

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* WAYNE G. FROMM

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Appeal 2008-5126  
Reexamination Control 90/006,546 and 90/007,236  
United States Patent 5,640,859 C1  
Technology Center 1700

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Decided: November 26, 2008

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Before BRADLEY R. GARRIS, ROMULO H. DELMENDO, and  
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

DELMENDO, *Administrative Patent Judge*.

DECISION ON APPEAL

Patent Owner (Appellant) appeals under 35 U.S.C. §§ 134(b) and 306 from a final rejection of claims 1-8, 11, and 12 (Appeal Brief filed November 28, 2005, hereinafter “App. Br.”; Final Office Action mailed August 4, 2005). We have jurisdiction under 35 U.S.C. §§ 134(b) and 306.

We AFFIRM.

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## STATEMENT OF THE CASE

This merged reexamination proceeding arose from a consolidation of two separate requests for *ex parte* reexamination filed by Third Party Requestor Mattel, Inc. on February 12, 2003 (Control 90/006,546) and October 6, 2004 (Control 90/007,236) of United States Patent 5,640,859 C1 ('859 Patent) originally issued to Wayne G. Fromm on June 24, 1997 and for which a Reexamination Certificate issued on November 27, 2001 (Decision Merging Reexamination Proceedings mailed January 27, 2005). Mattel asserts that the '859 Patent has been involved in patent infringement actions and that it is a defendant in *Fromm Group, Inc. v. Mattel, Inc.*, Case No. 1:02-cv-00952-WMS-HKS, which is pending in the United States District Court in the Western District of New York (Buffalo) (Request for Reexamination filed October 6, 2004 at 12; Information filed February 12, 2003 in Control 90/006,546 as updated in PACER). We have not been made aware of any other pending court proceedings.

The real party in interest of the present appeal is Wayne G. Fromm (App. Br. 2). Oral arguments were heard on November 19, 2008.

The '859 Patent states that the "invention relates generally to a kit which may be used for education purposes, and more particularly to a kit especially designed for teaching the art and craft of tie-dying. . . ." (col. 1, ll. 4-7). According to the '859 Patent, "[t]ie-dying is a method of dyeing by hand in which patterns are produced in a fabric by gathering together one or more portions of the fabric and tying them tightly together" and "then immers[ing], either partially or completely, in a dye bath," whereby "[t]he

dye will fail to penetrate the tied sections, and after dyeing, the fabric is untied to reveal interesting irregular patterns” (col. 1, ll. 16-23).

Claims 1-3, 11, and 12 on appeal read as follows:

1. A composite, ready-to-use, do-it-yourself tie-dyeing kit for producing a washable dyed pattern on an article of clothing so that the user of the kit may learn the art and craft of the tie-dyeing without ruining or consuming articles of clothing or fabric in the process and will be able to create designs and redo until satisfied with the results; the kit comprising:

a plurality of containers;

a washable nontoxic dye in each of the plurality of containers, each of which dyes may dye a fabric at room temperature and may be substantially completely washed out of the fabric by the user;

a ready-to-dye fabric garment to which the washable dyes will adhere until the garment is washed out; and

means for tying the garment while it is being dyed.

2. The composite, ready-to-use, do-it-yourself tie-dyeing kit as set forth in claim 1 wherein the means for tying the garment is a twist tie.

3. The composite, ready-to-use, do-it-yourself tie-dyeing kit as set forth in claim 1 wherein the means for tying the garment is a clip.

11. A composite, ready-to-use, do-it-yourself tie-dyeing kit for producing a washable dyed pattern on an article of clothing so that the user of the kit may learn the art and craft of tie-dyeing without ruining or consuming articles of clothing in the process and will be able to create designs and redo until satisfied with the results; the kit comprising:

a teddy bear or other toy animal;

a ready-to-dye fabric garment for a teddy bear;

a plurality of containers;

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a washable liquid nontoxic dye suitable for immediate use in each of the containers, which washable dyes may dye the ready-to-dye garment at room temperature, and which dye may be substantially completely washed out of the fabric by the user; and

means for tying the garment while it is being dyed.

12. The composite, ready-to-use, do-it-yourself tie-dyeing kit as set forth in claim 11 wherein the means for tying the garment is a twist die.

The Examiner relied upon the following prior art references as evidence of unpatentability:

Dona Z. Meilach, *Contemporary Batik and Tie-Dye* (Crown Publishers, Inc. 1972) (hereinafter “Meilach”).

Deborah M. Dryden, *Fabric Painting & Dyeing for the Theatre* (Drama Book Specialists 1981) (hereinafter “Dryden”).

*MATTEL Barbie® TIE & DYE™ INSTRUCTIONS* (Mattel, Inc. 1993) (hereinafter “Mattel 1993”).

TYCO® DOLLS “Color Me Kente KENYA™ Growing Up Proud,” 1994 *TYCO Toys TYCO Kente Catalog/Price List* (TYCO Toys 1994) (hereinafter “TYCO Kente”).

The Examiner rejected the claims under 35 U.S.C. § 103(a) as follows: (i) claims 1, 4-8, and 11 as unpatentable over the combined teachings of Mattel 1993 and TYCO Kente; and (ii) claims 2, 3, and 12 as unpatentable over the combined teachings of Mattel 1993 and TYCO Kente and further in view of either Meilach or Dryden (Examiner’s Answer mailed May 30, 2006, hereinafter “Ans.,” 3-7).

With respect to the first ground of rejection, Appellant argues claims 1, 4-8, and 11 together with identical arguments for all claims. Accordingly, we confine our discussion of this rejection to representative claim 1. *See* 37

C.F.R. § 41.37(c)(1)(vii). As to the second ground of rejection, Appellants have arguments under separate headings for claims 2, 3, and 12 and thus we address these arguments as necessary. *Id.*

The Examiner found that Mattel 1993 describes a tie-dyeing kit substantially as here claimed (claim 1) but does not include a “washable” dye (Ans. 3). Nevertheless, the Examiner found that TYCO Kente teaches “a composite, ready-to-use dyeing kit for producing a pattern on an article of clothing comprising. . . a liquid dye in each container for dyeing. . . where the dye is washable form [sic] the article of clothing so that the user may redo the design without ruining or consuming the article of clothing” (Ans. 3). On the basis of these findings, the Examiner concluded that it “would have been obvious to one having ordinary skill in the art to modify the dye in the Mattel[]1993 kit, to be a washable dye as taught by [TYCO Kente], since [TYCO Kente] teaches that it is old and well know[n] to employ a washable dye for the purpose of simply washing the garment/outfit to remove[] the dye therefrom, and start[] over again, thereby allowing the user to create many different designs” (Ans. 3-4). With respect to the specific means for tying in claims 2, 3, and 12, the Examiner found that twist-ties and clips are well known tying means in the tie-dyeing art and thus concluded that “[i]t. . . would have been obvious to one having ordinary skill [to] substitute for the rubber bands in Mattel[]1993, twist-ties and clips. . . since they clearly suggest various equivalents may be used in place of each other and since this is merely the substitution of equivalents known for the same purpose. . . .” (Ans. 4).

Appellant, on the other hand, contends that neither reference discloses or suggests a “do-it-yourself” tie-dyeing kit or “a washable dye that may be washed out of fabric by a user” (App. Br. 9-10). As to claims 2, 3, and 12, Appellant asserts that Mattel 1993 and TYCO Kente do not disclose or suggest the claimed means for tying and neither Meilach nor Dryden makes up for this difference (App. Br. 19).

## ISSUES

Thus, the issues arising from the contentions of the Examiner and Appellant are:

I. Has Appellant shown error in the Examiner’s determination that a person having ordinary skill in the art would have found it obvious to replace the non-washable permanent dyes of Mattel 1993 with TYCO Kente’s washable dyes for the purpose of allowing the user to start over, if desired, and to create many different designs using the same fabric?

II. Has Appellant shown error in the Examiner’s determination that a person having ordinary skill in the art would have found it obvious to replace the rubber bands of Mattel 1993 with a clip or twist-tie as interchangeable tying materials?

## FINDINGS OF FACT

1. The ‘859 Patent does not place any limitation on the term “user” in any way.
2. The ‘859 Patent informs one skilled in the relevant art:  
If one is not satisfied with the pattern, it will be necessary to wash out the dye. When the dye is wet, it may be

washed out in a bathroom or kitchen sink. However, if dry, best results have been found by washing the dyed garment separately from other garments in a hot wash cycle of a home washing machine. [Col. 3, ll. 36-42.]

3. Mattel 1993 describes a tie-dyeing kit comprising a fabric outfit for a doll suitable for tie-dyeing, two dye packages containing non-toxic dye that is “permanent on fabric,” and a bag of rubber bands for tying the fabric (MI2).
4. Mattel 1993 warns (MI2):
  - Not for walls or other hard-to-clean surfaces!
  - Use around surfaces where water can be easily wiped up and won’t leave stains!
  - Will stain hands, fabrics and some surfaces.
5. Mattel 1993 includes an instruction for dyeing that states; “Mom or Dad should help with this [dyeing] part” but Mattel’s product literature states that the kit is intended for use by persons of “[a]ges six years and older” (MI4 and MC1).
6. TYCO Kente teaches the use of washable markers in a kit for coloring doll outfits (p. 1).
7. TYCO Kente states (*id.*): “When they [users] want to create a new design, they simply wash the outfit and start all over. They can do it again and again.”
8. Meilach teaches that various cords such as pipe cleaners, wires, and clips are interchangeable with rubber bands as tie materials suitable for tie-dyeing (CBT6).
9. Appellant did not dispute the Examiner’s finding that a pipe cleaner or wire is a twist-tie (Ans. 4).

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10. Dryden depicts the use of clamps as a tie material in tie-dyeing (FPD13).
11. Appellant refers to “Tyco, Doodle Bear Instruction Sheet, ©1994,” but this document was not attached to the Appeal Brief as part of an Evidence Appendix.
12. “Tyco, Doodle Bear Instruction Sheet, ©1994” recommends: “For best cleaning results, wash Doodle Bear in a pillow case, in a hot wash cycle” (DB1).

#### PRINCIPLES OF LAW

On appeal to this Board, Appellant must show that the Examiner erred in finally rejecting the claims. *Cf. In re Kahn*, 441 F.3d 977, 985-986 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness”) (emphasis in original) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)); *see also* 37 C.F.R. § 41.37(c)(1)(vii).

It is well settled that the United States Patent and Trademark Office (PTO) is obligated to give claim terms their broadest reasonable interpretation, taking into account any enlightenment by way of definitions or otherwise found in the specification. *In re Icon Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (“[T]he PTO must give claims their broadest reasonable construction consistent with the specification . . . . Therefore, we look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation”).

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“Section 103 forbids issuance of a patent when ‘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.’” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1734 (2007).

*KSR* reaffirms the analytical framework set out in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), which states that an objective obviousness analysis includes: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; and (3) resolving the level of ordinary skill in the pertinent art. *KSR*, 127 S. Ct. at 1734. Secondary considerations such as commercial success, long felt but unsolved needs, or failure of others “‘might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.’” *Id.* (quoting *Graham*, 383 U.S. at 17-18).

“One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *KSR*, 127 S. Ct. at 1742.

*KSR* further instructs “that when a patent claims a structure already known in the prior art that is altered by mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *KSR*, 127 S. Ct. at 1740. And, “if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the

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technique is obvious unless its actual application is beyond his or her skill.”

*Id.*

“[O]ne cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references.” *In re Keller*, 642 F.2d 413, 426 (CCPA 1981).

“[C]hoosing to define an element functionally, *i.e.*, by what it does, carries with it a risk...[W]here the Patent Office [PTO] has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.” *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997); *accord In re Best*, 562 F.2d 1252, 1255 (CCPA 1977). Whether the rejection is based on inherency under 35 U.S.C. § 102 or on obviousness under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO’s inability to manufacture products or to obtain and compare prior art products. *In re Best*, 562 F.2d at 1255.

## ANALYSIS

### CLAIM CONSTRUCTION:

We start with claim construction. The Specification of the ‘859 Patent does not limit the term “user” in any way (Fact 1). Hence, a person having ordinary skill in the art would have understood that the term “user” reads on children and/or adults. One skilled in the relevant art would have understood that the term “user” includes, for example, a child who is assisted by an adult or even a teenage child. Also, the ‘859 Patent does not

place any limits on the term “washable” and, in fact, states that “if [the dye is] dry, best results have been found by washing the dyed garment separately from other garments in a hot wash cycle of a home washing machine” (Fact 2). Thus, we are obligated to construe the term “washable” to encompass the removal of dye from the fabric by any means, including a washing machine.

CLAIM 1:

Appellant has failed to show error in the Examiner’s obviousness analysis. While Mattel 1993 does not describe washable dyes, the reference identifies a problem with the permanent dyes, especially when the users are children (Facts 3-5). TYCO Kente, which like Mattel 1993 is directed to a kit for fabric outfits for dolls, describes washable markers (*i.e.*, washable dyes) that allow the user to create new designs by “simply wash[ing] the outfit and start[ing] all over. . . again and again” (Fact 6 and 7). Though TYCO Kente does not disclose tie-dyeing, a person having ordinary skill in the art would have understood that the benefits of TYCO Kente’s washable dyes may be applied to other related fields including tie-dyeing doll outfits. “[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *KSR*, 127 S. Ct. at 1740.

Thus, contrary to Appellant’s belief, the evidence in support of obviousness here is strong. As well stated by the Examiner (Ans. 3-4), a person having ordinary skill in the art would have found it obvious to

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replace the permanent dyes of Mattel 1993 with the washable dyes described in TYCO Kente in order to solve the problems described in Mattel 1993 and thus obtain the advantages of washable dyes as described in TYCO Kente. *KSR*, 127 S. Ct. at 1742 (“One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims”); *id.* at 1740 (“[W]hen a patent claims a structure already known in the prior art that is altered by mere substitution of one element for another known in the field, the combination must do more than yield a predictable result”).

Appellant argues that the kit in Mattel 1993 is not a “ready-to-use, do-it-yourself” kit because it requires the help of “Mom and Dad” during dyeing and the dyes are not reusable after opening the container as they will dry out (App. Br. 6-7). We find no merit in these contentions. Nothing in the express language of claim 1 or the Specification disclosure of the ‘859 Patent supports the reliance of “ready-to-use, do-it-yourself” as a basis to distinguish over Mattel 1993. That Mattel 1993 recommends the assistance of an adult parent for the dyeing step when the user is a young child does not necessarily mean that the disclosed kit cannot be used by the user without the help of such parent. Furthermore, claim 1 is directed to a kit, not a process of using a kit. Thus, it is immaterial that Mattel 1993 recommends the help of a parent when the user is a young child, because the disclosed prior art kit is fully capable of being used by a different user (*e.g.*, a teenager or an adult) as a “ready-to-use, do-it-yourself” kit (Facts 5). Here, the term “user” in claim 1 does not preclude the help of an adult user. Nor does it

preclude a teenage or even an adult user. As to the dye being reusable, claim 1 lacks any such limitation and, therefore, Appellant's argument fails.

Appellant argues that Mattel 1993 does not teach washable dyes and TYCO Kente does not teach tie-dyeing (App. Br. 7). But this argument fails to take into account the collective teachings of the applied prior art references, which would have led one of ordinary skill in the art to provide a tie-dyeing kit with washable dyes. "[O]ne cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references." *In re Keller*, 642 F.2d at 426.

Appellant urges that TYCO Kente "fails to show that the colors are washable by the user" because "any washable functionality would have been available only through a washing machine, which does not qualify as 'do it yourself,' as a child would not be able to safely operate a washing machine by him or herself" (App. Br. 10). In support, Appellant refers to "Tyco, Doodle Bear Instruction Sheet, ©1994" (*id.*). This argument is utterly ineffective to rebut the Examiner's rejection.

For one thing, Appellant's reliance on "Tyco, Doodle Bear Instruction Sheet, ©1994" is inappropriate because it was not included in the Evidence Appendix (Fact 11). Even if the evidence were properly entered into the appeal record, this document does not say that Tyco's washable dyes can only be removed by a washing machine. Instead, it simply recommends: "For best cleaning results, wash Doodle Bear in a pillow case, in a hot wash cycle" (Fact 12). Appellant failed to direct us to any persuasive evidence demonstrating that the dyes of TYCO Kente cannot be removed by safe hand washing performed by the user, including a child user. Here, TYCO

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Kente explicitly teaches that the dyes are “washable” (Fact 6). This disclosure is sufficient to shift the burden of proof to Appellant to show that the washable dyes of TYCO Kente are incapable of removal from a fabric by hand washing. Appellant failed to satisfy that burden. *In re Best*, 562 F.2d at 1255.

Moreover, Appellant’s position is untenable for an additional reason. The Specification of the ‘859 Patent does not exclude “washable functionality” through the use of a washing machine but in fact embraces it (Fact 2). Thus, we have not been made aware of any difference (chemical or otherwise) between the claimed dyes and those of TYCO Kente. Also, contrary to Appellant’s belief, nothing substantiates the allegation that a child is incapable of operating a washing machine, with or without help from an adult. But even if we assume that such were the case, claim 1 is directed to a kit and thus it is of no moment that the prior art does not explicitly teach a process in which a “user” who is able to operating a washing machine employs the kit. All that is required by claim 1 is a capability of the kit to be used by any “user” (Fact 1) as a “ready-to-use, do-it-yourself tie-dyeing kit for producing a washable dyed pattern. . . .” Appellant has not pointed to any evidence indicating that Mattel 1993, as modified by TYCO Kente, lacks such capability.

For these reasons, Appellant’s arguments fail.

CLAIMS 2, 3, AND 12:

Appellant does not dispute the Examiner’s factual findings that Meilach and Dryden teach that twist-ties, clips, and rubber bands are

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interchangeable as tying materials in tie-dyeing (Facts 8-10). Rather, Appellant merely allege that the combination of Mattel 1993 and TYCO Kente “fails to disclose” the claimed means for tying. But because Appellant did not address the Examiner’s reasoning based on the teachings of Meilach and Dryden, we summarily affirm the rejection of these claims.

We have considered all the arguments, including those in the Reply Briefs filed on July 27, 2006 and November 20, 2006, but none are found to warrant reversal.

#### CONCLUSION

On this record, we determine that Appellant has failed to show error in the Examiner’s determination that: (i) a person a having ordinary skill in the art would have found it obvious to replace the non-washable permanent dyes of Mattel 1993 with TYCO Kente’s washable dyes for the purpose of allowing the user to start over, if desired, and to create many different designs using the same fabric; and (ii) a person having ordinary skill in the art would have found it obvious to replace the rubber bands of Mattel 1993 with a clip or twist-tie as interchangeable tying materials.

#### DECISION

The Examiner’s decision to reject appealed claims 1-8, 11, and 12 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

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AFFIRMED

ack

HUNTON & WILLIAMS LLP  
INTELLECTUAL PROPERTY DEPARTMENT  
1900 K STREET, N.W.  
SUITE 1200  
WASHINGTON DC 20006-1109

THIRD PARTY REQUESTOR:  
CHARLES H. DEVOE, ESQ. (CUSTOMER No. 23581)  
KALISCH HARTWELL PC  
520 S W YAMHILL ST SUITE 200  
PORTLAND OR 97204