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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ZACHARY BAIANY

Appeal 2011-004255
Application 11/851,089
Technology Center 3700

Before EDWARD A. BROWN, ANNETTE R. REIMERS, and
RICHARD E. RICE, *Administrative Patent Judges*.

BROWN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Zachary Baiany ("Appellant") appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1-7 and 10-18. An oral hearing was conducted on February 11, 2013. We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

THE CLAIMED SUBJECT MATTER

Claims 1, 14, and 15 are the independent claims on appeal. Claim 1, reproduced below, is illustrative of the appealed subject matter:

1. A men's swimsuit comprising:
 - an outer shell having an outer-shell waistband; and
 - a form-fitting inner liner defining an interior lumen, the inner liner having:
 - an inner-liner waistband attached to the outer-shell waistband; and
 - a pair of inner-liner leg sleeves extending from the inner-liner waistband, each inner-liner leg sleeve terminating in a hem configured to exert a radially compressive force urging the hem against a thigh passing therethrough;
 - whereby, the hems of the inner-liner leg sleeves, in cooperation with the inner-liner waistband, prevent particulate matter from reaching the interior lumen of the inner liner
- wherein the inner liner comprises a form-fitting material.

THE REJECTIONS

Appellant requests review of the following rejections:

1. claims 1-3, 5, 6, 10, and 12-16 under 35 U.S.C. § 102(b) as anticipated by Cohen '924 (US 2,983,924; iss. May 16, 1961);
2. claims 4, 11, 17, and 18 under 35 U.S.C. § 103(a) as unpatentable over Cohen '924 and Cohen '589 (US 3,333,589; iss. Aug. 1, 1967); and
3. claim 7 under 35 U.S.C. § 103(a) as unpatentable over Cohen '924 and Bayer (US 7,251,840 B2; iss. Aug. 7, 2007).

ANALYSIS

Rejection of claims 1-3, 5, 6, 10, and 12-16 - Cohen '924

Claims 1-3, 5, 6, and 13-16

Appellant argues claims 1, 14, and 15 together as a group, and does not provide any separate argument for dependent claims 2, 3, 5, 6, and 13. App. Br. 3-7. We select claim 1 as representative of the grouping, with claims 2, 3, 5, 6, and 13-16 standing or falling with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2011).

Claim 1 recites a men's swimsuit comprising "a form-fitting inner liner." The Examiner found that Cohen '924 discloses a men's swimsuit comprising an inner liner 42 defining an interior lumen. Ans. 4. The Examiner determined that Cohen 924's inner liner is form fitting. *Id.* at 7.

Appellant contends that Cohen '924 discloses semi-form fitting swim trunks including an inner liner with front and rear panels that only stretch side to side, and a crotch portion that stretches only front to rear. App. Br. 3-4 (citing Cohen, col. 2, ll. 29-33, 52-55). Appellant contends that because

Cohen '924's front and rear panels stretch only in the direction of arrow 46, this is why Cohen '924 calls the trunks "*semi form fitting*." *Id.* at 4.

Appellant refers to the Declaration by John M. Airasian ("Declaration"). App. Br. 5-6. Appellant contends that Mr. Airasian "sets forth what one of ordinary skill in the art of clothing manufacture would regard as form fitting." *Id.* at 5. In the Declaration, Mr. Airasian states:

In reading US Patent 924 Cohen, it is well established that to conform to a two dimensional surface as defined above, a garment must be able to stretch in two directions. The garment disclosed by Cohen stretching along one direction, hereafter referred to as the elastic direction, does not stretch along a second direction, referred to herein as the inelastic direction. For the foregoing reasons, it is my opinion that *a garment incapable of stretching in two directions cannot reasonably be regarded as a form fitting garment.*

See Declaration 1, ll. 24-29 (emphasis added).

Appellant correctly contends that Cohen '924 discloses that its trunk provides a "semi-form fit." *See* Cohen '924, col. 2, ll. 29-32. We agree with the Examiner, however, that Cohen '924 does not explicitly describe the panty 42 as "semi-form fitting." Ans. 7-8.

Regarding claim construction, the Patent and Trademark Office gives claim limitations their broadest reasonable interpretation consistent with the specification, reading the claim language as it would be interpreted by one of ordinary skill in the art. *See In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Appellant does not direct us to a specific definition of "form-fitting" in the Specification, or contend that the Specification contains any disclosure that precludes the Examiner's

construction. *See In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994); *In re Bigio*, 381 F.3d 1320, 1325 (Fed Cir. 2004).

If the Specification does not assign or suggest a specific definition to a claim term, it is appropriate to consult a general dictionary definition of the term for guidance in determining its ordinary and customary meaning to one having ordinary skill in the art. *See Comaper Corp. v. Antec., Inc.*, 596 F.3d 1343, 1348 (Fed. Cir. 2010). An ordinary meaning of "form-fitting" is "conforming to the outline of the body: fitting snugly <a ~ sweater>." *Merriam-Webster's Collegiate Dictionary* 492 (11th ed. 2003). Similar to this ordinary meaning, the Examiner stated that "the term 'form fitting' requires that a garment conform to the outline of the body." Ans. 7. The Examiner also stated that "**[t]he form fitting function would depend greatly on the size of the wearer and not just on the type of material used to construct the garment.**" *Id.*

Appellant contends that the Declaration provides "art specific evidence" concerning the meaning of "form fitting," and that it is contrary to *Phillips* for the Examiner to attempt to rely on a general purpose dictionary definition of this term. App. Br. 7 (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1321 (Fed. Cir. 2005)). In the Declaration, Mr. Airasian states, however, that it is his *opinion* that it is unreasonable to regard a garment that cannot stretch in two directions as a "form fitting garment." Decl. 1, ll. 28-29; Ans. 8. Mr. Airasian does not state that the term "form fitting" has this same particular meaning in the pertinent field. *See* Ans. 8. We find that Mr. Airasian's statement noted above effectively provides his own construction of the claim term, but does not establish an art-specific definition of the term. As such, Appellant's contention that the Examiner improperly relied

on a general purpose dictionary definition of "form fitting," and not Mr. Airasian's "art specific evidence," is not persuasive.

As noted above, Mr. Airasian also states in the Declaration that "it is well established that to conform to a two dimensional surface as defined above, a garment must be able to stretch in two directions." *See* Declaration 1, ll. 24-25. Appellant contends that this statement is a fact, not an opinion. Reply Br. 5. However, this statement does not persuade us of error in the Examiner's finding that the liner 42 can stretch in two directions. *See* Ans. 7.

Cohen '924 describes the material used to make panty 42 as stretchable. We agree with the Examiner that the material would stretch to fit the wearer of the trunk. *See* Ans. 7. Cohen '924 states that "[t]he construction of the panty is such that it is adjustable along with the trunks and *gives proper support for all sizes from small through large.*" *See* Cohen '924, col. 2, ll. 48-51 (emphasis added). Appellant contends that this statement implies "that to the extent the trunks are semi-form-fitting, so too is the inner liner." Reply Br. 2. Figure 1 of Cohen '924 shows that the panty 42 is smaller than the swim trunk formed by the panels 10, 12. In order for the panty 42 to provide "proper support" to different-sized wearers, the panty would need to stretch sufficiently to conform, to at least some extent, to the outline of the wearer's body, and thus satisfies the "form-fitting" limitation as properly construed.

In view of the above, we sustain the rejection of claim 1, and also the rejection of dependent claims 2, 3, 5, 6, and 13-16.

Claim 10

Claim 10 depends from claim 1 and recites that "the inner liner comprises elastomeric fibers." The Examiner found that "[i]t is well known in the art that nylon is a form-fitting material that has elastic recovery and can dry quickly. The inner-liner [of Cohen '924] is therefore considered to comprise elastomeric fibers." Ans. 5. The Examiner also found that "[i]n order for a material to stretch it requires elastic properties. The nylon used to make the inner liner of Cohen has elastic properties since the liner stretches and is therefore considered to comprise elastomeric fibers." *Id.* at 9.

Appellant contends that the Examiner did not provide any factual evidence to support the assertion that nylon fibers are elastomeric fibers. App. Br. 8. Appellant also contends that because a garment stretches does not mean that garment is made of an elastomeric material. Reply Br. 6. These contentions are persuasive.

Appellant's Specification states that "[t]he materials used to construct parts of the swimsuit **100**, and in particular the inner liner **106**, may include *elastomeric fibers* or other such natural or synthetic materials *that, at room temperature, can be expanded or stretched to about twice or more of their original length.*" Spec. 4, ll. 1-4 (emphasis added). A technical dictionary definition of "elastomer" is "a polymeric material, such as a synthetic rubber or plastic, which at room temperature *can be stretched under low stress to at least twice its original length* and, upon immediate release of the stress, will return with force to its approximate original length." *See McGRAW-HILL DICTIONARY OF SCIENTIFIC AND TECHNICAL TERMS* 648 (5th ed. 1994) (emphasis added). This dictionary definition of elastomer is

consistent with the description of the elastic properties of the elastomeric fibers in the Specification.

We disagree with the Examiner's reasoning that Cohen '924's nylon inner liner can be considered to comprise elastomeric fibers. Cohen '924 does not disclose that the nylon material has sufficient elasticity such that it can be expanded or stretched to about twice or more of its original length. The Examiner has not provided any other evidence that nylon is an elastomer. Accordingly, the Examiner did not make a finding supported by a preponderance of the evidence that Cohen '924's inner liner comprises elastomeric fibers. We do not sustain the rejection of claim 10.

Claim 12

Claim 12 depends from claim 1 and recites that "the inner liner comprises a scrotal pouch." The Examiner found that the crotch portion of Cohen '924's inner liner can be considered a scrotal pouch. Ans. 5. The Examiner reasoned that "[t]he crotch portion 48 of Cohen when fitted to the body will form a pouch type structure around the genitals of the wearer thereby retaining the genitals in a defined and set position/location. Therefore the crotch portion is considered a scrotal pouch." *Id.* at 10.

Appellant disputes the Examiner's finding that Cohen '924's inner liner comprises a "scrotal pouch," as claimed. App. Br. 8-9. Appellant contends that the front panel of Cohen '924's inner liner is merely a flat panel that overlays the scrotal region, which does not make it a "scrotal pouch." Reply Br. 7. These contentions are persuasive.

Cohen '924 describes "the crotch portion **48** joining said front and rear portions." *See* Cohen '924, col. 2, ll. 55-59. Figure 3 of Cohen '924 shows the outer surface of the crotch portion 48, and does not depict any structure

that resembles a "pouch." The Examiner did not identify any disclosure in Cohen '924 that supports the finding that the crotch portion 48 will form a "pouch type structure" around the genitals of a wearer of the swim trunks. As such, the Examiner's finding that Cohen '924's crotch portion 48 is a "scrotal pouch," as claimed, is not supported by a preponderance of the evidence. We do not sustain the rejection of claim 12.

Rejection of claims 4, 11, 17, and 18 – Cohen '924 and Cohen '589

Claims 4, 11, and 17

Appellant indicates that claims 4, 11, and 17 stand or fall with claim 1 and does not provide any argument for these dependent claims. App. Br. 9. Accordingly, we also sustain the rejection of claims 4, 11, and 17.

Claim 18

Claim 18 depends from claim 1 and recites that "the inner liner comprises a long chain synthetic polymer having at least 85% segmented polyurethane." The Examiner found that Cohen '589 discloses an inner liner made of nylon and spandex. Ans. 5. The Examiner also found that Appellant's Specification states, "[f]or example, elastomeric fibers may include spandex, polyester, LYCRA, or any manufactured fiber in which the fiber forming substance is a long chain synthetic polymer comprised of, for instance, at least 85% of a segmented polyurethane." *Id.* at 6 (citing Spec. 4, ll. 1-7). The Examiner determined that therefore Cohen '589's inner liner comprises a long chain synthetic polymer having at least 85% segmented polyurethane. *Id.*

Appellant contends that the Specification lists four different alternatives, and "any manufactured fiber . . . at least 85% of a segmented polyurethane," is a fourth alternative to spandex, polyester, and LYCRA®

and not a restatement of a property inherent in these three alternatives. App. Br. 9. We agree with Appellant that the Specification does not explicitly describe spandex, polyester, and LYCRA® as "a long chain synthetic polymer having at least 85% segmented polyurethane." The Examiner did not provide any additional evidence to support this finding. Accordingly, because we find that the Examiner's rejection of claim 18 is based on an insufficient finding, we do not sustain the rejection.

Rejection of claim 7 – Cohen '924 and Bayer

Claim 7 depends from claim 1 and recites that "the hems comprise a drawstring that, when tightened, exerts a radially compressive force." The Examiner found that Cohen '924 does not disclose a hem around the legs that comprises a drawstring. Ans. 6. The Examiner found that Bayer discloses pants having a bottom hem comprising a drawstring 410 around each leg portion. *Id.* (citing Bayer, col. 6, ll. 10-20; *see also* Fig. 9). The Examiner concluded that it would have been obvious to use Bayer's drawstring hem to modify the hem of Cohen '924 "in order to provide a tight seal against the leg of the wearer, preventing particulate matter from entering." Ans. 6.

Appellant contends that Cohen '924 does not mention that the entry of particulate matter is a problem. App. Br. 10. Appellant also contends that the Examiner did not provide any articulated reasoning with a rational underpinning to support the obviousness of the modification of Cohen '924. Reply Br. 8. Appellant contends that Cohen '924's hem already provides a tight seal, and one skilled in the art would have recognized that the elastic hem would have been easier for a wearer. *Id.* Appellant also contends that a drawstring is not equivalent to an elastic hem because a drawstring provides

an unexpected advantage. *Id.* Particularly, Appellant contends that a drawstring, unlike an elastic hem, can be loosened and tightened at will, allowing trapped particulates to fall out, and water to enter to cleanse the interior of the swimsuit. *Id.* at 9. These contentions are not persuasive.

Bayer states that "the drawstrings **410** permit a user to draw the bottom of each leg **404**, **405** tightly about the leg and prevent the intrusion of cold air, water *or other similarly unwanted environmental hindrance or annoyance.*" *See* Bayer, col. 6, ll. 15-18 (emphasis added). One of ordinary skill in the art would have recognized particulate matter as such an "environmental hindrance or annoyance" for the wearer of Bayer's garment. Appellant has not provided any persuasive argument as to why Bayer's drawstrings 410 would lack the capability to "prevent particulate matter from reaching the interior lumen of the inner liner" when substituted in the Cohen '924 trunk for the elastic edging 54. Nor has Appellant provided any persuasive argument as to why one of ordinary skill in the art would not have recognized that Bayer's drawstrings 410 could be loosened by a wearer of Cohen '924's trunk to allow unwanted particulate matter to escape from inside of the panty 42, and to allow water to enter to cleanse the interior of the panty 42. The substitution of Cohen '924's elastic edging 54 with Bayer's drawstrings 410 appears to be no more than "the simple substitution of one known element for another" with predictable results. *See KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417 (2007). We sustain the rejection of claim 7.

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DECISION

The Examiner's rejection of claims 1-7, 11, and 13-17 is AFFIRMED, and rejection of claims 10, 12, and 18 is REVERSED. No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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