

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. 8

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JAMES STANFIELD

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Appeal No. 2000-2008  
Application No. 09/227,903

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ON BRIEF

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Before CALVERT, FRANKFORT, and MCQUADE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 11, all the claims in the application.

The involved invention concerns an aid for teaching children and the handicapped how to tie a bow in a shoelace. The subject matter in issue is defined by claims 1 to 11,

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which are reproduced in the appendix of appellant's brief.

The references applied in the final rejection are:

Bonfigli 1977	4,017,984	Apr. 19,
Stanfield 27, 1999	5,897,323	Apr.

Claims 1 to 11 stand finally rejected on the following grounds:

- (1) Anticipated by Bonfigli, under 35 U.S.C. § 102(b);
- (2) Obviousness-type double patenting, over claims 1, 3 and 4 of the Stanfield patent.

Rejection (1) - Anticipation

First considering this rejection with regard to the recitations of claim 1, the examiner finds that Bonfigli discloses apparatus for teaching, inter alia, how to tie a bow, having a plate 12 with first shoe markings, second shoe markings representing a loop (Fig. 3), a shoelace mount consisting of flaps 14, 16 (which have holes 34), and a hold-down consisting of tab 46, which is spaced from the shoelace mount.

In order to anticipate a claim, a prior art reference must disclose every limitation of the claimed invention,

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either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). Appellant argues that claim 1 is not anticipated, because Bonfigli's hold-down tab 46 cannot "be operated by a child to temporarily press a location along said shoelace which has been laid in a loop on said second shoe marking, against said upper surface," as recited in claim 1. The examiner's position seems to be that this recitation does not differentiate the claimed apparatus from the structure disclosed by Bonfigli because it is a recitation of how the claimed apparatus is intended to be employed (answer, page 5). However, we do not agree that the quoted claim language is merely a recitation of the intended use or function of the apparatus, but rather consider that it imports a structural limitation into the claim. As disclosed in appellant's specification at page 4, lines 19 to 21, and shown in Fig. 2, the hold-down 42 lies along the loop marking 40 or slightly beyond it, holding a location 44 along the corresponding shoelace loop 36 to the shoe device 12. Giving the claim recitation in question its broadest reasonable interpretation in light of this disclosure (see In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997)),

it is evident that it requires that the hold-down be so positioned as to enable it to be pressed upon a location along the portion of the shoelace which has been laid in a loop on the second shoe marking. Since Bonfigli's hold-down tab 46 is not located in a position to enable it to be pressed upon a location along the shoelace loop which has been laid on the second shoe marking 44, as shown in Fig. 4a, Bonfigli does not anticipate claim 1.

We therefore will not sustain rejection (1) as to claim 1, or as to claims 2 to 5 dependent thereon.

Claim 6 reads:<sup>1</sup>

6. A shoe device comprising:

a plate which has front and rear portions and upper and lower surfaces, with said upper surface of said plate marked along said front portion to represent the front of a shoe;

said plate has means for holding a middle portion of a shoelace that has opposite end portions;

said plate has a cutout forming a tab that is spaced from said means for holding a middle portion to hold down [a] location along one of said shoelace end portions to said

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<sup>1</sup> We note that "said location" in line 8 of the claim has no antecedent basis. In the interest of avoiding piecemeal appellate review, we will construe this term as --a location-- , but it should be corrected in the event of further prosecution.

plate.

The examiner reads the claimed "means for holding" on flaps 14, 16 of Bonfigli, and the claimed tab on Bonfigli's tab 46. Appellant argues that Bonfigli "does not have a tab spaced from the means for holding a middle portion of the shoelace, in order to hold-down a looped end portion of the shoelace" (brief, page 5). This argument is not persuasive because Bonfigli's tab 46 clearly is spaced from flaps 14 and 16. Also, claim 6 (unlike claim 1) does not require that the tab hold down a looped portion of the shoelace, but only that it "hold down said [sic: a, per footnote 1, supra] location along one of said shoelace end portions;" Bonfigli's tab 46 meets this limitation in that it holds down a location along the shoelace portion to the left of center dot 24b (in Fig. 8).

Thus, claim 6 is anticipated by Bonfigli.

Claim 7 is also anticipated by Bonfigli. Appellant's only argument as to this claim is that Bonfigli's plate (12) "does not have a rounded front end, but only rounded markings" (brief, page 5). However, as the examiner points out, Bonfigli discloses that the outline of the "shoe" "may be

formed from a sheet from which the side flaps 14 and 16 are made and adhered to the panel 12" (col. 1, lines 58 to 60). Such a sheet constitutes a "plate" as broadly recited, there being no requirement in the claim that the "plate" be of any particular stiffness. Bonfigli also meets claims 8 and 9, since flaps 14, 16, which contain holes 34, are made from the sheet ("plate"), according to the above-quoted disclosure.

Claims 10 and 11 each recite a hold-down (claim 10) or tab (claim 11) which is spaced from the holes in flaps 14 and 16. Claims 10 and 11 further require that the hold-down is "for holding down an end portion of said shoelace that projects from said holes" (claim 10) or "to hold down a second location which lies along one of said shoelace ends that projects from one of said holes" (claim 11). The tab 46 of Bonfigli meets these limitations because it would be capable of holding down a location on one of the shoelaces that project from holes 34. For example, considering Fig. 8 of Bonfigli, the end of the shoelace projecting from the hole in tab 14b could be brought over and placed under the tab 46. While the Bonfigli device is not described as being intended to be used in this manner, the disclosed structure meets

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claims 10 and 11 because it is capable of such use. It is well settled that the recitation of an intended new use for an old product does not make a claim to that old product patentable. In re Schreiber, supra. Cf. In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967).

Accordingly, rejection (1) of claims 6 to 11 will be sustained.

Rejection (2)-Double Patenting

On page 2 of the final rejection and page 4 of the answer, the examiner's statement of this rejection is:

Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, and 4 of U.S. Patent No. 5,897,323. Although the conflicting claims are not identical, they are not patentably distinct from each other because they derive from the same disclosure, contain slight variations on the same limitations, and could have been claimed in the original application.

This statement is not sufficient to enable this Board to determine whether or not the rejection should be sustained. Therefore, pursuant to 37 CFR § 1.196(a), this case is remanded to the examiner to amplify the basis of the rejection. In so doing, the examiner should, for each of claims 1 to 11, (1) compare that claim with the single claim

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of the patent to which that claim most closely corresponds;  
(2) determine the differences between that application claim  
and the patent claim; and (3) in light of those differences,  
determine whether the application claim is an obvious  
variation of the patent claim, and if so, explain why. See  
MPEP § 804, part II B.

We note that on page 8 of the brief appellant requests a  
decision "as to . . . which claims would require a terminal  
disclaimer." However, a terminal disclaimer under 37 CFR  
§ 1.321(a), second sentence, does not apply to individual  
claims, but rather to all claims in any patent to be issued.  
See MPEP  
§§ 804.02 and 1490.

#### Conclusion

The examiner's decision to reject claims 1 to 11 under  
35 U.S.C. § 102(b) is reversed as to claims 1 to 5, and  
affirmed as to claims 6 to 11. The application is remanded to  
the examiner with regard to the double patenting rejection.

Since this decision includes a remand, it shall not be  
considered a final decision. See 37 CFR § 1.196(e) and MPEP  
§§ 1211 and 1213.

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This application, by virtue of its "special" status, requires an immediate action, M.P.E.P 708.01(d). It is important that the Board be informed promptly of any action affecting the appeal in this case.

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

IAN A. CALVERT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JOHN P. MCQUADE	)	
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