

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARTIN LEE

Appeal No. 97-2996
Control No. 90/003,884¹

HEARD: October 16, 1997

Before McCANDLISH, Senior Administrative Patent Judge, LYDDANE
and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1 through 5, 7, 8 and 9. Claims 6 and 10, the only other claims pending in this reexamination proceeding, have been indicated as containing patentable subject matter.

¹ Request, filed June 30, 1995, for the reexamination of U. S. Patent No. 4,870,762, issued October 3, 1989, based on Application 07/250,163 filed, September 28, 1988.

Appeal No. 97-2996
Control No. 90/003,884

The invention relates to a safety shoe structure. Claim 1 is illustrative and reads as follows:

1. A safety shoe structure comprising a sole, an upper having an outer layer and a lining and being provided over and around the front periphery of said sole to define a toe receiving portion at the front end portion of said shoe, and a protective cap provided above said toe receiving portion and between said outer layer and said lining, said protective cap being formed in a shape as to have a generally U-shaped forward edge and an approximately arch-shaped rear edge, said safety shoe further comprises:

a lateral flange extending horizontally and inwardly from said forward edge of said protective cap;

a soft piece connected at said rear edge of said protective cap having a forward stepped portion adapted to engage beneath the lower surface of said rear edge and a rear body portion flushly extending from said rear edge and tapered to an edge so as to be snugly interposed between said outer layer and said lining;

a hard raised portion integrally formed at the front end of the upper surface of said sole and adapted to provide a base for resting said lateral flange;

a sponge member provided onto the remaining portion of said upper surface of said sole; and

an insole provided on said lateral flange and said sponge member.

Appeal No. 97-2996
Control No. 90/003,884

The references relied upon by the examiner as evidence of obviousness are:

Jallatte, French Patent Document ²	1,213,077	Oct. 26, 1959
British Patent Document (Desma)	1,098,708	Jan. 10, 1968
German Patent Document ²	2,822,872	Nov. 29, 1979

SAFETY FOOTWEAR CONCEPT, T. Sisman Shoe Co. Brochure
(May 1971)(Sisman).

The appealed claims stand rejected as follows:

a) claim 9 under 35 U.S.C. § 101 as being a substantial duplicate of claim 6;

b) claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Desma in view of Jallatte and Sisman; and

c) claims 1 through 5 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Desma in view of Jallatte and Sisman, and further in view of the German reference.

Reference is made to the appellant's main and reply briefs (Paper Nos. 19 and 23) and to the examiner's answer (Paper No. 21) for the respective positions of the appellant and the examiner with regard to the propriety of these rejections.

² An English language translation of this reference, prepared by the Patent and Trademark Office, is appended hereto.

Appeal No. 97-2996
Control No. 90/003,884

The appellant has not argued the merits of the standing 35 U.S.C. § 101 rejection of claim 9. Instead, the appellant states that "[a]s a convenience to the Examiner, Patent Owner added claim 9 which recites the patentable subject matter of claim 6 in independent form. [footnote omitted] Upon receipt of the Board's reversal of the Examiner's rejection of claim 1, Patent Owner intends to cancel claim 9" (main brief, page 6). Given the appellant's comments and failure to present any argument on the merits, we shall summarily sustain the standing 35 U.S.C. § 101 rejection of claim 9.

With regard to the standing 35 U.S.C. § 103(a) rejection of claim 8, the examiner explains that

Desma shows a shoe with a sole (18), an upper outer layer (10 and 16), a lining (27), a protective cap (14) with a U-shaped forward edge (figure 3), an arch rear edge (figure 5), and a lateral flange (15), a hard raised portion (17a) which is integrally formed (by molding) at the front end of the upper surface of the sole (figures 1 and 2) and provides a base for the flange of the toe cap, a cushioning member (13), and an insole (12) substantially as claimed except for extending the outer layer of the upper over the toe cap to encapsulate the cap between the outer layer and the lining and the exact material for the cushioning layer. Jallatte teaches positioning a toe cap (6) between an outer layer (5) of an upper and a lining (7). Sisman teaches the well known and conventional use of sponge materials (10) for a cushioning layer. It would have been obvious to extend the outer layer as taught by Jallatte in the shoe of Desma to give the shoe a smoother appearance and to reduce the amount of materials needed and steps of manufacture by

Appeal No. 97-2996
Control No. 90/003,884

eliminating the need for the second portion of the outer layer of the upper (16) and to use sponge materials for the cushioning layer as taught by Sisman to increase the amount of cushioning and the durability of the cushioning materials [answer, page 4].

As for the standing 35 U.S.C. § 103(a) rejection of claims 1 through 5 and 7, the examiner explains that

Desma as modified above shows a shoe substantially as claimed except for a soft piece located at the rear edge of the toe cap. The German Patent '872 teaches providing a soft piece (3) on the rear edge of a toe cap (7) substantially as claimed. It would have been obvious to provide a soft piece as taught by German Patent '872 in the shoe of Desma as modified above to make the shoe more comfortable and durable [answer, pages 4 and 5].

The only arguments advanced by the appellant with regard to the § 103 rejections involve the limitations in independent claims 1 and 8 requiring the claimed safety shoe structure to include a hard raised portion integrally formed at the front end of the upper surface of the sole and adapted to provide a base for resting (claim 1) or supporting (claim 8) the lateral flange of the protective cap. According to the appellant, the applied references, and particularly Desma, do not teach and would not have suggested a shoe having this feature (see pages 7 through 14 in the main brief). The appellant also relies on the 37 CFR § 1.132 affidavit of Richard Oris filed on January 11, 1996 (Paper No. 10) as evidence of non-obviousness because it

Appeal No. 97-2996
Control No. 90/003,884

purportedly establishes that the recited hard raised portion solves a problem not appreciated by Desma (see pages 12 and 13 in the main brief and pages 3 through 5 in the reply brief).

Desma discloses

a protective shoe of the kind comprising a steel cap at the toe of the shoe, an upper, and a sole of elastic material moulded to the upper . . . characterised by an outer sole of soft abrasion-resistant material and by at least one sole part of hard pressure-resistant material, in the region of the steel cap, extending down as far as the tread surface and adapted to resist displacement of the steel cap towards the tread surface [page 1, lines 38 through 47].

More particularly and with reference to the drawing figures, Desma teaches that

[e]ach of the illustrated shoes is provided with a steel toe-cap 14 which has an inwardly-extending flange 15 which rests directly or indirectly on a sole part 17a of hard pressure-resistant material extending down as far as the tread surface and adapted to resist displacement of the steel cap 14 towards the tread surface. Each shoe also comprises an outer sole 18 of soft abrasion-resistant material.

As may be seen in Figure 3 the flange 15 is approximately of U-shape in plan view.

In the shoes shown in Figures 1 to 3 the upper 10 extends over the steel cap 14 as far as the toe of the shoe and then inwardly under the flange 15 so that the cap 14 rests on a portion of the upper 10.

The sole part 17a of pressure-resistant material is formed in the width and shape of the flange 15 and is integral with an intermediate sole edge 17 which is also of hard pressure-resistant material and is moulded

Appeal No. 97-2996
Control No. 90/003,884

on to the upper 10. The sole edge 17 and the sole part 17a are moulded on to the upper 10 in a first injection-moulding operation, and then the outer sole 18 of soft abrasion-resistant material is moulded on in a second injection-moulding operation [page 1, line 89 through page 2, line 26].

As indicated above, the examiner considers the limitations in independent claims 1 and 8 relating to the hard raised portion to be met by Desma's sole part 17a of hard pressure-resistant material (also see pages 5 through 7 in the answer).

The appellant, on the other hand, contends that Desma's sole part 17a does not constitute "a hard raised portion integrally formed at the front end of the upper surface of said sole" as recited in claims 1 and 8. According to the appellant, "the hard raised portion as disclosed and claimed . . . comprises an integral part of the sole; but the hard raised portion does not extend to the sole's tread surface" (main brief, page 8, emphasis in the original) as does Desma's sole part 17a. The appellant also argues that "the sole part 17(a) of Desma is not formed on the upper surface of anything. . . . Thus, Desma fails to teach integrally forming a hard raised portion at the front end of the upper surface of the sole" (main brief, page 10, emphasis in the original).

Appeal No. 97-2996
Control No. 90/003,884

In reexamination proceedings, claims are given their broadest reasonable interpretation consistent with the specification without reading limitations from the specification into the claims. In re Paulsen, 30 F.3d 1475, 1479-1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). Interpreted under this principle, the recitations in claims 1 and 8 of "a hard raised portion integrally formed at the front end of the upper surface of said sole" read on Desma's sole part 17a. More particularly, Desma's sole part 17a is made of a "hard" pressure-resistant material, is a "raised portion" of the shoe as compared with the outer sole 18 of soft abrasion-resistant material, is injection molded and therefore "integrally formed," and is located "at the front end of the upper surface of said sole" (composed of sole elements 17, 17a and 18) as shown in Desma's Figures 1 and 2. Although Desma's sole part 17a does extend down to the tread surface as pointed out by the appellant, the appealed claims do not contain any limitation excluding the "hard raised portion" from extending down to the tread surface. In this regard, the appellant is improperly reading a limitation from the specification into the claims. Desma's sole part 17a also provides a base for resting or supporting the lateral flange 15 of Desma's toe-cap 14.

Appeal No. 97-2996
Control No. 90/003,884

The appellant's contention that the 37 CFR § 1.132 affidavit of Richard Oris constitutes persuasive evidence of non-obviousness is also unsound. In essence, Mr. Oris attributes slippage and sole-separation problems to the extension of Desma's sole part 17a to the tread surface, and states that the sole construction disclosed in the patent under reexamination solves these problems (see declaration paragraphs 6 and 7). As noted above, however, the claims on appeal do not exclude the "hard raised portion" recited therein from extending to the tread surface. Thus, the showing embodied by the Oris affidavit is entitled to little, if any, probative value with respect to the issues of obviousness raised in this appeal because it is not commensurate with the actual scope of the appealed claims.

In light of the foregoing and since the appellant has not otherwise challenged the examiner's findings as to what the applied references disclose or the examiner's conclusion that it would have been obvious to combine these references in the manner proposed so as to arrive at the subject matter recited in claims 1 through 5, 7 and 8, we shall sustain the standing 35 U.S.C. § 103 rejections of these claims.

Finally, we take the following actions in accordance with the provisions of 37 CFR 1.196:

Appeal No. 97-2996
Control No. 90/003,884

a) pursuant to 37 CFR § 1.196(b), we reject appealed claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Desma in view of Jallatte and Sisman, and further in view of the German reference; and

b) pursuant to 37 CFR § 1.196(d), we remand this reexamination proceeding to the examiner with the recommendation that claim 6 be rejected under 35 U.S.C. § 103(a) as being unpatentable over Desma in view of Jallatte and Sisman, and further in view of the German reference, and that claim 10 be rejected under 35 U.S.C. § 103(a) as being unpatentable over Desma in view of Jallatte and Sisman.

Claim 6 depends from independent claim 1 and recites that "said hard raised portion includes an upper surface and wherein said lateral flange [of the protective cap] extends rearwardly and inwardly so as to cover substantially the entire upper surface of said hard raised portion." In the appellant's words, "[c]laim 9 is an independent claim that contains the recitals of allowed claim 6. Claim 10 is an independent claim that contains the recitals of claims 6 and 8" (main brief, page 2, footnote 1).

The examiner concluded that the subject matter recited in these claims was patentable "because of the specific location and size of the flange and the size of the raised portion being

Appeal No. 97-2996
Control No. 90/003,884

completely covered by the flange. The prior art does not show or teach a 'raised portion' which is located solely under the flange portion of a toe cap" (final rejection, Paper No. 16, pages 4 and 5). Desma, however, discloses a toe-cap 14 having a lateral flange 15 which extends rearwardly and inwardly and "rests directly or indirectly on a sole part 17a of hard pressure-resistant material" (page 2, lines 1 through 3). Desma also teaches that the sole part 17a "is formed in the width and shape of the flange 15" (page 2, lines 17 and 18). This relationship between the flange 15 and sole part 17a is best shown in Desma's Figure 3 and would appear to meet, and certainly would have suggested, the subject matter at issue in claims 6, 9 and 10. Contrary to the position taken by the examiner, these claims do not require the raised portion (which corresponds to Desma's sole part 17a) to be completely covered by or located solely under the flange (which corresponds to Desma's flange 15). Thus, the examiner should have included claims 6 and 9 in the standing 35 U.S.C. § 103(a) rejection of claims 1 through 5 and 7 as being unpatentable over Desma in view of Jallatte and Sisman, and further in view of the German reference, and claim 10 in the standing 35 U.S.C. § 103(a) rejection of claim 8 as being unpatentable over Desma in view of Jallatte and Sisman.

Appeal No. 97-2996
Control No. 90/003,884

In summary:

a) the decision of the examiner to reject claims 1 through 5, 7, 8 and 9 is affirmed;

b) a new rejection of claim 9 is entered pursuant to 37 CFR § 1.196(b); and

c) this reexamination proceeding is remanded to the examiner with recommended rejections of claims 6 and 10 pursuant to 37 CFR § 1.196(d).

A period of two months is set in which the appellant may submit to the Primary Examiner an appropriate amendment, or a showing of facts or reasons, or both, in order to avoid the grounds set forth in the statement of the Board of Patent Appeals and Interferences under the provisions of 37 CFR § 1.196(d) and/or prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record with respect to the new rejection under 37 CFR § 1.196(b) if the appellant so elects.

In view, of the remand, the affirmance of the examiner's decision is non-final for purposes of seeking judicial review, and no request for reconsideration of the affirmance needs to be filed at this time.

Appeal No. 97-2996
Control No. 90/003,884

Upon conclusion of the proceedings before the Primary Examiner on remand, this case should be returned to the Board by the Primary Examiner so that the Board may either adopt its decision as final or render a new decision on all of the claims on appeal, as it may deem appropriate. Such return for this purpose is unnecessary if the application is abandoned expressly or as the result of an unanswered Office action, allowed or again appealed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR. § 1.136(a).

AFFIRMED AND REMANDED; 37 CFR § 1.196(b) and (d)

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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WILLIAM E. LYDDANE)	BOARD OF PATENT
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Appeal No. 97-2996
Control No. 90/003,884

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