

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 45

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte POL SCARPE SPORTIVE S. R. L.

Appeal No. 98-0478
Control No. 90/004,111¹

HEARD: APRIL 8, 1998

Before McCANDLISH, Senior Administrative Patent Judge, STAAB
and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the final rejection of claims 1 through 14. Inasmuch as the appellant has since canceled

¹ Request, filed January 16, 1996, for the reexamination of U.S. Patent No. 5,044,096, issued September 3, 1991, based on Application 07/448,393, filed December 11, 1989.

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claims 8 through 14, the appeal now involves claims 1 through 7, the only claims presently pending in this reexamination proceeding.

The invention relates to a footwear sole structure which allows transpiration despite being waterproof. Claim 1 is illustrative and reads as follows:

1. Sole structure for footwear, comprising an outsole which comprises at least one lower part and at least one upper part which are mutually united to form said outsole, said lower part defining an area at which a plurality of holes is provided which transverse said lower part, said upper part defining a zone at which through holes are provided which traverse said upper part, said outsole further comprising at least [on] one microporous waterproof membrane means sandwiched between said mutually united upper and lower parts, wherein said lower part defines a lower part perimetric region encompassing said area and said upper part defines an upper part perimetric region encompassing said zone, said lower part perimetric region being a lower part coupling region and said upper part perimetric region being an upper part coupling region, said lower part and said upper part being mutually united at said upper part coupling region and said lower part coupling region in a manner to create a fluid-tight seal at said coupling regions, said membrane means being arranged between said upper part and said lower part inside said coupling regions thereof.

The item relied upon by the examiner as evidence of anticipation and obviousness is:

Ohashi

4,507,880

Apr. 2, 1985

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The items relied upon by the appellant as evidence of patentability are:

The "AFFIDAVIT OF KEITH JOHN PARKER" filed pursuant to 37 CFR § 1.132 on October 18, 1996 (appended to Paper No. 13)

The "AFFIDAVIT OF EGON F. CLAUER" filed pursuant to 37 CFR § 1.132 on August 12, 1997 (appended to Paper No. 29)²

The claims on appeal stand rejected as follows:

a) claims 6 and 7 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention;³

b) claims 1, 2 and 4 through 7 under 35 U.S.C. § 102(b) as being anticipated by Ohashi; and

c) claim 3 under 35 U.S.C. § 102(b) as being anticipated

² These "affidavits" are actually declarations.

³ In a reexamination proceeding, only new or amended claims are examined for compliance with 35 U.S.C. § 112. See In re Etter, 756 F.2d 852, 856-857, 225 USPQ 1, 4 (Fed. Cir.), cert. denied, 474 U.S. 828 (1985); 37 CFR § 1.552; and MPEP § 2258. Claims 6 and 7 are new claims.

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by, or in the alternative under 35 U.S.C. § 103 as being unpatentable over, Ohashi.

Reference is made to the appellant's brief (Paper No. 33) and to the examiner's answer (Paper No. 35) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

As a preliminary matter, it is noted that the appellant requests review of the patentability of claims 6 and 7 as proposed to be amended in the paper filed subsequent to final rejection on August 12, 1997 (Paper No. 29) in the event that the examiner enters the amendments and rejects these claims (see pages 36 and 37 in the brief). The record indicates that the examiner refused entry of these amendments when they were filed (see Paper No. 30) and has maintained this refusal to the present time. Thus, the appellant's request is moot.

Turning now to the 35 U.S.C. § 112, second paragraph, rejection of claims 6 and 7, the examiner contends that "[i]n claims 6 and 7 the phrase 'are made of material which comprises at least one of...' is confusing, vague, and indefinite" (answer, page 3). It is not apparent, however, nor has the examiner cogently explained, why this phrase is

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confusing, vague and indefinite. Accordingly, we shall not sustain the standing 35 U.S.C. § 112, second paragraph, rejection of claims 6 and 7.

As for the standing prior art rejections, Ohashi discloses a sports boot, for example an ice skating boot, which is both water-proof and air permeable. As described by Ohashi,

[t]he boot 1 is comprised of an air permeable boot-shaped substrate 2 and is made of a soft and pliable material, an outer sheath 3 made of a synthetic material forming an outer cover of the substrate 2, air permeable members 4 provided at the sole part of the outer sheath 3 and having a multiplicity of ventilation through-holes 18, porous intermediate layers 5 (FIG. 4) provided between said substrate 2 and the outer sheath 3 at least in portions or areas coextensive as the through-holes 18 of the air permeable members, 4 and a skate blade 6 mounted to the outsole of the sheath 3. The numeral 7 in the drawing denotes metal hooks for engaging a bootstring (not shown).

The substrate 2 takes the form of a boot or shoe as shown in FIG. 3 and may be made of soft and pliable material such as natural leather or synthetic leather. Fiberous [sic, fibrous] materials may also be employed if desired. The substrate 2 is preferably endowed with air permeability. When an air impermeable material is employed as substrate material, it is necessary to provide a multiplicity of small openings 9 as shown in FIGS. 4 and 5 for permitting circulation of air. These openings 9 are preferably bored in a predetermined area of a sole part 8. The entire

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substrate 2 does not have to be made of one and the same material. Thus the sole part 8 can be made of harder material than a side portion 10 depending on the purposes and functions of the shoe.

The outer sheath 3 made of synthetic material is formed in situ around the outer side of the substrate 2, and the air permeable member 4 is fitted into an opening in the sole part 11 of the outer sheath 3.

. . . In FIGS. 3 and 4, a portion of the sheath 3 designated by the reference numeral 12 is formed of harder plastic material, while another portion designated by the reference numeral 13 is formed of softer plastic material.

The air permeable member 4 fitted into the mating opening in the sole portion 11 of the outer sheath 3 is formed of natural rubber, synthetic rubber or other synthetic material. Preferably, the air permeable member 4 is formed of a synthetic material having certain resiliency and being of the same type as the synthetic material of the outer sheath 3 [column 2, line 41 through column 3, line 26].

As for the manner in which the boot 1 is made, Ohashi teaches

[f]irst of all, the substrate 2 is formed of leather. The sole part of the substrate 2 is made of hard leather and the side or upper is made of soft leather. The sole part 8 is formed with a multiplicity of small openings 9 when the substrate 2 is not formed of air permeable material. Then,

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the layers 5 of porous synthetic material are formed in situ in any suitable portions of the sole part 8 of the substrate 2.

The air permeable members or units 4 are formed as mentioned above by a metal mold. With these members 4 applied to the layers 5 of porous synthetic material laminated to the bottom surface of the substrate 2, synthetic material is cast in situ about the outer surface of the substrate 2 by relying upon injection molding. In this manner, the sheath 3 is formed as one with the substrate 2. . . . In this manner, there is provided the boot 1 in which the substrate 2 and the outer sheath 3 are formed as one and the air permeable members 4 are also secured with the outer sheath 3 [column 5, line 55 through column 6, line 11].

With regard to the standing 35 U.S.C. § 102(b) rejections of claims 1 through 7 as being anticipated by Ohashi, it is well settled that anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). It is not

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necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference.

Kalman v. Kimberly Clark Corp., 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Claims 1 and 5, the two independent claims on appeal, recite a sole structure for footwear comprising an outsole which comprises at least one lower part and at least one upper part which are mutually united or monolithic, and at least one microporous waterproof membrane means sandwiched between the upper and lower parts. The examiner's determination (see pages 3 through 5 in the answer) that Ohashi's outer sheath sole part 11/air permeable members 4, substrate sole part 8, and porous intermediate layers 5 meet the limitations in claims 1 and 5 defining the features of the lower part, the upper part, and the at least one microporous waterproof membrane means, respectively, is well taken. Nonetheless, the appellant's "affidavit" evidence, which is unrefuted by the examiner, establishes that one of ordinary skill in the art would consider Ohashi's substrate sole part 8 to be an insole

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component rather than an outsole component. Indeed, the Ohashi reference itself implies that the outer sheath 3, i.e., outer sheath sole part 11 and air permeable members 4, forms the outsole of the boot disclosed therein (see column 2, line 51). Thus, the evidence before us, taken as a whole, shows that one of ordinary skill in the art would not read the recitation in claims 1 and 5 of an outsole comprising at least one lower part, at least one upper part and at least one microporous waterproof membrane means sandwiched therebetween on Ohashi's outer sheath sole part 11/air permeable members 4, substrate sole part 8, and porous intermediate layers 5. Since Ohashi does not disclose any other structure which meets this recitation, the examiner's determination that Ohashi anticipates the subject matter recited in these claims must fall. Accordingly, we shall not sustain the standing 35 U.S.C.

§ 102(b) rejections of claims 1 and 5, and of claims 2 through 4, 6 and 7 which depend therefrom, as being anticipated by Ohashi.

Nor shall we sustain the standing 35 U.S.C. § 103 rejection of claim 3 as being unpatentable over Ohashi. In

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addition to not teaching a sole structure comprising an outsole as recited in parent claim 1, Ohashi would not have suggested same to one of ordinary skill in the art.⁴

The following rejection is entered pursuant to 37 CFR § 1.196(b).

Claims 6 and 7 are rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which fails to comply with the written description requirement of this section of the statute.

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. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

⁴ The test for obviousness is what the teachings of the prior art would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

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The originally filed disclosure in Application 07/448,393, which matured into the patent involved in this reexamination proceeding, would not reasonably convey to the artisan that the inventor had possession at that time of a sole structure as now recited in claims 6 and 7 wherein the upper and lower parts of the outsole are made of material which comprises "at least one of rubber material and synthetic material." The originally filed disclosure indicates instead that these components are made of rubber or synthetic material.

Finally, the following observations are made pursuant to 37 CFR § 1.552(c). The originally filed disclosure in Application 07/448,393 fails to make any express mention of the "outsole" limitation in claims 1 and 5 which was dispositive in our determination that the examiner's prior art rejections of claims 1 through 7 could not be sustained. The "outsole" terminology was first introduced into the specification and claims in Application 07/448,393 in a paper filed subsequent to final rejection on April 8, 1991 (Paper No. 8). Notwithstanding the accompanying arguments that such terminology did not add new matter, and the examiner's

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implicit acceptance thereof, the introduction of the "outsole" terminology into the specification and claims after the filing of Application 07/448,393 raises serious questions as to whether the appellant's specification complies with the written description requirement of 35 U.S.C.

§ 112, first paragraph, with regard to the subject matter now recited in claims 1 through 7. Be this as it may, however, the current state of reexamination law and practice precludes this matter from being resolved in this proceeding since the "outsole" terminology is contained in the specification and claims of the patent. See In re Etter, supra; 37 CFR § 1.552; and MPEP § 2258.

In summary:

a) the decision of the examiner to reject claims 1 through 7 is reversed; and

b) a new rejection of claims 6 and 7 is entered pursuant to 37 CFR § 1.196(b).

This decision contains a new ground 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)).

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Administrative Patent Judge)	APPEALS AND
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