

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL K. PRATT

Appeal No. 2001-2330
Application No. 09/245,443

ON BRIEF

Before COHEN, STAAB, and McQUADE, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-15, all the claims currently pending in the application.

Appellant's invention pertains to a liner for a rigid sports boot shell (claims 1-11), the combination of a skate having a boot with a rigid shell, and a liner disposed within the boot shell (claim 12), and a method of adjusting the size of a skate (claims 13-15). A basic understanding of the invention

Appeal No. 2001-2330
Application No. 09/245,443

can be derived from a reading of exemplary claims 1, 12 and 13, which appear in the appendix to appellant's main brief.

The references applied in the final rejection as evidence of obviousness are:¹

Held	2,952,925	Sep. 20, 1960
Olson et al.	5,678,833	Oct. 21, 1997
Lin	5,570,523	Nov. 5, 1996

Claims 1-8 and 11-15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Olson in view of Lin.

Claims 9 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Olson in view of Lin and Held.

Reference is made to appellant's main and reply briefs (Paper Nos. 13 and 16) and to the examiner's answer (Paper No.

¹On page 7 of the answer, the examiner has mentioned several patents that purportedly show a boot liner with a tongue, but these patents have been given no consideration on appeal since they have not been listed among the references relied upon, and since they have not been included in the statement of the rejection. *Ex parte Raske*, 28 USPQ2d 1304, 1304-05 (Bd. Pat. App. & Int. 1993). *Compare In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970), cited in Section 706.02(j), Manual of Patent Examining Procedure ("Where a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of the rejection.").

Appeal No. 2001-2330
Application No. 09/245,443

14) for the respective positions of appellant and the examiner regarding the merits of these rejections.

Discussion

Olson, the examiner's primary reference, is directed to an adjustable fit in-line skate comprising a rigid boot shell (12) having overlapping toe (34) and heel (30) portions that are adjustable for accommodating feet of different sizes (column 3, lines 34-38). Olson's skate includes a liner (110), see Figure 2, constructed to accommodate increases in shoe size. To this end, the liner comprises a toe portion (112) joined to a main body portion (114) by an expandable resilient section (116). The manner in which the liner accommodates different shoe sizes is explained at column 3, lines 31-67.

Lin is directed to an adjustable child shoe comprising a heel (2), a toecap (3) and an insole (4). The heel and the toecap comprise overlapping sections that are provided with

Appeal No. 2001-2330
Application No. 09/245,443

fastening elements (e.g., 25, 341) and positioning means (211, 311) for accommodating feet of different sizes. Further explanation of the manner in which shoe of Lin is adjusted is found at column 2, lines 18-34.

The examiner concedes that Olson's liner does not meet the requirement that the liner comprises fore and heel portions having "respective surfaces arranged to overlap each other in use, the amount of overlap of said respective surfaces being adjustable for accommodating feet of different sizes," as called for in the last paragraph of claim 1.² The examiner takes the position, however, that it would have been obvious in view of Lin to modify the liner of Olson such that it comprises overlapping portions that allow for adjustment as called for by the claims.

Appellant argues, as a threshold issue, that Lin is nonanalogous art. There are two criteria for determining whether art is analogous: (1) whether the art is from the field of the inventor's endeavor, regardless of the problem addressed,

²Based on their direct incorporation of the subject matter of claim 1 therein, independent claims 12 and 13 also include these limitation.

Appeal No. 2001-2330
Application No. 09/245,443

and (2) if the reference is not within the field of the inventor's endeavor, whether the reference is reasonably pertinent to the particular problem with which the inventor is involved. *In re Clay*, 966 F.2d 656, 658-59, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992).

The field of the appellant's invention relates, at least in part, to a boot shell "adapted to enclose a wearer's foot and have overlapping toe and heel portions, the amount of overlap of the toe and heel portions being adjustable for accommodating feet of different sizes" (specification, page 2). Lin is directed to an adjustable shoe comprising a heel part having a plurality of protrusions (211) and a toecap having a plurality of holes (311), wherein selected protrusions are inserted into selected holes to provide a shoe that matches the size of foot. As such, Lin, in our opinion, is at least reasonably pertinent to the particular problem addressed by appellant and thus constitutes analogous art which was properly considered by the examiner in evaluating the obviousness of the subject matter on appeal.

Notwithstanding the above, we consider that the examiner's rejection of claims 1-8 and 11-15 as being unpatentable over

Appeal No. 2001-2330
Application No. 09/245,443

Olson in view of Lin is not well taken. From our perspective, Lin's adjustable heel and toecap are more akin to Olson's overlapping toe (34) and heel (30) portions than to Olson's liner (110). Furthermore, in that Olson's liner includes an expandable section (116) that enables the liner to stretch to accommodate various foot sizes, we are in accord with appellant's argument on page 7 of the main brief to the effect that there would be no need for providing a two-piece liner in Olson. Where, as here, the prior art references require a selective combination to render obvious a claimed invention, there must be some reason for the combination other than hindsight gleaned from the invention disclosure. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). In the fact situation before us, we are unable to agree with the examiner that one of ordinary skill in the art would have been motivated by the teachings of Lin to incorporate the overlapping heel and toecap adjustment feature thereof into the liner of Olson.

In addition, we do not agree with the examiner that Lin teaches a liner having a tongue extending rearwardly from the

Appeal No. 2001-2330
Application No. 09/245,443

toe box, as required by claims 1, 12 and 13. Thus, we consider that the examiner's evidence of obviousness is insufficient to support a conclusion that it also would have been obvious to incorporate into the liner of Olson a tongue liner extending away from the toe box.

In light of the foregoing, we shall not sustain the standing

§ 103 rejection of claims 1-8 and 11-15.

We have also reviewed the Held reference additionally applied by the examiner in the rejection of claims 9 and 10, but find nothing therein that makes up for the deficiencies of Olson and Lin noted above. Accordingly, we also shall not sustain the standing

§ 103 rejection of claim 9 and 10.

The decision of the examiner is reversed.

Appeal No. 2001-2330
Application No. 09/245,443

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

LJS/lp

Appeal No. 2001-2330
Application No. 09/245,443

TIMOTHY A FRENCH
FISH & RICHARDSON
225 FRANKLIN STREET
BOSTON MA 02110-2804

Letty

JUDGE STAAB

APPEAL NO. 2001-2330

APPLICATION NO. 09/245,443

APJ STAAB

APJ McQUADE

APJ COHEN

DECISION: **REVERSED**

PREPARED: Jul 22, 2002

OB/HD

PALM

ACTS 2

DISK (FOIA)

REPORT

BOOK