabs 18, 20 one of the tabs 18 could be tied to one of the tabs 20 and the circumference of the cushion could be adjusted by such tying. Ans. 7. The Examiner also finds that the individual tabs of the tab pair 18 or 20 could be wrapped around the cushion and tied to each other. Ans. 7. The fact that a string from each pair could potentially be tied at the same time and location to achieve the same or a similar degree of cinching does not mean that each pair of strings could not operate independently. Appellant does not apprise us of any language in the claim that expressly or implicitly requires a different result to follow from the “independent[] opera[tion].” Therefore, the Examiner correctly concludes that the tabs 18, 20 disclosed by Mintz meet the limitation imparted by the terminology “cinch assemblies ... for adjusting the

circumference of the cushion” and that the first and second cinch assemblies be “independently operable.” *Contra* App.Br. 7.

The Examiner contends that the functional language of claim 9 which Appellant relies upon to distinguish the Mintz disclosure was fully considered but does not define any structure beyond the structure disclosed by Mintz and that no apparent structural limitation related to this language has been advanced by Appellant. Ans. 8.

Anticipation is established only when a single prior art reference discloses expressly or under the principles of inherency, each and every element of a claimed invention. *RCA Corp. v Applied Digital Data Systems, Inc.* 730 F. 2d 1440, (Fed. Cir. 1984). Functional, non-§ 112 ¶ 6, limitations may render a claim quite broad encompassing any and all structures which perform the recited function. *In re Morris*, 127 F. 3d 1048, 1055 (Fed. Cir. 1997); *In re Swinehart*, 439 F. 2d 210, 213 (CCPA 1971). Other than citing the claim language (App.Br. 8) Appellant provides no convincing argument to dispute that the Examiner has correctly shown where the claimed elements appear in Mintz. We have been presented with no persuasive evidence to the contrary. Therefore the rejection of independent claim 9 and dependent claims 10-12, 16, 20, 21, 23 and 24 under 35 U.S.C. § 102(b) as being anticipated by Mintz will be sustained.

Rejection of claims 15, 16-19, 21 and 22 under 35 U.S.C. § 103(a).

Each of the above dependent claims directly or indirectly depends from independent claim 9. Appellant does not present arguments for separate patentability of claims 15, 16-19, 21 and 22 but rather relies on arguments presented for the patentability of claim 9, which we find

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unpersuasive. We sustain the rejection of claims 15, 16-19, 21 and 22 under 35 U.S.C. § 103(a).

The rejection of claims 16, 19, and 21 over Mintz and Alivizatos.

Each of the above dependent claims depends directly or indirectly from independent claim 9. Appellant does not present arguments for separate patentability of claims 16, 19 and 21 but rather relies on arguments presented for the patentability of claim 9, which we find unpersuasive. We sustain the rejection of claims 16, 19 and 21 under 35 U.S.C. § 103(a).

CONCLUSIONS

The rejection of claims 20 and 21 under 35 U.S.C. § 112, first paragraph, is reversed.

The rejection of claims 13 and 14 under 35 U.S.C. § 112, second paragraph, is affirmed.

The rejection of claims 9-12, 16, 20, 21, 23 and 24 under 35 U.S.C. § 102(b) is affirmed

The rejection of claims 15, 16, 21, and 22 under 35 U.S.C. § 103(a) is affirmed.

The rejection of claims 16-19 and 21 under 35 U.S. C. § 103(a) is affirmed.

A rejection of each of the claims on appeal having been affirmed, the decision of the Examiner 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).

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DECISION

AFFIRMED

MP