

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte PAUL ANDREW KELLY

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Appeal No. 2004-1264  
Application 09/909,168

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ON BRIEF

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Before ABRAMS, FRANKFORT, and BAHR, Administrative Patent Judges.  
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 18 through 34, all of the claims remaining in this application. Claims 1 through 17 have been canceled.

Appellant's invention relates to a shoe cleat of the type generally used, for example, in the soles of golf shoes.

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Independent claims 18 through 21, 28, and 31 through 34 are representative of the subject matter on appeal and a copy of those claims can be found in the Appendix to appellant's brief (pages 8-12).

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

Ferreira	5,123,184	Jun. 23, 1992
Kelly	6,272,774	Aug. 14, 2001

Claims 18 through 34 stand rejected under 35 U.S.C. §102(b) as being anticipated by Ferreira.

Claims 28 through 30 and 34 additionally stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of appellant's prior U.S. Patent No. 6,272,774.<sup>1</sup>

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<sup>1</sup> The examiner's final rejection of claims 18 through 27 and 31 through 33 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of appellant's prior U.S. Patent No. 6,272,774 has now been withdrawn by the examiner (supp. answer, page 3).

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The examiner's statement of the above-noted rejections and response to appellant's arguments appears on pages 3 through 11 of the supplemental examiner's answer (Paper No. 19, mailed December 19, 2003). Appellant's views concerning the examiner's rejections before us on appeal are found in the brief (Paper No. 13, filed October 31, 2002) and reply brief (Paper No. 15, filed January 16, 2003).

#### OPINION

In arriving at our decision in this appeal, we have given careful consideration to appellant's specification and claims, the applied references, and the respective viewpoints of appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

Turning first to the examiner's rejection of claims 28 through 30 and 34 under the judicially created doctrine of obviousness-type double patenting, we understand the examiner's position to be that 1) application claims 28 through 30 and 34 directed to a "shoe cleat" are merely broader than claim 1 of

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appellant's prior U.S. Patent No. 6,272,774 which is directed to a "shoe cleat and holder combination," and 2) "it would have been obvious to leave out the other elements" (supp. answer, page 6). Thus, the examiner points to the shoe cleat of the application claims and the requirement therein of "at least a first locking member" and finds correspondence with the shoe cleat of combination patent claim 1 and its recitation of "a locking means." The examiner further contends that "[t]he remaining language is all functional and the shoe cleat [of patent claim 1] is inherently capable of performing the function as claimed inasmuch as it has all of the structural limitations" (supp. answer, pages 6-7).

Appellant's response to the examiner's double patenting rejection is to point out that the application claims at issue are directed to a shoe cleat alone, while claim 1 of the '774 patent is directed to a shoe cleat and holder combination, and to further assert that "[a]pplicant is unable to find any precedent supporting an obviousness-type double patenting rejection where the patent claims are directed to a combination and the application claims are directed to a sub-combination" (brief,

page 7). Thus, appellant urges that the combination claims do not render the sub-combination claims obvious, and contends that the examiner has submitted no authority to the contrary.

What is immediately apparent from the foregoing is that appellant has made no attempt to provide a specific merits-based argument establishing error in the examiner's rejection of claims 28 through 30 and 34 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of appellant's prior U.S. Patent No. 6,272,774. Instead, appellant merely indicates that he is unaware of any precedent supporting an obviousness-type double patenting rejection where the patent claims are directed to a combination and the application claims are directed to a sub-combination. It further appears from comments on page 8 of the brief that if such an obviousness-type double patenting rejection is a viable rejection in a combination/sub-combination context, then appellant intends to file an appropriate terminal disclaimer to overcome the rejection.

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As noted in In re Berg, 140 F.3d 1428, 1432, 46 USPQ2d 1226, 1229 (Fed. Cir. 1998), obviousness-type double patenting is a judge-made doctrine that prevents an extension of the patent rights beyond the statutory limit and requires rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent. Its purpose is to prevent an unjustified extension of the term of the right to exclude granted by a patent by allowing a second patent claiming an obvious variant of the same invention to issue to the same owner later. In the present case, it is the examiner's view that the shoe cleat defined in application claims 28 through 30 and 34 is obvious in view of the shoe cleat which is an element of combination claim 1 of appellant's '774 patent.

In the context of a combination/sub-combination as framed by appellant, we note that as early as 1951 the Court of Customs and Patent Appeals (CCPA) recognized the possibility of obviousness-type double patenting being an issue where the patent claims are directed to a combination and the later filed application

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claim(s) are directed to a sub-combination. See, In re Coleman, 189 F.2d 976, 979, 90 USPQ 100, 102 (CCPA, 1951), wherein the Court notes that

It is settled law that a party might be entitled to a patent for a combination because of the cooperation of the elements contained therein, and at the same time be entitled to a separate patent for one of the elements of the combination. In re Carlton, 22 C.C.P.A. (Patent) 1223, 77 F.2d 363, 25 USPQ 390; In re Ferenci, 23 C.C.P.A. (Patents) 1023, 83 F.2d 279, 29 USPQ 162. In such a case, the question to be determined is whether two or more different inventive concepts are involved. In re Hadsel, 36 C.C.P.A. (Patents) 1075, 173 F.2d 1010, 81 USPQ 376. If the claims are so related that the separately claimed element constitutes the essential distinguishing feature of the combination as claimed, different concepts are not involved, the inventions are not distinct, and double patenting will be found.

In re Coleman, was further cited with approval in another combination/subcombination double patenting case, i.e., In re Heinle, 342 F.2d 1001, 1005, 145 USPQ 131, 134 (CCPA 1965).

Although the Court in Heinle determined that double patenting did not exist in that case because the tubular core "subcombination" was determined not to be the "essential distinguishing feature" of the combination claim of the Heinle patent.

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In the absence of any substantive argument from appellant and since it is abundantly clear to us that an obviousness-type double patenting rejection is a viable rejection where the patent claims are directed to a combination and the later filed application claims are directed to a sub-combination, if the claims of the patent and application are so related that the later claimed element (sub-combination) is the "essential distinguishing feature" of the combination, we will sustain the examiner's rejection of claims 28 through 30 and 34 under the judicially created doctrine of obviousness-type double patenting.

Next we look to the examiner's rejection of claims 18 through 34 under 35 U.S.C. § 102(b) based on Ferreira. In this instance, the examiner notes that Ferreira teaches (e.g., in Figures 3-7) a shoe cleat or spike-carrying unit (26) including a screw-threaded spigot (34) and a body member having a ring of free-standing, axially extending posts or lock tongues (33) projecting therefrom, with the lock tongues each including a base secured to the body member. The examiner then observes that "[a]ll of the functional claim language and statements of intended use do not make an otherwise unpatentable claim

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patentable" (supp. answer, page 4). Subsequently, the examiner contends that "[s]ince the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed" (supp. answer, pages 5-6).

In both the brief and reply brief, appellant acknowledges that the posts or locking tongues (33) of the shoe cleat in Ferreira are resiliently deflectable in the axial and circumferential directions as they pass over successive cam surfaces (41a) of socket side projections (41) as seen in Figure 5 of that patent. However, appellant points out that each of the claims presently on appeal defines posts or locking members that are resiliently deflectable in a generally radially outward direction in response to outwardly applied forces applied to the posts/locking members during rotary insertion thereof into a socket, and contends that the examiner's conclusion of inherency in this regard is not justified by the Ferreira disclosure.

On page 8 of the answer, the examiner indicates agreement with appellant that the posts (tongues) of Ferreira are not taught to be deflectable in a radially outward direction,

however, the examiner goes on to urge that inasmuch as the posts (tongues) of Ferreira will resiliently deflect in the vertical and axial direction "then they are inherently capable of deflecting in a generally radially outward direction in response to an outwardly directed force."

It is well settled that inherency may not be established by probabilities or possibilities, but must instead be "the natural result flowing from the operation as taught." See In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). In the present case, the disclosure of Ferreira does not provide an adequate factual basis to establish that the natural result flowing from following the teachings of that reference would be a post or locking member which is deflectable in a generally radially outward direction in response to outwardly applied forces applied to the posts/locking members during rotary insertion thereof into a socket, as required in appellant's claims on appeal. This is especially true in Ferreira since we have no idea as to the exact structure of the lock tongues (33) in the radial direction, even in the embodiment described in column 2, lines 42-46, of that patent. Moreover, we also note our agreement with appellant's

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views as set forth on page 3 of the reply brief concerning those claims on appeal which set forth that the radially inner surface of the posts have a convex profile. Thus, we can not sustain the examiner's rejection of claims 18 through 34 under 35 U.S.C. § 102(b) based on Ferreira.

To summarize our decision, we have sustained the examiner's rejection of claims 28 through 30 and 34 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,272,774. However, we have not sustained the examiner's rejection of claims 18 through 34 under 35 U.S.C. §102(b) based on Ferreira.

In accordance with the foregoing, the decision of the examiner is affirmed-in-part.

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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

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JENNIFER D. BAHR	)	
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