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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KIMBERLY MARIE SARUBBI

Appeal 2019-002025
Application 15/701,834
Technology Center 3700

Before DANIEL S. SONG, EDWARD A. BROWN, and
LISA M. GUIJT, *Administrative Patent Judges*.

BROWN, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–15. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Kimberly Marie Sarubbi. Br. 1.

CLAIMED SUBJECT MATTER

Appellant's disclosure relates to "personal effects and garments that promote healing and good health." Spec. ¶ 1.

Claims 1 and 8 are independent claims. Claim 1 illustrates the claimed subject matter.

1. A personal effect comprising:
a first solid and a second solid, wherein the first is different from the second solid; and
a conductive element comprising a conductive metal coupling the first solid to the second solid, wherein the first solid is associated with a first vibrational rate and the second solid is associated with a second vibrational rate.

Br. 8 (Claims App.).

REJECTIONS

Claims 1, 2, 4–8, 10, 11, and 13–15 stand rejected under 35 U.S.C. § 103 as unpatentable over Caton (GB 2468175 A, published Sept. 1, 2010) and Scott (US 2015/0224011 A1, published Aug. 13, 2015).

Claims 3, 9, and 12 stand rejected under 35 U.S.C. § 103 as unpatentable over Caton, Scott, and Lee (GB 2468175 A, published Sept. 1, 2010).

ANALYSIS

Obviousness of claims 1, 2, 4–8, 10, 11, and 13–15 over Caton and Scott

Appellant argues claims 1, 2, 4–8, 10, 11, and 13–15 as a group. Br. 2–6. We select claim 1 as representative of this grouping, and claims 2, 4–8, 10, 11, and 13–15 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

As to claim 1, the Examiner finds that Caton discloses a personal effect (a garment) comprising a first solid and a second solid different from the first solid (“stones and crystals”), where the first and second solids are associated with respective first and second vibrational rates (“crystals provide a piezoelectric charge”), and an element (“dernier knitted fabric”) coupling the first solid to the second solid. Final Act. 2–3 (citing Caton, Abstract, Figs. 1a–1c, 1e, p. 1, ll. 20–21, 39–41, p. 7, ll. 31–37). The Examiner concedes Caton does not teach that the coupling element is a conductive element comprising a conductive metal. *Id.* at 3.

The Examiner relies on Scott as teaching a personal effect (a garment) comprising a conductive element comprising a conductive metal (antimicrobial thread 510 formed with fine wires of copper or silver). Final Act. 3 (citing Scott ¶ 42, Fig. 5). The Examiner concludes that it would have been obvious to one of ordinary skill in the art to modify Caton’s garment to include a conductive element comprising a conductive metal thread, as taught by Scott, to provide an integral antimicrobial material that can reduce a likelihood of infection. *Id.* (citing Scott ¶ 42).

Appellant contends that Scott teaches only that a *compression* garment with an integrated antimicrobial thread can reduce the likelihood of infection when placed over wounds. Br. 3 (citing Scott ¶¶ 38, 42). Appellant contends that, in contrast to Scott, Caton discloses underwear garments, not compression garments, and Caton does not direct the garments to wounds. *Id.* Appellant further contends that Scott does not disclose that the result of reducing the likelihood of infection could be obtained if the antimicrobial thread were integrated into other, looser fitting garments. *Id.*

The Examiner responds that although Caton does not disclose compression garments or directing the lingerie and underwear garments to wounds, the garments still “could benefit from having a material made from or integrated by antimicrobial thread(s) in order to reduce a likelihood of infection while wearing the garment.” Ans. 8. The Examiner submits that, in Scott, “the effect of reducing a likelihood of infection of an antimicrobial thread is always present regardless whether the garment is applied over a wound or not.” *Id.* at 10 (citing Scott ¶ 42).

Appellant’s contentions are not persuasive. Paragraph 38 of Scott describes compression garment 300 positioned in relation to “an underlying wound.” Scott ¶ 38. However, paragraph 42 of Scott also cited by Appellant does not describe that the antimicrobial effect provided by antimicrobial thread 510 being “wound together or otherwise integrated with” stimulated auxetic material 520 is only achieved by placing antimicrobial thread 510 in contact with a wound, as Appellant seems to contend. Paragraph 42 describes that “antimicrobial thread **510** can reduce a likelihood of infection,” but does not indicate that antimicrobial thread 510 is limited to being placed overlying an existing wound.

Appellant also contends that Scott does not disclose that the antimicrobial thread material possess any qualities that Caton teaches as being desirable. Br. 3. Appellant notes that Caton teaches the use of a particular fabric having certain properties. *Id.* at 4 (citing Caton 6, ll. 26–29). Appellant contends that Caton teaches the use of fabrics that are elastically stretched and/or are comfortable, whereas the copper and silver threads disclosed in Scott are neither. *Id.* at 5.

These contentions are also unpersuasive. Appellant's Specification describes the meaning of "coupled to," stating:

Also, as used in this application, and unless the context dictates otherwise, the term "coupled to" is intended to include both *direct coupling* (in which two elements that are coupled to each other contact each other) and *indirect coupling* (in which at least one additional element is located between the two elements). Therefore, the terms "coupled to" and "coupled with" are used synonymously.

See Spec. ¶ 31 (emphasis added). Appellant does not apprise us of error in the Examiner's finding that Caton's fabric couples the first solid to the second solid. Final Act. 3. The Examiner proposes to modify Caton's fabric by incorporating Scott's conductive element into or with Caton's fabric. Appellant also does not apprise us of error in the Examiner's position that this proposed modification of Caton's fabric would result in the coupling of a first solid to a second solid with a conductive element, as claimed. Nor does Appellant provide any persuasive argument or evidence to show that the Examiner's proposed modification would render Caton's fabric undesirable or unsuitable.

Appellant also contends that "[t]he present invention aims 'to improve the[] experience of the placebo effect,'" which Appellant states is "the enhanced placebo effect of a garment with two solids of different vibrational rates coupled with a conductive metal element, as claimed." Br. 3 (citing Spec. ¶¶ 7, 11, 12), 6. Appellant describes the placebo effect as "unexpected." *Id.* at 3. Appellant contends that neither Caton nor Scott provides any suggestion that their combination would yield a desirable placebo effect, nor has the Examiner cited any other evidence to establish

that the placebo effect would “flow naturally” from the combination of Caton and Scott. *Id.*

These contentions are unpersuasive. As the Examiner responds, the claims do not recite a placebo effect. Ans. 9. Indeed, Appellant provides no objective evidence of any “enhanced placebo effect” purportedly provided by the claimed personal effect. In that regard, paragraphs 7, 11, and 12 of the Specification cited by Appellant as support for this effect do not appear to describe any such “enhanced” “placebo effect.” Moreover, the Examiner points out that Canton teaches that stones or crystals provide the same desirable placebo effect. *Id.* at 16 (citing Canton 1, ll. 18–20).

Appellant contends that the Examiner “fails to establish any teaching, suggestion, or motivation to combine Caton and Scott that would overcome Caton *teaching away from the disclosure in Scott.*” Br. 3 (emphasis added). The Examiner responds that “there is no evidence found in Caton to actually criticize, discredit, or otherwise discourage investigation into an antimicrobial thread that can be wound together or otherwise integrated with a material that can be employed to form a weave of a garment (as taught and suggested by Scott).” Ans. 9.

Appellant’s contention is not persuasive. “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Urbanski*, 809 F.3d 1237, 1244 (Fed. Cir. 2016) (citation omitted). “A prior art reference evidences teaching away if it ‘criticize[s], discredit[s], or otherwise discourage[s] the solution claimed.’” *In re Brandt*, 886 F.3d 1171 (Fed. Cir. 2018) (quoting *In re Fulton*, 391 F.3d 1195, 1201

(Fed. Cir. 2004)). Here, Appellant does not does not direct us to any particular disclosure in Caton or Scott that criticizes, discredits, or otherwise discourages the claimed limitations.

For the foregoing reasons, we sustain the rejection of claims 1, 2, 4–8, 10, 11, and 13–15 as unpatentable over Caton and Scott.

Obviousness of claims 3, 9, and 12 over Caton, Scott, and Lee

Appellant relies solely on the dependency of claims 3, 9, and 12 from claim 1 or 8 for patentability. Br. 6. Accordingly, we sustain the rejection of claims 3, 9 and 12 as unpatentable over Caton, Scott, and Lee for the same reasons as for claims 1 and 8.

CONCLUSION

In summary:

Claims Rejected	Basis	Affirmed	Reversed
1, 2, 4–8, 10, 11, 13–15	§ 103 Caton, Scott	1, 2, 4–8, 10, 11, 13–15	
3, 9, 12	§ 103 Caton, Scott, Lee	3, 9, 12	
Overall Outcome		1–15	

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