

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

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 R. LIND

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Appeal No. 2003-0117  
Application 09/747,077

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ON BRIEF

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Before FRANKFORT, STAAB, and NASE, 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, 2, 4 through 13 and 15 through 27, which are all of the claims remaining in the application. Claims 3 and 14 have been canceled.

Appellant's invention relates to 1) a wedge-soled bowling shoe and a plurality of replaceable sole members, wherein each

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replaceable sole member has two surface regions with different coefficients of friction; 2) a pair of wedge-soled bowling shoes wherein one shoe is a slide shoe and the other is a traction shoe dependent upon appropriate selection of suitable replaceable sole members having appropriate coefficient of friction regions; 3) a replaceable sole member for a wedge-soled bowling shoe; and 4) a method of providing different relative percentages of slide and traction to each shoe of a pair of wedge-soled bowling shoes. Claims 1, 11, 13, 16, 18, 24 and 26 are representative of the subject matter on appeal, and a copy of those claims can be found in the Appendix to appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the claims on appeal are:

McCord ('661)	3,027,661	Apr. 3, 1962
Einstein, Jr. (Einstein)	3,538,628	Nov. 10, 1970
Dilg	4,279,083	Jul. 21, 1981
Taylor	4,716,664	Jan. 5, 1988
Famolare	5,542,198	Aug. 6, 1996

Claims 8, 9, 11, 12 and 17 through 27 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

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Claims 1, 2, 4, 5, 7 through 9, 11 through 13, 15 through 19 and 21 through 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Einstein in view of either Famolare or Taylor.

Claims 6 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Einstein in view of either Famolare or Taylor as applied to claims 1 and 18 above, and further in view of Dilg.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Einstein in view of either Famolare or Taylor as applied to claims 1 and 2 above, and further in view of McCord.

Rather than reiterate the conflicting viewpoints advanced by appellant and the examiner regarding the above-noted rejections, we refer to the examiner's answer (Paper No. 14, mailed June 5, 2002) and appellant's brief (Paper No. 11, filed February 14, 2002) supplemental communication (Paper No. 13, filed April 30, 2002) and reply brief (Paper No. 15, filed August 2, 2002) for a full exposition thereof.

OPINION

Having carefully reviewed the indefiniteness and obviousness issues raised in this appeal in light of the record before us, we have made the determinations which follow.

Looking first to the examiner's rejection of claims 8, 9, 11, 12 and 17 through 27 under 35 U.S.C. § 112, second paragraph, as being indefinite, we observe that the examiner is of the view that claims 8, 9, 11, 12, 17 and 22 through 26 are "functional, indefinite, and incomplete because they contain functional language not supported by recitation in the claim of sufficient structure to warrant the presence of such language" (answer, page 3). More particularly, the examiner contends that

it is not clear what structural limitations applicant intends to encompass with phrases such as 'a relatively greater percentage of . . . coefficient of friction regions'. Such a recitation is a comparable limitation and it is not clear in comparison to what the percentage is greater. There is no clear guidance as to what structural limitations applicant intends to encompass with such a phrase.

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Like appellant, we are at a loss to understand this aspect of the indefiniteness rejection as it applies to claims 11, 18 through 21, 24 and 25, since none of these claims include the particular language or phrase found to be offending by the examiner. The examiner's further comment on page 6 of the answer that some of the claims contain "phrases which include a comparable limitation, i.e. 'relatively greater percentage' which is more confusing, vague and indefinite . . .," if intended to apply to claims 11, 18 through 21, 24 and 25, is entirely without merit, since we find no such "comparable limitation" in those claims and the examiner has pointed to none.

As for the examiner's concern about the language "a relatively greater percentage of . . . coefficient of friction regions" present in some of the claims on appeal (i.e, claims 8, 9, 12, 17, 22, 23, 26 and 27), we share appellant's view as set forth on pages 25-28 of the brief, that one of ordinary skill in the art reading the limitations in question in light of appellant's specification would readily understand those limitations and their import with regard to the claimed subject matter as a whole. In determining whether a claim sets out and circumscribes a particular area with a reasonable degree of

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precision and particularity, the definiteness of the language employed in the claim must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. See In re Johnson, 558 F.2d 1008, 1016 n.17, 194 USPQ 187, 194 n.17 (CCPA 1977). When that standard of evaluation is applied to the language employed in claims 8, 9, 12, 17, 22, 23, 26 and 27 before us on appeal, we are of the opinion that those claims set out and circumscribe a particular area with a reasonable degree of precision and particularity.

Concerning the examiner's problem with the recitations of claims 18 and 20, wherein "[a] replaceable sole member" is defined in terms of its relationship to a wedge-soled bowling shoe with which it is intended to be used, and wherein details of said wedge-soled bowling shoe are set forth in the preamble of the claim and referred back to in defining and limiting the replaceable sole member, we share appellant's view that these claims set out and circumscribe a particular area with a

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reasonable degree of precision and particularity, and thus fully comply with the requirements of 35 U.S.C. § 112, second paragraph.

In light of the foregoing, we must refuse to sustain the examiner's rejection of claims 8, 9, 11, 12 and 17 through 27 under 35 U.S.C. § 112, second paragraph.

Regarding the examiner's rejection of claims 1, 2, 4, 5, 7 through 9, 11 through 13, 15 through 19 and 21 through 27 under 35 U.S.C. § 103(a) as being unpatentable over Einstein in view of either Famolare or Taylor, we share appellant's view that neither Einstein, Famolare, nor Taylor teaches or suggests a "wedge-soled bowling shoe." While Einstein teaches a shoe with a replaceable sole, which sole could apparently be that of a bowling shoe (col. 4, line 1), Einstein does not teach or suggest a "wedge-soled bowling shoe" like that set for in the claims before us on appeal. In our view, the fact that the sandal-type shoe seen in Figure 5 of Einstein has a wedge-sole and can be used with replaceable sole members like those seen in Figures 7-10 of that patent does not teach, and would not have been suggestive to one of ordinary skill in the art of a bowling shoe having a wedge-

sole. As for the secondary references to Famolare and Taylor, both of these patents teach bowling shoes having a conventional elevated arch portion and a conventional raised heel, not a "wedge-soled bowling shoe." Thus, we find no teaching, suggestion or incentive in the collective disclosures and teachings of Einstein and Famolare, or Einstein and Taylor, for modifying the footwear of Einstein to provide a "wedge-soled bowling shoe," as claimed by appellant.

Moreover, while both Famolare and Taylor teach a bowling shoe having a sole portion or member with one coefficient of friction (e.g., 18 of Taylor and 16 of Famolare) and a heel member (20 of Taylor and 46 of Famolare) which clearly can have a different coefficient of friction from the sole portion, none of the references applied by the examiner teaches or suggests a replaceable sole member having regions of two different coefficients of friction (e.g., like the regions seen on replaceable sole member 22 in Figure 3 and replaceable sole member 54 in Figure 6 of the application drawings) for use on a wedge-soled bowling shoe. Nor do any of the applied references teach or suggest the aspect of appellant's invention as set forth in method claim 26, and identified on page 4 of the specification

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as being "an essential feature" of appellant's invention, wherein it is specifically noted that either shoe of a pair of wedge-soled bowling shoes may independently be a slide shoe or a traction shoe according to the relative percentage of coefficient of friction regions of the selected replaceable sole members applied thereto, thereby allowing a single pair of shoes to be adaptable to either a left- or right-handed bowler.

Like appellant (brief, pages 40-41), in this case, it is our opinion that the examiner has engaged in "hindsight reconstruction" by impermissibly drawing from appellant's own teachings and then picking and choosing from isolated disclosures in the various prior art references in an attempt to declare the claimed subject matter obvious, thereby falling victim to what our reviewing Court has called "the insidious effect of a hindsight syndrome wherein that which only the inventor has taught is used against its teacher." W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983).

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Since we have determined that the teachings and suggestions which would have been fairly derived from either Einstein and Famolare or Einstein and Taylor would not have made the subject matter as a whole of claims 1, 2, 4, 5, 7 through 9, 11 through 13, 15 through 19 and 21 through 27 on appeal obvious to one of ordinary skill in the art at the time of appellant's invention, we must refuse to sustain the examiner's rejection of those claims under 35 U.S.C. § 103(a).

We have also reviewed the additional patents to Dilg and McCord applied by the examiner against dependent claims 6, 10 and 20 on appeal under 35 U.S.C. § 103(a). However, we find nothing in these patents which overcomes the deficiencies in the basic combinations of Einstein and Famolare or Einstein and Taylor noted above or which otherwise renders obvious the claimed subject matter. Thus, the examiner's rejection of dependent claims 6, 10 and 20 under 35 U.S.C. § 103(a) will likewise not be sustained.

To summarize, we note that the examiner's rejection of claims 8, 9, 11, 12 and 17 through 27 under 35 U.S.C. § 112, second paragraph, as being indefinite has not been sustained, and

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that each of the examiner's rejections of the claims on appeal under 35 U.S.C. § 103(a) have likewise not been sustained. Thus, the decision of the examiner is reversed.

REVERSED

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

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