

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DAVID JUNIMAN

\_\_\_\_\_  
Appeal No. 96-3446  
Application 08/327,147<sup>1</sup>

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HEARD: May 5, 1999

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Before CALVERT, Administrative Patent Judge, and McCANDLISH, Senior Administrative Patent Judge and ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 8, all the claims in the application.

The claims on appeal are drawn to a stocking (claims 1, 3 and 6), dancing tights (claims 2, 4 and 7), and a method of using a stocking (claims 5 and 8). Claim 6 is illustrative, and reads:

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<sup>1</sup> Application for patent filed October 21, 1994. According to appellant, this application is a continuation of Application 08/106,807, filed August 16, 1993, which is a continuation of Application 07/891,039, filed June 1, 1992.

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6. A tubular seamless stocking knitted on a circular knitting machine with reciprocating cylinders, said stocking comprising a main tubular portion, a toe pocket portion attached to one end of the main tubular portion, and a foot opening collar comprising a tubular collar attached to the border of the main tubular portion and to the edge of the toe pocket portion, wherein said foot opening collar is adapted to provide an opening having sufficient size and stretchability to permit the entire foot of the wearer to pass through the opening thereby allowing the wearer to wear the stocking alternatively in a footed or footless manner.

The prior art applied in the final rejection is:

Bounous et al. (Bounous)	3,905,212	Sept. 16, 1975
Bédier	4,445,345	May 1, 1984
Wormser	5,067,179	Nov. 26, 1991

The admitted prior art in the declarations under 37 CFR § 1.132 of Leslie Roy Score and Delphine Del Bello Spencer, filed on August 16, 1993 in parent application 08/106,807, of which the instant application is a file wrapper continuation under 37 CFR § 1.62 (APA).

The appealed claims stand finally rejected on the following grounds:

- (1) Claims 1 and 6, anticipated by Bounous, under 35 U.S.C. § 102(b);
- (2) Claims 1, 3 and 6, unpatentable over Bounous, under 35 U.S.C. § 103;
- (3) Claims 2, 4 and 7, unpatentable over Bounous in view of Bédier, under 35 U.S.C. § 103;
- (4) Claims 5 and 8, unpatentable over Bounous in view of Bédier and Wormser, under 35 U.S.C. § 103;
- (5) Claims 1 to 8, unpatentable over the APA in view of Bounous, under 35 U.S.C. § 103.

Rejection (1)

"To anticipate a claim, a prior art reference must disclose every limitation of the claimed

invention, either explicitly or inherently." In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). In the present case, the Bounous patent discloses a stocking having an opening at the lower end surrounded by a collar providing a "mock rib appearance". The purpose of the opening is to allow inspection of the wearer's toes (col. 1, lines 36 to 50), and consequently the opening is made to provide "sufficient stretch ... to permit the toe end of the stocking to be removed from the toes of the wearer so that the toes may pass through the opening for inspection purposes" (col. 3, lines 63 to 67); this is shown in Fig. 6.

Appellant argues that Bounous does not meet the limitation of claims 1 and 6 that the collar provides an opening sufficient "to permit the entire foot of the wearer to pass through the opening". Since Bounous does not expressly disclose this limitation, it cannot anticipate claims 1 and 6 unless this limitation is inherently disclosed. The examiner asserts that it is, stating at pages 4 to 5 of the answer:

It is inherent from the choice of yarns and the construction of the proposed modifications provided in columns 3 and 4 of Bounous et al., as discussed above, that the opening would have had sufficient stretch provided to allow the entire foot of the wearer to pass therethrough.

Also, at pages 10 to 11:

Bounous et al. discloses that the opening size may be made in looser or tighter configuration according to the end need. This inherently allows the toe opening to be made with sufficient stretch to fit over the entire foot. The requirement of sufficient stretch as claimed is understood to provide enough stretch to allow the foot to pass through the hole without tearing the yarns around or within the hole. This meaning affords the hole of Bounous et al. to be constructed within the disclosed method since the opening is positioned rearwardly of the toes (column 1, lines

55-56) and therefore would have to stretch over the toes for the inspection thereof. This stretch would have offered ample stretch for the entire foot to pass therethrough due to the placement of the opening in the bottom of the foot.

After fully considering the record in light of the arguments presented in appellant's brief and the examiner's answer, we agree with appellants that the above-quoted limitation concerning the size of the opening is not inherent in Bounous. We note initially that the examiner's remarks concerning modifications proposed by Bounous concern the question of whether it would have been obvious to modify the Bounous stocking, a matter which relates to patentability under § 103, rather than § 102. Secondly, in order for a claimed limitation to be anticipated by inherency, it must be "the natural result flowing from the operation as taught" in the reference and be inevitably present therein. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). In this case, the fact that the opening of Bounous' stocking is sized to fit over the wearer's toes does not necessarily mean that it would also be sufficiently large to permit the entire foot of the wearer to pass through, since the opening would have to stretch to a larger size to fit over the heel than it would to fit over the toes. Third, we note that Bounous discloses at col. 1, lines 50 to 53 that the stocking's leg and foot portions are "knit with stretchable yarn to provide a compressible force against the leg and foot of the wearer". This would militate against the stocking being so loose on the wearer's foot that the opening would fit over the entire foot.

Rejection (1) will therefore not be sustained.

Rejection (2)

Rejection (2) will not be sustained. Even if Bounous suggests that "the construction of the opening [20] may be modified to offer more or less stretch in the opening" (answer, page 4), the claimed subject matter would not have been obvious because there is no teaching or suggestion in Bounous that the opening may be made sufficient to permit the entire foot of the wearer to pass through it, as required by the rejected claims.

Rejections (3) and (4)

These rejections will likewise not be sustained, since neither Bédier nor Wormser supplies the above-discussed deficiency of Bounous.

Rejection (5)

As noted above, the APA on which this rejection is based on consists of the declarations of Score and Spencer, dated July 30, 1993, and August 12, 1993, respectively. Score, formerly a dancer with the New York City Ballet, is the owner of a retail store in Saratoga Springs, New York, specializing in products for dancers, and Spencer, a dance professional, is the owner and director of the Dance Institute in Feasterville, Pennsylvania. The pertinent portions of the two declarations are

substantially the same; that of Spencer's declaration states:

I am familiar with the PRIMA SOFT dance tights sold by Mr. David Juniman of Footloose Dancewear. I am also familiar with the usage and availability of tights in the dance field. Prior to the introduction of the PRIMA SOFT tights by Mr. Juniman, it was customary among dancers to modify a standard pair of footed

tights by cutting a slit or hole in each foot of the tights. The tights could then be used as footed or footless tights interchangeably without having to completely change the tights. However, the slit eventually caused runs in the tights which would then have to be replaced.

The examiner takes the position that (answer, pages 8 to 9):

Applicant has admitted in the declarations of Score and Spencer that it is well known for dancers to take footed dance tights and cut a hole or slit in the bottom thereof so as to allow the dancer to wear the tight in a footed or footless manner while dancing. The importance of the wearing of the tight in either manner allows for the dancer to continue to wear the tight in both ballet and jazz dances. This affords the dancer the ability to quickly move from one type of dance, such as ballet where the foot must be covered, to another type of dance, such as jazz where the foot is left uncovered, without having to change tights. As mentioned in the declarations of both Score and Spencer the disadvantage of cutting the known type tights is that they eventually begin to run and become unusable. Bounous et al. discloses forming a hole in the bottom of stockings, in the manner as claimed, by using a circular knitting machine and forming a toe pocket and also providing a collar about the hole to allow for the reinforcement of the formed hole . . . . It would have been obvious to one of ordinary skill in the art to have formed a pair of dance tights in the known manner, as defined in the declarations of Score and Spencer, with a toe pocket and collar as disclosed in Bounous et al. so as to provide a permanent opening in the bottom of the tights that would allow multiple use of the tights without degradation in the manner of runs, pulls or holes caused by cutting of the knit stitches. As to wearing of the tights for dancing, since the admitted prior art is specifically designed for dancing, the wearing of the tights in the manner claimed would have been an obvious method of use.

Although appellant argues that Bounous does not suggest modification of the APA, we do not agree. As indicated in the APA, making a slit or hole in tights to allow footed or footless use eventually caused the tights to run. Bounous suggests a solution to this problem, namely, by knitting the tights with a collar and seam 22 which "prevent[s] raveling of the fabric" (col. 3, line 57). In view of this teaching of Bounous, we consider that it would have been prima facie obvious to one of ordinary skill, having knowledge of the custom of cutting a foot hole in dance tights as described in the APA, to make tights with a collar and seam surrounding the foot hole in order to avoid the problem of runs or raveling.

Having determined that a prima facie case of obviousness has been established, we now evaluate the evidence directed to secondary considerations to determine whether it is sufficient to rebut the prima facie case. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Appellant argues that the Score and Spencer declarations, together with three declarations by the appellant (Juniman I, II and IV declarations, dated July 27, 1993, October 18, 1994, and March 30, 1995, respectively), are

(a) evidence of long felt need for a product and method to solve the problems solved by applicant's invention as well as (b) evidence of commercial success of the invention. The commercial success is evidenced by rapid trade acceptance directly attributable to the features and advantages of the invention. (Brief, page 12).

The claimed tights are sold by appellant under the name PRIMA SOFT. Spencer states in her declaration that:

Despite a long-felt need within the dance profession for a solution to the problem of

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runs in the tights caused by slits, no other product was available before the the PRIMA SOFT tights.

Score also states that there was "a long felt need within the dance community for a remedy to the problem of runs in the tights caused by slits". Also:

As a small business owner, I am very careful about adding new products to my offerings and I do not purchase an inventory of new products without close scrutiny. However, I found the features of the PRIMA SOFT tights to be appealing, and decided to stock the product in my store. Since I first introduced the tights, my sales of the product have been very brisk. I have had to re-order the PRIMA SOFT tights frequently in order to keep them in stock. In short, The PRIMA SOFT tights have been a very successful product. In my opinion, the commercial success of the PRIMA SOFT tights is primarily attributable to the features that I outlined above.

The following are excerpts from appellant's Declaration II which is, in essence, an update of his declaration I:

In a total market that I estimate to be about 300 professional dancewear retail stores, my invention was introduced and purchased wholesale by more than 150 of these stores within a period from August, 1991 and June, 1993. The first commercial sales began in May, 1992.

\* \* \* \*

Attached as Exhibit I is a chart illustrating the number of new retail store accounts which I acquired and to whom I sold the PRIMA SOFT product to during each month. Exhibit II graphically illustrates the substantial growth in the total number of retail accounts to whom I sold the convertible tights during the period referred to in my earlier declaration. In the period from May, 1992 through June, 1994, the total number of dancewear stores that carry my PRIMA SOFT product grew from 0 to 265. This growth in retail accounts from the introduction of my product through June, 1994 is illustrated in Exhibit III.

The customers are located in most of the 50 states throughout the country and I

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have sold to customers in Puerto Rico, Canada, Japan, Philippines and Singapore. Additional, I have sold the PRIMA SOFT tights to approximately 50 ballet schools and thousands of individual dancers.

\* \* \* \*

The only advertising that I have placed with respect to the PRIMA SOFT product is the block advertisement in the monthly magazine Dance as illustrated in the Examiner's Answer. I began running this single ad in the June, 1992 issue of Dance. No ad appeared in the July, 1992 issue. Thereafter, beginning in August, 1992, I ran the ad each month in Dance magazine. Subsequently, the ad was changed (as illustrated in Exhibit IV) in 1993 to introduce a second unrelated product.

Most companies in this industry employ or contract sales personnel to promote and sell their dance-related products to retail store accounts. Unlike other companies, I have had no promotion of the PRIMA SOFT product through salespersons. I have relied solely on the features of the product and the minimal advertising as set forth above. The typical response to the ad is not a wholesale purchase order from the retailer, but rather a request for a product sample. Typically, new retail accounts have placed orders only after they have satisfactorily tried and tested the PRIMA SOFT product. Therefore, in my opinion, it is the technical features of the product that are the cause for the purchase by the retail accounts and commercial success.

In his Declaration IV, appellant asserts that recently (i.e., in early 1995), two competitors, Bloch, Inc. and Capezio/Ballet Makers, Inc., had copied his invention and launched competitive products.

However, at the oral hearing counsel for appellant acknowledged that appellant's (article) claims were not readable on the Capezio product.

The examiner in his answer finds this evidence insufficient to overcome the rejection because no nexus between the commercial success and the claimed invention has been shown, citing In re Mageli, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973)) and In re Noznick, 478 F.2d 1260, 178 USPQ 43

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(CCPA 1973). In particular, the examiner stresses that "there is no

indication that sales were not the result of advertising or other extraneous factors not related to the invention" (answer, page 15).

It is well settled that, to consider objective evidence of nonobviousness, the applicant has the burden of showing that there is a nexus, i.e., a legally and factually significant connection, between the proven success and the claimed invention. In re Paulsen, 30 F.3d 1475, 1482, 31 USPQ2d 1671, 1676 (Fed. Cir. 1994). We consider that appellant has carried that burden here. The invention in issue is a relatively simple one, involving a dance stocking or pair of tights which are conventional except for the presence at the lower end of a foot hole surrounded by a collar. Since the PRIMA SOFT tights do not appear to include any feature distinguishing them from conventional tights other than the claimed foot hole, it seems evident that the claimed invention was the reason for the growth in the number of dancewear stores carrying the PRIMA SOFT tights (to 265 stores out of an estimated 300, according to appellant's Declaration II), in other words, that there was a nexus between the claimed invention and the commercial success of the PRIMA SOFT tights. This is borne out by the above-quoted statements from the Score declaration.

The evidence also does not show that the commercial success of the PRIMA SOFT tights was due to factors other than the invention, such as extensive advertising and marketing. As

appellant states in Declaration II, the only advertising of the tights was a monthly advertisement in Dance magazine, and he did not employ or contract any sales personnel to promote and sell the product, but "relied solely on the features of the product and the minimal advertising [in Dance magazine]

as set forth above." We do not regard this advertising as indicative that sales of the PRIMA SOFT tights were not due to the claimed invention. Some amount of advertising is generally necessary to bring a new product to the attention of the relevant market, and appellant's advertisements (which are quite modest in size<sup>2</sup>) emphasize the claimed invention, i.e., show the foot hole and state that the tights are "convertible" and "worn footed or footless without cutting". This case thus differs from the In re Mageli and In re Noznick cases cited by the examiner, where in Mageli, for example, the Court observed that "the sales could have resulted from a large advertising campaign, price concessions to get the product moving, or purchases by an affiliate or controlled company rather than from the

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<sup>2</sup> A copy of an advertisement from the October 1992 issue of Dance magazine is attached to the examiner's answer in parent application 08/106,807, and a copy of an advertisement from the August 1993 issue is attached to appellant's Declaration II as Exhibit IV.

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advantageous attributes of the claimed compound" (470 F.2 at 1383-84, 176 USPQ at 308).

Accordingly, we conclude that the evidence of secondary considerations submitted by appellant is sufficient to overcome the prima facie case of obviousness as to the claimed subject matter.

Rejection (5) will therefore not be sustained.

Conclusion

The examiner's decision to reject claims 1 to 8 is reversed.

REVERSED

IAN A. CALVERT )  
Administrative Patent Judge )  
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HARRISON E. McCANDLISH )  
Senior Administrative Patent Judge )  
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NEAL E. ABRAMS )  
Administrative Patent Judge )

IAC/dal

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JOHN P. BLASKO  
J P BLASKO LAW OFFICES  
111 NORTH BROAD STREET  
DOYLESTOWN, PA 18901