

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN G. POSA

Appeal No. 2004-0146
Application 09/851,911

HEARD: March 4, 2004

Before FRANKFORT, STAAB, and BAHR, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3, 4 and 11 through 16. Claims 7 through 10, the only other claims pending in the application, stand withdrawn from further consideration by the examiner as being directed to a non-elected invention. Claims 2, 5 and 6 have been canceled.

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As noted on page 1 of the specification, appellant's invention relates generally to footwear and, in particular, to footwear having a sole portion from which material may be selectively removed to create personalized imprinted images or messages while walking on wet sand or other surfaces. A preferred embodiment is shown in Figures 1, 4A and 4B of the application drawings, wherein a sole portion of the footwear (100) has a bottom surface including a closely packed matrix of projections (120) extending therefrom, and wherein each projection is selectively removable, thereby enabling a user to remove a subset of the projections corresponding to a desired personalized imprint. Independent claims 1, 15 and 16 are representative of the subject matter on appeal and a copy of those claims may be found in the Appendix to appellant's brief.

The prior art references relied upon by the examiner in rejecting the appealed claims are:

Berger	5,084,988	Feb. 4, 1992
Ellis	WO 91/11924 (PCT)	Aug. 22, 1991

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Claims 1, 3, 4, 13 and 14 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Ellis.

Claims 11, 12 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellis.

Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellis in view of Berger.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the examiner's answer (Paper No. 13, mailed April 2, 2003) for the reasoning in support of the rejections, and to appellant's brief (Paper No. 12, filed March 26, 2003) and reply brief (Paper No. 15, filed June 4, 2003) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

With regard to the rejection of claims 1, 3, 4, 13 and 14 under 35 U.S.C. §102(b) based on Ellis, we have reviewed the applied Ellis reference and, like appellant, find no teaching or disclosure therein of a sole portion having a bottom surface with a densely packed matrix of projections extending therefrom and wherein "each projection has a nominal length of 3/16 inch or greater, and a nominal width of 1/8 inch or greater," as specifically set forth in independent claim 1, from which claims 3, 4, 13 and 14 depend. The examiner's assertion on page 3 of the answer that "[i]t would appear the projections [of Ellis] have the dimensions as claimed," would seem to be based entirely on speculation and conjecture, since the examiner has pointed to no such disclosure in Ellis or provided any

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explanation as to why projections of appellant's claimed dimensions are necessarily present in the footwear of Ellis. Thus, the examiner has not made out a prima facie case of anticipation based on the disclosure of Ellis.

In light of the foregoing, we will not sustain the examiner's rejection of claims 1, 3, 4, 13 and 14 under 35 U.S.C. § 102(b) as being anticipated by Ellis.

Regarding the examiner's various rejections of claims 1, 3, 4, 11 through 14 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Ellis, the examiner has urged with respect to appellant's independent claim 1 that even if Ellis does not teach or disclose projections having the dimensions claimed, the selection of a suitable size for the projections formed by the intersecting slits (151) seen, for example, in Figure 11A of Ellis, "would appear to constitute no more than optimization of size by routine experimentation inasmuch as a number of thickness [sic] would appear to be suitable depending on the individual

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wearer and the type of footwear being constructed" (answer, pages 3-4). In this regard, the examiner further contends that

the size of the projections (the thickness of the sole) is recognized in the art to be a variable that is result effective. Generally, it is considered to have been obvious to develop workable or even optimum ranges for such variables. For example, see *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955) and *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Since the applicant has not demonstrated or even alleged that the specifically claimed size produces unexpected results, it is our conclusion that it would have been obvious for an artisan with ordinary skill to determine a workable or even optimum size for the projections and thereby arrive at the size (i.e. length and width) as claimed by the applicant (answer, page 4).

Concerning the requirements in dependent claims 4, 11 and 12 on appeal that there be a non-partitioned border surrounding the matrix of projections (claim 4), and that each of the projections of appellant's footwear be either triangular in cross-section (claim 11) or rectangular in cross-section (claim 12), the examiner first points to a non-partitioned border surrounding the matrix of projections in Figures 10A-10C of Ellis and urges that to have used such a border with the embodiments seen in Figures 11A, 11B of Ellis would have been obvious. The examiner

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next points out that Ellis teaches that the projections therein can be of different shapes, and urges that it would have been an obvious matter of design choice to make the projections in Ellis of whatever form or shape desired or expedient, noting that a change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results.

For the reasons aptly set forth on page 3 of the brief, we agree with appellant that the examiner has failed to set forth a prima facie case of obviousness with regard to the footwear of independent claim 1 on appeal. More particularly, given that the purpose in Ellis of providing enhanced flexibility to a shoe sole so that it can more readily deform in parallel with the natural deformation of a human foot is so distinctly different from appellant's reasons for forming and sizing the projections of the presently claimed footwear to provide for ease of removability of the projections, we find no reason to conclude that optimization of the size of the projections in Ellis by routine experimentation to arrive at the desired goal of Ellis would

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necessarily result in projections on the sole of the footwear of Ellis being sized in the manner set forth in appellant's claim 1. Nor do we find any evidentiary basis to conclude, as the examiner has, that "the size of the projections (the thickness of the sole) is recognized in the art to be a variable that is result effective" (answer, page 4). Accordingly, we will not sustain the examiner's rejection of independent claim 1 under 35 U.S.C. § 103(a) based on Ellis.

It follows from our determination with regard to independent claim 1 above that we will likewise not sustain the examiner's rejections of claims 3, 4 and 11 through 14, which depend from claim 1, under 35 U.S.C. § 103(a) based on Ellis alone.

As for independent claim 16 and the requirement therein that the footwear be a sandal or thong including a sole portion having a densely packed matrix of projections, wherein each projection is removable so as to enable a user to remove a subset of the projections corresponding to a personalized imprint, the examiner has pointed to the disclosure in Ellis indicating that the

invention therein relates "generally to the structure of shoes" (page 1, lines 4-5) and urged that the term "shoes" in the art includes sandals or thongs, and concluded that it therefore would have been obvious to provide the shoe sole as taught in Ellis as part of a sandal or thong to provide traction to such footwear. Appellant has challenged this position, contending that because Ellis also notes that it particularly relates to "athletic shoes," it is absolutely clear to anyone of skill in the art that Ellis teaches away from the consideration of a sandal or thong, thereby defeating prima facie obviousness.

Like the examiner, it is our view that Ellis more broadly addresses the construction of shoe soles in general and is not only limited to the construction of athletic shoes, although athletic shoes are clearly one particular type of shoe focused on by the reference. In particular, we note that in paragraphs on pages 2-3, Ellis broadly discusses the shortcomings of a "conventional shoe sole" and mentions that the concepts of his invention are applicable to both street shoes and athletic shoes. In addition, Ellis specifically notes that it is a general object

of the "new invention" to elaborate upon the application of the principle of the theoretically ideal stability plane to "other shoe structures" (page 3, last full paragraph). In addition, in the paragraph bridging pages 10-11, Ellis broadly notes that the deformation sipes of his invention "can provide a significant benefit on any portion of the shoe sole that is thick and firm enough to resist natural deformation due to rigidity." Page 12 of Ellis sets forth that the shape of the channels (in Fig. 5C) should be such that the resultant shape of the shoe sole sections would be "like the Maseur sandals." The embodiments seen in Figures 6 and 7 of Ellis are said to depict the new invention applied to a "conventional flat plane shoe sole" (page 13) or a "conventional flat, roughly rectangular shoe sole" (page 15). Page 16 of the disclosure in Ellis notes that the deformation sipes therein can be applied, not only to conventional flat shoe soles, but "to any intermediate or partial contour between flat shoe soles . . . and naturally contoured shoe soles conforming fully or in part to the foot sole."

Thus, based on a full consideration of the disclosure in Ellis, it is clear to us that one of ordinary skill in the art

would have recognized that the teachings of Ellis have broad applicability to a variety of different shoe soles and in particular to what is referred to as sole sections "like the Maseur sandals" (page 12), a "conventional flat plane shoe sole" (page 13), or a "conventional flat, roughly rectangular shoe sole" (page 15). In this light, it is our view that one type of well-known flat plane shoe sole which would have immediately occurred to one of ordinary skill in the art is that of a sandal or thong. Accordingly, we concur in the examiner's ultimate determination that it would have been obvious, within the meaning of 35 U.S.C. § 103, to utilize deformation sipes and Ellis' concept of a theoretically ideal stability plane in flat plane shoe soles or flat, roughly rectangular shoe soles like those conventionally seen on sandals or thongs. Thus, we will sustain the examiner's rejection of independent claim 16 under 35 U.S.C. § 103(a) as being obvious over Ellis.

The last of the examiner's rejections for our review is that of independent claim 15 under 35 U.S.C. § 103(a) based on the combined teachings of Ellis and Berger. Claim 15 defines

footwear for leaving a personalized imprint on wet sand, wherein a sole portion which is "at least partially transparent" includes a bottom surface with a tight matrix of projections extending therefrom, wherein each projection is removable, enabling a user to look through the sole portion and remove a subset of the projections corresponding to a desired personalized imprint.

In this rejection, the examiner concedes that the footwear of Ellis, with its densely packed matrix of removable projections (e.g., Fig. 11A), has no transparent sole portions. However, the examiner points to Berger, noting transparent portions (3, 4) of the footwear sole seen therein and the benefit described in the patent of a simple and inconspicuous construction for allowing viewing through the shoe sole, so that one can regularly and accurately monitor or measure the remaining distance of the toe tips from the portion of the shoe upper adjacent to the outsole tip to see whether the shoe has become too small. From the collective teachings of the applied references, the examiner has concluded that it would have been obvious to one of ordinary skill in the art to provide the shoe sole as taught by Ellis with

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transparent portions, as taught in Berger, to permit viewing of the toes of the wearer within the shoe so as to determine whether the shoe has become too small. Appellant contends that there is no teaching or suggestion to make the modification of Ellis proposed by the examiner and that the examiner's justification for doing so is clearly not the justification appellant recites in claim 15.

We share the examiner's view that there is ample suggestion in the combined teachings of Ellis and Berger for making at least some portions of the shoe sole in Ellis transparent, as taught in Berger, so that it can readily be determined by looking through the transparent portions if the shoes are becoming too small for the wearer. As for appellant's assertion that the examiner's justification for the combination is not that of appellant, we observe that it matters not that the reason for combining the teachings as noted above is not exactly the same as appellant's reason for providing that feature or modification. The law is clear that the purpose proposed as the reason why an artisan would have found the claimed subject matter to have been obvious

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under 35 U.S.C. § 103 need not be identical to the purpose or problem which the patent applicant indicates to be the basis for having made the invention. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) and In re Dillon, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). Moreover, it is not required that the prior art teachings relied upon disclose the same advantage that appellant alleges, all that is required is that there is a reasonable suggestion to do what the claimed subject matter encompasses. See In re Kronig, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976) and Ex parte Obiaya, 227 USPQ 58 (Bd. Pat. App. & Int. 1985).

Accordingly, for the above reasons, we will sustain the examiner's rejection of claim 15 under 35 U.S.C. § 103(a) as being obvious over Ellis in view of Berger.

In summary, we have refused to sustain the examiner's rejection of claims 1, 3, 4, 13 and 14 under either 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a) based on Ellis alone. In

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addition, we have refused to sustain the examiner's rejection of claims 11 and 12 under 35 U.S.C. § 103(a) based on Ellis. However, we have sustained the examiner's rejection of claim 15 under 35 U.S.C. § 103(a) based on Ellis in view of Berger, and that of claim 16 under 35 U.S.C. § 103(a) based on Ellis alone. Thus, the decision of the examiner is affirmed-in-part.

In addition, we REMAND this application to the examiner to consider whether or not the subject matter currently set forth in claims 1, 3, 4 and 11 through 14 on appeal has adequate support under 35 U.S.C. § 112, first paragraph, in appellant's originally filed disclosure. More particularly, it is the open-end ranges regarding "a nominal length of 3/16 inch or greater" and "a nominal width of 1/8 inch or greater" (emphasis added) set forth in independent claim 1, as amended in Paper No. 9, filed August 26, 2002, that are of primary concern. No such open-ended ranges appear to be set forth in appellant's originally filed specification and claims. We also REMAND for the examiner to again consider the teachings of U.S. Patent No. 3,932,950 to Taber under either 35 U.S.C. § 102(b) or § 103(a). While it may

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not appear from a perusal of the drawings of this patent that the matrix of projections on the shoe sole therein has a density of packing wherein the projections (46) are "immediately adjacent to one another if not touching," as in appellant's claim 1 on appeal, we note that the sizing and center-to-center spacing of the projections disclosed in the Taber patent and as set forth in claim 1 thereof, in particular, would appear to fall within appellant's broadly claimed size ranges and result in a densely packed matrix of projections like that claimed by appellant. Moreover, since the projections in Taber are of an equivalent size to those claimed by appellant and formed of rubber or neoprene, it would appear that they are inherently removable, thereby enabling a user to remove a subset of the projections corresponding to a desired personalized imprint, although no such express disclosure appears in the Taber patent. The examiner may also wish to revisit the Ellis references of record and consider the sizing of the projections therein when the size limitation of appellant's claim 1 is viewed through the prism of In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

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In addition to affirming the examiner's rejection of one or more claims, this decision contains a remand. 37 CFR § 1.196(e) provides that

[w]hensoever a decision of the Board of Patent Appeals and Interferences includes or allows a remand, that decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

The effective date of the affirmance is deferred until conclusion of the proceedings before the examiner unless, as a mere incident to the limited proceedings, the affirmed rejection is overcome. If the proceedings before the examiner does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent

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Appeals and Interferences for final action on the affirmed rejections, including any timely request for rehearing thereof.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (Eighth Edition, Rev. 1, Feb. 2003), item (D).

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

AFFIRMED-IN-PART and REMANDED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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LAWRENCE J. STAAB)	APPEALS AND
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