

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

Paper No. 52

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL P. KOLADA,
TERRY M. BIRCHLER,
MICHAEL J. PAINTER,
and STEPHEN D. OPIE

Appeal No. 2000-0321
Application No. 08/834,578

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, 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, 4-9, 13, 15 and 16, which are all of the claims pending in this application.

We REVERSE and enter a new rejection pursuant to 37 CFR

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§ 1.196(b).

BACKGROUND

The appellants' invention relates to footwear and insole assemblies for footwear (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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

Arrowsmith 1903 (Arrowsmith '523)	717,523	Jan. 6,
Arrowsmith 1913 (Arrowsmith '306)	1,055,306	Mar. 11,
Lobel 1935	2,022,247	Nov. 26,
Rigandi 1936	2,063,625	Dec. 8,
Gilkerson 8, 1966	3,233,348	Feb.
Brown 1985	4,510,700	Apr. 16,
Meyer 1988	4,756,096	July 12,

Claims 1, 2 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Rigandi in view of Arrowsmith '306 or Arrowsmith '523 and Lobel.

Claims 6-9, 15 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Rigandi in view of Arrowsmith '306 or

Arrowsmith '523 and Lobel as applied above, and further in view of Meyer.

Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Rigandi in view of Arrowsmith '306 or Arrowsmith '523 and Lobel as applied above, and further in view of Gilkerson.

Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Rigandi in view of Arrowsmith '306 or Arrowsmith '523, Lobel and Gilkerson as applied above, and further in view of Brown.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 48, mailed June 28, 1999) for the examiner's complete reasoning in

support of the rejections, and to the brief (Paper No. 47, filed June 7, 1999) and reply brief (Paper No. 49, filed September 1, 1999) for the appellants' arguments thereagainst.

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. 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 rejections of claims 1, 2, 4-9, 13, 15 and 16 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).

Basic to all the rejections before us in this appeal is the examiner's determination (answer, pp. 3 and 7-8) that Rigandi's member 80 and wing 86 were readable on the claimed "resilient support member" and "resilient cantilevered arm member." We agree with the appellants (brief, pp. 10-11, and reply brief, pp. 2-4) that the above-noted determinations of the examiner are incorrect. In that regard, Rigandi describes (page 2, left column, lines 4-5) member 80 as "a rigid member having end wings 82 and 84 and a center wing 86." Thereafter, Rigandi teaches that the rigid member 80 is preferably formed from metal. Since a rigid member is the antithesis of a resilient member for the reasons pointed out by the appellants, it is our view that Rigandi's member 80 and wing 86 are not readable on the claimed "resilient support member" and "resilient cantilevered arm member." Thus, even if it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have modified Rigandi as set forth in the rejections under appeal, such

modifications would not have arrived at the claimed invention.¹

We have reviewed the references to Arrowsmith '306, Arrowsmith '523, Lobel, Meyer and Gilkerson but find nothing therein which would have suggested modifying Rigandi to arrive at the claimed invention.

For the reasons set forth above, the decision of the examiner to reject claims 1, 2, 4-9, 13, 15 and 16 under 35 U.S.C. § 103 is reversed.

New ground of rejection

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claims 1, 2, 4-9, 13, 15 and 16 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter

¹ The examiner never determined that any of the applied prior art would have made it obvious at the time the invention was made to a person having ordinary skill in the art to have made Rigandi's rigid member 80 resilient.

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the appellants, at the time the application was filed, had possession of the claimed invention.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

Each of the claims under appeal recite that each cantilevered arm member has a stiffness such that the resilient support member supports the user's arch "without the use of any auxiliary supporting mechanism." We have reviewed the application as originally filed and fail to find any

support therein for the above-noted claim limitation.² In fact, it is our view that the application as originally filed contradicts the above-noted claim limitation since other auxiliary supporting mechanisms are disclosed (e.g., upraised arch surface 28 of cushioning member 22; outsole 14). It is our conclusion that the written description requirement of 35 U.S.C. § 112, first paragraph, has not been complied with in this instance since the disclosure of the application as originally filed does not reasonably convey to the artisan that the inventors had possession at that time of the later claimed subject matter (i.e., "without the use of any auxiliary supporting mechanism" as recited in independent claims 1 and 13).

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 4-9, 13, 15 and 16 under 35 U.S.C. § 103 is reversed and a new rejection of claims 1, 2, 4-9, 13, 15 and

² This claim limitation was added to independent claims 1 and 13 in the amendment filed on February 17, 1998 (Paper No. 40).

16 under 35 U.S.C. § 112, first paragraph, has been added pursuant to provisions of 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

REVERSED; 37 CFR § 1.196(b)

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
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JEFFREY V. NASE)	
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