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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/159,251	05/31/2002	David E. Chen	48370/GTL/B437	8795
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CHRISTIE, PARKER & HALE, LLP 350 WEST COLORADO BOULEVARD SUITE 500 PASADENA, CA 91105			EXAMINER HALE, GLORIA M	
			ART UNIT 3765	PAPER NUMBER

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/159,251

Applicant(s)
Chen

Examiner
Gloria Hale

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 6, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 16-29 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 16-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Claim Objections

1. Claims 5 and 19 are objected to because of the following informalities: The use of the trademark VELCRO should be avoided in the claims since it is owned by another. Only the generic terminology in the claims should be used since it best identifies the material itself. Claim 19 also refers to a canceled claim. Appropriate correction is required

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-8 and 16-29 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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The use of the term “permanently grown” as used in the present application has not been adequately or fully explained in terminology which is widely known in the art of textile and garment manufacturing. The basic definition of “permanently” and “grown” have not been given in regard to the prior art area of garment manufacturing but only has been given in a separate and general sense. The applicant has also not described in the specification the specific type of adhesive used or the method of application used to yield the “permanently grown” characteristics. Is it just a general adhesive or a special type of adhesive that allows it to be washed etc.? The application of the adhesive in a certain manufacturing step of the pad has not been explained. Therefore it is not clear as to how the adhesive is applied to the pad.

Second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 7,9 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Also, in claim 7, line 2; claim 9, line 2 and claim 16, line 3 it is not clear as to what the term “permanently grown” means.

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Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1,2,7,16,20-23,26,28 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Noble et al (US 5,755,611).

In regard to claims 1,2,7,16,20-23,26,28 and 29 Noble et al discloses a backless, strapless bra (22) comprising a pair of bra cups (22) with an interior surface (38) which comprises pressure sensitive adhesive layer (46,48) to adhere the bra to the user's skin and the connector (50) as broadly claimed. The adhesive of the adhesive layer would inherently seep into the crevices of the fabric used (i.e. within the knit of the tricot fabric) and would therefore be incorporated within the interior surface or fabric which contacts the skin of the wearer. (See Noble et al, figures 18-21; col. 5, line 51- col. 6, line 22). In regard to claim 2, Noble et al discloses the connector with the first and second portions decorative laced tying bands (50) as seen in figure 18 and col. 6, lines 3-6. In regard to claims 7 and 26 the adhesive is permanently given as broadly claimed and defined in the specification since the adhesive would seep into the fabric covering layer next to the wearer's skin and when removed from the wearers body remains on the pad and would therefore have the level of adhesion as claimed. Applicant's own specification on pages 4-6 states that any

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type of padding material structure and adhesive attachment can be used. The preferred method being the silicone pad with the adhesive "permanently grown" into the surface of the pad adjacent the skin of the wearer.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noble et al (US 5,755,611) in view of Barg (2,882,905).

In regard to claim 3, Noble et al discloses the invention substantially as claimed. However, Noble et al does not disclose the specific connector first portion as being a clasp and the second portion as being a plurality of loops. Barg discloses a connector with a clasp 25 and a plurality of loops 24 (See Barg, figure 1) for adjustability and fit. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the fastener of Noble et al with the claimed fastener as disclosed by Barg for improved fit and adjustability.

9. Claims 4, 6, 18, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noble et al. in view of Panighini (2,293,369).

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In regard to claims 4, 6, 18, 24 and 25, Noble et al. discloses the invention substantially as claimed. However, Noble et al does not disclose the specific fastener as claimed. Panighini discloses a fastener with first and second connector portions, the ends of the second which are removably connected to the breast forms at 5. The Panighini fastener is a ring and string as broadly claimed. Accordingly it would have been obvious to one having ordinary skill in the art at the time the invention was made to use such a fastener as disclosed by Panighini for greater adjustability and fit. In regard to claim 6, Panighini is a single unit (2) which engages the inner surface of the breast forms.

(See Panighini, figure 1 and lines 50-63).

10. Claim 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noble et al in view of Johnstone.

Noble et al discloses the invention substantially as claimed. However, Noble et al does not specifically disclose the first and second portion of the fastener as being VELCRO hook and loop fasteners. Johnstone discloses a front bra fastener which use hook and loop fasteners 30,46 to connect the front of the bra while providing improved fit and adjustability. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the hook and loop fastener in place of the Noble et al fastener to provide improved fit and adjustability. (See Johnstone, figure 1 and col. 3, lines 6- col. 4, line 10.)

11. Claims 8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noble et al in view of Huang (6,283,820).

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In regard to claims 8 and 19, Noble et al discloses the invention substantially as claimed.

However, Noble et al does not specifically disclose the breast form upper portion as being thicker than the lower portion or the silicone gel within. Huang discloses a bra breast form with a thermoplastic film material and a fabric layer on one of the thermoplastic sheets with a liquid material therein. The Examiner takes Official Notice that it is well known that silicone gel materials are used in bra pads to add bulk to the wearer's breasts. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a breast form of thermoplastic and fabric with silicone as disclosed by Huang and which is well known in the art. (See Huang, figures).

12. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Noble et al in view of Huang as applied to claims 8 and 19 above, and further in view of Johnstone.

In regard to claim 15, Noble et al and Huang disclose the bra structure as discussed above in regard to claims 8 and 19. However, the fastener used is not a hook and loop fastener as claimed. Johnstone discloses the use of a hook and loop fastener for improved fit and adjustability. Accordingly, it would have been obvious to substitute the fastener of Noble et al and Huang with that of Johnstone in order to provide the improved fit and adjustability. (See Johnstone, fig. 1 and col. 3, line 60-col. 4, line 10).

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Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1-8 and 16-29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12, 17-30 and 35-38 of copending Application No. 10/211110. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are not patently distinct from each other because they claim the same adhesively attached bra cup structure with the same adhesive structure within the interior layer of the cups.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

15. Applicant's arguments with respect to claims 1-8 and 16-21 have been considered but are moot in view of the new ground(s) of rejection.

In regard to the May 30, 2003 telephone interview the applicant's remarks do not state that no agreement was reached. Additionally the examiner stated that the prior art search would be updated especially in view of any amendments to the claims. During the May 30, 2003 telephone conversation the sample of applicant's invention, "The Nubra" was discussed in addition to an adhesive bra with side tabs. No written draft claims were discussed or sent to the examiner at that time. The attorney suggested that the claims would be amended to include language in regard to the "permanently grown" characteristic that the adhesive is within the layer of material adjacent

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to the skin of the wearer.

As indicated in the above rejection the Examiner does not believe that the use of the term “permanently grown” has been clearly defined in the specification nor that it is widely used in the textile/garment manufacturing art. The use of the trademarks in a claim should be avoided if they are owned by another as indicated. The arguments in regard to the claim rejections under 35 USC 102 and 103 are moot in regard to the new rejections above. The newly added claims 22-29 are not allowable over the prior art as stated above. The proposed draft claims submitted, number 30 received by facsimile on 11/19/2003 and number 31 received on 11/21/2003 have been placed in the file but not entered since they do not overcome the prior art of record. The Examiner did not believe that the claims could be amended to overcome the prior art and that any further attempts to amend the claims must be submitted formally. It is noted that the substitution of the Nobel et al pad structure with the pad structure seen in the Dr. Leonard’s catalog, page 15 , a copy of which is included in the present action, would also have been obvious, especially in view of applicant’s statements on pages 4-6 of the specification which indicate that any type of known pad can be used. It also would have been obvious to one of ordinary skill in the art at the time the invention was made to use the silicone pad as seen in the Dr. Leonard’s catalog which is a silicone pad with a polyurethane film covering since the pad is well known in the prior art and known to give a desired aesthetic effect such as smoothness, a certain density and the replication of the texture of a human breast `

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Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gloria Hale whose telephone number is (703) 308-1282.


Gloria Hale

Primary Patent Examiner- AU 3765

December 27, 2003