

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. 42

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BYRON A. DONZIS

Appeal No. 1999-2107
Application No. 08/926,299

ON BRIEF

Before ABRAMS, METZ and McQUADE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 27, 30-38, 43 and 48, as amended after the final rejection.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to an apparatus for protecting feet (claims 27, 30-32, 34, 37 and 38), a method for protecting feet (claims 33, 35, 36 and 48), and to a foot protection system (claim 43). An understanding of the invention can be derived from a reading of exemplary claim 27, which appears in the appendix to the appellant's Brief.

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

Vaccari	4,232,459	Nov. 11, 1980
Vermonet	4,361,969	Dec. 7, 1982
Cohen <u>et al.</u> (Cohen)	5,158,767	Oct. 27, 1992

Claims 27 and 30-33 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claims 34, 37, 38, 43 and 48 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.¹

Claims 27, 30-38, 43 and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Vermonet in view of Vaccari.

¹ Claims 37 and 38 should have been listed with claim 34, from which they depend.

Claims 27, 30-38, 43 and 48 also stand rejected under 35 U.S.C. § 135(b) as not being made prior to one year from the date on which Cohen U.S. Patent No. 5,158,767 was granted (See MPEP § 2307.02).

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. 32) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 31) and Reply Brief (Paper No. 33) 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 references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The appellant's invention is directed to a tennis type shoe having an inflatable pad capable of having its internal pressure changed attached to the shoe, a built-in pump attached to the shoe, and a passage within the shoe establishing communication between the pad and the pump. As disclosed, the inflatable pad can be located in the sole of the shoe or in the heel portion of the upper, the pump is attached to the pad by means of a passage located within the shoe, and a one-way valve is attached to the pump.

The Rejection Under Section 112, First Paragraph

It is the examiner's view that there is no basis in the specification for the limitation in claims 27 and 30 that the shoe comprises "a generally flexible upper." The appellant's response is that such a limitation is implicit to one of ordinary skill in the art in the description of the invention in the specification, and is conveyed to the artisan by Figure 14. We agree, and we will not sustain this rejection.

The Rejection Under Section 112, Second Paragraph

The only one of the issues under this rejection that remains subsequent to the entry of the amendment after the final rejection is the "means for enclosing a foot . . ." appearing in claims 43 and 48, which the examiner believes is unclear. We agree with the appellant that this is an expression of structure in the "means-plus-function" style that is permitted under the sixth paragraph of Section 112. This rejection is not sustained.

The Rejection Under Section 103

Claims 27, 30-38, 43 and 48 stand rejected as being unpatentable over Vermont in view of Vaccari. The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973

(Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

Vermonet discloses a shoe comprising a first inflatable chamber 18 located in the sole of the shoe beneath the heel, second and third inflatable air chambers 19 in the sides of the shoe upper flanking the portion in which the user's heel fits, and a fourth inflatable air chamber 20 on the upper edge of the heel portion of the upper. The four chambers are connected, and a valve 11 is provided to inflate them. They are filled to a moderate pressure. Because of the connection between them, when high pressure is placed upon one chamber, the reduction in volume in that chamber is accommodated by being transmitted to the other chambers in the form of an increase in pressure which, however, is smaller than if a single chamber had to absorb all of it. With regard to the structure recited in claim 27, Vermonet does not disclose or teach "a built-in pump attached to the shoe" or, it follows, "a passage within the shoe establishing fluid communication" between the pump and the chamber(s) or "a one-way valve attached to the pump."

Vacarri is directed to a ski boot of the type having a bladder which is inflated by the user after the boot is put on "so as to firmly lock the foot inside the boot," that is, the user

puts on the boot and then pumps air into the bladder until the boot reaches the desired level of tightness around the user's foot (column 1, lines 9-12). The bladder is deflated prior to removing the boot. Vaccari's improvement is to position a pumping means on the boot in such a location as to allow it to easily be operated by the wearer when the foot is in the boot.

It is the examiner's view that one of ordinary skill in the art would have found it obvious to install a built-in pump on the Vermonet shoes in view of the teachings of Vaccari, "to make the shoe easier to use by making the pump always easily available" (Answer, page 5). However, we do not agree with this conclusion. Unlike the Vaccari ski boot, in which the air chamber is inflated each time the boot is put on in order to provide firm gripping of the foot and is deflated each time in order to allow the boot to be removed, there is no such explicit teaching or apparent requirement with regard to the Vermonet shoe. It appears to us that the Vermonet shoe initially is provided with a level of air pressure in the chambers which cushions the sole of the foot each time it strikes the walking surface, considering that such striking causes air to flow from the sole chamber to the side chambers and seldom, if ever, would need to be adjusted. In any event, such action clearly is not explicitly suggested in the disclosure. Moreover, there is nothing in the disclosure that suggests the chambers must be deflated to put the shoe on or take it off, which is the problem solved in the Vaccari invention.

The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See, In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). We fail to perceive any teaching, suggestion or incentive in the two applied references which would have led one of ordinary skill in the art to modify the Vermonet shoe in the manner proposed by the examiner since there appears to be no reason to do so. From our perspective, the only suggestion for doing so is found in the luxury of the hindsight afforded one who first viewed the appellant's disclosure. This, of course, is not a proper basis for a rejection under Section 103. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

The combined teachings of Vermonet and Vaccari therefore fail to establish a prima facie case of obviousness with regard to the subject matter of claim 27 and we will not sustain the rejection of claim 27 or of claims 30-32, which depend therefrom.

Independent claim 33, while directed to a method for protecting feet, requires the presence of a built-in pump. The same is true of independent apparatus claims 34 and 43, and independent method claim 48. On the basis of the same reasoning, we will not sustain the rejection of these claims or the claims that depend from them.

The Rejection Under Section 135(b)

According to the examiner, all of the claims on appeal are rejected under 35 U.S.C. § 135(b), presumably because the appellant is claiming “the same or substantially the same subject matter” as that claimed in the Cohen patent and did so more than one year after the Cohen patent was granted, although the precise language used in Section 135(b) is not stated or applied by the examiner. Moreover, the examiner has not informed us as to which of the patent claims are in issue and has not provided an explanation as to why each of the application claims sets forth “the same or substantially the same subject matter” as a patent claim. Thus, we are left essentially to our own devices to evaluate each claim.

At the outset, we find ourselves in agreement with the appellant that the only claim that could be involved in this rejection is Cohen's claim 6, for the others contain limitations that are far removed from the subject matter in the appellant's claims. Claim 6 is a Jepsen-type claim in which the components of an athletic shoe of the same general construction as that of the appellant's invention are recited in the preamble, and the appellant has advanced no arguments directed to this portion of the claim. The “improvement” provided in claim 6 comprises “an inflatable bladder disposed within said upper and a pump substantially permanently affixed to said upper for inflating said bladder with air.” The issue with regard to each of the appellant's claims thus is whether it contains “the same or substantially the same subject matter” as claim 6 of the patent.

Turning first to independent claim 27, this claim recites, inter alia, an inflatable pad attached to the shoe, a built-in pump attached to the shoe, “a passage within the shoe” and establishing fluid communication between the pump and the pad, and “a one-way valve attached to the pump.” The appellant argues that claim 27 is more detailed than Cohen’s claim 6 in that the patent claim does not require that there be a passage “within the shoe” or a “one-way valve” that is “attached to the pump.” In this regard, the appellant further points out that in the Cohen specification the location of the passage 55 between the pump and the pad is not described, and it is shown in Figure 3 as being on the outside of the shoe. From our perspective, a comparison of the language of the two claims clearly indicates that they do not recite the same subject matter, for the application claim contains elements not found in the patent claim. Nor, in our view, is the subject matter substantially the same, inasmuch as patent claim 6 is broad enough to include means other than a passage “within” the shoe to provide the required communication between the bladder and the pump, means other than a one-way valve for causing the air to be maintained in the inflatable bladder and/or pump, and to allow this means to be located at a point other than “attached” to the pump. We therefore agree with the appellant that these differences cause claim 27 not to be directed to the same or substantially the same subject matter as patent claim 6 and we will not sustain the rejection under Section 135(b).

We reach the same conclusion with regard to claims 31 and 32, which depend from claim 27, for the same reasons, and therefore will not sustain the rejection of these two claims.

Independent claim 33 is directed to a method for protecting feet, and contains the limitations that the pump be connected to the pad by a passage “within the shoe,” and that there be a “pump cavity having a one-way valve.” Even giving a broad interpretation to the latter phrase, claim 33 requires a one-way valve, which is not in Cohen’s claim 6, as well as locating the passage between the pump and the pad within the shoe, which is not required by claim 6 of the patent. This causes us also to conclude that claim 33 is not directed to the same or substantially the same subject matter as patent claim 6, and we will not sustain this rejection.

Claim 36 depends from claim 33, and thus avoids being categorized as the same or substantially the same subject matter on the same grounds as claim 33. The rejection of claim 36 is not sustained.

Claim 30 also depends from claim 27 and therefore includes all of the limitations therein set forth. It further requires that the pad be located in the sole of the shoe, as opposed to the pad in claim 6, which is specified as being in the upper. Thus, claim 30 avoids being directed to the same or substantially the same subject matter as Cohen’s claim 6 for the same reasons as claim 27, plus the placement of the pad in the sole, and

we will not sustain this rejection. It is noteworthy in this regard to recognize that the objective of the Cohen invention recited in claim 6 is to provide an inflatable means in the shoe upper to tighten the grip of the laced shoe upon the wearer's foot, which would appear to preclude its being placed in the shoe sole.

Claim 35 adds to claim 33 the additional requirement that the pad be in the sole of the shoe, and therefore avoids the category in issue on the same basis as claim 33, plus the location of the pad. The rejection is not sustained.

Independent claims 43 and 48 also require that the pump be in the sole of the shoe, which leads to the conclusion that they are not directed to the same or substantially the same subject matter as Cohen's claim 6, on the basis of the reasoning expressed above. We will not sustain this rejection of claims 43 and 48.

Claim 34 reads as follows:

Apparatus for protecting feet, comprising:
a tennis type shoe suitable for activities that include running;
inflatable pad means for providing cushioning protection against impact and shock attached to said tennis type shoe; and
inflation means attached to a shoe upper in fluid communication with the pad means for permitting a wearer to alter fluid content within the pad while said shoe is worn.

The only argument presented by the appellant is that this claim is not directed to the same or substantially the same invention as Cohen's claim 6 because the phrase "inflatable pad means for providing cushioning protection against impact and shock" is a means-plus-

function description of structure that is substantially different in function and structure than the bladder recited in Cohen's claim 6. We find ourselves in agreement with the examiner that this phraseology recites a structural element followed by an intended use, rather than a means-plus-function expression of structure.

The guidance provided by our reviewing court on this matter is expressed in Signtech USA Ltd. v. Vutek Inc., 174 F.3d 1352, 1356, 50 USPQ2d 1372, 1374-75 (Fed. Cir. 1999), which states that if the word "means" appears in a claim element in combination with a function, it is presumed to be a means-plus-function element to which 35 U.S.C. § 112, sixth paragraph, applies; however, according to the language of the statute, the sixth paragraph governs only claim elements that do not recite sufficient structure in support of the means-plus-function element.² The court in Signtech decided that the phrase "ink delivery means" which was in issue there fell under the sixth paragraph because "ink delivery" is "purely functional language" and the claim "does not recite disqualifying structure which would prevent application" of the sixth paragraph (174 F.3d at 1356, 50 USPQ2d at 1375). That is not so, in our view, in the situation before us. Independent claim 34 recites "inflatable pad means for providing cushioning protection against impact and shock" (emphasis added). The common applicable definition of "pad"

²Citing Sage Prods., Inc. v. Devon Indus., Inc., 126 F.3d 1420, 1427, 44 USPQ2d 1103, 1109 (Fed. Cir. 1997).

is “a thin mat or cushion: as . . . a guard worn to shield body parts against impact.”³ Thus, “inflatable pad means” is, in and of itself, a specific structural element which is being used in accordance with its definition, that is, for providing cushioning protection against impact and shock, and therefore it does not fall within the scope of the sixth paragraph of Section 112 as would “means for providing cushioning protection against impact and shock,” for example.

In view of the foregoing, it is our opinion that the subject matter recited in application claim 34 is the same or substantially the same as that of patent claim 6. In this regard, the “inflatable pad means . . . attached to said tennis type shoe” of claim 34 corresponds to the “inflatable bladder disposed within said upper” of patent claim 6. With regard to function or use, application claim 34 requires that the pad means provide cushioning protection against impact and shock, but does not specify where on the shoe it need be located, and the bladder of patent claim 6 inherently would provide such protection in its location on the shoe upper, along with its disclosed function of tightening the shoe on the user’s foot. Application claim 37, which depends from claim 34, states that the pad means is located in the shoe upper, which is exactly where the bladder is located in patent claim 6. We therefore will sustain the Section 135(b) rejection of claims 34 and 37.

³See, for example, Merriam Webster’s Collegiate Dictionary, Tenth Edition, 1996, page 834.

We will not, however, sustain this rejection of dependent claim 38, which locates the pad means in the shoe sole, as opposed to the shoe upper, as is specified in patent claim 6.

SUMMARY

The rejection of claims 27 and 30-33 under 35 U.S.C. § 112, first paragraph, is not sustained.

The rejection of claims 34, 37, 38, 43 and 48 under 35 U.S.C. § 112, second paragraph, is not sustained.

The rejection of claims 27, 30-38, 43 and 48 under 35 U.S.C. § 103(a) as being unpatentable over Vermonet in view of Vaccari is not sustained.

The rejection of claims 27, 30-33, 35, 36, 38, 43 and 48 under 35 U.S.C. § 135(b) is not sustained.

The rejection of claims 34 and 37 under 35 U.S.C. § 135(b) is sustained.

The decision of the examiner is affirmed-in-part.

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
ANDREW H. METZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

Appeal No. 1999-2107
Application No. 08/926,299

Page 16

SUE Z. SHAPER
FELSMAN, BRADLEY, VADEN, GUNTER & DILLON
ONE RIVERWAY, SUITE 1100
HOUSTON , TX 77056-1920

APPEAL NO. 1999-2107 - JUDGE ABRAMS
APPLICATION NO. 08/926,299

APJ ABRAMS

3 JUDGE CONFERENCE

APJ McQUADE

APJ METZ

DECISION: **AFFIRMED-IN-PART**

Prepared By:

DRAFT TYPED: 14 Aug 02

FINAL TYPED: