

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOSEPH J. SKAJA

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Appeal No. 1998-1430  
Application No. 08/376,298

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HEARD: JANUARY 10, 2000

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

DECISION ON APPEAL

This is a decision on an appeal from the examiner's decision twice rejecting claims 121-134, all the claims currently pending in the application.

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Appellant's invention pertains to a shoe sole component comprising flexible thermoplastic top and bottom sheets of substantially uniform thickness having compressible indentations molded therein. Each indentation defines a recess opening to one side of the sheet and a projection extending from the other side of the sheet. The sheets are joined at their outer peripheries to define a cavity therebetween such that a plurality of the projections of the top and bottom sheets abut one another.

Independent claim 121, a copy of which is found in an appendix to appellant's brief, is illustrative of the appealed subject matter.

The references of record relied upon by the examiner in support of the appealed rejections are:

Staats-Oels	1,539,283	May 26, 1925
Derderian et al. (Derderian)	4,535,553	Aug. 20, 1985

The following rejections are before us for review:<sup>1</sup>

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<sup>1</sup>In the previous office action, claims 121, 124-127, and 130-132 were also provisionally rejected under obviousness-type double patenting. In that appellant has filed a terminal disclaimer, and in that the examiner's answer does not contain a restatement of this provisional rejection, we assume it to have been withdrawn. See *Ex parte Emm*, 118 USPQ 180, 181 (Bd. App. 1957).

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1. Claims 121-132, rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. § 103 as obvious over Derderian.

2. Claims 121, 127, 133 and 134, rejected under 35 U.S.C. § 103 as being unpatentable over Derderian.

3. Claims 121, 122, 124, 125, 127, 128, 130 and 131, rejected under 35 U.S.C. § 103 as being unpatentable over Staats-Oels.

With respect to the rejections based on Derderian (i.e., rejections 1 and 2), the essence of the rejections is the examiner's determination that the elongated members 26 of Derderian's insert member 22 collectively comprise a "sheet" of substantially uniform thickness, as called for in claims 121 and 127, and that the flexible legs 32 and cap portions 42 of Derderian's insert member 22 collectively comprise a plurality of resiliently compressible (or deformable) "indentations" in the sheet, with each "indentation" defining a "projection" extending away from one side of the "sheet" and a "recess" extending into an opposite side of the "sheet," also as called for in claims 121 and 127. Appellant argues (main brief, page 3) that the examiner has misconstrued the

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words "sheet" and "indentations" appearing in the claims. Appellant also argues (reply brief, pages 1-2) that the examiner's construction of these terms is inconsistent with appellant's specification and improperly overbroad. In responding to appellant's arguments, the examiner contends (answer, pages 7-9) that the terms "sheet" and "indentations" appearing in the appealed claims are sufficiently broad to read on the noted components of the insert member 22 of Derderian.

While it is true that the claims in a patent application are to be given their broadest reasonable interpretation consistent with a specification (*In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)), and that limitations from a pending application's specification will not be read into the claims during prosecution of a patent application (*Sjolund v. Musland*, 847 F.2d 1573, 1581-82, 6 USPQ2d 2020, 2027 (Fed. Cir. 1988)), it is also well settled that terms in a claim should be construed in a manner consistent with the specification and construed as those skilled in the art would construe them (see *In re Bond*, 910

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F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990);  
*Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 986, 6  
USPQ2d 1601, 1604 (Fed. Cir. 1988); and *In re Sneed*, 710 F.2d  
1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983)).

In the present case, it is clear that appellant's use of the terms "sheet" and "indentations" is consistent with the ordinary and accepted dictionary definition of these words.<sup>2</sup> In contrast, the portions of Derderian's insert member that the examiner contends form a "sheet" are actually a plurality of rod-like base members 26 that collectively form a skeletal framework of hexagons (see particularly Figure 3), and the portions of Derderian's insert member that the examiner contends form "indentations" in the "sheet" are actually a plurality of flexible legs 32 joined at their ends by hexagonal cap members 42. We appreciate that in side elevation, base members 26 of Derderian appear as a planar

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<sup>2</sup>The word "sheet" may mean "[a] broad, thin, usu. rectangular piece of material, as paper, metal, glass, or wood" or "[a] broad, flat, continuous surface or expanse." The word "indentation" may mean "[t]he . . . state of being indented," and the word "indent" may mean "[t]o impress (e.g., a design): stamp." *Webster's II New Riverside University Dictionary*, Riverside Publishing Company, copyright © 1984 by Houghton Mifflin Company.

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member of uniform thickness. We also appreciate that the flexible legs 32 and cap members 42 of Derderian project above the plane of the base members 26 to set off and in part circumscribe a hollow space. Nevertheless, we can think of no circumstances under which an artisan, consistent with appellant's specification, would construe such structure as corresponding to the claimed flexible "sheet" of substantially uniform thickness having "indentations" therein. From our perspective, Derderian's base members 26 do not define a "sheet" (e.g., a thin piece of material having a broad, generally flat, continuous surface), and Derderian's legs 32 and cap members 42 do not define "indentations" (e.g., structures that are impressed in or stamped from the base members 26). The examiner's position to the contrary is strained and unreasonable. Furthermore, Derderian contains no teaching of making the insert member as a "sheet" having "indentations" therein, as now claimed. Accordingly, we cannot sustain the examiner's anticipation and obviousness rejections based on Derderian.

Turning to the obviousness rejection based on Staats-Oels (rejection 3), Staats-Oels discloses a shoe sole component

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comprising a slab-like attaching section 1 and a slab-like tread section 2. Section 1 includes a flange 3 adjacent to the periphery of the section, and section 2 includes a peripheral flange 4 for receiving the flange of section 1. Each section includes cone-shaped bosses 6 extending from one side of the section. The bosses have recesses 9 and 10 extending partially therethrough, with the bosses of section 2 being recessed at 8 to receive the ends of the bosses of section 1. As with the rejection based on Derderian, we do not think an artisan, consistent with appellant's specification, would construe such structure as corresponding to the claimed flexible "sheet" of substantially uniform thickness having "indentations" therein. In our view, Staats-Oels' slab-like sections 1 and 2 do not define "sheets" (e.g., thin pieces of material having a broad, generally flat, continuous surface), and Staats-Oels' cone-shaped bosses 6 do not define "indentations" (e.g., structures that are impressed in or stamped from sections 1 and 2). Here again, the examiner's position to the contrary is strained and unreasonable. Further, Staats-Oels contains no teaching of making either section as a "sheet" having "indentations"

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therein, as now claimed. In light of the foregoing, we cannot sustain the examiner's rejection of claims 121, 122, 124, 125, 127, 128, 130 and 131 as being unpatentable over Staats-Oels.

The decision of the examiner is reversed.

REVERSED

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

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