

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte IONE PAMELA GORSKI and
CYNTHIA CHIARMONTE-ARCE

Appeal 2008-1094
Application 10/304,769
Technology Center 3700

Decided: June 30, 2008

Before WILLIAM F. PATE, III, MURRIEL E. CRAWFORD, and
JENNIFER D. BAHR, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Ione Pamela Gorski and Cynthia Chiarmonite-Arce (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 21-32, which are the only pending claims. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

The Invention

Appellants' claimed invention is directed to "nipple covers which are substantially flat and can be stretched to fit different sizes" (Specification 2:3-4). Claims 21, 22, and 26, the only independent claims, read as follows:

21. A stretchable and substantially flat nipple cover for covering the nipple and immediate surrounding area comprising:

a skin side and an outer side;

said skin side having an adhesive and soft pad thereon;

said adhesive covered by an adhesive protector;

said cover having outer peripheral edges forming a seashell shape; and

said outer side have a central seashell decoration thereon;

said cover measuring about three inches by about three inches;

said central seashell measuring about one and a half inches by about one and a half inches;

said cover being opaque and skin colored; and

said soft pad being decorative.

22. A stretchable and substantially flat nipple cover comprising:

a skin side and outer side; said skin side have an adhesive and a soft pad thereon;

said adhesive covered by an adhesive protector;

said cover having an outer periphery forming a decorative shape which is not a geometric shape;

said outer side having a central decorative shape thereon which is not a geometric shape.

26. A stretchable and substantially flat nipple cover comprising:

a skin side and outer side;

said skin side having an adhesive and a soft pad thereon:

said adhesive covered by an adhesive protector;

said cover having an outer periphery forming a seashell decoration;

said outer side having a central seashell decoration thereon.

The Rejection

Appellants seek review of the Examiner's rejection of claims 21-32 under 35 U.S.C. § 103(a) as unpatentable over Noble (US 5,755,611, issued May 26, 1998) in view of the pasty worn by Lil Kim at the 1999 MTV Video Music Awards, as documented by *Celebrity Movie Archive::Lil Kim*, <http://www.celebritymoviearchive.com/tour/movie.php/11351> and Jennifer Weiner, *Salon, The 1999 MTV Video Music Awards*, September 11, 1999, http://www.salon.com/ent/feature/1999/09/11/mtv_video/print.html.

THE ISSUE

Each of Appellants' independent claims 21, 22, and 26 requires a "stretchable and substantially flat nipple cover." The Examiner finds that

Noble discloses a stretchable and substantially flat nipple cover (Answer 3)¹. Appellants contend that Noble's breast supports are cup shaped and thus are not "substantially flat" as defined in Appellants' Specification (Appeal Br. 5).

The issue presented in this appeal is whether Appellants demonstrate error in the Examiner's rejection of claims 21-32 as unpatentable over Noble in view of the pasty worn by Lil Kim at the 1999 MTV Video Music Awards. This issue turns, in part, on whether the Examiner erred in determining that Noble's breast supports are "substantially flat," as required in each of the independent claims.

FINDINGS OF FACT

- FF1. Appellants' Specification, at page 5, line 2, defines "substantially flat" as meaning that "the cover has no concave or cup-like parts."
- FF2. Noble teaches a $\frac{3}{4}$ cup embodiment 20 of breast support apparatus that reveals the top part of the breast in wear (col. 3, ll. 54-55), a $\frac{1}{2}$ cup embodiment 120 that reveals the top half of the breast in wear (col. 5, ll. 36-38), and a full cup embodiment 220 that covers the entire breast and is designed for women with especially close separation of the breasts (col. 5, ll. 52-54). In each of the embodiments of Noble's invention, the breast support apparatus includes a cup portion 22 that is preformed in the shape of the portion of the breast to support the breast while covering the nipple

¹ We make reference in this opinion to the Examiner's Answer, mailed March 23, 2007 and to the Appellant's Appeal Brief, filed November 20, 2006.

(col. 2, ll. 39-41, col. 3, l. 52, col. 5, l. 43, and col. 5, l. 67). In addition, each breast support apparatus of the $\frac{3}{4}$ cup and $\frac{1}{2}$ cup embodiments includes a flattened peripheral flange portion 24 extending about part of the periphery of the cup portion (col. 2, ll. 42-45, col. 3, l. 53, col. 5, l. 40).

FF3. Noble does not disclose any embodiment of the breast support apparatus that does not have a concave or cup-like portion. Even the prior art “StaykupsTM” self-supporting brassiere cups discussed by Noble in column 1 include a cup portion.

FF4. The Celebrity Movie Archive and Weiner article establish that Lil Kim wore a pasty having a peripheral shape and design resembling a seashell adhered using adhesive bonding to her left breast covering the nipple. These articles provide no indication as to the material or material properties of the pasty. These articles also provide no indication as to whether the pasty has a concave or cup shape prior to being adhered to the breast.

PRINCIPLES OF LAW

It is elementary that to support an obviousness rejection all words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

While the analysis in support of a legal conclusion of obviousness “need not seek out precise teachings directed to the specific subject matter of the challenged claim,” there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int’l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007).

ANALYSIS

Each of Appellants' independent claims 21, 22, and 26 recites a stretchable and *substantially flat* nipple cover. The Examiner correctly notes that the terminology "substantially flat" appears only in the preambles of these claims and not in the body of any of the claims. This in no way indicates that the terminology "substantially flat" is not a limitation of the claim entitled to patentable weight. The preamble of a claim does not limit the scope of the claim when it merely states a purpose or intended use of the invention; however, terms appearing in a preamble may be deemed limitations of a claim when they give meaning to the claim and properly define the invention. *See In re Paulsen*, 30 F.3d 1475, 1479 (Fed. Cir. 1994). In this case, the terminology "substantially flat" is clearly not a statement of purpose or intended use of the invention. Rather, it is a limitation on the structure, or shape, of the nipple cover.

In accordance with the definition in Appellants' Specification, "substantially flat" means that "the cover has no concave or cup-like parts" (FF1). Each of independent claims 21, 22, and 26 therefore is limited to a nipple cover that has no concave or cup-like parts.

All of the breast support apparatus discussed or taught by Noble includes a cup portion (FF2 and FF3) and thus is not "substantially flat," as required in claims 21, 22, and 26. The Examiner therefore erred in finding that Noble discloses a substantially flat nipple cover. The Examiner does not rely on the Lil Kim pasty for any teaching that would overcome the deficiency in Noble. Moreover, Noble's cup shape performs the function of supporting the breast (FF2). Thus, even assuming that the Lil Kim pasty is

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substantially flat, that is, devoid of any concave or cup-like parts, it is not apparent why a person of ordinary skill in the art would have found a reason to make Noble's breast support apparatus substantially flat.

In light of the above, we conclude that the Examiner failed to establish a *prima facie* case that the subject matter of claims 21, 22, and 26 would have been obvious to a person of ordinary skill in the art at the time of Appellants' invention. Appellants have carried their burden of demonstrating error in the Examiner's rejection. The rejection of claims 21, 22, and 26 and claims 23-25 and 27-32, which depend either directly or indirectly from one of claims 21, 22, and 26, cannot be sustained.

DECISION

The decision of the Examiner to reject claims 21-32 is reversed.

REVERSED

vsh

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