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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERT A. HANSEN and BJORN RYDIN

Appeal 2019-001799
Application 12/479,258
Technology Center 1700

Before LINDA M. GAUDETTE, WESLEY B. DERRICK, and MONTÉ T. SQUIRE, *Administrative Patent Judges*.

SQUIRE, *Administrative Patent Judge.*

DECISION ON APPEAL[1]

Appellant[2] appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1, 4, 5, 9–14, and 23–35.[3] We have jurisdiction under 35 U.S.C. § 6(b).

[1] In this Decision, we refer to the Specification filed June 5, 2009 ("Spec."); Non-Final Office Action mailed May 9, 2018 ("Non-Final Act."); the Appeal Brief filed July 13, 2018 ("Appeal Br."); the Examiner's Answer mailed Nov. 2, 2018 ("Ans."); and the Reply Brief filed Dec. 27, 2018 ("Reply Brief").

[2] We use the word "Appellant" to refer to "Applicant" as defined in 37 C.F.R. § 1.42(a). Appellant identifies Albany International Corp. as the real party in interest. Appeal Br. 3.

[3] Claims 2, 3, 6–8, 15–22, and 26–48 are withdrawn or canceled. Appeal Br. 4.

We REVERSE.

CLAIMED SUBJECT MATTER

Appellant's disclosure relates to a laminated pad structure, which includes axially and radially elastic hollow members and relatively inelastic yarns in various patterns. Abstract, Spec. 3:4–7, 4:24–30, 6:11–15.

Regarding the "laminated structure" recitation of the claimed subject matter, the Specification discloses that the pad's structure includes, for example, two independently woven fabric layers with a hollow elastic member layer there between and a binder yarn system weaving between the layers of the laminate. Spec. 6:11–15. Figure 10A of the Specification also shows the claimed laminated structure with the hollow elastomeric member 40 and functional yarns 20 and 30 laminated between two fabrics, as described at page 6 of the Specification. Spec. 16:17–24, Figs. 10A, 10B. The structure is also said to have a high degree of both compressibility under an applied normal load and excellent recovery (resiliency or spring back) upon removal of that load. Spec. 1:11–13, 3:1–8, Abstract.

Claim 1 illustrates the claimed subject matter on appeal and is reproduced below from the Claims Appendix to the Appeal Brief (Appendix I):

> 1. A compressible resilient pad, wherein the pad includes a structure having an original thickness, the structure comprising:
>
> a plurality of parallel longitudinal yarns;
>
> a plurality of parallel cross-direction yarns;
>
> a plurality of parallel hollow elastic members;
>
> ***wherein the structure is a laminated structure*** of independent layers not interwoven comprising;
>
> a first layer of the parallel yarns running in either the longitudinal or the cross-direction;

> a second layer of the parallel hollow elastic members on one side of the first layer, the second layer's hollow elastic members running in the longitudinal or cross-direction different from that of the first layer; and
>
> a third layer of the parallel yarns on the opposite side of the second layer as the first layer and running in the same direction as those of the first layer, wherein the parallel yarns of the third layer are aligned such that the parallel yarns of the third layer nest between the parallel yarns of the first layer without interfering with one another to allow the structure to compact to form a planar structure in a through thickness direction when the pad is under a pressure load;
>
> wherein the hollow elastic members are elastic in their thickness or radial direction and length or axial direction such that under the pressure load the hollow elastic members stretch and compress to conform to the nesting and, the structure springs back to substantially the original thickness after removal of the pressure load.

Appeal Br. 20 (Claims Appendix I) (key disputed claim language italicized and bolded).

REFERENCES

The Examiner relies on the following prior art references as evidence in rejecting the claims on appeal:

Name	Reference	Date
Scott	US 3,095,258	June 25, 1963
Rohlig	US 3,630,824	Dec. 28, 1971
Gaffney	US 3,723,218	Mar. 27, 1973
Wiegand	US 4,088,805	May 9, 1978
Basse et al. ("Basse")	US 5,436,052	July 25, 1995

REJECTIONS

On appeal, the Examiner maintains (Ans. 3) the following rejections:

1. Claims 1, 4, 5, 9–14, and 23–25 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Basse in view of Scott and/or Rohlig, as evidenced by Gaffney ("Rejection 1"). Ans. 3–5.

2. Claims 1, 4, 5, 9–14, and 23–25 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Basse in view of Wiegand, Scott, and/or Rohlig, as evidenced by Gaffney ("Rejection 2"). *Id.* at 6–8.

3. Claims 1, 4, 5, 9–14, and 23–25 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Wiegand in view of Basse, Scott, and/or Rohlig ("Rejection 3"). *Id.* at 9–11.

OPINION

Rejection 1

The Examiner rejects claims 1, 4, 5, 9–14, and 23–25 under § 103(a) as obvious over the combination of Basse, Scott, and Rohlig (Ans. 3–5), which we refer to as Rejection 1.

The Examiner determines that the combination of Basse, Scott, and Rohlig suggests a pad satisfying all of the limitations of claim 1 and concludes the combination would have rendered the claim obvious. *Id.* at 3–5. Regarding the "laminated structure" recitation of claim 1, the Examiner relies on Basse, as evidenced by Gaffney, for teaching or suggesting that element of the claim. *Id.* at 4 (citing Basse 2:43–51, 4:22–39; Gaffney 1:12–21, 1:45–48).

Appellant argues the Examiner's rejection of claim 1 should be reversed because the cited art does not teach or suggest a "laminated structure," as recited in the claim. Appeal Br. 7–10; Reply Br. 2–3. Appellant contends that, in contrast to the claimed laminated structure, Basse teaches a net made up of three layers of offset strands wherein the strands in the outer planes are connected to strands in the middle plane at points of intersection. Appeal Br. 9–10 (citing Basse, Abstract, 2:47–51, 2:67–3:2).

Appellant's argument is persuasive because the Examiner has not established by a preponderance of the evidence that the cited art teaches or suggests a "laminated structure," as claimed. The Examiner also has not provided adequate reasoning or directed us to persuasive evidence in the record sufficient to establish one of ordinary of skill would have combined the cited art to arrive at the claimed invention. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (holding the examiner bears the initial burden of establishing a prima facie case of obviousness).

The portions of Basse the Examiner cites and relies upon in the rejection do not teach or suggest a "laminated structure," as required by the claim. *See* Ans. 3–5. Rather, as Appellant correctly points out (Appeal Br. 9–10), Basse is directed to and teaches a net and, in particular, a spacing net with strands arranged in three planes and strands in two planes oriented equidirectionally. Abstract, 1:26–29, 2:43–46. Although Basse teaches that the inner strands of the net may be elastically deformable and have good resilience (Basse 1:40–45, 1:50–52), Basse does not teach or suggest that the net is a laminated structure, as claimed.

Although the Examiner cites and relies on Gaffney as an evidentiary reference (Ans. 4), Gaffney does not cure the deficiencies in Basse's disclosure. Like Basse, Gaffney does not teach or suggest a laminated structure, as recited in the claim. Rather, Gaffney is directed to a method for manufacturing net and net-like products and discloses an extrusion process for forming an "extruded net" from molten polymer and that the nets can be bonded during co-extrusion. Gaffney 1:3–4 (Title), 1:10–21 (Abstract), Figs. 1, 2. Although Gaffney discusses co-extruding a plurality of strands or continuous sheets from molten polymer via multiple die members and contacting them to cause bonding to form a net (Gaffney 1:14–21, 1:26–31), there is no teaching or suggestion that the net structure formed via Gaffney's co-extrusion process is a laminated structure, as recited in the claims.

Thus, for principally the same reasons provided by Appellant at pages 7–10 of the Appeal Brief and pages 2–3 of the Reply Brief, and in light of the claim language and the Specification's disclosure regarding the claimed laminated structure having two independently woven fabric layers with a with the hollow elastic member layer there between and a binder yarn system weaving between the layers of the laminate (Spec. 6:11–15), we are not persuaded the Examiner has established by a preponderance of the evidence that the net taught by Basse falls within the scope of or would have reasonably suggested to one of ordinary skill a laminated structure as claimed.

Based on Basse's disclosures, we are also not persuaded Basse is analogous art to the claimed invention. Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the

field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Klein*, 647 F.3d. 1343, 1348 (Fed. Cir. 2011) (citing *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004)). "A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992).

Here, the claimed invention is directed to a laminated structure having, for example, two independently woven fabric layers with a hollow elastic member layer there between and a binder yarn system weaving between the layers of the laminate. Spec. 6:11–15, 16:17–24, Figs. 10A, 10B. The Specification discloses the claimed laminated structure as being a fabric structure, which conforms under pressure and springs back to substantially the original thickness after removal of the pressure, for use as a pad in, for example, sports shoes, running shoes, boots, and heels/soles for athletic shoes. *Id.* at 1:10–13, 1:21–23, 3:8–9. In contrast to the claimed invention, however, Basse is in the field of netting and, as previously discussed above, directed to nets and netting structures. *See* Basse, Abstract, 2:47–51, 2:67–3:2.

Moreover, based, for example, on Basse's teachings regarding a net for use as a spacing net or protective net for highly finished surfaces (Basse 1:9–10), we are not persuaded that Basse logically would have commended itself to an inventor's attention in considering the problem addressed by the claimed invention. Given the clear differences between Basse's net and netting structures and the claimed laminate structure in the

form of a fabric having woven layers with a hollow elastomeric layer there between, it is not apparent why one of ordinary skill in the art would have been led to Basse's disclosures regarding netting in considering, for example, the problem of developing a shock-absorbing laminated pad structure for use in sports and running shoes.

Thus, on the record before us, we are not persuaded that Basse is analogous art.

We, therefore, do not sustain the Examiner's rejection of claim 1 and determination that it would have been obvious to combine the teachings of the cited art to arrive at the subject matter recited in the claim. Because claims 4, 5, 9–14, and 23–25 depend from claim 1, we also do not sustain the Examiner's rejection of these claims.

Accordingly, we reverse the Examiner's rejection of claims 1, 4, 5, 9–14, and 23–25 under 35 U.S.C. § 103(a) as obvious over the combination of Basse, Scott, and/or Rohlig.

Rejections 2 and 3

The Examiner rejects claims 1, 4, 5, 9–14, and 23–25 under § 103(a) as obvious over the combination of Basse, Wiegand, Scott, and/or Rohlig (Ans. 6–8), which we refer to as Rejection 2, and the combination of Wiegand, Basse, Scott, and/or Rohlig (Ans. 9–11), which we refer to as Rejection 3.

The foregoing deficiencies in the Examiner's findings and analysis regarding the Basse reference discussed above in reversing the Examiner's Rejection 1, including our determination that Basse is non-analogous art, are not remedied by the Examiner's findings regarding the additional references

or combination of references cited in support of the second and third grounds of rejection.

Accordingly, for principally the same reasons stated above for reversing Rejection 1, we reverse the Examiner's rejections of claims 1, 4, 5, 9–14, and 23–25 under 35 U.S.C. § 103(a) as obvious over the combination of Basse, Wiegand, Scott, and/or Rohlig, and the combination of Wiegand, Basse, Scott, and/or Rohlig.

CONCLUSION

In summary:

Claim(s) Rejected	35 U.S.C. §	References/Basis	Affirmed	Reversed
1, 4, 5, 9–14, 23–25	103(a)	Basse, Scott, Rohlig		1, 4, 5, 9–14, 23–25
1, 4, 5, 9–14, 23–25	103(a)	Basse, Wiegand, Scott, Rohlig		1, 4, 5, 9–14, 23–25
1, 4, 5, 9–14, 23–25	103(a)	Wiegand, Basse, Scott, Rohlig		1, 4, 5, 9–14, 23–25
Overall Outcome				**1, 4, 5, 9–14, 23–25**

REVERSED