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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DEBORAH YEOMANS, DAVID O'MAHONY,
TRUDY ANNE WATSON, and JAMES TARRIER

Appeal 2019-005328
Application 14/043,365
Technology Center 3700

Before EDWARD A. BROWN, CHARLES N. GREENHUT, and
LEE L. STEPINA, *Administrative Patent Judges*.

BROWN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ seeks review under 35 U.S.C. § 134(a) of the Examiner's decision rejecting claims 1, 2, 5–14, and 16–20.² We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE and enter a NEW GROUND OF REJECTION.

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 Adidas AG. Appeal Br. 3.

² Claims 3, 4, 15, and 21–30 are withdrawn. Appeal Br. (Claims App.).

CLAIMED SUBJECT MATTER

Claim 1, reproduced below, is representative of the claimed subject matter on appeal.

1. An item of clothing comprising:
 - a first textile area having a portion adapted to receive at least one sensor;
 - a second textile area; and
 - a third textile area, which is arranged at least partially between the first and second textile areas,
 - wherein the third textile area is adapted to isolate relative motion between the first textile area and the second textile area, so that the portion of the first textile area adapted to receive at least one sensor remains substantially fixed in relation to an area of a subjacent organ of a wearer of the item of clothing when the item of clothing is worn,
 - wherein the first textile area is adapted to exhibit a stretching pattern in response to forces experienced during a motion so that the portion of first textile area adapted to receive at least one sensor remains substantially fixed during the motion to an area of a subjacent organ of the wearer of the item of clothing when the item of clothing is worn, and
 - wherein the first textile area comprises a first piece and a second piece, wherein the first piece is adapted to exhibit a maximum stretch during the motion of between 25% and 60% longer than an initial length of the first piece, and wherein the second piece is adapted to exhibit a maximum stretch during the motion of between 10% and 20% longer than an initial length of the second piece.

Appeal Br. 24 (Claims App.).

REJECTIONS ON APPEAL

Claims 1, 2, 5–9, 12–14, 16, and 17 are rejected under 35 U.S.C. § 103(a) as unpatentable over Olrich (US 2,554,380, issued May 22, 1951) and Uno (US 6,892,396 B2, issued May 17, 2005).

Claim 10 is rejected under 35 U.S.C. § 103 as unpatentable over Olrich, Uno, and Louis (CA 2504416 A1, published Oct. 10, 2006).

Claims 11, 12, 19, and 20 are rejected under 35 U.S.C. § 103(a) as unpatentable over Olrich, Uno, and Eldridge (US 2006/02111937 A1, Sept. 21, 2006).

Claim 18 is rejected under 35 U.S.C. § 103(a) as unpatentable over Olrich, Uno, and Lebby (US 6,080,690, issued June 27, 2000).

ANALYSIS

New Ground of Rejection of Claims 1, 2, 5–14, and 16–20

Claim 1 is directed to an item of clothing, “wherein the first textile area is adapted to exhibit a stretching pattern in response to forces experienced *during a motion* so that the portion of first textile area adapted to receive at least one sensor remains substantially fixed *during the motion* to an area of a subjacent organ *of the wearer of the item of clothing* when the item of clothing is worn.” Appeal Br. 15 (Claims App.) (emphasis added). As further recited, “the first textile area comprises a first piece and a second piece,” “the first piece is adapted to exhibit a maximum stretch *during the motion* of between 25% and 60% longer than an initial length of the first piece,” and “the second piece is adapted to exhibit a maximum stretch *during the motion* of between 10% and 20% longer than an initial length of the second piece.” *Id.* (emphasis added) (herein also “maximum stretch limitations”). Based on our review of the record before us, we determine that claim 1 is indefinite.

Appellant contends that the claimed first and second pieces of the first textile area are adapted to exhibit the recited maximum stretch values during

the motion, that is, the recited values refer to the greatest stretch experienced by these pieces during the motion. Appeal Br. 7–8 (citing Spec. ¶¶ 103–111, Fig. 11). Further, Appellant contends, the maximum stretch of the first and second pieces must be within the respective recited ranges during the same motion. *Id.* at 8. Appellant also asserts, “although the claims do not limit the minimum stretch that the pieces are adapted to exhibit during the motion, the claims do set both upper and lower bounds on the maximum stretch the pieces are adapted to exhibit during the motion.” Reply Br. 6.

The Examiner notes, however, that claim 1 recites an “arbitrary ‘motion.’” Final Act. 6. Indeed, claim 1 does not specify a type of motion of the wearer of the item (e.g., bending, twisting, running, or jumping) during which the maximum stretch limitations are exhibited by the first and second pieces. Nor does claim 1 limit the wearer’s motion to a single type of motion. It appears, however, that the type of motion made by the wearer, as well as aspects of the motion, for example, the motion’s speed, direction and/or range, would affect the forces that the first textile area is subjected to, and, consequently, the maximum stretch exhibited by the first and second pieces during the motion.

Additionally, claim 1 recites the maximum stretch limitations of the first and second pieces in relation to an undefined “wearer.” Wearers can, however, vary significantly in their body types and sizes, for example. These variations would affect how the item fits a given wearer. For example, the same item of clothing when worn could range from being very loose-fitting to very tight, depending on the wearer. This relative size difference between the item and the wearer would, for different wearers, affect the forces that the item is subjected to, even during the same motion.

Further, the item could be stretched, even significantly, by a relatively larger wearer even before the wearer makes a motion. It is unclear whether the recited maximum stretch includes this pre-motion stretching of the item in determining the maximum stretch. In contrast, for a relatively smaller wearer of the same item with a loose fit, such pre-motion stretching could be substantially or completely absent. Consequently, it appears that for the same claimed item of clothing, different wearers may or may not cause the item of clothing to infringe the claim even if the wearers undergo the same motion.

In sum, based on the claim language, a particular “item of clothing” may or may not infringe depending on the particular wearer and the particular motion used for analysis of “maximum stretch.” There is nothing wrong, per se, with defining the claimed subject matter based on functional language, or based on its interaction with some unclaimed subject matter. Here, however, the range of potential motions, and potential wearers, is so vast as to make it unduly burdensome for the potential infringer seeking to determine the meets and bounds of the claim, insofar as the claimed “item of clothing” itself is concerned. *See In re Hammack*, 427 F.2d 1378, 1382 (CCPA 1970) (“the language of the claims must make it clear what subject matter they encompass . . . [to provide the potential infringer] with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved”).

A claim is properly rejected as indefinite under 35 U.S.C. § 112, second paragraph, if, after applying the broadest reasonable interpretation in light of the specification, the metes and bounds of a claim are not clear. *See In re Packard*, 751 F.3d 1307, 1310 (Fed. Cir. 2014). Thus, we conclude

that claim 1 and dependent claims 2, 5–14, and 16–20 fail to comply with the requirements of 35 U.S.C. § 112, second paragraph. Therefore, pursuant to 37 C.F.R. § 41.50(b), we enter a new ground of rejection of claims 1, 2, 5–14, and 16–20 under this ground.

Claims 1, 2, 5–9, 12–14, 16, and 17 over Olrich and Uno

Claim 10 over Olrich, Uno, and Louis

Claims 11, 12, 19, and 20 over Olrich, Uno, and Eldridge

Claim 18 over Olrich, Uno, and Lebby

The Examiner finds that Olrich discloses an item of clothing comprising a first textile area made from a stretchable material and including first and second pieces. Final Act. 4–7. The Examiner concedes that Olrich does not describe that the first and second pieces of the first textile area satisfy the recited maximum stretch limitations, and relies on Uno to attempt to cure this deficiency in Olrich. *Id.* at 6–7.

Appellant contends that the combination of Uno and Olrich fails to disclose or suggest the recited maximum stretch limitations. Appeal Br. 5–13. As we determine that claims 1, 2, 5–14, and 16–20 are indefinite under 35 U.S.C. § 112, second paragraph, for the above-discussed reasons, sustaining the rejections of these claims under 35 U.S.C. § 103(a) as unpatentable over the noted combinations of references would require speculation on our part as to their scope. *See In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962) (holding that the Board erred in affirming an obviousness rejection of indefinite claims because the rejection was based on speculative assumptions as to the meaning of the claims). Thus, we do

not sustain the rejection of claims 1, 2, 5–14, and 16–20 under 35 U.S.C.
§ 103(a).³

DECISION SUMMARY

In summary:

Claim(s) Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed	New Ground
1, 2, 5–9, 12–14, 16, 17	103(a)	Olrich, Uno		1, 2, 5–9, 12–14, 16, 17	
10	103(a)	Olrich, Uno, Louis		10	
11, 12, 19, 20	103(a)	Olrich, Uno, Eldridge		11, 12, 19, 20	
18	103(a)	Olrich, Uno, Lebbly		18	
1, 2, 5–14, 16–20	112, second paragraph				1, 2, 5–14, 16–20
Overall Outcome				1, 2, 5–14, 16–20	1, 2, 5–14, 16–20

FINALITY OF DECISION AND RESPONSE

This Decision contains a new ground of rejection pursuant to
37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of

³ It should be understood, however, that our decision is based solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the references applied in the prior art rejections.

rejection pursuant to this paragraph shall not be considered final for judicial review.” 37 C.F.R. § 41.50(b) also provides:

When the Board enters such a non-final decision, [Appellant], within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the Examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, [Appellant] may again appeal to the Board pursuant to this subpart.
- (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in MPEP § 1214.01.

REVERSED; 37 C.F.R. § 41.50(b)