

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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ERNIE L. DEACON and FARIS W. McMULLIN

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Appeal No. 1999-2103  
Application No. 08/734,205

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ON BRIEF

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Before COHEN, STAAB and BAHR, Administrative Patent Judges.  
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 18-20, which are all of the claims pending in this application.

BACKGROUND

The appellants' invention relates to detachable cleats or spikes for golf shoes which are suitable for winter play (specification, page 1). Claim 18 is illustrative of the invention and reads as follows:

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18. A removable athletic shoe cleat comprising:  
a disk-like flange, having an upper surface, for placement underneath and in contact with the sole of an athletic shoe, and having an opposing bottom surface;

a plurality of ridges, each of said ridges being elongated and having a substantially triangular cross-sectional shape, and being integrally formed with and extending down from the bottom surface, for supplying traction against the ground; and

an attachment means, extending from the upper surface, for removably attaching the cleat to the athletic shoe, whereby the cleat provides traction but does not damage the surface being walked upon.

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

Zaleski et al. (Zaleski) 1949	2,491,596	Dec. 20,
Lorme (Swiss patent document)	62336	Nov. 11, 1912 <sup>1</sup>
Studer (Swiss patent document)	77922	Jun. 1, 1918 <sup>2</sup>
Castioni (Italian patent document)	467815	Dec. 22, 1951 <sup>3</sup>
Baylo (European patent application)	342232	Nov. 23, 1989

The following rejections are before us for review.

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<sup>1</sup> An English language translation of this reference, prepared by the Patent and Trademark Office, is appended hereto.

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

<sup>3</sup> We derive our understanding of this reference from the translation submitted by appellants with the appeal brief (Paper No. 17).

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(1) Claim 18 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Studer.<sup>4</sup>

(2) Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Studer in view of Zaleski.

(3) Claims 18 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Baylo in view of Lorme.

(4) Claims 18 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Baylo in view of Castioni.

(5) Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Baylo in view of Lorme, as applied above to claim 18, and further in view of Zaleski.

(6) Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Baylo in view of Castioni, as applied above to claim 18, and further in view of Zaleski.

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<sup>4</sup> Notwithstanding appellants' contention in the brief (page 7) and reply brief (page 3) that rejections (1) and (2) are based on the French Studer reference, the examiner's answer (pages 3-4) clearly states that the rejections are based upon the Swiss Studer reference (77922). As there is no indication that appellants timely filed a petition under 37 CFR § 1.181 alleging that the examiner's answer contained an impermissible new ground of rejection (37 CFR § 1.193(a)(2)), the right to make such allegation has been waived (MPEP § 1208.01). In any event, appellants concede, and the attached translation of the Swiss Studer reference confirms, that the disclosures of the French and Swiss references are the same (with the exception of the claims). Accordingly, in reaching our decision in this appeal, we have treated all arguments made by appellants with regard to the French Studer reference as applying equally to the Swiss Studer reference. Thus, appellants do not appear to be prejudiced by this treatment.

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Reference is made to the brief and reply brief (Paper Nos. 17 and 23) and the answer (Paper No. 19) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

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. As a consequence of our review, we make the determinations which follow.

***The anticipation rejection***

As noted above, the examiner's rejection of claim 18 under 35 U.S.C. § 102(b) is based upon the Swiss Studer reference, not the French Studer reference. Nevertheless, in that a comparison of the attached translation of the Swiss reference with the translation of the French reference supplied by appellants confirms that the disclosures (with the exception of the claims) are the same, for appellants' convenience, we shall refer to the translation of the French

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reference submitted by appellants in discussing the Studer reference.

Appellants argue on pages 8 and 9 of their brief that claim 18 is not anticipated by Studer because (1) Studer "never mentions 'ridges' or any similar term at all" and (2) even assuming that Studer shows "ridges" as claimed, Studer does not show an elongated ridge having a "substantially triangular" cross section, as required by claim 18.

Turning first to appellants' argument that Studer never mentions "ridges" or any similar term, we note that a reference does not fail as an anticipation merely because it does not contain a description of the subject matter of the appealed claim in *ipsisssimis verbis*. In re May, 574 F.2d 1082, 1090, 197 USPQ 601, 607 (CCPA 1978). Appellants' specification (page 6) defines a ridge as having "a crest that is at least one line, compared to the crest of the prior art spikes which are a point or a circle (for a truncated cone, for example)." From our perspective, even if appellants' translation (page 2) of the French Studer reference is

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accurate in translating "*nervures*"<sup>5</sup> (page 1, lines 28-29, of the French language document) as "grooves," the walls of the grooves are formed by ribs or ridges which, as clearly illustrated in Figures 4 and 5 of Studer, have a crest in the form of a line, as set forth in appellants' specification. According, we are of the opinion that Studer does indeed disclose elongated "ridges."

Turning now to appellants' second argument, we note that appellants have not expressly defined "substantially triangular" in their specification. In fact, aside from claim 18, the phrase "substantially triangular" does not appear in appellants' specification. With regard to the cross sectional shape of the ribs or ridges, appellants' specification (page 5) states:

The cross sectional shape of ribs 15 may be arcuate, triangular, rectangular, or a combination thereof. Preferably, ribs 15 are triangular, but with rounded edges to provide the best compromise between traction and damage to the turf. By "rounded edges" we mean that whenever two surfaces meet (the edge), the region of the edge is free from sharp points or angularity (rounded). This is true wherever our

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<sup>5</sup> The French-English Dictionary for Chemists (John Wiley & Sons, Inc. 1921) translates "*nervure*" as "vein, nerve (as of a leaf); rib; web, fin, vane, feather, flange, fillet; groove."

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cleat may meet the turf -- on the ribs 15 and on the bottom surface of the flange.

This disclosure indicates that the cross sectional shape of the ribs or ridges may have elements of arcuate, triangular and rectangular shapes. We interpret "substantially triangular" within this context to denote a shape having sidewalls which are spaced farther apart at the base than at an apex toward which they converge. The apex of such a "substantially triangular" shape may be rounded and the sidewalls of the "substantially triangular" shape may be either straight or curved and may comprise portions which are perpendicular to the base and, thus, do not converge toward the apex. This interpretation is consistent with the definition "triangular, but possibly with rounded corners, or possibly with sides that are nearly straight, but somewhat less than completely straight" urged by appellants on page 8 of the brief.

The ridges illustrated in Figures 4 and 5 of Studer, even if not perfectly triangular, certainly appear to us to have a cross-sectional shape which falls within the broad definition of "substantially triangular" set forth above. Thus, it is

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our opinion that the ridges between the grooves of Studer are "substantially triangular" as required by claim 18.

For the foregoing reasons, we shall sustain the examiner's rejection of claim 18 under 35 U.S.C. § 102(b).

***The obviousness rejections***

With regard to the examiner's rejection of claim 20 as being unpatentable over Studer in view of Zaleski, appellants' only argument (brief, page 9) is that Zaleski does not show or suggest elongated ridges with triangular<sup>6</sup> cross sections, which appellants have argued that Studer lacks. As we have concluded, *supra*, that Studer does disclose elongated ridges having substantially triangular cross-sectional shapes and as appellants have offered no other argument in support of the patentability of claim 20, it follows that we shall also sustain the examiner's rejection of claim 20 as being unpatentable over Studer in view of Zaleski.

The examiner also rejects claims 18 and 19 as being unpatentable over Baylo in view of Lorme. Baylo discloses a

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<sup>6</sup> We interpret appellants' argument to be that Zaleski does not teach or suggest ridges having "substantially triangular" cross sections, as this is the terminology used in claim 18.

multi-purpose shoe and a variety of different types of spikes for use in different applications. For example, Figures 4-9 illustrate, respectively, an ordinary spike (e.g., for use after golfing), a rain shoe spike, an ice/snow shoe spike, a golf spike, a fishing spike and a mountain climbing spike. In making this rejection, the examiner relies upon the spike illustrated in Figure 5 (the rain shoe spike) and discussed in column 5, lines 15-29. This spike comprises a disk-shaped portion 51a made of metal or plastic, an elastic member 51b fitted over the disk-shaped portion 51a to cover one surface thereof and screw portion 51c made of a metal or a plastic and extended from the other surface of the disk-shaped portion 51a in the direction perpendicular thereto. The surface of the elastic member 51b is formed of relatively small ridges and valleys in order to prevent slippage. Furthermore, the elastic member 51b is made of a rubber containing a non-slip agent.

According to the examiner, Baylo (Figure 5) discloses a removable athletic shoe cleat as recited in claim 18 except for the exact shape of the ridges (answer, page 3). We have considered appellants' argument (brief, pages 10-11) that the

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spike or cleat of Baylo's Figure 5 embodiment is not an athletic shoe cleat, in that it is disclosed as a rain spike, but we do not find it persuasive. As the shoe for use with which the rain shoe spike is disclosed is a multi-purpose shoe, with most of the enumerated purposes therefor being directed to athletics, the rain spike of Figure 5 is an "athletic shoe cleat" as claimed. Moreover, it is not apparent to us why the rain shoe spike of Figure 5 is not capable of use in an athletic endeavor or how it is to be distinguished from cleats which are used in athletic endeavors, aside from its intended use. It is well settled that the recitation of an intended use for an old product does not make a claim to that old product patentable. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

Lorme discloses a removable stud for the tread of shoes or tires for preventing, or significantly reducing, sliding on the street surface (translation, page 2). Lorme's studs have teeth which appellants concede are triangular in cross-section (brief, page 10).

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The basis of the examiner's rejection is that it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to shape the ridges as taught by Lorme in the cleat of Baylo to increase traction (answer, page 4). For the reasons which follow, we do not agree with the examiner.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Indeed, a *prima facie* case of obviousness is established where the reference teachings would appear to be sufficient for one of ordinary skill in the art having those teachings before him to make the proposed combination or modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

We recognize that both the rain shoe spike of Baylo (Figure 5) and the stud of Lorme are intended to reduce or prevent slippage. However, from our perspective, Lorme discloses an alternative spike for achieving this purpose.

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While Lorme may suggest replacing the rain shoe spike of Baylo with the stud taught by Lorme, we perceive no teaching or suggestion in the combined references to modify the shape of the ridges of Baylo's rain shoe spike as proposed by the examiner. Accordingly, we shall not sustain rejection (3).

The examiner has rejected claim 20, which depends from claim 18, as being unpatentable over Baylo in view of Lorme and Zaleski. The deficiency in the combination of Baylo and Lorme finds no cure in the teachings of Zaleski. Therefore, it follows that we shall also not sustain rejection (5).

Turning now to the examiner's rejection of claims 18 and 19 as being unpatentable over Baylo in view of Castioni, we note that Castioni discloses a rubber heel-tap and sole-tap which present a series of progressively circular ribbings 2-5. While Castioni (translation, pages 1 and 4) describes the taps as possessing the property of agility (nimbleness, elasticity, springiness or resilience), Castioni does not teach or suggest that the heel or sole taps reduce or prevent slippage, as the rain shoe spikes of Baylo are intended to do. Thus, it is not apparent to us why one of ordinary skill in the art would have found any suggestion in Castioni to modify the shape of the

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ridges of the Baylo rain shoe spike as proposed by the examiner. Accordingly, we shall not sustain rejection (4).

Turning finally to the examiner's rejection of claim 20 as being unpatentable over Baylo in view of Castioni and Zaleski, we have reviewed the teachings of Zaleski and find no teaching or suggestion therein to modify the shape of the ridges of Baylo's rain shoe spike to arrive at the claimed invention. It follows then that we shall also not sustain rejection (6).

#### CONCLUSION

To summarize, the decision of the examiner to reject claim 18 under 35 U.S.C. § 102(b) as being anticipated by Studer and claim 20 under 35 U.S.C. § 103(a) as being unpatentable over Studer in view of Zaleski is affirmed. The examiner's decision to reject claims 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Baylo in view of either Lorme or Castioni and claim 20 under 35 U.S.C. § 103(a) as being unpatentable over Baylo in view of either Lorme and Castioni and further in view of Zaleski is reversed.

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

AFFIRMED-IN-PART

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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