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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LEVI J. PATTON¹,

Appeal 2018-000461
Application 13/590,892
Technology Center 1700

Before MARK NAGUMO, BRIAN D. RANGE, and
SHELDON M. MCGEE, *Administrative Patent Judges*.

NAGUMO, *Administrative Patent Judge*.

DECISION ON APPEAL

Levi J. Patton (“Patton”) timely appeals under 35 U.S.C. § 134(a) from the Final Rejection² of all pending claims 1–20. We have jurisdiction. 35 U.S.C. § 6. We reverse for reasons well-stated by Patton.

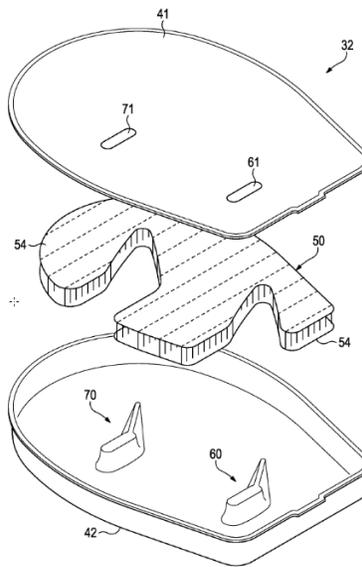
¹ The real party in interest is identified as Nike, Inc. (Appeal Brief, filed 18 May 2017 (“Br.”), 2.)

² Office Action mailed 21 December 2016 (“Final Rejection”; cited as “FR”).

OPINION

A. Introduction³

The subject matter on appeal relates to a structurally reinforced fluid-filled chamber **32**⁴ disclosed to be especially useful as an element of the midsole of a shoe that serves to “further attenuate forces, enhance stability or influence the motions of the foot.” (Spec. 1 [02].) As illustrated in Figure 5, shown below, chamber **32** comprises two largely planar barrier portions **41**



{Figure 5 shows an exploded perspective view of chamber **32**}

and **42** that face one another and that are sealed to one another at peripheral bond **44** (see Figure 7, *infra*) to contain a fluid, e.g., air and octafluoropropane. (*Id.* at 10 [38].)

³ Application 13/590,892, *Fluid-filled chamber with a stabilization structure*, filed 21 August 2012. We refer to the “892 Specification,” which we cite as “Spec.”

⁴ Throughout this Opinion, for clarity, labels to elements are presented in bold font, regardless of their presentation in the original document.

As shown in greater detail in Figures 7 and 8C–8E, below,

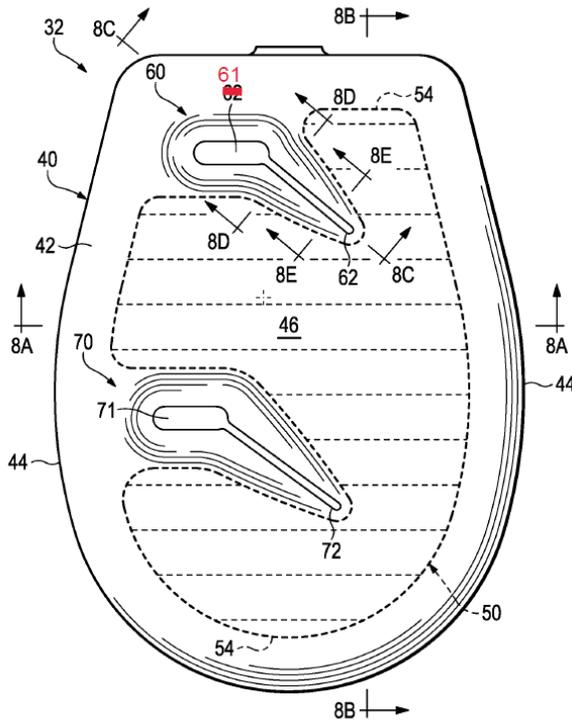


Figure 7

{Figure 7: bottom plan view (annotations added)⁵}

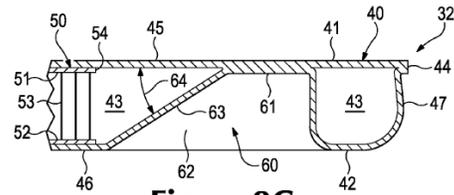


Figure 8C

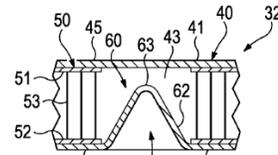


Figure 8D

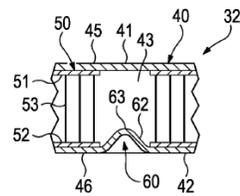


Figure 8E

{Figures 8C–8E: cross sections as defined by section lines 8C, 8D, and 8E in Figure 7}

in an embodiment (independent claims 1 and 10), chamber 32 comprises one or more stabilization structures (60, 70), which are said to restrict or limit distortion of chamber 32 due to shearing forces arising during walking or running while wearing the shoe. (*Id.* at 14 [49].) Stabilization structures 60 and 70 are formed by molding second barrier portion 42 to provide an elevated flat region that will form interior bond 61 with first barrier portion 41, and at least one fold 62, the apex 63 of which extends from the region of bond 61 back to the main plane 46 of second barrier portion 42 at a

⁵ In Figure 7, leftmost label “62” has been changed to “61,” consistent with corresponding label “71” and with Figure 8C.

constant angle **64**. (*Id.* at 12 [43]–[46]; see Figure 8C; Figures 8D and 8E show cross sections at lower elevations of fold **62**.)

In a further embodiment (dependent claims 6 and 12), tensile member **50** fills interior void **43** of chamber **32**. (Spec. 13 [48].) As shown in Figure 5, *supra*, peripheral edge **54** of tensile member **50** defines indentations that extend at least partially around any stabilization structures **60**, **70**. As indicated in Figures 8C–8E, tensile member **50** is comprised of first or upper layer **51**, second or lower layer **52**, and a plurality of connecting members **53** that extend between layers **51** and **52** and are arranged in various substantially parallel rows. (*Id.* at 10 [39].) Tensile member **50** is secured to each of barrier portions **41** and **42**, and the connecting members **53** are placed in tension by the outward force of the pressurized fluid in void **43** on barrier **40**. (*Id.*) Thus, “tensile member **50** prevents barrier **40** from expanding outward or otherwise distending due to the pressure of the fluid.” (*Id.*)

Claim 1 is representative and reads:

A chamber [**32**] comprising:

- a first barrier portion [**41**]
 - formed from a polymer material and
 - defining a first surface [**45**] of the chamber,
 - a majority of the first surface coinciding with a first plane;
- a second barrier portion [**42**]
 - formed from the polymer material and
 - defining a second surface of the chamber,
 - the first surface [**45**] being opposite the second surface [**46**] and
 - a majority of the second surface coinciding with a second plane;

a peripheral bond [44] that joins the first barrier portion [41] and the second barrier portion [42] to form an interior void within the chamber and seal a fluid within the interior void;

a first interior bond [61] that is spaced inward from the peripheral bond [44] and joins the first barrier portion [41] and the second barrier portion [42]; and

a first fold [62] in the second barrier portion [42] that extends away from the first interior bond [61] and through a majority of a thickness of the chamber,

the first fold [62] including

a first portion of the second barrier portion [42] and

a second portion of the second barrier portion [42]

that extend toward one another and

are joined at a first junction [63] that is formed at a first angle [64] relative to the first surface,

the first junction [63] extending continuously from the first interior bond [61] to the second plane [46] at the first angle [64].

(Claims App., Br. 21; some formatting, emphasis, and bracketed labels to elements illustrated in the Figures added.)

The Examiner maintains the following grounds of rejection:^{6, 7}

- A. Claims 1–20 stand rejected under 35 U.S.C. § 112(1) for lack of adequate written description.
- B. Claims 1–20 stand rejected under 35 U.S.C. § 112(2) for indefiniteness.

⁶ Examiner’s Answer mailed 13 September 2016 (“Ans.”).

⁷ Because this application was filed before the 16 March 2013, effective date of the America Invents Act, we refer to the pre-AIA version of the statute.

- C. Claims 1, 2, 4, 5, 9, 10, 11, 15, 16, 17, and 19 stand rejected under 35 U.S.C. § 102(b) in view of Marvin.⁸
- C1. Claims 3 and 18 stand rejected under 35 U.S.C. § 103(a) in view of Marvin.
- C2. Claims 6, 7, 8, 12, 13, 14 and 20 stand rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Marvin and Hazenberg.
- D. Claims 1, 2, 4, 6, 7, 8, 9, 16, 17, 19, and 20 stand rejected under 35 U.S.C. § 102(b) in view of Hazenberg.⁹
- D1. Claims 3, 5, 10, 11, 12–15, and 18 stand rejected under 35 U.S.C. § 103(a) in view of Hazenberg.

B. Discussion

The Board’s findings of fact throughout this Opinion are supported by a preponderance of the evidence of record.

We select claim 1 as representative. The rejections of remaining independent claim 10, and the separate rejections of dependent claims 6 and 12 raise similar issues that do not merit separate discussion.

The Examiner finds that the terms “first junction,” “first portion, and second portion,” recited in claim 1, are new matter. (FR 3, ¶ 7.) In the Examiner’s words, “[t]he specification as originally filed does not use or provide a definition for the word “junction” with respect to the claimed invention nor does it define a ‘first portion’, ‘second portion’, . . . with

⁸ William Marvin et al., *Cushioning sole for an article of footwear*, U.S. Patent Application Publication 2004/0261293 A1 (2004).

⁹ K. Pieter Hazenberg et al., *Article of footwear having a fluid-filled chamber with flexion zones*, U.S. Patent No. 7,555,851 B2 (2009) (assigned to Nike, Inc.).

respect to the second barrier coating . . . , therefore, the terms/phrases are new matter.” (*Id.* at ¶ 8.)

The Examiner determines further that the meaning of the term “junction,” as used in claim 1, is not clear, and is not consistent with common dictionary definitions. (*Id.* at 3–4, ¶ 7.) In particular, the Examiner states, “[i]t is not clear if the ‘first junction’ is in reference to a special type bonding or joining structure that is present in/on the second barrier coating, or if it is simply in reference to some arbitrary position along the second barrier coating.” (*Id.* at 4, ¶ 8.) Similarly, the Examiner determines that the meanings of the terms “first portion” and “second portion” are not clear: “[i]t is not clear if these are simply arbitrary portions of the second barrier coating, or if they are portions of the second barrier layer that are comprised of different materials and joined in a special manner at the ‘first junction’.” Moreover, the Examiner determines that the phrase in claim 1, “the first junction extending continuously from the first interior bond to the second plane at a first angle” is indefinite because “it is unclear what structure is being claimed with respect to the claimed invention.” (*Id.* at 5, ¶ 10.) Referring to the dictionary definitions cited earlier, the Examiner reasons that “it appears that the term ‘junction’ refers to a point or area where two things are joined, however, it is not clear how a single point, i.e. junction, can be recited as ‘extending continuously from the first interior bond to the second plane at a first angle.’” (*Id.*)

Based on this indefiniteness analysis, the Examiner provides the following interpretation: “[t]he terms are interpreted as arbitrary features with respect to the claimed invention, and Marvin et al. is viewed as meeting these limitations until further clarification is provided by the Applicant.”

(*Id.* at 9, 2d full sentence.) The Examiner reads the limitations of claim 1 on the hollow fluid container disclosed to act as a cushioning mechanism by Marvin, as shown in the annotated version of Marvin, Figure 2E, reproduced below from the Final Rejection.

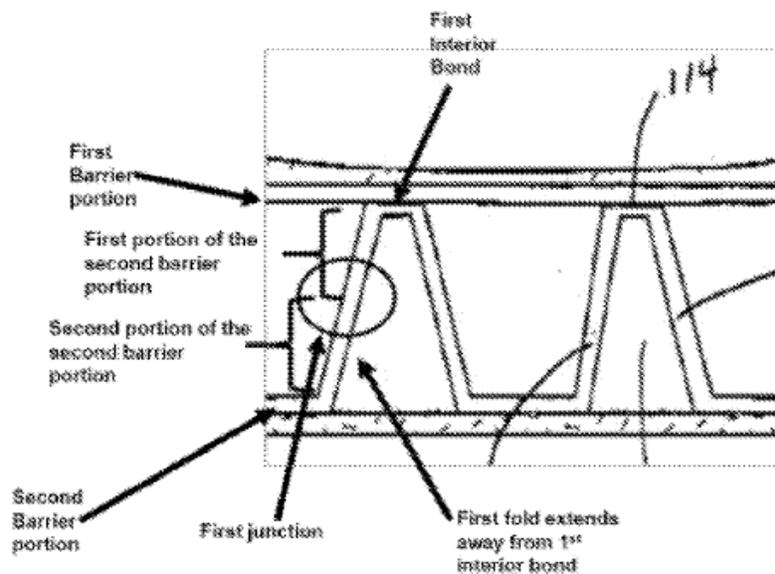


Figure 2: Zoomed in portion of Figure 2E from US 2004/0261293

{Marvin, Figure 2E, annotated by the Examiner (FR 10.)}

Similarly, the Examiner determines that “[t]he terms are interpreted as arbitrary features with respect to the claimed invention, and Hazenberg et al. is viewed as meeting these limitations until further clarification is provided by the Applicant.” (*Id.* at 13, ¶ 32.) The Examiner reads the limitations of claim 1 on the structure of Hazenberg, Figure 11A, as shown in the annotated version from the Final Rejection on the next page.

{Hazenberg Figure 11A, inset, annotated by the Examiner, is shown below }

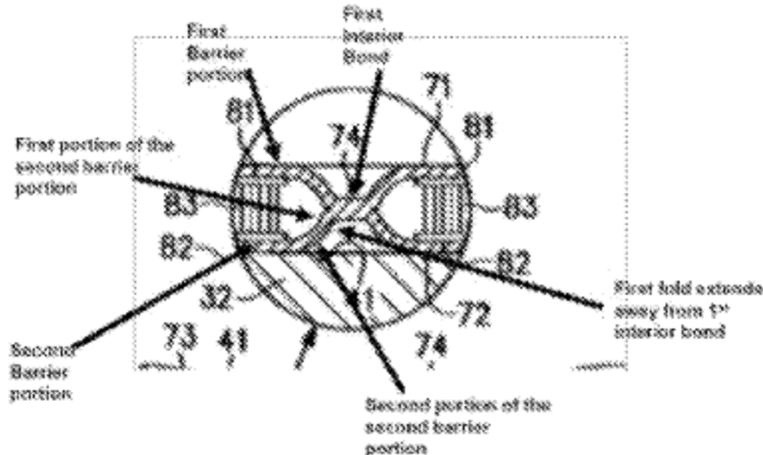


Figure 4: Zoomed portion of Figure 11A, US 7,555,581

{Hazenberg Figure 11A, inset, shows a fluid-filled chamber for foot ware }

The inquiry into whether the written description requirement of 35 U.S.C. § 112 is met is a question of fact. *Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010)(en banc). Before the USPTO, questions of fact are resolved by the preponderance of the evidence of record. *In re Epstein*, 32 F.3d 1559, 1564 (Fed. Cir. 1994) (“Preponderance of the evidence is the standard that must be met by the PTO in making rejections.”). Our reviewing court has explained that “[t]he purpose of the written description requirement is to prevent an applicant from later asserting that he invented that which he did not; the applicant for a patent is therefore required to ‘recount his invention in such detail that his future claims can be determined to be encompassed within his original creation.’ *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1330 (Fed. Cir. 2003), quoting *Vas-Cath v. Mahurkar*, 935 F.2d 1555, 1561 (Fed. Cir. 1991) (internal quote and citation omitted). It is long settled that “the invention claimed does not have to be described *in ipsius verbis* [in identical language] in order to satisfy the description requirement of § 112.” *In re*

Lukach, 442 F.2d 967, 969 (CCPA 1971). Indeed, under certain circumstances, “drawings alone may provide a written description of an invention as required by § 112, first paragraph.” *Vas-Cath*, 935 F.2d at 1555. In any event, the predecessor to our reviewing court held that “[t]he burden of showing that the claimed invention is not described in the specification rests on the PTO in the first instance, and it is up to the PTO to give reasons why a description not *in ipso verbis* is insufficient.” *In re Wertheim*, 541 F.2d 257, 265 (1976).

Patton provides a detailed explanation (which is consistent with the summary provided *supra*) of what the alleged “new” terms mean, with specific reference to Figures 7, 8C, and 8D, reproduced *supra*. (Br. 6–8.) The Examiner’s interpretations, summarized *supra*, are strained, and are not supported by any analysis showing how the ’892 Specification might suggest the broad interpretation proposed by the Examiner. Nor does the Examiner explain satisfactorily why the interpretation proposed by Patton is faulty or misleading. We conclude that the Examiner has not carried the burden of showing, more likely than not, that the objected language now used to describe the invention is not adequately supported by the original disclosure.

We reverse the rejection for lack of written description.

The Examiner has also not shown why Patton’s explanations of the meanings of the objected to terms in the claims are inaccurate, or are contradicted by or inconsistent with the Specification or the understanding of persons having ordinary skill in the relevant arts. Accordingly, we reverse the rejection for indefiniteness.

The legal error in the Examiner’s position, that the “terms are [properly] interpreted as arbitrary features with respect to the claimed invention” (FR 9, ¶ 24; *id.* at 13, ¶ 32; Ans. 7, ¶ 17, *id.* at 11, ¶ 25), was explained long ago by the predecessor to our reviewing court: “We think the examiner and the board were wrong in relying on what at best are speculative assumptions as to the meaning of the claims and basing a rejection under 35 U.S.C. § 103 thereon.” *In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962). Or, as the court put the matter more bluntly, “[i]f no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious—the claim becomes indefinite.” *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). On the merits, the particular interpretation advanced by the Examiner has been shown to be without merit, and the Examiner has not come forward with any reasonable argument supported by credible evidence to disregard the interpretation advanced by Patton.

Because the Examiner’s claim interpretation is erroneous—the objected terms are not properly interpreted as arbitrary features of the prior art structures—rather, they refer to specific structures described by the Specification and illustrated in the Figures—we reverse the findings of anticipation of the independent claims. No findings regarding the further limitations recited in the dependent claims cure the fundamental defects of the applied prior art with respect to the independent claims. Therefore, the rejections of the remaining claims for anticipation and for obviousness are also reversed.

C. Conclusion

In summary:

Claims Rejected	Basis	Affirmed	Reversed
1–20	§ 112(1), written description		1–20
1–20	§ 112(2), indefiniteness		1–20
1, 2, 4, 5, 9, 10, 11, 15, 16, 17, and 19	§ 102 Marvin		1, 2, 4, 5, 9, 10, 11, 15, 16, 17, and 19
1, 2, 4, 6, 7, 8, 9, 16, 17, 19, and 20	§ 102 Hazenberg		1, 2, 4, 6, 7, 8, 9, 16, 17, 19, and 20
3, 5, 10, 11, 12–15, and 18	§ 103 Hazenberg		3, 5, 10, 11, 12–15, and 18
6, 7, 8, 12, 13, 14 and 20	§ 103 Marvin and Hazenberg		6, 7, 8, 12, 13, 14 and 20
Overall Outcome			1–20

REVERSED