

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHANE BUSSIÈRE

Appeal 2007-1313
Application 10/162,098
Technology Center 3600

Decided: July 20, 2007

Before MURRIEL E. CRAWFORD, JENNIFER D. BAHR, and LINDA E. HORNER, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

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STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 6-9¹. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.

THE INVENTION

Appellant's claimed invention is to a tongue structure for use in a boot. Claim 6, reproduced below, is representative of the subject matter on appeal.

6. A tongue structure for use in boot, said tongue structure comprising an upper layer formed of a rigid protective material, a lower layer formed of a resilient stretchable material, said upper layer being secured to said lower layer along marginal side edges thereof, said upper layer being spaced from said lower layer intermediate said side marginal edges to thereby provide an air space between said upper and lower layers, the arrangement being such that when said tongue is used in a boot, the foot of a user will contact said lower layer with said upper layer being spaced therefrom in a central region.

¹ Claims 1-17 are pending in the application. Claims 10-16 are allowed and Appellant dropped claims 1-5 and 17 from this appeal (Br. 2).

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THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Hoshizaki	US 4,835,885	Jun. 6, 1989
Gabrielli	EP 0 629 358 A1	Dec. 21, 1994

Claims 6-9 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Gabrielli and Hoshizaki.

ISSUE

The issue before us is whether the combination of Gabrielli and Hoshizaki would have led one having ordinary skill in the art at the time of the invention to the subject matter of claim 6. In particular, the issue focuses on whether Gabrielli discloses an air space between upper and lower layers of a tongue structure and whether there would have been a reason to make the lower layer of Gabrielli's tongue structure from a resilient stretchable material in view of Hoshizaki.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427, 7 USPQ2d 1152, 1156 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Gabrielli discloses a “tongue 16 with an internal lining 64 welded to a waterproof layer 66 to form the tongue pocket 36 to be filled by silicone 68” (Gabrielli, col. 4, ll. 6-9).

2. Gabrielli describes that once the tongue pocket 36 has been formed, an injection gun 80 is used to fill the pocket with silicone (Gabrielli, col. 4, ll. 11-21).
3. As such, prior to injection of the silicone, Gabrielli's tongue structure has an inner liner and an outer layer separated by an air space.
4. Gabrielli discloses that once the pocket has been completely filled with silicone, then the silicone is left to vulcanize for about twenty minutes (Gabrielli, col. 5, ll. 13-15).
5. As such, during use of Gabrielli's shoe, the tongue structure has an inner liner and an outer layer separated by silicone.
6. Gabrielli does not disclose that the inner lining is made of a resilient stretchable material or that the outer layer is made of a rigid protective material.
7. Hoshizaki discloses a tongue structure for a skate having “[a] conventional inner liner 84 and leather or the like cover 86 stitched at 88 about the periphery thereof (Hoshizaki, col. 5, ll. 50-53).
8. Hoshizaki discloses that two layers are inserted within the sandwich created by the inner liner 84 and cover 86: a base layer 90 of semi-rigid material, such as molded closed cell polyurethane foam, and a stiff layer 92 made of a rigid thermoplastic material (Hoshizaki, col. 5, ll. 53-63).

PRINCIPLES OF LAW

“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, 82 USPQ2d 1385, 1391 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). See also *KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court explained, “[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *Id.* at 1740-41, 82 USPQ2d at 1396. The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.*, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory

statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

ANALYSIS

Appellant argues claims 6-9 as a group. We select claim 6 as a representative claim, and claims 7-9 will stand or fall with claim 6. 37 C.F.R. § 41.37(c)(1)(vii)(2006).

The Examiner found Gabrielli teaches all of the elements of claim 6 except that Gabrielli does not specifically disclose the upper layer to be a rigid material and the lower layer to be a resilient stretchable material (Answer 3). Appellant contends that Gabrielli fails to disclose a tongue structure having an air space between upper and lower layers when used in a boot, because Gabrielli teaches to fill its air space with a liquid material which becomes vulcanized elastomer (Br. 4).

Claim 6 recites “A tongue structure for use in boot, said tongue structure comprising ... said upper layer being spaced from said lower layer intermediate said side marginal edges to thereby provide an air space between said upper and lower layers.” Gabrielli’s tongue structure includes an air space between the upper and lower layers *during manufacture*, prior to injection of the silicone between the layers (FF 3). Claim 6 further recites that “when said tongue is used in a boot, the foot of a user will contact said lower layer with said upper layer being spaced

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therefrom in a central region.” Gabrielli’s tongue structure has this arrangement when the user’s foot is inserted in the boot, *i.e.*, *during use*, because its upper and lower layers are spaced from each other in a central region by silicone during use (FF 5). The Examiner, however, cannot have it both ways. Either the “tongue structure” of Gabrielli that meets the claim is the tongue structure during manufacture, or the tongue structure during use, not both. As such, Gabrielli’s tongue structure fails to meet the limitations of claim 6 of having an air space between the upper and lower layers and of the layers being separated from one another during use.

The Examiner found that Hoshizaki discloses a tongue structure for use in footwear that has a resilient lower layer and a rigid upper layer as claimed (*Id.*). The Examiner concluded that it would have been obvious to modify Gabrielli’s tongue structure to include the specific material characteristics of the tongue structure of Hoshizaki since it is within the general skill of a worker to select a known material on the basis of its suitability for the intended use (Answer 4) and because comfort is an important factor in a shoe or boot (Answer 5). Appellant contends that there is no reason why one would want to use a resilient stretchable material for the lower layer of Gabrielli’s tongue structure, because when the liquid is placed in the air space, the lower layer would stretch, which would be undesirable (Br. 5). We agree with Appellant.

We see no reason why one having ordinary skill in the art would have replaced the internal lining 64 of Gabrielli’s tongue structure with the materials of Hoshizaki. By using a stretchable inner liner, Gabrielli’s pocket 36 would be

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subject to distortion and enlargement as the pocket 36 is being filled with silicone. We do not agree with the Examiner that the use of a resilient stretchable material would have been an obvious design choice or a material suitable for Gabrielli's intended purpose. As such, we hold that the combination of Gabrielli and Hoshizaki would not have led one having ordinary skill in the art to the subject matter of claim 6.

CONCLUSIONS OF LAW

We conclude that Appellant has shown the Examiner erred in rejecting claims 6-9 under 35 U.S.C. § 103(a) as unpatentable over Gabrielli and Hoshizaki.

DECISION

The decision of the Examiner to reject claims 6-9 is reversed.

REVERSED

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