

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JEFFREY E. GEBHARD

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Appeal No. 2005-2544  
Application No. 09/328,749

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ON BRIEF

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Before FRANKFORT, MCQUADE 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 through 4, 7 through 21 and 23 through 26, all of the claims remaining in the application. As noted on page 2 of the supplemental answer, mailed August 9, 2004, the appeal as to claim 6 has been dismissed. Claims 5 and 22 have been canceled.

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As noted on page 1 of the specification, appellant's invention relates to a torsion system for an article of footwear, in particular, a cycling shoe. The torsion system includes a sole plate constructed and configured to allow, in a pre-selected manner, rotation of a forefoot portion of the article of footwear relative to a rearfoot portion of the footwear about a longitudinal axis of the article of footwear, without compromising the vertical stiffness of the footwear sole necessary for pressure distribution to a pedal or other surface. A further understanding of the invention can be derived from a reading of independent claims 1, 21 and 26 on appeal, a copy of which appears in the Appendix to appellant's brief.

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

Dubner	3,903,621	Sep. 9, 1975
Eisenbach et al. (Eisenbach)	4,815,222	Mar. 28, 1989
Anderie	4,922,631	May 8, 1990
Nagano et al. (Nagano)	5,446,977	Sep. 5, 1995
Kraeuter et al. (Kraeuter)	5,915,820	Jun. 29, 1999
		(filed Aug. 20, 1996)

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Claims 1, 8 through 11, 15 through 17, 19 through 21, 24 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderie in view of Dubner and Kraeuter.

Claims 23 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderie in view of Dubner and Kraeuter as applied to claim 21 above, and further in view of Nagano.

Claims 2 through 4, 11 through 14 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderie in view of Dubner and Kraeuter as applied to claims 1 and 9 above.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderie in view of Dubner and Kraeuter as applied to claim 1 above, and further in view of Eisenbach.

Rather than attempt to reiterate the examiner's commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by appellant and the examiner regarding the rejections, we make reference to the answer (mailed August 19, 2003) and supplemental answer (mailed August 9, 2004) for the examiner's reasoning in support of the rejections, and to

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appellant's brief (filed July 28, 2003) and reply briefs (filed October 23, 2003 and October 14, 2004) 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 determination that the examiner's rejections before us on appeal will not be sustained. Our reasoning in support of that determination follows. In addition, we have exercised our authority under 37 CFR § 41.50(b) and entered a new ground of rejection.

In rejecting claims 1, 8 through 11, 15 through 17, 19 through 21, 24 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Anderie in view of Dubner and Kraeuter, the examiner has determined that Anderie discloses all the limitations of the enumerated claims except for 1) the forefoot portion of the torsion system spanning the entire forefoot area

of the shoe sole, 2) the rearfoot portion spanning the entire rearfoot area of the shoe sole, and 3) the forefoot portion having a generally smooth concave contour along the longitudinal axis of the torsion system. More particularly, the examiner points to the embodiment seen in Figures 4-10 of Anderie noting that the torsion system therein includes a forefoot portion (119), a rearfoot portion (118)<sup>1</sup> and an intermediate portion (110, 114, 115) coupling together the forefoot portion and the rearfoot portion and constructed of a material and configured to allow, in a pre-selected manner, rotation of the forefoot portion relative to the rearfoot portion about a longitudinal axis of the torsion system (see, e.g., col. 6, line 51 - col. 7, line 37). The examiner further notes that the torsion system of Anderie includes a rib (e.g., Fig. 6, 114, 115, 116) projecting beyond an

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<sup>1</sup> It appears the examiner has mistakenly interchanged the reference characters for the forefoot and rearfoot portions of the stiffening element (109). As noted in column 6, lines 24-26, the anchoring inserts (118) and (119) of stiffening element (109) in Anderie are "embedded in the front sole portion 103 and rear sole portion 104 respectively," thus, making anchoring insert (118) the forefoot portion and anchoring insert (119) the rearfoot portion of the stiffening member. This minor oversight does not appear to significantly affect the issues before us on appeal.

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adjacent surface of the web or flat base portion (113) of the torsion system.

To account for the above identified differences between the claimed subject matter of appellant's invention and that of Anderie, the examiner relies on the patents to Dubner and Kraeuter, urging that it would have been obvious to one of ordinary skill in the art to make the forefoot and rearfoot portions of Anderie's torsion system "as shown in Dubner '621 to give support to the largest area of the user's foot and to spread out the impact of the foot with the ground over the largest possible area" (answer, page 5) and to further make the now expanded forefoot area of the torsion system of Anderie as modified by Dubner concave upwardly as shown in Kraeuter (Figs. 7-8) "to allow it to follow along the natural contour of the user's foot while giving a feeling of comfort on the user's foot" (answer, page 6).

In the brief and reply briefs, appellant contends that the examiner has engaged in impermissible hindsight reconstruction by using appellant's claimed invention as a template to pick and choose among isolated disclosures in the applied prior art

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references and then piece those disparate disclosures together in an effort to render appellant's claimed invention obvious. We agree.

More particularly, we find no reasonable basis in the collective teachings of the applied prior art to Anderie and Dubner for modifying the forefoot anchoring portion (118) of Anderie's stiffening member (109) to span substantially the entire forefoot area of the shoe sole from a midtarsal area to a toe area and from a lateral side to a medial side, or the rearfoot anchoring portion (119) of the stiffening member (109) to span substantially the entire rearfoot area of the shoe sole from a midtarsal area to a heel area and from the lateral side to the medial side, as is required in claims 1 and 21 on appeal. Nothing in Dubner's conforming supporting innersole device is suggestive of any such modification in the anchoring portions of the embedded stiffening member in Anderie. Moreover, absent the examiner's proposed expansion of the size of the forefoot anchoring portion (118) of Anderie's stiffening member (109), we see no basis in the combined teachings of Anderie, Dubner and Kraeuter for attempting to make the forefoot anchoring portion (118) of Anderie's embedded stiffening member with "a generally

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smooth concave contour along the longitudinal axis," as set forth in independent claims 1, 21 and 26 on appeal. As for the examiner's position on page 16 of the answer that any shoe can be used to pedal a bicycle and would thus meet the limitation of a "cycling shoe" as set forth in claim 21 on appeal, we agree with appellant's comments on page 10 of the reply brief and further direct the examiner's attention to pages 1-3 of appellant's specification for an indication of the recognized special characteristics of a "cycling shoe."

For the above reasons, we agree that the examiner has failed to make out a *prima facie* case of obviousness, and therefore will not sustain the rejection of claims 1, 8 through 11, 15 through 17, 19 through 21, 24 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Anderie in view of Dubner and Kraeuter.

Nor will we sustain the examiner's rejection of dependent claims 2 through 4, 11 through 14 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Anderie in view of Dubner and Kraeuter. Simply stated, nothing in the examiner's explanation of this rejection (answer, pages 7-8) overcomes the shortcomings in the combined teachings of the applied patents as noted above.

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We have additionally reviewed the patents to Nagano and Eisenbach relied upon by the examiner in the rejections of dependent claims 7, 23 and 25 under 35 U.S.C. § 103(a), but find nothing therein that makes up for the deficiencies in the combined teachings of the applied patents to Anderie, Dubner and Kraeuter as noted above. Accordingly, we also refuse to sustain the examiner's rejections of claims 7, 23 and 25 under 35 U.S.C. § 103(a).

In light of the foregoing, the decision of the examiner rejecting claims 1 through 4, 7 through 21 and 23 through 26 of the present application is reversed.

However, pursuant to 37 CFR § 41.50(b), we enter the following new ground of rejection:

Claims 1, 9, 15, 20 and 26 are rejected under 35 U.S.C. § 102(b) as being anticipated by Anderie. More particularly, we point to the embodiment seen in Figures 4-10 of Anderie and find that the intermediate sole member (101) constitutes a "torsion system" like that defined in appellant's claims 1, 9, 15, 20 and 26 on appeal, while the wearing or outsole (102) provides

response for the inferentially recited shoe "sole with a forefoot area and a rearfoot area" in those claims. In that regard, we note that the sports shoe bottom described in Anderie and shown in Figures 9 and 10 appears to include an outer wearing sole (102) having a forefoot area (103) and a rearfoot area (104), as well as a "torsion system" comprised of the intermediate sole member (101) which includes a forefoot portion spanning substantially the entire forefoot area of the outer wearing sole, with the forefoot portion having a generally smooth concave contour along the longitudinal axis thereof (Fig. 10); a rearfoot portion spanning substantially the entire rearfoot area of the outer wearing sole; and an intermediate portion (including central limb 108 and stiffening element 109 embedded therein) coupling the forefoot portion and the rearfoot portion of the torsion system, and constructed of a material and configured to allow, in a pre-selected manner, rotation of the forefoot portion relative to the rearfoot portion about the longitudinal axis (see, col. 7, lines 15-19), and wherein the intermediate portion includes a rib (e.g., 114, 115, or 116) that projects beyond an adjacent surface (e.g., 113, 118, or 119) of the tension system.

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Contrary to appellant's arguments in the brief and reply briefs, it appears to us that the language of claims 1 and 26 on appeal with regard to the rib projecting beyond "an adjacent surface of the torsion system" (emphasis added) does not require the rib to project beyond all surfaces of the torsion system, as appellant seems to believe, but only requires that the rib project beyond some "adjacent surface" of the torsion system. This is particularly true, since the rib as set forth in independent claims 1 and 26 is clearly recited as being part of the torsion system, not as being an element separate from the torsion system, as appellant's arguments seem to imply.

Concerning claims 9, 15 and 20, we note that the intermediate sole member (101) defining the "torsion system" of the shoe sole seen in Anderie includes a forefoot portion, a rearfoot portion and an intermediate portion that together form a single plate and wherein a width of the intermediate portion of the plate is narrower than the forefoot and rearfoot portions (Fig. 9) and the material properties of the foamed plastic forefoot and rearfoot portions are different than the intermediate portion including the hard polyamide stiffening element (109).

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This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50 (b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . . .
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . . .



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