

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARY B. MACKLEY

Appeal No. 97-0771
Application No. 08/405,385¹

ON BRIEF

Before COHEN, ABRAMS and STAAB, *Administrative Patent Judges*.
STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 15-21, all the claims currently pending in the application.

¹ Application for patent filed March 15, 1995. According to the appellant, the application is a continuation of Application 08/191,114, filed February 3, 1994, now abandoned.

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Appellant's invention pertains to a shorts type garment for providing protection from environmental elements. Independent claim 15, a copy of which is found in the appendix to appellant's brief, is illustrative of the appealed subject matter.

The references of record relied upon by the examiner in support of rejections under 35 U.S.C. § 103 are:

Guithues 1948	2,446,326	Aug. 3,
Finlay 1982	4,310,929	Jan. 19,
Boll 23, 1990	4,894,869	Jan.

Claims 15-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Finlay in view of Boll. Claim 21 stands similarly rejected with further reliance on Guithues.

It is the examiner's foundation position that Finlay discloses all the structure called for in claim 15, except for the outer and inner panels not being made of the materials claimed. The examiner contends, however, that it would have been obvious to one of ordinary skill in the art in view of the teachings of Boll "to modify the Finlay garment to incorporate the material layers as claimed to protect the

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wearer from cold, moist surfaces during outdoor activity"
(answer, page 3), and thereby arrive at the subject matter of
claim 15.

Appellant argues that there is no suggestion in the
applied references for combining them in the manner proposed
by the examiner. In addition, appellant argues that Finlay
does not disclose the closure devices called for in the last
paragraph of claim 15, such that even if Finlay were modified
in the manner proposed, the subject matter of claim 15 would
not result.

Independent claim 15, the sole independent claim on
appeal, calls for a garment comprising inner and outer panels
joined together by a crotch portion to define a front primary
flap and a rear primary flap. The outer panel is made of a
material which forms a barrier against moisture penetration,
and the inner panel is made of a lining material. In the last
paragraph, claim 15 further calls for a pair of closure
devices than can be repeatedly closed and opened

for joining [the] left side of said front primary
flap to [the] left side of said rear primary flap
over the left hip and waist areas of the wearer and
for joining [the] right side of said primary flap to

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[the] right side of said rear primary flap over the right hip and waist areas of the wearer.

Finlay, the examiner's primary reference, is directed to wraparound reversible running shorts. The Finlay garment comprises first and second panels secured together in facing relationship to form an hourglass shape when laid out flat. See Figure 4. In use, the narrow part of the hourglass shape becomes the crotch portion and the upper and lower edges become the waist band of the shorts garment. Pile and hook fasteners 34, 35 are provided at the ends of the upper and lower edges where the edges meet the sides of the hourglass shape to hold the waist band together. Although not expressly stated, it reasonably appears that the curved sides to the hourglass shape are of sufficient extent so that, in use, they overlap to avoid undue exposure of the wearer's hip area.

Boll is directed to a protective under garment. The Boll under garment comprises waist and leg bands, and a rear panel having a waterproof outer surface and an absorptive inner surface. An objective of Boll is to provide comfort, dryness and warmth to a wearer engaged in outdoor activity that may include sitting on cold and damp ground. Boll indicates that

prior art waterproof trousers and the like lack adequate ventilation and therefore may become too hot and restrictive (column 1, lines 58-60; column 2, lines 8-10). To overcome this alleged deficiency of the prior art, Boll's garment is "open faced" (i.e., without a front panel) to provide adequate ventilation and prevent overheating. See column 2, lines 8-10 and lines 56-58.

We take up first for consideration the examiner's determination that it would have been obvious to modify Finlay's garment in view of Boll to provide material layers as claimed. It is not clear precisely how the examiner intends to "incorporate" the teachings of Boll into Finlay's garment. Presumably, the examiner intends to make one or the other of the panels 4, 6 of Finlay of material that forms a moisture barrier, while making the other one of the panels as a lining material. Alternatively, it may be that the examiner intends to modify Finlay by incorporating material that forms a moisture barrier into only the rear primary flap portion of one or both of Finlay's panels 4, 6.² In any event,

²It is questionable whether that latter modification would result in the subject matter of claim 15.

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regardless of the modification intended, the examiner's position is not well taken.

Finlay's shorts garment is "particularly . . . suited for runners or joggers" (column 1, lines 5-6). As such, the artisan would reasonably presume that it would be advantageous to use fabric in the construction of Finlay's garment that provides for a certain amount of breathability. Turning to Boll, based on the teaching thereof that prior art waterproof garments lack adequate ventilation and that the way to alleviate this problem is to provide an "open faced" garment, it is our view that one of ordinary skill in the art would consider Boll's waterproof material to be ill suited for use in the construction of Finlay's garment because it would make Finlay's running shorts hot and uncomfortable to a runner or jogger. Accordingly, we agree with appellant that it would not have been obvious to one of ordinary skill in the art to modify Finlay by incorporating into one of the panels thereof a material which forms a barrier against moisture penetration, as proposed by the examiner, in view of the teachings of Boll. This constitutes a first reason necessitating reversal of the examiner's rejection of claims 15-20.

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The closure devices called for in the last paragraph of claim 15 are described as joining the left and right *sides* of the front primary flap to the respective left and right *sides* of the rear primary flap over the waist *and hip* areas of the wearer. While it is true that claims are to be given their broadest reasonable interpretation in proceeding before the PTO, this interpretation must be consistent with the specification and construed as those of ordinary skill in the art would construe them. See *In re Bond*, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990); *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 986, 6 USPQ2d 1601, 1604 (Fed. Cir. 1988) and *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Here, we believe one of ordinary skill in the art would interpret the closure device language of claim 15 as requiring the closure devices to extend a substantial distance along the sides of the primary flaps in order to join the front and rear primary flaps over both the waist area and the hip area of the wearer, as now claimed. While we appreciate that the closure fasteners 34, 35 of Finlay located in the corners of the hourglass shape may be said to extend,

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at least to some extent, along the sides of the front and rear primary panel, it is our view, based on the above interpretation, that this circumstance does not justify a finding that the closure fasteners 34, 35 of Finlay satisfy the closure device limitation of claim 15. The examiner's determination to the contrary is based on an unreasonable interpretation of the claim language, in our view. In that Boll does not overcome this deficiency of Finlay, we conclude, as did appellant, that even if Finlay were modified in the manner proposed by the examiner the subject matter of claim 15 would not result. This constitutes a second reason necessitating reversal of the examiner's rejection of claims 15-20.

In light of the foregoing, we will not sustain the standing § 103 rejection of claims 15-20 as being unpatentable over Finlay in view of Boll. We have also reviewed the Guithues reference additionally relied upon by the examiner in the rejection of dependent claim 21 but find nothing therein that makes up for the deficiencies of Finlay and Boll discussed above. Accordingly, we also will not sustain the standing § 103 rejection of claim 21.

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The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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LAWRENCE J. STAAB)	
Administrative Patent Judge)	

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