

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL ANDREW KELLY

Appeal No. 2003-1290
Application 09/909,168

ON BRIEF

Before ABRAMS, FRANKFORT, and BAHR, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

REMAND TO THE EXAMINER

The above identified application is being remanded to the examiner under the authority of 37 CFR § 1.196(a) and MPEP § 1211 for appropriate action with regard to the items listed below.

1. In reviewing the record of the present application, we note that in the examiner's answer mailed November 20, 2002

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(Paper No. 14, pages 4-5) the examiner has maintained an obviousness-type double patenting rejection of claims 18 through 34 of the present application over "the claims of U.S. Patent Nos. [sic] 6,272,774." The examiner's position is expressed as follows

Although the conflicting claims are not identical, they are not patentably distinct for each other because they are claiming the same common subject matter. In patent '774, the cleat is being claimed in combination with the holder and it [sic] the present claims just the holder [sic] is being claimed. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: The shoe cleat having, a spigot, free standing post being deflected resiliently in a radial direction, and a convex profile.

The present application contains nine independent claims reciting varying limitations and eight dependent claims. U.S. Patent No. 6,272,774 contains 21 claims, of which four are independent. As noted in MPEP § 804, in making a double patenting rejection of the type present in this case, the examiner must ascertain whether any claim in this application defines an invention that is merely an obvious variation of an invention claimed in the patent. Further, the analysis employed in making such an obviousness-type double patenting rejection must parallel that used in the guidelines for analysis of a

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35 U.S.C. § 103 obviousness determination. In the present case, however, we observe that the examiner has not identified any specific differences between any claim of the present application and a claim of appellant's U.S. Patent No. 6,272,774, or provided reasons why any such differences would have been obvious to one of ordinary skill in the art at the time of appellant's invention. Instead, it appears that the examiner has merely asserted that claims 18-34 of the present application are not patentably distinct from claims 1 through 21 of U.S. Patent No. 6,272,774 by asserting that the claims of the application and those of the patent "are claiming the same common subject matter" (answer, page 4). We do not see that this constitutes a valid prima facie case of obviousness-type double patenting. Thus, we REMAND for the examiner to consider a proper rejection based on obviousness-type double patenting where a claim by claim analysis and treatment of the limitations thereof has been made to establish an unjustified timewise extension of protection afforded by appellant's prior patent.

In addition, given that the examiner's comments in the rejection itself appear to more closely relate to a nonstatutory double patenting rejection of the type made in In re Schneller,

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397 F.2d 350, 158 USPQ 210 (CCPA 1968), we REMAND for the examiner to consider the guidelines set forth in MPEP § 804 (pages 800-26 to 800-28) regarding that type of rejection, and particularly to obtain proper authorization from the Technology Center (TC) Director if any such rejection were to be made in the present application.

The examiner's mere assertion that all of the elements of the claimed subcombination (shoe cleat) in the present application are claimed in U.S. Patent No. 6,227,774 is of little value without adequate factual and legal analysis to substantiate such an assertion.

2. Looking next to the examiner's rejection of claims 18 through 34 under 35 U.S.C. § 102(b) based on Ferreira, we note that it appears the examiner has merely pointed to the lock tongues (33) on the skirt (32) of Ferreira's shoe cleat and urged that such tongues "seem to be inherently capable of performing the functions as claimed" (answer, page 4). Again, we find no factual analysis or convincing line of technical reasoning as to why the examiner has reached such a conclusion. Accordingly, we REMAND the present application to the examiner to provide such

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factual analysis and technical reasoning, and for answers to appellant's arguments in the brief and reply brief regarding this rejection. In that regard, we note that the examiner should explain why the posts or lock tongues (33) of Ferreira would of necessity be deflectable in the particular manner required in the claims on appeal. Moreover, the examiner must address appellant's arguments in the paragraph bridging pages 6-7 of the brief, providing a clear explanation of where the argued limitations are found in Ferreira.

3. In further accord with the foregoing, we direct the examiner to consider and provide response for the issues raised by appellant in the reply brief (Paper No. 15, filed January 16, 2003).

If appropriate, the examiner is authorized to prepare a supplemental examiner's answer to address the issues on remand noted above.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (item D), Eighth Edition, Aug. 2001. It is important that the Board of Patent

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Appeals and Interferences be promptly informed of any action
affecting the appeal in this case.

REMAND TO THE EXAMINER

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	APPEALS AND
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