

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. 61

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERNIE L. DEACON and FARIS W. McMULLIN

Appeal No. 1998-0210
Application No. 08/149,193¹

HEARD: JANUARY 10, 2000

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

DECISION ON APPEAL

This is an appeal from the final rejection of claims 113 through 138. These claims constitute all of the claims remaining in the application.

¹ This application is a continuation of application 07/872,819, filed April 24, 1992, now U.S. Patent No. 5,259,129. In this application, it appears that an earlier obviousness-type double patenting rejection (Paper No. 10) may have been withdrawn in light of the filing of a terminal disclaimer (Paper No 11). However, the face of the file and the record in the application do not specify entry of the terminal disclaimer.

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Appellants' invention pertains to a removable golf shoe cleat. A basic understanding of the invention can be derived from a reading of exemplary claim 113, a copy of which appears in "APPENDIX A" to the main brief (Paper No. 40).

As evidence of obviousness, the examiner has applied the documents listed below:

Hyatt et al (Hyatt)	39,575	Aug. 18, 1863
Zaleski et al (Zaleski)	2,491,596	Dec. 20, 1949
Jordan, Jr.	3,583,082	Jun. 8, 1971
Studer (France) ²	493,748	Aug. 20, 1919

The following rejections are before us for review.³

² Our understanding of this document is derived from a reading of a translation thereof prepared in the United States Patent and Trademark Office. A copy of the translation is appended to this opinion.

³ In paragraph 4. of section (11) of the answer ("Grounds of Rejection"), the examiner has included an advisory regarding claims 128 and 129. While the paragraph is labeled "Double Patenting", MPEP Section 706.03(k) referenced by the examiner provides for an objection under 37 CFR 1.75 when claims are substantial duplicates of one another such as in
(continued...)

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1. Claims 119 and 132 stand rejected under 35 U.S.C. § 112, first paragraph as being based upon a specification which does not descriptively support the claimed invention.

2. Claims 113 through 138 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

3. Claim 134 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Jordan, Jr.

4. Claims 113 through 119, 121, 123 through 130, and 132 stand rejected under 35 U.S.C. § 103 as being unpatentable over Jordan, Jr.

5. Claims 120, 133, and 135 stand rejected under 35 U.S.C. § 103 as being unpatentable over Jordan, Jr. in view of Zaleski.

³(...continued)
the present case. Since paragraph 4. does not set forth a rejection of claims 128 and 129 for our review under 35 U.S.C. § 134, no further comment thereon is necessary.

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6. Claims 122, 131, and 136 through 138 stand rejected under 35 U.S.C. § 103 as being unpatentable over Jordan, Jr. in view of Studer or Hyatt.

The full text of the examiner's rejections and response to the argument presented by appellants appears in the answer (Paper No. 41), while the complete statement of appellants' argument can be found in the main and reply briefs (Paper Nos. 40 and 42).

OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered

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appellants' specification and claims,⁴ the applied teachings,⁵ the respective abridged and unabridged videotapes submitted by appellants,⁶ the respective declarations of John R. Cockrell, Jr. and George W. Hamilton, Jr., and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determinations which follow.

⁴ The following obvious informalities are deserving of correction during any subsequent prosecution before the examiner. In claim 113, line 19 "means" clearly should be -- ribs-- to correspond to its antecedent basis "traction ribs" on line 12. In claim 123, line 15 "ribs" obviously should be --means-- for consistency with the recited "traction means" of line 12. In claim 134, line 13 --traction-- should be inserted before "ribs" to effect a consistent antecedent basis for "said traction ribs" of line 15.

⁵ In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

⁶ The label secured to each of the abridged and unabridged videotapes indicates that the videotape was presented at the interview of March 6, 1996. In this decision, we shall focus upon the content of the unabridged videotape.

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At the outset, we particularly note that appellants, in their summary of the invention (main brief, page 4), characterize the invention as a golf cleat that includes a flange that distributes the weight of the golfer over the turf (specification, page 6, lines 1 through 3) and a plurality of ribs on the flange which are presented to the turf to provide traction (specification, page 6, lines 14-15). The impression given by appellants is that the disclosure specifies that the functions of weight distribution and traction are divided between the flange and the ribs. This understanding of appellants' point of view is corroborated by arguments presented, i.e., "the flange supports the golfer's weight and the ribs provide traction" (main brief, page 16).

However, it is the opinion of this panel of the Board that appellants' underlying disclosure does not teach or reasonably infer an absolute division or separation of the functions of weight distribution and traction between the flange and ribs. Our overall technical assessment of the disclosed golf cleat configuration indicates to us that one skilled in the art would comprehend that golfer weight would

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also be borne and distributed by the plurality of ribs and that the flange provides a bottom traction surface. As we see it, a person skilled in this art would appreciate that the nature of the turf or surface upon which a golfer would stand would determine what portions of the cleat would be engaged by the turf or surface. The parts of the specification referenced by appellants do not teach weight distribution by the flange to the exclusion of the ribs. The reference to page 6, lines 1 through 3 must be understood in light of the disclosure that begins on page 5. On lines 13 through 15 of page 5, the traction ribs 15 are specified as being formed on "the bottom traction surface of generally concavo-convex flange 12." This shape of the flange provides a lower bend, seen in Fig. 2, that aids in enlarging the surface area of the cleat to provide more room for the traction ribs 15, and provides "more surface area over which to distribute the weight of the golfer" (page 5, last line to page 6, line 3). The lower bend is such that the cleat is not so pronounced and does not do so much damage to the turf (page 5, lines 10 and 11).

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With the aforementioned lower bend, there is "more angle on the sides of the cleat surface, and the ribs there are presented to the turf more aggressively for more traction" (page 6, lines 13 through 15). Consistent with our view, as expressed above, we are of the opinion that one skilled in this art would recognize, from a technical perspective, that the lower bend of the flange distributes weight and provides a traction surface and that the traction ribs provide for traction and are of a configuration such that they would also distribute weight of the golfer. For example, the inclined side walls of the eight (8) ribs of cross sectional shape (Fig. 8) may be subjected to golfer weight. In the main brief (page 24), in seeking to distinguish an applied reference, appellants argue that with the present invention the flange distributes weight so that it is spread over the tops of grass plants, allowing the ribs or other traction means to extend between and engage the grass plants "substantially without

transmitting any load".⁷ As we see it, implicit in this argument, is appellants' recognition that the ribs do transmit or distribute the weight of the golfer. This is also evident from claims 119 and 132. The underlying disclosure simply does not allocate any percentage of the load borne by the flange and by the ribs. However, we perceive that one skilled in the art would understand that the side surfaces of the eight (8) ribs referenced above would be expected to distribute a measurable amount of load (golfer weight), i.e., not an inconsequential amount of weight as inferred from appellants' earlier noted assessment of the ribs as performing their function "substantially without transmitting any load". This perception on our part is buttressed by the showing in the unabridged videotape, submitted into the record by appellants, wherein a depicted golf cleat with radiating ribs having a triangular shape (swirl embodiment) reveals side surfaces of each rib that can clearly be appreciated as being

⁷ We note that the examiner well appreciated that appellants' traction ribs would also bear weight (answer, page 12).

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capable of distributing a considerable proportion of a golfer's weight in conjunction with weight distribution by portions of the lower surface of the flange exposed between the ribs.

In light of our differing perspective of the underlying teaching of appellants' disclosure, as above, we make note of appellants' objective (main brief, page 6) of pursuing "broader coverage" in the present application commensurate with the "true scope" of the invention, as compared to the narrow coverage obtained for a swirl embodiment (U. S. Patent Nos. 5,259,129 and 5,367,793).

The first rejection

We affirm the rejection of claims 119 and 132 under 35 U.S.C. § 112, first paragraph.

The examiner is of the view (answer, page 4) that the specification, as originally filed, does not provide descriptive support for the recitation that traction ribs

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(claim 119) and traction means (claim 132) "distribute weight in a plurality of different directions" to provide (adequate) traction.⁸ We agree. Our reasoning in support of this conclusion follows.

The test for determining compliance with the written description requirement is whether the disclosure of an 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. Further, the content of the drawings may also be considered in determining compliance with the written description requirement. See Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1562-63, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The purpose of this provision is to ensure that claimed subject matter does not overreach the scope of an inventor's contribution to the field of art described in a

⁸ Claims 119 and 132 were introduced into the application (Paper No. 24) subsequent to the filing thereof.

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specification. See Reiffin v. Microsoft Corp., 214 F.3d 1342, 1345, 54 USPQ2d 1915, 1917 (Fed. Cir. 2000).⁹

As explained earlier in this opinion, we have determined that one skilled in the art would technically recognize that the disclosed ribs (traction means) would not only provide for traction but would be reasonably expected to bear some weight of the golfer, depending upon the nature of the golf turf or surface that a golfer is standing on. Having said this, however, on the particular facts of this case, it is also quite apparent to us that the underlying disclosure would not have expressly or inferentially instructed a person skilled in this art that the ribs or traction means are provided specifically to distribute weight in a plurality of different directions, as now claimed. In other words, one skilled in the art would not have immediately discerned the limitation at issue in claims 119 and 132 from a reading of the original disclosure, i.e., there would not be a recognition that the limitation was encompassed within the original invention. See

⁹ Of interest, are the Guidelines for Examination of Patent Applications Under the 35 U.S.C. § 112, first paragraph, "Written Description" Requirement found at 1242 OG 168 (January 30, 2001).

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Purdue Pharma L.P. v. Faulding Inc., 230 F.3d 1320, 1323, 56 USPQ2d 1481, 1483 (Fed. Cir. 2000) and Waldemar Link GmbH & Co. v. Osteonics Corp., 32 F.3d 556, 558, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994). For these reasons, we determine that the examiner's conclusion that the limitation at issue in each of claims 119 and 132 lacks description in the original disclosure is sound.

The argument of appellants simply does not persuade us that the examiner erred in rejecting claims 119 and 132 under 35 U.S.C. § 112, first paragraph.

In the main brief (pages 11 and 12), appellants argue that the limitation at issue is inherent in what is taught by the specification and that expert declarants¹⁰ Cockrell, Jr. and Hamilton, Jr., focus on the "plurality of different directions" language, and support that position. At this point, we note that, contrary to appellants' understanding, our reading of the Hamilton declaration reveals to us that the

¹⁰ The Declarations of John R. Cockrell, Jr. and George W. Hamilton, Jr. are found in APPENDIX D of the main brief at Tab 1 and Tab 2, respectively.

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declarant does not address the language of claims 119 and 132, i.e., distribution of weight "in a plurality of different directions". Thus, as to the rejection of claims 119 and 132, no further discussion of the Hamilton declaration is deemed necessary.

Declarant Cockrell, Jr., on the other hand, indicates (paragraph 6) that

I further understand that golf cleats described in the specification function by providing adequate traction for normal golfing conditions without puncturing golf turf, by spreading the golfer's weight and engaging the grass blades to distribute force in different directions.

In paragraph 7 through 9, declarant refers to the concept of forces in a plurality of different directions, and specifies page 5, line 32 through page 6, line 15 as support for the concept in addressing "more angle" to present the ribs to the turf more aggressively for more traction.

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Taking into full account the language of claims 119 and 132 and the opinion of declarant Cockrell, Jr., we remain unpersuaded that the content of the specified claims is descriptively supported by appellants' original disclosure. As is evident to us from the Cockrell, Jr. declaration, declarant perceives a basis for forces distributed in a plurality of different directions in the present disclosure. However, this assessment is not commensurate with the language of each of claims 119 and 132 which addresses a distribution of "golfer" weight (not force) in a plurality of directions. Further, like the examiner (answer, page 10), we do not perceive the basis in the disclosure referenced by declarant Cockrell, Jr., for the limitation at issue in each of claims 119 and 132, as appropriate descriptive support, in the patent law sense as mandated by 35 U.S.C. § 112, first paragraph. Appellants' specification (page 5, line 32 to page 6, line 15) provides a discussion of a lower flange bend that at a maximum may be one-half hemispherical such that there is more angle to the sides of a cleat surface, and the ribs there are presented to the turf more aggressively for more traction. Distinct from

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declarant Cockrell, Jr.'s perception, and applying the law of the Federal Circuit, we appreciate appellants' disclosure as informing those skilled in the art as to lower bend shape and rib orientation for gaining more aggressive rib traction, with no hint whatsoever therein of rib or traction means to establish a weight distribution "in a plurality of different directions," as set forth in claims 119 and 132.

It is for this reason that appellants' underlying disclosure cannot be fairly said to provide descriptive support for the limitations of claims 119 and 132.

The second rejection

We reverse the rejection of claims 113 through 138 under 35 U.S.C. § 112, second paragraph, as being indefinite.

In assessing the language at issue under 35 U.S.C. § 112, second paragraph, we are guided by the following principle.

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The definiteness inquiry focuses on whether those skilled in the art would understand the scope of the claim when the claim is read in light of the rest of the specification.

See Union Pacific Resources Co. v. Chesapeake Energy Corp.,
236 F.3d 684, 692, 57 USPQ2d 1293, 1297 (Fed. Cir. 2001).

The examiner considers the phrase "said flange distributing weight . . . against said turf" in independent claims 113, 123, 134, and 138 to be functional, vague, and indefinite in that it is not clear what structural limitations are encompassed by such language. Further, from the examiner's standpoint, the wherein phrases "said cleat provides . . . walked on" (claim 113), "distribute weight" (claim 119 and 132), "said cleat provides . . . golf turf" (claim 123), "said ribs are so dimensioned to provide traction against . . . golf turf" (claim 134), and "said protrusions provide . . . golf turf" (claim 138) are functional, indefinite, and incomplete because the language is not supported by the recitation of sufficient claimed structure.

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We fully appreciate the examiner's point of view as to each of the asserted instances of indefiniteness focused upon. However, while it is true that the language at issue is functional, it is understandable in the context used in the claim, when read in light of the underlying specification. It is important to recognize that there is nothing wrong in defining something by what it does rather than by what it is. See In re Hallman, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981). For these reasons, the language at issue is found to be definite within the meaning of 35 U.S.C. § 112, second paragraph.

The third rejection

We reverse the rejection of claim 134 under 35 U.S.C. § 102(b) as being anticipated by Jordan, Sr.

Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See In re Schreiber, 128 F.3d 1473, 1477,

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44 USPQ2d 1429, 1431 (Fed. Cir. 1997); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); and RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Claim 134 is drawn to a removable golf shoe cleat for use in a golf shoe having a sole, said sole having a plurality of sole attachment means for attachment of removable cleats, said removable golf shoe cleat comprising, inter alia, a plurality of ribs on an opposing lower surface of a substantially circular flange, with the ribs providing traction against turf.

In understanding the meaning of the term "ribs" used by appellants in claim 134, we refer to the underlying specification (page 6) which provides an explicit definition thereof, as follows:

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By "ribs" we mean more than one vertical ridges in the bottom surface of flange 12. The ridges have a crest that is at least one line

We turn now to the Jordan, Jr. reference, a prior art patent specifically referred to by appellants on page 1 of their specification.

Jordan, Jr. discloses a track shoe cleat (Figs. 3 and 4) for use on composition tracks or other modern surfaces formed of natural or synthetic materials such as synthetic turf (column 1, lines 44 through 47 and column 2, lines 1 through 4). The cleat is characterized by a circular disc 16 having a plurality of bristles 18 extending down from the bottom surface thereof. The bristles are of tough plastic, for example, nylon or polycarbonate varieties (column 2, lines 29 through 31). As explained by the patentee (column 2, lines 51 through 53), "the bristle spikes are most effective when they

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result in indentation of a running surface as opposed to penetration of the surface."¹¹

It is quite apparent to us that the bristles taught by Jordan, Jr. do not correspond to the claimed ribs, i.e., ridges having a crest that is at least one line. Jordan, Jr. simply does not disclose a crest of at least one line for the bristles. For the above reason, claim 134 is not anticipated by the Jordan, Jr. document, and the rejection of this claim under 35 U.S.C. § 102(b) must be reversed.

The fourth rejection

On the merits, we reverse the rejection of claims 113 through 119, 121, and 128 through 130 under 35 U.S.C. § 103 as

¹¹ It is particularly important to recognize that the bristles of the Jordan, Jr. patent, as set forth in each of claims 3 and 9 thereof, extend from the bottom surface of the body portions for a distance of between "about 1/16 inch to 1/4 inch" (about 0.0625 inch to 0.250 inch) which range overlaps appellants' rib or ridge height (specification, page 6) of between about 0.03125" (1/32 inch) and 0.125" (1/8 inch).

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being unpatentable over Jordan, Jr.,¹² but we reverse the rejection of claims 123 through 127, and 132 for procedural reasons, as explained below.

Independent claim 113 (with claims 114 through 119, and 121 dependent thereon), akin to claim 134 discussed above in the third rejection, requires "traction ribs". Consistent with our assessment of the Jordan, Jr. document above, and once again taking into account appellants' definition of ribs in the present application, it is our determination that the "traction ribs" of claim 113 are simply not taught by and would not have been suggested by the overall teaching of the Jordan, Jr. patent.

More specifically, it is our opinion that the Jordan, Jr. reference would not have been suggestive of a crest for the bristles that is at least one line. Thus, notwithstanding the examiner's focus upon the obviousness of ascertaining profile

¹² A reading of the examiner's rejection indicates to us that the Jordan, Jr. reference was not fully appreciated as to its teaching (claims 3 and 8) of bristle distance (height), as discussed, supra, in footnote No. 11. Likewise, it is apparent to us from the main brief (page 25) that appellants also did perceive this teaching in the Jordan, Jr. patent.

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thickness, rib height, and cleat material, the evidence of obviousness would not have been suggestive of the claimed invention for the reasons articulated above. It is for this reason that the rejection cannot be sustained.

The rejection of claims 123 through 127, and 132 is reversed for the following procedural reasons. We cannot ascertain the meaning of the "traction means" recitation in claim 123, when that means plus function language (sixth paragraph of 35 U.S.C. § 112)¹³ is read in light of the underlying disclosure, i.e., the claims are indefinite in meaning under 35 U.S.C. § 112, second paragraph.¹⁴ More specifically, the disclosed ribs are seen to be the corresponding structure described in the

¹³ Independent claim 123 sets forth, inter alia, a plurality of "traction means" (line 12) that "provide traction" (line 15) against turf. We consider the "traction means" recitation and corresponding recitation of the function of providing traction, without the recital of any structure for performing the function, to indicate that the "traction means" is a means plus function recitation.

¹⁴ A specification must set forth an adequate disclosure showing what is meant by means-plus-function language in a claim. See In re Donaldson, 16 F.3d 1189, 1194-95, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994)

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specification but the "equivalents" of ribs in this art, as ribs are defined by appellants, are not set forth and not apparent.¹⁵ Thus, since the metes and bounds of the subject matter of claims 123 through 127, and 132 is indeterminate, we cannot address the content of these claims relative to prior art as in the rejection before us. It is appropriate in this situation to reverse the rejection for procedural reasons. To speculate on the meaning of the language in question and consider the applied prior art would be inappropriate. See In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) and In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). Accordingly, we procedurally reverse the rejection of claims 123 through 127 under 35 U.S.C. § 103 and enter a new ground of rejection for these claims, infra, based upon 35 U.S.C. § 112, second paragraph.

¹⁵ Should there be a subsequent understanding of what may constitute a rib equivalent thereby resolving the issue under 35 U.S.C. § 112, second paragraph, it would be incumbent upon the examiner, if prior art is then to be applied to appellants' "traction means" claims, to make a specific determination as to whether a reference teaches a rib equivalent, if the reference fails to teach a rib. Donaldson, 29 USPQ2d at 1852.

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Claims 128 through 130, depend indirectly from independent claim 123 which we have found to be indefinite, supra, in the matter of the recitation of "traction means". However, dependent claim 128 explicitly specifies the indefinite term "traction means" as comprising "ribs", with the term "ribs" of course being definite in meaning and having the definition thereof which we have earlier discussed in this opinion. Based upon the clear recital of "ribs" in claim 128, as was the case with claim 113 addressed above, it is our determination that the ribs of claims 128 through 130 are simply not taught by and would not have been suggested by the overall teaching of the Jordan, Jr. reference. It is for these reasons that the rejection of claims 128 through 130 must be reversed on the merits.

The fifth rejection

We reverse the rejection of claims 120 and 135 under 35 U.S.C. § 103 as being unpatentable over Jordan, Jr. in view of Zaleski on the merits, but procedurally reverse the

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rejection of claim 133 on this same ground, as explained below.

Claims 120 and 135, dependent from claims 113 and 134, respectively, require "ribs", while claim 133, dependent from claim 123, requires "traction means".

The examiner is of the view (answer, pages 7 and 8) that Jordan, Jr. teaches the claimed invention except for the exact shape of the flange portion and that the claimed shape would have been suggested by the showing (Fig. 4) in the Zaleski patent

As to claims 120 and 135, it is clear to us that the teaching of Zaleski simply does not overcome the rib deficiency of the Jordan, Jr. reference, as earlier discussed, notwithstanding its showing (Fig. 4) of a shock absorbing spike for a golf shoe provided with an arcuate spike plate A_1 (flange) and a single spike 27. Thus, we cannot sustain the rejection of these claims.

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We turn now to claim 133, dependent from claim 123. For the reason of the indefiniteness of independent claim 123, as explained above, which indefiniteness is incorporated into dependent claim 133, we must procedurally reverse the rejection of claim 133 on prior art, and make a new rejection thereof, infra, under 35 U.S.C. § 112, second paragraph.

The sixth rejection

We do not sustain the rejection of claims 122, 131, and 136 through 138 under 35 U.S.C. § 103 as being unpatentable over Jordan, Jr. in view of Studer or Hyatt.

In assessing this rejection, it is important to recognize that each of dependent claims 122, 131, 136, and 137 addresses "ribs", while independent claim 138 recites "protrusions".

In the examiner's view, it would have been obvious to form the "projections/ribs" as taught by either Studer or Hyatt in the shoe of Jordan, Jr. We disagree for the following reasons.

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Notwithstanding our full appreciation of the Jordan, Jr. document as a highly relevant reference,¹⁶ it is our viewpoint that one having ordinary skill in the art would not have been motivated to alter the track shoe cleat of Jordan, Jr. based upon either the Studer or Hyatt teaching, as proposed by the examiner. As we see it, such a consequential modification would not have been made since an advantage or benefit would not have been perceived by one having ordinary skill in the art for altering bristles on a track shoe intended for use on turf (Jordan, Jr.) to provide either a radially grooved and hardened hemispherical stud shape recognized as suitable for mountain climbing shoes as disclosed by Studer or a spur or projection ice-creeper configuration intended to roughen and take hold of ice as described by Hyatt. It is for this reason that the rejection of these claims is not sound.

NEW GROUNDS OF REJECTION

¹⁶ We apply the Jordan, Jr. reference in a new ground of rejection for claim 138, infra.

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Under the authority of 37 CFR 1.196(b), this panel of the Board introduces the following new grounds of rejection.

Claims 123 through 127, 132, and 133 are rejected under 35 U.S.C. § 112, first paragraph, as being based upon an underlying disclosure which lacks descriptive support for the invention now claimed.¹⁷

Appellants claimed "traction means" was introduced into the application subsequent to the filing thereof (Papers Nos. 20 and 24). By operation of law (35 U.S.C. § 112, sixth paragraph), a means plus function recitation is construed to cover the corresponding structure, material or acts described in a specification and equivalents thereof. Addressing the particular facts of the present case, appellants only disclosed "ribs", with no mention whatsoever of any alternatives or equivalents thereof at the time of the filing of the application. Thus, one skilled

¹⁷ Of interest, we simply note the Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. § 112 § 6 at 1236 O.G. 98, July 25, 2000.

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in the art, reading the original disclosure, would not have been informed of appellants' interest in or possession of equivalents, now claimed as part of the means plus function recitation. It worthy of noting that if, for example, subsequent to the filing of the application appellants had submitted amendments to the specification and drawing describing a number of rib equivalent structures, this would have violated the prohibition against the introduction of new matter. Therefore, in this case, it is our opinion that by introducing a means plus function recitation into the present application, subsequent to its filing date, appellants have, in effect, added to the original disclosure equivalents of the ribs. Thus, as we see it, this late introduction of a means plus function recitation adds new matter (equivalents) to the application since the means plus function recitation lacks a descriptive basis as to the inclusion of any equivalents in the original disclosure.

Claims 123 through 127, 132, and 133 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

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We cannot ascertain what is intended by the means plus function recitation of "traction means" in claim 123, when that recitation is read in light of the underlying disclosure, i.e., the claims are indefinite in meaning. More specifically, the disclosed ribs are readily found to be the corresponding structure described in the specification (sixth paragraph of 35 U.S.C. § 112) but the "equivalents" of ribs in this art, as ribs are defined by appellants, are not characterized. For this reason, the metes and bounds of claims 123 through 127, 132, and 133 are uncertain or indefinite.¹⁸

¹⁸ Should this new ground of rejection be overcome by way of findings as to what constitutes an equivalent of appellants' disclosed "ribs", the examiner should appropriately consider the application of relevant prior art to the claims. In assessing the equivalency issue, the examiner might consider appellants' unabridged video showing of not only a cleat with swirl or curved ribs but also a cleat with mini-spikes (protrusions). Of course, should a rejection be made under 35 U.S.C. § 103 the evidence of obviousness must be weighed with appellants' evidence of nonobviousness (the commercial success showing of record).

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Claim 138 is rejected under 35 U.S.C. § 102(b) as being unpatentable over Jordan, Jr.¹⁹

This claim is drawn to a removable golf shoe cleat, for use in a golf shoe having a sole, with the sole having a plurality of sole attachment means for attachment of removable cleats, the cleat comprising, inter alia, (a) a flange having a lower surface that distributes weight of a wearer of the cleat over turf being walked on; (b) flange attachment means for removably attaching the cleat to one of the sole attachment means; and (c) a plurality of protrusions²⁰ on the lower surface of the flange, the flange distributing said weight over the turf being walked on while the protrusions provide traction against the turf, wherein the protrusions

¹⁹ The Jordan, Jr. teaching of no bristle penetration (column 2, lines 51 through 53) appears to us to rebut appellants' assertion that "Only applicants/appellants realized that one could achieve traction without damaging penetration." (main brief, page 25).

²⁰ The word "protrusions" does not appear in appellants' specification. We understand the singular form of this term to broadly denote something that protrudes, i.e., projects, sticks out, or juts out from a surrounding surface. Webster's New Collegiate Dictionary, G. & C. Merriam Company, Springfield, Massachusetts, 1979.

provide traction without doing damage to the turf surface being walked on and without puncturing the golf turf.

Jordan, Jr. teaches a track shoe cleat that may be used on synthetic turf, for example. The patentee seeks to overcome a damage problem that accrues from the use of long and sharp metal traction spikes that penetrate a track surface (column 1, lines 21 through 40).²¹ A cleat is disclosed that comprises a disc-shaped body having a plurality of bristles downwardly extending therefrom (column 1, lines 68 through 70). In our opinion, the bristles can reasonably be viewed as protrusions. These bristles are indicated to have sufficient stiffness so that they won't collapse or break when supporting the weight of an athlete (column 2, lines 25 through 27). Jordan, Jr. sets a lower limit of about 10 bristles per square inch (column 2, lines 41, 42). Further, the patentee expressly indicates that "[i]n use, the bristle spikes are most effective when they result in indentation of the running surface as opposed to penetration of the surface" (column 2,

²¹ The problem addressed by the patentee is akin to the problem discussed by appellants (specification, page 1).

lines 51 through 53). It is for the latter reason that "the ends of the bristles need not be pointed" (column 2, lines 53, 54). Claims 3 and 9 of the patent reveal a length between about 1/16 inch and 1/4 inch for the bristles.²² Considering the disclosed density of about 10 bristles per inch, it is clear to us that one skilled in the art would understand that the underside of the circular disc (flange) of Jordan, Jr. would be exposed between bristles and would also be capable of distributing weight over turf being walked on, while the bristles additionally support weight and provide traction. Based upon the overall Jordan, Jr. teaching, it is quite apparent to us that one skilled in this art would have fairly expected the bristles (protrusions) of Jordan, Jr. to provide traction without doing damage to the turf surface being walked on and without puncturing turf. For the above reasons, we conclude that the Jordan, Jr. cleat is capable of performing as the claimed golf shoe cleat. Thus, claim 138 is anticipated by the Jordan, Jr. patent.

²² As earlier indicated in footnote no. 11, this length range overlaps appellant's corresponding height range for the ribs.

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In summary, this panel of the board has:

sustained the rejection of claims 119 and 132 under
35 U.S.C. § 112, first paragraph;

not sustained the rejection of claims 113 through 138
under 35 U.S.C. § 112, second paragraph, as being indefinite;

not sustained the rejection of claim 134 under 35 U.S.C.
§ 102(b) as being anticipated by Jordan, Jr.;

not sustained the rejection of claims 113 through 119,
121, 123 through 130, and 132 under 35 U.S.C. § 103 as being
unpatentable over Jordan, Jr.;

not sustained the rejection of claims 120, 133, and 135
under 35 U.S.C. § 103 as being unpatentable over Jordan, Jr.
in view of Zaleski; and

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not sustained the rejection of claims 122, 131, and 136 through 138 under 35 U.S.C. § 103 as being unpatentable over Jordan, Jr. in view of Studer of Hyatt.

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

In addition to affirming the examiner's rejection of one or more claims, this decision contains NEW GROUNDS OF REJECTION pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63,122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellants may file a single request for rehearing within two months from the date of the original decision

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37 CFR § 1.196(b) also provides that the appellants, 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 (37 CFR § 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. . . .

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

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If the appellants elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for reconsideration thereof.

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, 37 CFR 1.196(b)

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

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JENNIFER D. BAHR)
Administrative Patent Judge)

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