

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BERNIE ALLEN and ZORAN PETROVIO

Appeal No. 97-3173
Application No. 08/462,310¹

ON BRIEF

Before McQUADE, CRAWFORD and GONZALES, Administrative Patent Judges

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 43 through 45, which are all of the claims

¹Application for patent filed June 5, 1995.

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pending in this application.²

We REVERSE.

According to appellants, the invention is directed to a golf shoe having a sole portion including a heel section, a shank section, a metatarsal section and a toe section and a spike socket frame embedded in and extending throughout all sections of the sole portion (brief, page 2). Claim 43 is illustrative of the subject matter on appeal and is reproduced below:³

43. A golf shoe comprising:
a sole portion having heel, shank, metatarsal and toe sections; and
a single frame embedded in the sole and extending across all sections, wherein the frame includes a plurality of spike sockets that are located in each of the sections and are approximately planar, and wherein the frame further includes rod shaped ribs that interconnect each of the spike sockets to at least two other spike sockets.

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

² Claim 43 was amended and claims 27 through 42 and 46 were canceled, subsequent to the final rejection. See Paper No. 15.

³ Claim 43 as reproduced in the "Appendix" to appellants' brief is incorrect.

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Strickland 1967	3,328,901	Jul. 04,
Bernier et al. (Bernier) 03, 1970	3,492,744	Feb.
Austin 1973	3,718,996	Mar. 06,

Claims 43 through 45 stand rejected under 35 U.S.C. § 103 as being unpatentable over Austin in view of Bernier in combination with Strickland.

The full text of the examiner's rejection and response to the argument presented by appellants appear in the answer (Paper No. 20), while the complete statement of appellants' argument can be found in the main and reply briefs (Paper Nos. 19 and 21).

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it

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is

our conclusion that the evidence adduced by the examiner is insufficient to establish a case of obviousness with respect to independent claim 43. Accordingly, we will not sustain the examiner's rejection of claim 43, and claims 44 and 45 dependent thereon, under 35 U.S.C. § 103. Our reasoning for this determination follows.

Claim 43 recites a golf shoe comprising a sole portion having heel, shank, metatarsal and toe sections and a single frame embedded in the sole and extending across all of the sections. The frame is further defined in claim 43 as including a plurality of spike sockets located in each of the sections of

the sole portion and rod shaped ribs interconnecting each of the spike sockets to at least two other spike sockets.

Appellants argue that the applied prior art fails to teach or suggest locating spike sockets in the shank section

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of the sole portion (main brief, pages 6 and 7).⁴ The examiner, on the other hand, asserts that Figure 10 of Austin shows at least two spike sockets in the shank section (answer, page 5). Our review of Austin, however, fails to reveal any teaching or suggestion that the members 40 which are most distant from the toe section in Figure 10 of Austin are located or should be located in the shank section of the sole. Austin neither describes the sole as including spike sockets in the shank section nor illustrates the "linkage" of Figure 10 incorporated into a shoe sole. Accordingly, we agree with appellants that Figure 10 of Austin would not have suggested locating spike sockets in the shank section, of the sole portion. Our review of Bernier and Strickland reveal that they suffer from the same deficiency.

⁴ The shank section is defined at page 10 of the specification as the section of the sole that underlies the arch of the foot and is illustrated as the section between lines CC and DD in Figure 2 of appellants' drawings.

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Thus, even if Austin were modified in view of Bernier and Strickland, as set forth in the rejection, all the limitations of claim 43 would not have been suggested by the applied prior art.⁵

Even if we agreed with the examiner that Austin would have suggested locating spikes in the shank section, we still could not sustain the stated rejection. In this regard, claim 43 requires "a single frame embedded in the sole and extending across all sections . . . wherein the frame further includes rod shaped ribs that interconnect each of the spike sockets to at least two other spike sockets." The examiner acknowledges that Austin does not show a frame including rod shaped ribs that interconnect each of the spike sockets to at least two other spike sockets (answer, page 4). To solve this deficiency in Austin, the examiner relies on Strickland which is described as teaching

⁵ The examiner also refers to U.S. Patent No. 2,416,526 (Koenig) as showing spike sockets extending in the shank section (answer, page 6). However, the examiner has not included this reference in the statement of the rejection. Where a reference is relied on to support a rejection, whether or not in a minor capacity, there is no excuse for not positively including the reference in the statement of the rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). See also Ex parte Raske, 28 USPQ2d 1304, 1305 (Bd. Pat. App. & Int. 1993). Accordingly, we have not considered the teachings of Koenig in reviewing the merits of the appealed rejection.

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a detachable golf cleat wherein the frame has thicker and more stiffer crosswise rod shaped ribs (20) and thinner lengthwise rod shaped ribs (18) and all of the sockets are interconnected to at least two other spike sockets.
(answer, page 4)

The examiner asserts that it would have been obvious to construct the frame taught by Austin with rod shaped ribs as taught by Strickland in order to provide a lightweight and flexible frame and because rod shaped ribs would be simpler and cheaper to make than the corrugated flexible portions 42 of Austin. (answer, pages 7 and 8). We do not agree.

Strickland discloses a detachable cleat assembly for converting ordinary street shoes into cleated shoes (col. 1, lines 8 and 9) including a one-piece, integrally molded, plastic web 12, a plurality of cleats 14 and anchoring means 16 for securing the web to the bottom of the sole of an ordinary street shoe (col. 2, lines 18-23). Strickland also teaches that the single piece, plastic construction can be inexpensively mass-produced (col. 2, lines 29-32). However, Austin likewise teaches that the link or mesh structure

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disclosed therein is "preferably formed of a moldable, castable or injectable material, such as a plastic material" (col. 3, lines 64-67). Since Austin and Strickland each teach that their

respective structures are capable of being fabricated of plastic using conventional molding techniques, we cannot subscribe to the examiner's determination that one of ordinary skill in the art at the time of appellants' invention would have been motivated to construct the frame disclosed in Austin using rod shaped ribs as taught by Strickland because it would have been simpler and cheaper to make. Thus, we must conclude that the examiner used impermissible hindsight.⁶

⁶ The conclusion that the claimed subject matter is obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual

(continued...)

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For the reasons set forth above, the rejection of claim 43 under 35 U.S.C. § 103 will not be sustained.

Claims 44 and 45 are dependent on claim 43 and contain all of the limitations of that claim. Accordingly, the examiner's rejection of claims 44 and 45 under 35 U.S.C. § 103 will not be sustained.

CONCLUSION

To summarize, the decision of the examiner to reject claims 43 through 45 under 35 U.S.C. § 103 is reversed.

REVERSED

JOHN P. McQUADE)
Administrative Patent Judge)
)

⁶(...continued)
basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

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