



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
Row 1: 11/525,619, 09/22/2006, William L. Grilliot, H28479, 1961
Row 2: 93730, 7590, 03/11/2013, HONEYWELL/WOOD PHILLIPS, EXAMINER: HOEY, ALISSA L
Row 3: Patent Services, ART UNIT: 3765, PAPER NUMBER
Row 4: 101 Columbia Road, NOTIFICATION DATE: 03/11/2013, DELIVERY MODE: ELECTRONIC
Row 5: Morristown, NJ 07962-2245

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ksanderson@woodphillips.com
patentservices-us@honeywell.com
docketing@woodphillips.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* WILLIAM L. GRILLIOT, MARY I. GRILLIOT and  
PATRICIA K. WATERS

---

Appeal 2011-000164  
Application 11/525,619  
Technology Center 3700

---

*Before* WILLIAM V. SAINDON, WILLIAM A. CAPP and  
JEREMY M. PLENZLER, *Administrative Patent Judges*.

CAPP, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 5, 6, 9 and 10 as unpatentable under 35 U.S.C. § 103(a) over Grilliot (US 6,134,717; iss. Oct. 24, 2000) and Moses (US 5,918,314; iss. Jul. 6, 1999). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

## THE INVENTION

Appellants' invention is a protective garment for persons such as firefighters characterized by a pair of leg portions each with a detachable sock. Spec. 1. Claim 5, reproduced below, is illustrative of the subject matter on appeal.

5. For wear with a pair of boots having leg encasing portions, a protective garment comprising

a pair of leg portions, each leg portion having a lower end, each leg portion being adapted for fitting into the leg encasing portion of an associated one of the boots when the garment and boots are worn together, the protective garment further comprising a sock attached detachably directly to each leg portion so that the socks and the protective garment, apart from the socks, can be separately sized to fit a wearer, and an outer shell comprising a pair of leg-covering portions, each of which is adapted for wearing over an associated one of the leg portions, the leg portions and socks being removable as a unit from the outer shell with the socks attached to the leg portions.

## OPINION

Appellants argue claims 5, 6, 9 and 10 as a group. App. Br. 3-6. We select claim 5 as representative of the group. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2011). Claims 6, 9 and 10 stand or fall with claim 5.

The Examiner finds, and Appellants do not dispute, that Grilliot discloses all of the elements of claim 5, except that Grilliot fails to teach the sock detachably attached to the leg portions. Ans. 3-4. The Examiner relies on Moses as disclosing a protective garment that has leg portions with socks detachably attached thereto. *Id.*

The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the protective garment of Grilliot with removable socks. *Id.* According to the Examiner, a person of ordinary skill in the art would have been motivated to so modify Grilliot because it would allow the user to don and doff the garment in pieces for greater ease and, in addition, the removable leg and sock portions would allow for more adjustment and adaptability of the garment. *Id.* In addition, as a separate and alternative rationale for modifying Grilliot with Moses, the Examiner concluded that it would have been obvious to provide detachable socks because constructing a formerly integral structure in various elements involves only routine skill in the art, citing *Nerwin v. Erlichman*, 168 USPQ 177, 179 (BPAI 1969) (hereinafter “*Nerwin*”).<sup>1</sup>

Appellants argue that the Examiner failed to establish a prima facie case of obviousness. App. Br. 3. Appellants argue that Moses discloses only detachable outer foot covers, which are not “socks” within the meaning of claim 5. App. Br. 4. Appellants contend that a person of ordinary skill in the art would associate Moses’s outer foot covers with Grilliot’s boots and Moses’s foot cover liners with Grilliot’s socks. *Id.* Appellants further argue that Moses’s foot cover liners are not directly attached to either Moses’s body suit liner or the leg portions of Moses’s outer body suit. App. Br. 4-5.

---

<sup>1</sup> The Examiner misspelled “Erlichman” as “Drlichman.”

Appellants challenge the Examiner's reason for making the proposed combination of Grilliot and Moses as a naked, unsupported assertion unsupported by either reference. App. Br. 5. Furthermore, in their Reply Brief, Appellants note that the Examiner belatedly introduced a statement into the record that socks are well known to be made of lightweight, waterproof material with treads to provide for friction grip against a surface. Reply 2. Finally, Appellants argue that *Nerwin* is not competent legal authority for the proposition that constructing a formerly integral structure in various elements involves only routine skill in the art. Reply 2-3.

On the latter issue, we agree with Appellants that *Nerwin* is not good legal authority for the proposition relied on by the Examiner, i.e., that constructing a formerly integral structure in various elements involves only routine skill in the art. *See Ex Parte Kawano*, 2013 WL 603839, at \*4 (PTAB) (*Nerwin* does not establish that it is *per se* obvious to separate a single component into two components). “The examiner’s reliance on and citation of *Nerwin v. Erlichman*, 168 USPQ 177, 179 ( BPAI 1969), which according to the examiner held that ‘constructing a formerly integral structure in various elements involves only routine skill in the art,’ appears to us to be misplaced. We find no such ‘holding’ in *Nerwin v. Erlichman*.” *Ex Parte Gruden*, 1997 WL 1883962, at \*3 (BPAI).<sup>2</sup>

Notwithstanding the foregoing, the Examiner’s reliance on *Nerwin* does not rise to the level of reversible error. The Examiner provided two

---

<sup>2</sup> We do note however, that the predecessor to our reviewing court has found, under somewhat analogous circumstances, that merely taking something that was permanently attached and making it separable is obvious and could be accomplished by anyone having ordinary skill. *In re Dulberg*, 289 F.2d 522, 523 (CCPA 1961).

Appeal 2011-000164  
Application 11/525,619

reasons for combining Grilliot and Moses and, although we disagree with the reason based on *Nerwin*, we discern no error in the Examiner's alternative rationale that a person of ordinary skill in the art would have been motivated to modify Grilliot because it would allow the user to don and doff the garment in pieces for greater ease and, in addition, the removable leg and sock portions would allow for more adjustment and adaptability of the garment. Ans. 4.

Appellants' argument that a firefighter would find it more difficult to don garments individually is unpersuasive. App. Br. 5; Reply 4. Appellants do not otherwise dispute the Examiner's statement that providing detachable socks would facilitate doffing the garment(s) and allow for adjustment and adaptability. Ans. 4. Consequently, the Examiner's reason for making the combination is largely unchallenged and is otherwise sufficient to support a prima facie case of unpatentability.

We turn now to Appellants' argument that Moses's detachable footwear is not a "sock." During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). "Therefore, we look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation." *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007). In the instant case, Appellants did not define "sock" and we do not agree that the term "sock" must be narrowly construed to exclude any and all possible uses as an outermost garment layer. Although the plain

Appeal 2011-000164  
Application 11/525,619

meaning of “sock” includes a foot covering usually worn inside footwear,<sup>3</sup> there is nothing preventing a sock from being the outermost foot covering. Moreover, there is nothing that would prevent the detachable outer foot cover in Moses from being worn inside a boot, such as a firefighter’s boot. Thus, we agree with the Examiner that Moses’s outer foot cover may properly be considered to be a “sock.” Finally, we note that the Examiner’s proposed combination is not to swap the foot covering in Grilliot for the one in Moses, but rather to make the foot covering in Grilliot (which is undeniably a sock) removably attached to its leg portion according to the teachings of Moses. *See In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973) (“Combining the teachings of references does not involve an ability to combine their specific structures.”).

Appellants allege that the Examiner raised the issue of the Examiner’s extensive experience in sock garments for the first time in the Answer. *See* Ans. 8; Reply 2. However, Appellants waived the right to assert that the Examiner entered a new ground of rejection by filing a Reply Brief instead of requesting to re-open prosecution. *See* 37 C.F.R. § 41.40(a). In any event, as persons of scientific competence in the fields in which they work, examiners are responsible for making findings, informed by their scientific knowledge, as to the meaning of prior art references to persons of ordinary skill in the art and the motivation those references would provide to such persons. *In re Berg*, 320 F.3d 1310, 1315 (Fed. Cir. 2003). Absent legal error or contrary factual evidence, those findings can establish a prima facie case of obviousness. *Id.*

---

<sup>3</sup> *See, e.g.*, “sock,” Webster’s Third New International Dictionary (1993) (available at [lionreference.chadwyck.com](http://lionreference.chadwyck.com)).

Appeal 2011-000164  
Application 11/525,619

Appellants have failed to apprise us of any error in the Examiner's conclusion of obviousness. Accordingly, we sustain the Examiner's rejection of claims 5, 6, 9 and 10.

**DECISION**

The decision of the Examiner to reject claims 5, 6, 9 and 10 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)(1)(iv).

**AFFIRMED**

hh