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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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EXAMINER	
HALE, GLORIA M	
ART UNIT	PAPER NUMBER
3765	7

DATE MAILED: 04/23/2003

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

PTO-90C (Rev. 07-01)

N.K.

Office Action Summary	Application No. 10/159,251	Applicant(s) Chen
	Examiner Gloria Hale	Art Unit 3765

-- 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 _____.

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) *1-21* 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4a) Of the above, claim(s) _____ is/are withdrawn from consideration.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) *1-21* 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)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Specification

1. The use of the trademark VELCRO has been noted in this application. **It should be capitalized wherever it appears and be accompanied by the generic terminology.**

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

2. The disclosure is objected to because of the following informalities: It is not clear as to what is meant by "permanently grown" in the Abstract and Specification..

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3.The following is a quotation of the 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 5,7,9,11 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.

In regard to claims 5 and 11, the term VELCRO has been used which renders the claim indefinite in that it only identifies a source of material and not the material itself. The generic terminology

for VELCRO should be used in the claims. 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.

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 1,2,7,9,13,16,17,20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Valentin (6,231,424).

In regard to claims 1,2,7,9,13,16,17,20 and 21, Valentin discloses a pair of breast forms (12,14) each with an interior surface having a pressure sensitive adhesive (60,62,64) to attach to a wearer's skin and a connector (16) with first (72) and second (74) portions to adjoin the breast forms together as broadly claimed. (See Valentin, figures 1,6,7 col. 2, line 57- col. 4,line 10;col. 4, line 62-col. 5, line 9 and col. 6, lines 58-65).

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 negatived by the manner in which the invention was made.

8. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentin in view of Barg (2,882,905).

In regard to claim 3, Valentin discloses the invention substantially as claimed. However, Valentin 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 thet ime the invention was made to substitute the fastener of Valentin with the claimed fastener as disclosed by Barg for improved fit and adjustability.

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

In regard to claims 4, 6and 18, Valentin discloses the invention substantially as claimed. However, Valentin 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 arta t thet ime 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. Claims 5, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentin in view of Johnstone.

In regard to claims 5, 11 and 12, Valentin discloses the invention substantially as claimed. However, Valentin 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 thet ime the invention was made to use the hook and loop fastener in place of he Valentin fastener to provide improved fit and adjustability. (See Johnstone, figure 1 and col. 3, lines 6- col. 4, line 10.)

11. Claims 8, 14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentin in view of Huang (6,283,820).

In regard to claims 8 and 19, Valentin discloses the invention substantially as claimed. However, Valentin 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 Valentin in view of Huang as applied to claims 8 and 19 above, and further in view of Johnstone.

In regard to claim 15, Valentin 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 Valentin 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).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure..

14. 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

April 19, 2003