

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN J. LAWLER

Appeal No. 98-2136
Application No. 08/497,634¹

ON BRIEF

Before CALVERT, ABRAMS, and STAAB, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed June 30, 1995. According to Appellant this application is a continuation of Application No. 08/205,658, now abandoned.

Appeal No. 98-2136
Application No. 08/497,634

This is an appeal from the final rejection of claims 2 to 6 and 25, all the claims remaining in the application.

Appellant's invention concerns a garment having a pocket, and a toy animal insertable into the pocket. A pictorial representation of a habitat on the garment is so related to the pocket that the opening in the pocket coincides with a representation of an opening into a habitat element (e.g., a hollow stump) into which the toy animal (e.g., a squirrel) may be placed. The claims on appeal are reproduced in the appendix to appellant's brief.

The reference applied in the final rejection is:

Stocker et al. (Stocker)	5,210,881	May
18, 1993		

Claims 2 to 6 and 25 stand finally rejected under 35 U.S.C. § 103 as unpatentable over Stocker.

The basis of the rejection of claim 25, the only independent claim on appeal, is stated on page 3 of the examiner's answer as:

Stocker, Jr. et al. discloses, in combination, at least one toy animal (12) and a garment (10) having a pocket (11) with an opening into the pocket (11) and a pictorial presentation (30) applied to the garment (10)

Appeal No. 98-2136
Application No. 08/497,634

with the representation being of a habitat (i.e. - a tree; see Stocker, Jr. et al., col. 2, line 63-col. 3, line 29) for the animal wherein the opening for the pocket is within the pictorial representation. However, Stocker, Jr. et al. does not specifically disclose the pictorial representation as being over at least a portion of the pocket or the opening of the pocket as being coincident with the opening of the interior space. The specific orientation of the pictorial representation and the content of the pictorial representation itself is a matter of design choice for aesthetic purposes. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the garment of Stocker, Jr. et al. to place the pictorial representation on the pocket for aesthetic purposes to achieve a desired aesthetic effect.

After fully considering the record in light of the arguments presented in the appellant's brief and the examiner's answer, we conclude that the claims on appeal are patentable over Stocker.

In the portion of Stocker referred to by the examiner, supra, it is disclosed that the garment (shirt) 10 may have a tree branch printed on it, and the toy 12 "positioned in the pocket 11 to make it appear that the toy, which may be a koala bear, is nested on the tree branch" (col. 3, lines 2 to 4). The examiner further refers to col. 1, lines 39 to 48, wherein

Appeal No. 98-2136
Application No. 08/497,634

Stocker discloses an example of "a jungle scene which shows a tree branch printed on the garment and a teddy bear nested in the tree branch," and to Stocker's disclosure at col. 3, lines 16 to 29, that there is "a 'hide and seek' aspect to the arrangement of such a garment pocket and toy, which captivates the child."

We do not consider that Stocker, and particularly the disclosure thereof referred to by the examiner, would have suggested appellant's claimed structure to one of ordinary skill in the art. The content of the pictorial representation is not merely "a matter of design choice for aesthetic purposes," as the examiner argues, supra, but rather is related to the structure of the garment in that the opening into the pocket of the garment is coincident with the opening into the interior space of the habitat element depicted on the pocket. Thus, there is a functional relationship between the pictorial representation on the garment and the structure of the garment itself. Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). This relationship is not taught by Stocker. The fact that Stocker states that the garment may be printed with a tree branch so that it appears

Appeal No. 98-2136
Application No. 08/497,634

that a toy koala bear in the pocket "is nested on the tree branch" (col. 3, line 4), does not suggest the claimed invention because a tree branch is not "a habitat element which has an interior space," as claimed, and there is no indication that a nest be printed on the pocket.² Further militating against any suggestion that a nest, hollow stump, or other such habitat element with an interior space be depicted on the pocket 12 of Stocker is the fact that the pocket is constructed so that the appendages of the toy protrude from slits in the sides of the pocket, which would tend to destroy the appearance of the pocket as being a nest or the like.

We do not regard Stocker's disclosure concerning the "hide and seek" aspect of his pocket and toy as being of significance, as that would be true of any toy which is insertable into and removable from a pocket.

Accordingly, the rejection will not be sustained.

² This assumes that koala bears have nests, which we doubt.

Appeal No. 98-2136
Application No. 08/497,634

Conclusion

The examiner's decision to reject claims 2 to 6 and 25 is reversed.

REVERSED

IAN A. CALVERT)	
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)	

Appeal No. 98-2136
Application No. 08/497,634

Boris Haskell
2316 South Eads Street
Arlington, VA 22202

Shereece

Appeal No. 98-2136
Application No. 08/497,634

APJ CALVERT

APJ ABRAMS

APJ STAAB

REVERSED

Prepared: April 12, 2000