

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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANCIS C. CARROLL

Appeal No. 2000-2040
Application No. 09/027,867

ON BRIEF

Before McQUADE, NASE, and LAZARUS, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 5, 6, 9, 10, 15, 16 and 21, which are all of the claims pending in this application.¹

We REVERSE and REMAND.

¹ Claim 9 was amended subsequent to the final rejection.

BACKGROUND

The appellant's invention relates to a golf shoe cleat. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

Jordan et al. (Jordan)	4,014,114	Mar. 29, 1977
Johnson	4,327,503	May 4, 1982
Dassler	4,375,728	Mar. 8, 1983
Kelly	5,321,901	June 21, 1994
Kataoka et al. (Kataoka)	5,581,913	Dec. 10, 1996

Softspikes advertisement, "A Unique Holiday Offer," Golf Digest, page 149, December 1996 (Softspikes)

Claims 1, 15 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Softspikes in view of Dassler.

Claims 2, 5 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Softspikes in view of Dassler and Kelly or Jordan.

Claims 6 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Softspikes in view of Dassler and Kelly or Jordan and either Johnson or Kataoka.

Claim 16 stands rejected under 35 U.S.C. § 103 as being unpatentable over Softspikes in view of Dassler and Johnson or Kataoka.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 17, mailed January 27, 2000) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 16, filed December 29, 1999) and reply brief (Paper No. 18, filed March 24, 2000) for the appellant's arguments thereagainst.

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, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the

evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1, 2, 5, 6, 9, 10, 15, 16 and 21 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art 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) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The appellant argues in the briefs that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims under appeal require the claimed golf shoe cleat to include a plurality of teeth having a surface with an

outward angulation to provide lateral stability and enhanced traction. While Dassler does teach a cleat having arms disposed at an outward angulation to provide a high degree of slip resistance, sole elasticity, and lateral stability, we fail to find any motivation in any of the applied prior art, to have modified the Softspikes' golf shoe cleat to have included such a feature absent the use of impermissible hindsight.² It follows that we cannot sustain the examiner's rejections of claims 1, 2, 5, 6, 9, 10, 15, 16 and 21.

REMAND

We remand this application to the examiner for consideration of the following issues of patentability:

1. Are any of the pending claims anticipated under 35 U.S.C. § 102(b) by French Publication No. 2,679,421 (of record) to Bouyer? As shown in Figures 1-4 of Bouyer, the spike/cleat (for a sports shoe, especially a golf shoe) does include a plurality of points/teeth having a surface with an outward angulation.

² The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

2. Are any of the pending claims anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 3,656,245 (of record) to Wilson? As shown in Figures 3 and 4 of Wilson, the athletic shoe cleat does include webs 18 having a surface with an outward angulation.

3. Are any of the pending claims obvious under 35 U.S.C. § 103 by the combined teachings of Dassler (cited above) and U.S. Patent No. 3,859,739 (of record)? That is, from the teachings of U.S. Patent No. 3,859,739 would it have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Dassler's cleat shown in Figures 1-2 to be able to be screwed into a threaded insert on the outsole of a sports shoe, by means of a threaded extension and if so, does this result in the subject matter of any of the pending claims?

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 5, 6, 9, 10, 15, 16 and 21 under 35 U.S.C. § 103 is reversed. In addition, the application has been remanded to the examiner for further consideration.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (Seventh Edition, Rev. 1, Feb. 2000).

REVERSED and REMANDED

JOHN P. McQUADE)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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RICHARD B. LAZARUS)	
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