

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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARIO POLEGATO MORETTI

Appeal No. 2004-0127
Application No. 09/765,605

HEARD: May 18, 2004

Before COHEN, ABRAMS, and McQUADE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 3-8. The only rejection that included dependent claim 2 was withdrawn in the Answer (page 11), and therefore claim 2 is considered as containing allowable subject matter.

We REVERSE.

BACKGROUND

The appellant's invention relates to a waterproofed and vapor-permeable sole for shoes. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's Brief.

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

Dassler	4,100,685	Jul. 18, 1978
Ohashi	4,771,555	Sep. 20, 1988
Polegato	5,983,524	Nov. 16, 1999
Squadroni	6,282,813	Sep. 04, 2001 (filed Dec. 10, 1999)

Claims 1 and 3-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dassler in view of Ohashi, Polegato and Squadroni.¹

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the Answer (Paper No. 16) for the examiner's reasoning in support of the rejection, and to the Brief (Paper No. 14) and Reply Brief (Paper No. 17) for the appellant's arguments thereagainst.

¹A rejection of claims 1-8 under 35 U.S.C. § 103(a) as being unpatentable over Margolin in view of Simmons and Polegato was withdrawn in the Answer (page 11).

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

All of the claims stand rejected as being obvious² in view of the combined teachings of four references. With regard to claim 1, the sole independent claim, the examiner has found all of the subject matter to be disclosed in Dassler, except for the tread being made of leather, the presence of a membrane permeable to vapor and impermeable to water sealed to the peripheral regions of the tread, and the inserts being made of plastic (Answer, page 4). However, the examiner takes the position that it would have been obvious to modify the Dassler shoe to meet the terms of claim 1 in view of the teachings of the other three references. The appellant argues that no suggestion exists to combine the references in the manner proposed by the examiner.

²The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988).

The appellant's invention is directed specifically to improvements in shoes having leather soles (specification, page 1) and, in this context, claim 1 requires "a tread made of leather." Dassler discloses a sports shoe, such as a tennis shoe, having "a flexible plastics outsole" (Abstract; column 1, lines 44-49). There is no teaching in this reference, express or implied, that the sole can be made of leather. Thus, the primary reference clearly lacks disclosure or teaching of this feature and, since leather is not utilized, the problems arising in leather soles owing to exposure to water and vapor, to which the appellant has directed his inventive efforts, are not present in Dassler.

The examiner then looks to Squadroni, concluding that Squadroni "teaches it is desirable to ventilate a shoe sole made of leather (see column 2, lines 65-68) to allow for the foot of the user to breathe," and therefore "it would have been obvious to make the shoe sole of Dassler '685 out of leather, or any other known sole material, and ventilate it . . . to allow the foot of the user to breathe and prevent fluid build-up in the shoe of the user" (Answer, page 5).

Squadroni discloses a shoe sole with a plurality of check valves for allowing air to be discharged from the inside of the shoe to ventilate the shoe. The passage in the Squadroni specification to which the examiner refers states that Figure 2 shows a

partial section of a sole “(preferably made of rubber or leather, most preferably rubber).” While it is true that Squadroni mentions leather as a less desirable option to rubber, we agree with the appellant that Squadroni fails to provide a reason to motivate one of ordinary skill in the art to replace the plastic sole of the Dassler sports shoe with a leather sole. In this regard, Squadroni explicitly teaches a preference for a non-leather material, and the use of leather in a sports shoe would seem to give rise to the problems inherent with leather soles which are eliminated by utilizing a plastics or rubber material. Moreover, by virtue of being made of plastics material, the Dassler sole already solves the problem of providing a water barrier, and changing to a leather sole would eliminate a desirable feature of this reference, which would be a disincentive to the artisan to do so. This lack of suggestion to combine Dassler and Squadroni is not overcome by further consideration of Ohashi and Polegato.

Further with regard to Ohashi, this reference is directed to a rigid ski boot, and teaches that plastic inserts having openings for providing ventilation in the interior of the boot can be installed in holes in the sole. The examiner proposes to modify the Dassler shoe by replacing the disclosed ventilation vents in the sole with the inserts disclosed by Ohashi “to allow for air to flow through and ventilate the shoe while supporting the opening in the sole of the shoe” (Answer, page 5). From our perspective, this already is

accomplished by the Dassler system, and we therefore fail to appreciate why one of ordinary skill in the art would have been motivated to make this change.

The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In the present case, we fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to modify Dassler by replacing the sole of plastics material with one of leather, and to replace the vent system with that of Ohashi. On this basis, it is our conclusion that the combined teachings of the four references cited against claim 1 fail to establish a prima facie case of obviousness with regard to the subject matter recited therein, and the rejection cannot be sustained.

This being the case, we will not sustain the rejection of claim 1 or, it follows, of claims 3-8, which depend therefrom.

CONCLUSION

The rejection of independent claim 1 and dependent claims 3-8 under 35 U.S.C. § 103(a) as being unpatentable over Dassler in view of Ohashi, Polegato and Squadroni is not sustained.

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
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JOHN P. McQUADE)	
Administrative Patent Judge)	

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