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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte IKUO TORATANI

Appeal 2019-003873
Application 13/219,785
Technology Center 3700

Before JILL D. HILL, LEE L. STEPINA, and ARTHUR M. PESLAK,
Administrative Patent Judges.

HILL, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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 Toratani Co., LTD. Appeal Br. 3.

BACKGROUND

Appellant's invention relates to clothing such as shorts. Independent claims 1, 2, 3, and 4 are pending. Claim 1, reproduced below, illustrates the claimed invention, with certain limitations italicized:

1. Shorts, comprising:

a tubular body (14) including a stretchable front covering portion (11) and a stretchable back covering portion (12), the front covering portion (11) having high-thigh-size formation portions (15) which are bilaterally symmetrical and each coved upward in a lower end of the front covering portion (11); and

a gusset portion (13) disposed between an inner-crotch front portion (16) at the lower end of the front covering portion (11) and an inner-crotch back portion (17) at a lower end of the back covering portion (12), wherein

the body (14) includes a left half (12a) and a right half (12b) of the back covering portion (12) on left and right sides respectively of the front covering portion (11), and a sewing part in which an edge of the left half (12a) of the back covering portion (12) and an edge of the right half (12b) of the back covering portion (12) are sewn, and wherein

in a development plan view of the body (14) in which the body (14) is opened along a back center line (S2) vertically running through a middle in a lateral direction of the back covering portion (12), the back center line (S2) is extended from a vicinity of an upper end of the back center line (S2), which corresponds to an upper end of the back covering portion (12), to a lower end of the back center line (S2), which corresponds to the lower end of the back covering portion (12), in a downward narrowing manner with respect to a front center line (S1) vertically running through the middle in the lateral directions of the front covering portion (11) so that a downward extension of the back center line (S2) approaches a downward extension of the front center line (S1).

REJECTIONS²

I. Claims 3, 10, 13, 16 and 19 stand rejected under 35 U.S.C. § 102(b) as anticipated by Osborne (WO 96/23426 A1, pub. Aug. 8, 1996). Final Act. 6.

II. Claims 1, 2, 4–9, 11, 12, 14, 15, 17, 18, and 20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Osborne. Final Act. 12.

ANALYSIS

Rejection I – Anticipation by Osborne

In rejecting independent claim 3 as anticipated by Osborne, the Examiner finds that the limitation “in a development plan view of the body . . . a downward extension of the back center line approaches a downward extension of the front center line,” is a “non-assembled state before the final product (that) is not germane to the patentability of the final product in the present product claim.” Final Act. 8. The Examiner considers this limitation to be a product-by-process limitation describing an intermediate shape that “adds no patentable distinction to the claim,” and the final product of the claimed invention being structurally the same as the Osborne product. *Id.* at 10 (citing *In re Thorpe*, 777 F.2d 695, 697 (Fed. Cir. 1985); *see also* MPEP § 2113.

Appellant argues that the “development plan view” limitation is not a product-by-process limitation, instead defining “the shape of the back covering portion (12)” when the final product is opened, the shape being

² A rejection of claims 1, 2, 5–9, 12, 15, and 18 under 35 U.S.C. § 112, second paragraph, and a rejection of claim 3, 10, 13, 16, and 19 under 35 U.S.C. § 103(a) are withdrawn. Ans. 3–4; Final Act. 4, 6.

“germane to the claimed overall structure of the shorts.” Appeal Br. 12. Appellant further argues that the Examiner does not explain how Osborne’s product would be “opened along a ‘hypothetical back centerline’ running through a middle in a lateral direction of the rear panel 16, so that downward extensions of a ‘hypothetical front center line and back center line’ are capable of approaching one another in a downward narrowing manner.” *Id.* at 11. Indeed, Appellant contends that downward extensions of Osborne’s “hypothetical front center line and back center line,” if such extensions existed, would not be capable of approaching one another in a downward narrowing manner. *Id.*

The Examiner responds that Appellant’s arguments are directed to an intermediate product, not the final product. Ans. 5. According to the Examiner, “[a]ll of the limitations directed to the shorts ‘in a development plan view’ are not describing the final ‘shorts’ product,” and because “Osborne teaches all of the limitations of independent claim 3 regarding the final ‘shorts’ product, Osborne is anticipatory.” Ans. 5–6.

In reply, Appellant again argues that the disputed “recitation defines a specific shape of the back covering portion (12) (as depicted in Fig. 3 of the present application), and this shape imparts specific structure to the claimed shorts.” *Id.* at 3.

Appellant has the better position. Appellant’s “development plan view” illustrates the shape of the claimed back covering portion 12 when the final product is opened along a middle of its back covering portion, such that claim 3 is not a product-by-process claim merely describing an intermediate shape. Rather, claim 3 defines the structure of the final product. Claim 3 requires that, after the final product is produced, the final product, when

viewed in a particular manner, namely, as split (opened) through the middle in a vertical direction of the back covering, defines a specific shape. This shape requires the back center line (S2) to extend “in a downward narrowing manner with respect to a front center line (S1) vertically running through the middle in the lateral directions of the front covering portion (11).” Appeal Br. 19 (Claims App.). As such, although Appellant claims a “tubular body,” the body will have a taper causing the body to extend in a narrowing manner. This is consistent with the Specification, which discloses that “body 14 is formed into a tubular shape so that the vicinity of the hip hem can be three-dimensionally narrowed down in a non-worn state.” Spec. ¶ 21.

The Examiner has not provided evidence that Osborne’s tubular blank would have such a taper. It is our understanding that a development plan view of Osborne would illustrate its back center line being parallel to its front center line, because Osborne’s tubular blank is cylindrical. *See* Osborne, Figs. 7 and 8. We agree with Appellant that the Examiner does not provide evidence that, or sufficiently explain how, Osborne’s product could have a back center line approaching a front center line in a downward narrowing manner. Moreover, the Examiner provide no factual basis for the finding that, because Osborne’s product is made from a flexible material, its front and rear center lines can approach one another (*see* Final Act. 8). Because the Examiner has not provided evidence that a development plan view of the body of Osborne opened along a back center line would result in a downward extension of the back center line approaching a downward extension of the front center line, anticipation has not been established.

For these reasons, we do not sustain the rejection of claim 3 as anticipated by Osborne. Claims 10, 13, 16, and 19 depend from claim 3, containing all of the limitations thereof. We do not sustain the rejection of the dependent claims for the same reasons.

Rejection II – Obviousness Based on Osborne

Each of independent claims 1, 2, and 4 recites, *inter alia*, “in a development plan view of the body . . . a downward extension of the back center line approaches a downward extension of the front center line.” The Examiner makes the same findings regarding Osborne set forth above in Rejection I, again finding that the limitation regarding the developmental plan view is not germane to the patentability of the final product, that the flexibility of the fabric of Osborne makes it capable of meeting the limitation, and that the limitation is a product-by-process limitation. *See* Final Act. 13–22. Appellant makes the same arguments contending the Examiner’s findings. Appeal Br. 14–15.

For the reasons set forth above in Rejection I, we do not sustain Rejection II.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
3, 10, 13, 16, 19	102(b)	Osborne		3, 10, 13, 16, 19
1, 2, 4–9, 11, 12, 14, 15, 17, 18, 20	103(a)	Osborne		1, 2, 4–9, 11, 12, 14, 15, 17, 18, 20

Appeal 2019-003873
Application 13/219,785

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
Overall Outcome				1-20

REVERSED