



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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/055,190	10/16/2013	KC Nguyen	LFS0010-00US	2656
48394	7590	09/30/2020	EXAMINER	
SERVILLA WHITNEY LLC 33 WOOD AVE SOUTH SUITE 830 ISELIN, NJ 08830			LEE, MICHELLE J	
			ART UNIT	PAPER NUMBER
			3786	
			NOTIFICATION DATE	DELIVERY MODE
			09/30/2020	ELECTRONIC

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):

docket@dsiplaw.com
hservilla@dsiplaw.com
lmurphy@dsiplaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KC NGUYEN, BENG SIM CHUAH,
CHAYAPORN PONGTHANOMSAK, CHINTANA NETRUNG,
MATTHEW STEVEN GROSKORTH, UTAIN PATTANAPRADIT, and
PAUL D'AGUIAR

Appeal 2020-001319
Application 14/055,190
Technology Center 3700

Before PHILLIP J. KAUFFMAN, ANNETTE R. REIMERS, and
TARA L. HUTCHINGS, *Administrative Patent Judges*.

HUTCHINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1–4, 20–24, and 27–31. We have jurisdiction under 35 U.S.C. § 6(b).

¹ We use the term “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Our Decision references Appellant's Appeal Brief (“Appeal Br.,” filed June 14, 2019), and Reply Brief (“Reply Br.,” filed Dec. 4, 2019), and the Examiner's Answer (“Ans.,” mailed Oct. 8, 2019), Advisory Action (“Adv. Act.,” mailed Feb. 20, 2019), and Final Office Action (“Final Act.,” mailed Nov. 15, 2018). Appellant identifies the real party in interest as LIFESTYLES HEALTHCARE PTE. LTD. Appeal Br. 4.

We REVERSE.

CLAIMED INVENTION

The claims are directed to decorated polymeric articles, such as prophylactics and protective devices. Spec. ¶¶ 1, 4. Claims 1 and 31 are independent. Claim 1 is reproduced below:

1. A polymeric condom having a tip configured to fit over a tip of a user's penis, the condom for use by the user in sexual activity with a partner, comprising:

a polymeric sheath, the sheath comprising at least two tubular polymeric fluid barrier layers that have the shape of the sheath, the sheath having an open and a closed end at the tip;

a tubular portion of the sheath corresponding to the tubular polymeric fluid barrier layers; and

a decoration disposed on a flexible, two-dimensional substrate having a defined area bounded on all sides by edges;

the two-dimensional substrate conformed to the tubular shape of the polymeric sheath and sandwiched between the at least two tubular polymeric fluid barrier layers, wherein the substrate comprises at least one of a polymeric film, paper, or a combination of polymeric film and paper that traverses at least a quarter of a circumference of the at least two tubular polymeric fluid barrier layers, and

wherein the decoration comprises an image defined by differences across the image in color or color density.

REJECTIONS

Claims 1, 2, 20–24, and 27–31 are rejected under 35 U.S.C. § 103(a) as unpatentable over Vistins (US 2003/0124354 A1, pub. July 3, 2003) and Hirano (US 4,757,557, iss. July 19, 1998).

Claim 3 is rejected under 35 U.S.C. § 103(a) as unpatentable over Vistins, Hirano, and Maeder (WO 2004/014266 A1, pub. Feb. 19, 2004).

Claim 4 is rejected under 35 U.S.C. § 103(a) as unpatentable over Vistins, Hirano, and Stager (US 4,186,445, iss. Feb. 5, 1980).

ANALYSIS

Independent Claims 1 and 11, and Dependent Claims 2, 20–24, and 27–30

We are persuaded by Appellant’s argument that the Examiner erred in rejecting claims 1 and 13 under 35 U.S.C. § 103(a) because the combination of Vistins and Hirano does not teach or suggest a polymeric condom having “a decoration disposed on a flexible, two-dimensional substrate,” the substrate being “sandwiched between the at least two tubular polymeric fluid barrier layers,” as recited in claim 1, and similarly recited in claim 31.

Appeal Br. 11–12; *id.* at 19, 21 (Claims App.); Reply Br. 2.

In rejecting claims 1 and 31 under 35 U.S.C. § 103, the Examiner primarily relies on Vistins as disclosing the recited limitations. *See* Final Act. 4. However, the Examiner acknowledges that Vistins does not teach “a decoration disposed on a flexible, two-dimensional substrate . . . sandwiched between the at least two tubular polymeric fluid barrier layers.” *Id.* For this aspect of the claim language, the Examiner relies on Hirano. *Id.* at 5 (citing Hirano, 3:20–41, Fig. 4).

Hirano relates to a synthetic resin or rubber domestic gauntlet with a design seal to be used in washing and cooking. Hirano 1:7–10. Hirano seeks to provide a design seal (e.g., animal(s), flower(s), letter(s)) that does not easily detach with frequent use of the gauntlet. *Id.* at 1:14–18, 32–39. Hirano’s gauntlet 10 includes hand portion 12, first wrist portion 13 having design seal 16 (e.g., a flower), and second wrist portion 14. *Id.* 3:8–41, Fig. 1. Design seal 16 is rubber or vinyl film applied to core sheet 15 at a

location corresponding to first wrist portion 13. *Id.* at 3:17–32, Figs. 1, 4. Paste layer 18 is applied to an external surface of first wrist portion 13, and then flocking 19 is applied to paste layer 18. *Id.* at 3:36–41, Fig. 4.

The Examiner finds that Hirano design seal 16 is “sandwiched between core sheet 15 and paste 18.” Final Act. 5. Appellant argues, and we agree, that paste layer 18 is not a polymeric fluid barrier layer, as required by claims 1 and 31. *See* Appeal Br. 11 (“Those skilled in the art understand that a combination of paste and fibers does not form a polymeric fluid barrier layer.”).

In response, the Examiner explains that Vistins, not Hirano, teaches the claimed polymeric layers. Ans. 12; *see also* Adv. Act. 3.² According to the Examiner, one of ordinary skill in the art would have been motivated to provide the polymeric layers of Vistins “with a decoration between them, as taught by Hirano” to “avoid a monotonous appearance and have a distinctly displayed seal/decoration.” Ans. 12, 13 (citing Hirano 1:44–46); *see also* Adv. Act. 2.

Yet, Hirano’s paste and flocking layers are not analogous, structurally or functionally, to the polymeric layers described by Vistins. Appeal Br. 11–12. Because of this structural and functional difference, Hirano would not have suggested sandwiching a film design seal between polymeric layers. Although a desire to avoid a monotonous appearance and have a distinctly displayed seal or decoration might have led one of ordinary skill in the art to add surface ornamentation to a condom, that desire alone would

² Although the Advisory Action does not include page numbers, we refer to the pages of the Advisory Action by number beginning with the cover sheet as page 1.

not have suggested sandwiching a two-dimensional substrate on which a design was disposed between at least two polymeric fluid barrier layers, as recited in claims 1 and 31. Therefore, we do not sustain the rejection of claims 1, 2, 20–24, and 27–31 under 35 U.S.C. § 103(a) as unpatentable over Vistins and Hirano.

Dependent Claims 3 and 4

Claims 3 and 4 depend from claim 1. The Examiner’s rejections of these claims does not remedy the deficiencies in the rejection of independent claim 1. Therefore, we do not sustain the rejections of claims 3 and 4 under 35 U.S.C. § 103(a) for the same reasons described with respect to claim 1.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Basis/References	Affirmed	Reversed
1, 2, 20–24, 27–31	103(a)	Vistins, Hirano		1, 2, 20–24, 27–31
3	103(a)	Vistins, Hirano, Maeder		3
4	103(a)	Vistins, Hirano, Stager		4
Overall Outcome				1–4, 20–24, 27–31

REVERSED