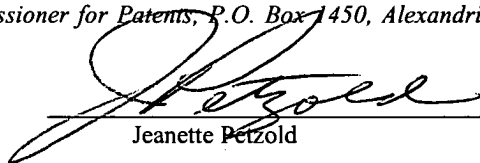




PATENT

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Jeanette Petzold

Appl No. : 11/053,211 Confirmation No. 6748  
Applicant : David E. Chen, et al.  
Filed : February 7, 2005  
Title : ATTACHABLE BREAST FORM ENHANCEMENT SYSTEM  
TC/A.U. : 3765  
Examiner : Gloria M. Hale  
Docket No. : 54378/B437  
Customer No. : 23363

**AMENDMENT**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Post Office Box 7068  
Pasadena, CA 91109-7068  
January 23, 2006

Commissioner:

In response to the Office action of November 1, 2005, please amend the above-identified application as follows:

**Amendments to the Claims** are reflected in the listing of claims, which begins on page 2 of this paper.

**Remarks/Arguments** begin on page 4 of this paper.

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**Amendments to the Claims:**

This listing of claims will replace all prior versions, and listings, of claims in the application:

**Listing of Claims:**

1. (Currently Amended) An improved backless, strapless breast form system to be worn in place of a traditional bra, comprising:

a pair of breast forms, wherein each breast form comprises:

a volume of silicone gel encased between thermoplastic film material;

~~an eoneave~~ interior surface shaped to fit over a natural female breast facing towards a user's breast having a pressure sensitive adhesive layer for securing the breast form to the user's breast; and

a connector adapted to adjoin the breast forms together, wherein the connector is positioned between inner sides of each of the breast forms.

2. (Original) The breast form system of claim 1 wherein the connector comprises a first portion attached to the inner side of one of the breast forms and a second portion attached to the inner side of the other breast form, and the first portion and the second portion are adapted to cooperatively engage.

3. (Original) The breast form system of claim 2 wherein the first portion includes a clasp and the second portion includes a plurality of loops adapted to receive the clasp.

4. (Original) The breast form system of claim 2 wherein the first portion and the second portion are removably attached to the breast forms.

5. (Original) The breast form system of claim 2 wherein the first portion and the second portion are permanently attached to the breast forms.

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6. (Original) The breast form system of claim 2 wherein the first portion comprises a strip having a plurality of minute hooks and the second portion comprises a corresponding strip with a surface of uncut pile.

7. (Original) The breast form system of claim 1 wherein the connector is a single unit adapted to removably adjoin to the inner side of each of the breast forms.

8. (Original) The breast form system of claim 1 wherein the connector is a single unit permanently adjoined to the inner side of each of the breast forms.

9. (Original) The breast form system of claim 8 wherein the connector comprises an elastic material.

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**REMARKS/ARGUMENTS**

Claims 1-9 remain in the present application, of which claim 1 is independent. Claim 1 has been amended without introducing any new matter in the present application. More specifically, the language "a concave interior surface" has been modified to read "an interior surface shaped to fit over a natural female breast." This modification is supported by the specification and expresses accurately the characteristics of the interior surface of the present invention. Therefore, Applicant respectfully submits that this amendment places the application in condition for allowance. Applicant responds to each point raised by the Examiner in the November 1, 2005 Office action as follows:

**Claim Rejection under 35 U.S.C. § 103(a)**

Claims 1, 2 and 5 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Noble et al. ("Noble" U.S. Pat. No. 5,755,611) in view of Mulligan et al. ("Mulligan" U.S. Pat. No. 5,922,023). Applicant submits that all relevant elements disclosed in Mulligan have been previously disclosed in art already considered during the prosecution history, and thus Mulligan is merely cumulative of previously cited art. (See "Wild" U.S. Pat. No. 5,584,883). Regardless, Applicant respectfully traverses this claim rejection because there is no motivation to combine the cited references.

Noble et al. and Mulligan et al. are directed to two very different purposes. Noble et al. relates to a bra requiring no straps or hooks. (See Col. 1, lns. 7-8). As such, its invention is designed, necessarily, to work with both breasts. (See Col. 2, lns. 26-28.) Moreover, in particular, it is an object of Noble et al. to provide a bra that feels like skin. (See Col. 2, lns. 29-30). On the other hand, Mulligan et al. relates to a breast prosthesis. (See Col. 1, ln. 4). That is, to a replacement for a single breast. While the invention of Mulligan et al. may be used in connection with a bra worn over the prosthesis, it is in no way intended to be a bra. There is no suggestion in Mulligan et al. that its prosthesis could be used as part of a bra. Rather, Mulligan

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et al. suggests only use to replace a surgically removed breast. Its adaptation to work with scar tissue makes this readily apparent. Thus, nothing in the distinct and different purposes and applications of Noble et al. and Mulligan et al. would suggest a combination to achieve the Applicant's invention.

Typically, when a breast is removed, for example because of cancer, only one breast must be removed. Therefore, a typical breast prosthesis is used on only one side of the user's chest. Hence, no connectors are needed to connect multiple prostheses because only one prosthesis is in use. Mulligan follows this line of reasoning, disclosing a prosthesis device, that consists of "two shell-like bodies," used to replace a single breast. (*emphasis added*) (See Col. 4, ln. 8). Therefore, because Mulligan discloses a breast prosthesis, which is typically only needed to replace one breast, there would be no motivation for one skilled in the art to modify said breast prosthesis to include two prostheses linked together with a connector. Indeed, addition of a connector would unduly limit the use of a prosthesis and unnecessarily increase the cost and complication of manufacture.

Furthermore, Mulligan discloses a prosthesis having an interior surface with a "gel-like consistency," which enables the interior surface to be adapted "to the irregularities of the skin of the user, for instance to scars caused by an operation." (See Col. 3, lns. 8-11). Thus, Mulligan discloses a device that is intended to fit over the void created by the removal of a "natural female breast." Therefore, one skilled in the art would not be motivated to modify Mulligan to fit over a "natural female breast."

For example, Noble discloses a bra cup that is "adapted to receive a portion of the breast," so that "the upper part of the woman's breast is revealed." (See Col. 2, lns. 38-39 and Col. 4, lns. 39-40). Therefore, only a portion of the woman's breast is covered by the bra cup. Hence, if the silicone-filled shell disclosed in Mulligan, which is intended to replace an entire breast, were to be combined with the partial bra cup of Noble, only a portion of the user's breast would have to be covered with the silicone-filled shell. Yet Mulligan provides no guidance on

how its prosthesis could be modified to accomplish such a configuration. Therefore one skilled in the art would not be motivated to modify the bra cup in Noble to include a silicone-filled shell.

Moreover, Noble discloses a device, which comprises "a soft, skin-like cup." (*See* Col. 2, ln. 38). Such a thin, "skin-like cup" would tend to be lightweight when worn on the user's breast. Conversely, Mulligan discloses a prosthesis, which comprises two "shell-like bodies" filled with "silicone compositions" and formed into the shape of a female breast. (*See* Abstract). Therefore, there would be no motivation for one skilled in the art to modify the invention disclosed in Noble to include thick, heavy silicone-filled shells in place of lightweight, "skin-like cups" for placing over female breasts.

Additionally, the term "concave" previously used to define the interior surface in claim one in the present invention was adopted to emphasize that it was configured to fit over a natural female breast, unlike a prosthesis. Thus, it is more accurately defined as "shaped to fit over a natural female breast." This language clearly distinguishes the subject matter disclosed in Mulligan. For example, as mentioned above, Mulligan discloses an interior surface that can be adapted "to the irregularities of the skin of the user, for instance to scars caused by an operation." (*See* Col. 3, lns. 8-11). Given that scars caused by the removal of a breast tend to be shaped quite differently than the shape of a "natural female breast," Mulligan, or any combination including Mulligan, teaches away from an apparatus with an interior surface shaped like a "natural female breast."

Accordingly, there would be no motivation for one skilled in the art to combine Noble and Mulligan and thus claim 1 of the present invention is patentable over Noble in view of Mulligan. Furthermore, because claims 2 and 5 all depend, either directly or indirectly, from claim 1, these claims are also patentable over Noble in view of Mulligan for at least the reasons set forth above for claim 1. Accordingly, Applicant respectfully requests that the rejections to claims 1, 2, and 5 under 35 U.S.C. § 103(a) be reconsidered and withdrawn, and the claims allowed.

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Moreover, claim 6 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Noble in view of Mulligan in further view of Johnstone ("Johnstone" U.S. Pat. No. 5,538,502). However, because claim 6 depends indirectly from claim 1, and Johnstone does not overcome the deficiencies of Noble and Mulligan in rejecting claim 1, claim 6 is patentable over Noble in view of Mulligan in further view of Johnstone. Accordingly, Applicant respectfully requests that the rejection to claim 6 under 35 U.S.C. § 103(a) be reconsidered and withdrawn, and the claim be allowed.

Likewise, claims 3 and 4 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Noble in view of Mulligan in further view of Barg ("Barg" U.S. Pat. No. 2,882,905). However, because claims 3 and 4 depend indirectly from claim 1, and Barg does not overcome the deficiencies of Noble and Mulligan in rejecting claim 1, claims 3 and 4 are patentable over Noble in view of Mulligan in further view of Barg. Accordingly, Applicant respectfully requests that the rejections to claims 3 and 4 under 35 U.S.C. § 103(a) be reconsidered and withdrawn, and the claims be allowed.

Furthermore, claims 7 and 8 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Noble in view of Mulligan in further view of Conde ("Conde" U.S. Pat. No. 2,579,365). However, because claims 7 and 8 depend directly from claim 1, and Conde does not overcome the deficiencies of Noble and Mulligan in rejecting claim 1, claims 7 and 8 are patentable over Noble in view of Mulligan in further view of Conde. Accordingly, Applicant respectfully requests that the rejections to claims 7 and 8 under 35 U.S.C. § 103(a) be reconsidered and withdrawn, and the claims be allowed.

Moreover, claims 8 and 9 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Noble in view of Mulligan in further view of Panighini ("Panighini" U.S. Pat. No. 2,793,369). However, because claims 8 and 9 depend, either directly or indirectly, from claim 1, and Panighini does not overcome the deficiencies of Noble and Mulligan in rejecting claim 1, claims 8 and 9 are patentable over Noble in view of Mulligan in further view of

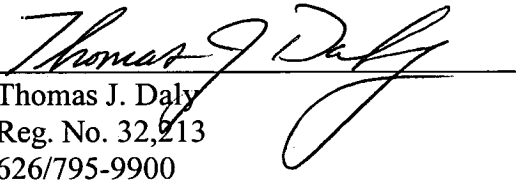
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Panighini. Accordingly, Applicant respectfully requests that the rejection to claims 8 and 9 under 35 U.S.C. § 103(a) be reconsidered and withdrawn, and the claims be allowed.

**Conclusion**

In view of the foregoing amendment and remarks, Applicant respectfully submits that this application, including claims 1-9, is in condition for allowance and, accordingly, a timely indication thereof is respectfully requested.

Respectfully submitted,  
CHRISTIE, PARKER & HALE, LLP

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