

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL ANDREW KELLY

Appeal 2008-0977
Application 10/409,185
Technology Center 3700

Decided: March 18, 2008

Before HUBERT C. LORIN, ANTON W. FETTING, and
STEVEN D.A. McCARTHY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Paul Andrew Kelly (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-18, 20, and 21. Claim 19 has been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.¹

THE INVENTION

The invention relates to studded footwear such as sports shoes. Fig. 1 of the Specification depicts an embodiment of the invention – a golf shoe. According to the Specification (p. 3, ll. 19-25), the shoe comprises outsole (1), receptacle (2), sole (3), heel (4), stud (5), ground-engaging spikes (6), and, traction elements (7) integrally formed with the outsole 1. Each receptacle (2) is adapted to receive a specifically-oriented stud (5). When in use, traction elements (7) interact with spikes (6). Fig. 2 is a side view showing dynamic spikes (6a) which flex when pressure is applied to them. Fig. 5 shows the stud installed by insertion of a spigot 9 into socket 23. The spikes (6a) and static spikes (6b) project from the stud. In use, the stud contact the traction elements (7) via the outward flexing of spikes (6a).

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. An outsole for an article of studded footwear in which said outsole includes receptacles for specifically-oriented studs wherein said outsole also includes traction elements formed integrally with said outsole, said studs and said traction elements being so constructed and arranged to permit said studs to contact said traction elements in use of said footwear.

¹ Our decision will make reference to Appellant's Appeal Brief ("Br.," filed Feb. 20, 2007) and the Examiner's Answer ("Answer," mailed May 10, 2007).

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Patterson	US 6,289,611 B1	Sep. 18, 2001
Dalton	US 6,161,315	Dec. 19, 2000
McMullin	US 6,023,860	Feb. 15, 2000

The following rejection is before us for review:

1. Claims 1-18, 20, and 21 are rejected under 35 U.S.C. § 103(a) as unpatentable over either Dalton or Patterson in view of McMullin.

ISSUES

The issue is whether the Appellant has shown that the Examiner erred in rejecting claims 1-18, 20, and 21 under 35 U.S.C. § 103(a) as unpatentable over either Dalton or Patterson in view of McMullin given the broadest reasonable construction of the claims in light of the Specification as it would be interpreted by one of ordinary skill in the art.

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 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

The scope and content of the prior art

1. Patterson discloses a golf shoe outsole with traction-enhancing elements including soft spikes (42) and pyramid-shaped protrusions (44). (Col. 3, ll. 13-20.) Receptacles (52) for receiving

these elements are also disclosed. (See col. 3, ll. 35-36 and Figs. 2 and 8.)

2. Dalton discloses a shoe outsole with receptacles (36) to receive spikes (38). (Col. 3, ll. 18-24.)(See also Fig. 1. Mini-spikes (40) integral with the outsole are also disclosed.)
3. McMullin discloses receptacles for receiving a cleat (160) with traction elements (1642) attached to a stud (20). (Col. 8, ll. 10-21; see also col. 7, ll. 60-64.)

Any differences between the claimed subject matter and the prior art

4. The claimed invention combines in a single shoe various elements separately described in the references such that, in use, studs contact traction elements.

The level of skill in the art

5. Neither the Examiner nor the Appellant has addressed the level of ordinary skill in the pertinent art of constructing studded footwear. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”)(Quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Secondary considerations

6. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

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 (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, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

The Appellant argues claims 1-18, 20, and 21 as a group (Br. 10). We select claim 1, reproduced *supra*, as the representative claim for this group, and the remaining claims 2-18, 20, and 21 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

We have reviewed the record and conclude that the Appellant has not shown error in the rejection.

“Many of appellant’s arguments fail from the outset because, . . . they are not based on limitations appearing in the claims” *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982). Numerous statements made in support of the patentability of the claims are not commensurate in scope with what is claimed. These statements include:

- on page 10 of the Brief:
 - “As recited in Appellant’s claims, a dynamic spike . . . :”
 - “Second, the claims, in one form or other, require that the dynamic spike . . . “
 - “Thus, the references are totally lacking in any suggestion of Applicant’s invention, namely, that the static traction elements are positioned relative to the dynamic spikes of the stud . . . ”, and,
- on page 11 of the Brief:
 - “Appellant’s claims define dynamic spikes as being of the type that resiliently flex . . . ”
 - “... there is nothing to indicate that any resulting flexure would be resiliently outward to extend a predetermined radial distance from the stud as required by Appellant’s claims.”
 - “Nothing in these patents suggests any flexure.”

There is no mention of “dynamic spikes” or “flexure” in claim 1.

On page 12 of the Brief, the Appellants argues that “ . . . the basic requirement that a proper reference combination requires some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or to combine references.” This is not the standard for determining obviousness.

The Supreme Court decision in *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007) has clarified the test for obviousness. In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious without an explicit application of the teaching, suggestion, motivation test. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *Id.* (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966) (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The operative question in this “functional approach” is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740.

Here the Examiner explained that each of the elements of the claimed outsole was shown in the cited references and provided some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness for combining the elements in the manner claimed. “[W]hen a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *Id.* at 1740, (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282, 96 S.Ct. 1532 (1976)). In that regard, the record does not include any objective evidence of secondary considerations, such as unexpected results for the claimed combination, to rebut the Examiner’s prima facie case of obviousness.

Accordingly, it was not necessary, as Appellant appears to argue, that the Examiner show a suggestion to combine the teachings of the references in the references themselves before coming to the conclusion that the claimed article would have been obvious to one of ordinary skill in the art. In light of *KSR*, to establish a prima facie case of obviousness under 35 U.S.C. §103(a), it is sufficient to show that the claimed article is the combination of prior art elements according to known methods to yield predictable results.

Finally, the Appellant argues that “[i]ndependent claim 1 requires the studs and traction elements to contact one another when the footwear is in use. Nothing in Patterson et al., Dalton or McMullin discloses or suggests this contact in use.” (Br. 12.) We are not persuaded by this argument because the broadest reasonable construction of claim 1 in light of the Specification as it would be interpreted by one of ordinary skill in the art is such that the scope of the claimed subject matter is not limited so as to include studs. Claim 1 requires the outsole to comprise two elements, receptacles for specifically-oriented studs and traction elements integrally formed with the outsole. Claim 1 does not require studs, only that the receptacles have the *capability* of receiving studs “so constructed and arranged to permit said studs to contact said traction elements in use of said footwear” (claim 1). In that respect, the Appellant does not rebut the rejection on the ground that the receptacles of the cited prior art do not have the *capability* of receiving such studs. Accordingly, the argument is not persuasive as to error in the rejection.

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CONCLUSIONS OF LAW

We conclude the Appellant has failed to show that the Examiner erred in rejecting claims 1-18, 20, and 21 under 35 U.S.C. § 103(a) as unpatentable over either Dalton or Patterson in view of McMullin.

DECISION

The decision of the Examiner to reject claims 1-18, 20, and 21 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). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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